Chapter 700 Examination of Applications

701 Statutory Authority for Examination

35 U.S.C. 131. Examination of application. The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102, 103.

35 U.S.C. 101. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

FORM PARAGRAPH 7.04 COPIES 35 U.S.C. 101.

35 U.S.C. 100. Definitions. When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the sucessors in title to the patentee.

702 Requisites of the Application

When a new application is assigned in the examining group the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111. Any matters affecting the filing date of the application, such as lack of an oath or declaration, filing fee, or claims should be checked before the application is placed in the storage racks to await the first action.

The examiner should be careful to see that the application meets all the requisites set forth in chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

702.01 Obviously Informal Cases

When an application is reached for its first action and it is then discovered to be impractical to give a complete action on the merits because of an informal or insufficient disclosure, the following procedure may be followed:

(1) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention and claims and any apparently pertinent art cited. In the rare case in which the

disclosure is so incomprehensible as to preclude a reasonable search the action should clearly inform applicant that no search was made.

(2) Informalities noted by the Application Division and deficiencies in the drawing should be pointed out by means of attachments to the examiner's letter (see § 707.07(a)),

(3) A requirement should be made that the specification be revised to conform to idiomatic English and United States practice;

(4) The claims should be rejected as failing to define the invention in the manner required by 35 U.S.C. 112 if they are informal. A blanket rejection is usually sufficient.

The examiner should not attempt to point out the specific points of informality in the specification and claims. The burden is on the applicant to revise the application to render it in proper form for a complete examination.

If a number of obviously informal claims are filed in an application, such claims should be treated as being a single claim for fee and examination purposes.

It is obviously to applicant's advantage to *file* the application with an adequate disclosure and with claims which conform to the U.S. Patent and Trademark Office usages and requirements. This should be done whenever possible. If, however, due to the pressure of a Convention deadline or other reasons, this is not possible, applicants are urged to submit *promptly, preferably within three months after filing,* a preliminary amendment which corrects the obvious informalities. The informalities should be corrected to the extent that the disclosure is readily understood and the claims to be initially examined are in proper form, particularly as to dependency, and otherwise clearly define the invention. "New matter" must be excluded from these amendments since preliminary amendments do not enjoy original disclosure status, § 608.04(b).

Whenever, upon examination, it is found that the terms or phrases of modes of characterization used to describe the invention are not sufficently consonant with the art to which the invention pertains, or with which it is most nearly connected, to enable the examiner to make the examination specified in 37 CFR 1.104, the examiner should make a reasonable search of the invention so far as it can be understood from the disclosure. The action of the examiner may be limited to a citation of what appears to be the most pertinent prior art found and a request that applicant correlate the terminology of the specification with art-accepted terminology before further action is made.

Use Form Paragraph 7.01 where the terminology is such that a proper search cannot be made.

7.01 Use of Terminology, Cannot Be Examined

A preliminary examination of this application reveals that it includes terminology which is so different from that which is generally accepted in the art to which this invention pertains that it is impractical to make a proper search of the prior art.

For example: [1]

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology so that a proper comparison with the prior art can be made.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 30 DAYS FROM THE DATE OF THIS LETTER.

Examiner Note:

(1) Use this or the next paragraph when a search cannot be made.

(2) In the "bracket", fill in an appropriate indication of the terminology, properties, units of test data, etc. that are the problem as well as the pages of specification involved.

(3) For the procedure to be followed when only the drawing is informal, see 608.02(a) and 608.02(b) of the MPEP.

Use Form Paragraph 7.02 where the application is so incomprehensible that a reasonable search cannot be made.

7.02 Disclosure Is Incomprehensible

The disclosure is objected to under 35 U.S.C. 112, first paragraph, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: [1].

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 30 DAYS FROM THE DATE OF THIS LETTER.

Examiner Note:

1. Use this paragraph when a search cannot be made.

2. In the bracket, indicate the page numbers and features which are not understood.

3. See form paragraphs 6.28 and 6.30 for improper idiomatic English.

Use Form Paragraph 7.03 where the invention cannot be understood because of illegible handwritten pages.

7.03 Handwritten Pages Are Illegible

The Examiner cannot understand the invention because the handwritten pages are illegible.

Applicant is required to submit legible pages preferably in typed, double spaced form.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 30 DAYS FROM THE DATE OF THIS LETTER.

For the procedure to be followed when only the drawing is informal, see §§ 608.02(a) and 608.02(b).

703 "General Information Concerning Patents"

The pamphlet "General Information Concerning Patents" may be sent to an applicant handling his own case when the examiner deems it advisable.

704 Search

After reading the specification and claims, the examiner searches the prior art.

The subject of searching is more fully treated in Chapter 900. See §§ 904 through 904.02. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution.

PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See § 717.05.

705 Patentability Reports

Where an application, properly assigned to one examining group, is found to contain one or more claims *per se* classifiable in one or more other groups, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups concerned for a report as to the patentability of certain designated claims. This report is know as a Patentability Report (P.R.) and is signed by the primary examiner in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is suspended, except in extraordinary circumstances. See § 705.01(e).

705.01 Instructions re Patentability Reports

When an application comes up for any action and the primary examiners involved agree that a Patentability Report is necessary, the application is forwarded to the proper group with a memorandum attached, for instance, "For Patentability Report from group —— as to claims ——."

705.01(a) Nature of P.R., Its Use and Disposal

The primary examiner in the group from which the Patentability Report is requested, if he or she approves the request will direct the preparation of the Patentability Report. This Patentability Report is written or typed on a memorandum form and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. When an examiner to whom a case has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he or she should so state. The Patentability Report when signed by the primary examiner in the reporting group will be returned to the group to which the application is regularly assigned.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the examiner to whom the case is assigned to avoid duplication of work. If the primary examiner in a reporting group is of the opinion that a Patentability Report is not in order, he or she should so advise the primary examiner in the forwarding group.

DISAGREEMENT AS TO CLASSIFICATION

Conflict of opinion as to classification may be referred to a patent classifier for decision.

If the primary examiner in the group having jurisdiction of the case agrees with the Patentability Report, he or she should incorporate the substance thereof in his or her action, which action will be complete as to *all* claims. The Patentability Report in such a case is *not* given a paper number but is allowed to remain in the file until the case is finally disposed of by allowance or abandonment, at which time it should be removed.

DISAGREEMENT ON PATENTABILITY REPORT

If the primary examiner does not agree with the Patentability Report or any portion thereof, he or she may consult with the primary examiner responsible for the report. If agreement as to the resulting action cannot be reached, the primary examiner having jurisdiction of the case need not rely on the Patentability Report but may make his or her own action on the referred claims, in which case the Patentability Report should be removed from the file.

APPEAL TAKEN

When an appeal is taken from the rejection of claims, all of which are examinable in the group preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the case to said group should be made for the purpose of appeal only. The receiving group will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said group with its classification determined by the controlling claims remaining in the case.

705.01(b) Sequence of Examination

In the event that the supervisory primary examiners concerned in a P.R. case cannot agree as to the order of examination by their groups, the supervisory primary examiner having jurisdiction of the case will direct that a complete search be made of the art relevant to his or her claims prior to referring the case to another group for report. The group to which the case is referred will be advised of the results of this search.

If the supervisory primary examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

705.01(c) Counting and Recording P.R.'s

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding group. When the P.R. is completed and the application is ready for return to the forwarding group, it is not counted either as a receipt or action by transfer. Credit, however, is given for the time spent. See § 1705.

The date status of the application in the reporting group will be determined on the basis of the dates in the group of original jurisdiction. To insure orderly

progress in the reported dates, a timely reminder should be furnished to the group making the P.R.

705.01(d) Duplicate Prints of Drawings

In Patentability Report cases having drawings, the examiner to whom the case is assigned will furnish to the group to which the case is referred, prints of such sheets of the drawings as are applicable, for interference search purposes. That this has been done may be indicated by a pencil notation on the file wrapper.

When a case that has had Patentability Report prosecution is passed for issue or becomes abandoned, NOTIFICATION of this fact will AT ONCE be given by the group having jurisdiction of the case to each group that submitted a Patentability Report. The examiner of each such reporting group will note the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

705.01(e) Limitation as to Use

The above outlined Patentability Report practice is not obligatory and should be resorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ is scope only, prosecution by Patentability Report is never proper.

Exemplary situation where Patentability Reports are ordinarily not proper are as follows:

(1) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(2) Where the claims are related as product and a process which involves merely the fact that a product having certain charateristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(3) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination *per se. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.*

Where it can be shown that a Patentability Report will save total examiner time, one is permitted with the approval of the group director of the group to which the application is assigned. The "Approved" stamp should be impressed on the memorandum requesting the Patentability Report.

705.01(f) Interviews With Applicants

In situation where an interview is held on an application in which a Patentability Report has been adopted, the reporting group may be called on for assistance at the interview when it concerns claims treated by them. See §§ 713 to 713.10 regarding interviews in general.

706 Rejection of Claims

Although this part of the Manual explains the procedure in *rejecting* claims, the examiner should never overlook the importance of his or her role in *allowing* claims which properly define the invention.

37 CFR 1.106. Rejection of claims. (a) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered umpatentable will be rejected.

(b) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to § 1.107.

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied *in each and every case.* The Supreme Court in *Graham v. John Deere,* 148 USPQ 459 (decided February 21, 1966), stated that,

> "Under § 103, the scope and content of the prior art to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . . .
>
> "This in not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down

here will result in that uniformity and definiteness which Congress called for in the 1952 Act.

"While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system. We have observed a notorious difference between the standards applied by the Patent Office and by the courts. While many reasons can be adduced to explain the discrepancy, one may well be the free rein often exercised by examiners in their use of the concept of 'invention.' In this connection we note that the Patent Office is confronted with a most difficult task. . . . This is itself a compelling reason for the Commissioner to strictly adhere to the 1952 Act as interpreted here. This would, we believe, not only expedite disposition but bring about a closer concurrence between administrative and judicial precedent."

Accordingly, an application covering an invention of doubtful patentability should not be allowed, unless and until issues pertinent to such doubt have been raised and overcome in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it "strictly adhere" to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court.

Office policy has consistently been to follow *Graham* v. *John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the three factual inquires; enunciated therein as a background for determining obviousness are briefly as follows:

1. Determination of the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims in issue; and
3. Resolving the level of ordinary skill in the pertinent art.

The Supreme Court reaffirmed and relied upon the Graham three pronged test in its consideration and determination of obviousness in the fact situations presented in both the *Sakraida* v. *Ag Pro,* 189 USPQ 449 (decided April 20, 1976) and *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.,* 163 USPQ 673 (decided December 8, 1969) decisions. In each case, the Court went on to discuss whether the claimed combinations produced a "new or different function" and a "synergistic result", but clearly decided whether the claimed inventions were unobvious on the basis of the three-way test in Graham. Nowhere in its decisions in those cases does the Court state that the "new or different function" and "synergistic result" tests supersede a finding of unobviousness or obviousness under the Graham test.

Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in Graham. It should be noted that the Supreme Court's application of the Graham test to the fact circumstances in Ag Pro was somewhat stringent, as it was in Black Rock. Note *Republic Industries, Inc.* v. *Schlage Lock Co.* 200 USPQ 769 (C.A. 9th Cir.) The Court of Appeals for the Federal Circuit stated in Stratoflex Inc. v. Aeroquip Corp., 713 F2d 1530, 218 USPQ 871, 880 (Fed. Cir. 1983) that

A requirement for synergism or a synergistic effect is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in Graham, supra, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. Bowser Inc. v. United States, 388 F. 2d 346, 156 USPQ 406 (Ct. Cl. 1967)

The standards of patentability applied in the examination of claims must be the same throughout the Office. In every art, whether it be considered "complex," "newly developed," "crowded," or "competitive," all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and '103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture" claim) is never, in itself, justification for the allowance of such a claim.

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

37 CFR 1.112. Reconsideration. After response by applicant or patent owner (§ 1.111) the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action, in the same manner provided in § 1.111 with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

See § 1.112 for reexamination and reconsideration of a patent under reexamination after responses by the patent owner.

706.01 Contrasted With Objection

The refusal to grant claims because the subject matter as claimed is considerd unpatentable is called a

"rejection." The term "rejected" must be applied to such claims in the examiner's letter. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Appeals, while an objection, if persisted in, may be reviewed only by way of petition to the Commissioner.

An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See § 608.01(n).

706.02 Rejection on Prior Art

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for the patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United State, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. Conditions for patentability; nonobvious subject matter. A patent may not be obtained thought the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed matter is either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See § 707.07(d).

For scope of rejections in reexamination proceedings see § 2258.

35 U.S.C. 102 (Anticipation or Lack of Novelty)

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. It may be advisable to identify a particular part of the reference to support the rejection. If not, the expression "rejected under 35 U.S.C. 102 as clearly anticipated by" is appropriate.

7.07 Statement of Statutory Basis. 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless.

Examiner Note:

1. One or more of paragraphs 7.08 to 7.14 must follow this heading.

2. Paragraphs 7.07–7.14 are to be used only ONCE in an Office action.

7.08 102(a), Activity by Another Before Invention by Applicant

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Examiner Note:

This paragraph must be preceded by paragraph 7.07.

7.09 102(b), Activity More Than One Year Prior To Filing

(b) the invention was patented or described in a printed puiblication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Examiner Note:

This paragraph must be preceded by paragraph 7.07, and may be preceded by paragraph 7.08.

7.10 102(c), Invention Abandoned

(c) he has abandoned the invention.

Examiner Note:

This paragraph must be preceded by paragraph 7.07, and may be preceded by one or more of paragraphs 7.08 and 7.09.

7.11 102(d), Foreign Patenting

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Examiner Note:

This paragraph must be preceded by paragraph 7.07, and may be preceded by one or more of paragraphs 7.08–7.10.

7.12 102(e), Patent to Another With Earlier Filing Date

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Examiner Note:

This paragraph must be preceded by paragraph 7.07, and may be preceded by one or more of paragraphs 7.08–7.11.

7.13 102(f), Applicant not the Inventor

(f) he did not himself invent the subject matter sought to be patented.

Examiner Note:

This paragraph must be preceded by paragraph 7.07, and may be preceded by one or more of paragraphs 7.08–712.

7.14 102(g), Priority of Invention

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there

shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Examiner Note:

This paragraph must be preceded by paragraph 7.07 and may be preceded by one or more of paragraphs 7.08–7.13

7.15 Rejection, 35 U.S.C. 102(a), (b) Patent or Publication (e) and/or (g)

Claim [1] rejected under 35 U.S.C. 102 [2] as being [3] by [4].

Examiner Note:

1. In bracket 2, insert the appropriate paragraph letter or letters in parenthesis of 35 U.S.C. 102.
2. In bracket 3, insert "clearly anticipated", or insert "anticipated" and add an explanation at the end of the paragraph.
3. In bracket 4, insert the prior art relied upon.
4. This rejection must be preceded by paragraphs 7.07, 7.08, 7.09, 7.12 and 7.14, as appropriate.

7.16 Rejection, 35 U.S.C. 102(b), Public use or on Sale

Claim [1] rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

Examiner Note:

1. A full explanation of the evidence establishing a public use or sale must be provided.
2. This paragraph must be preceded by paragraphs 7.07 and 7.09.

7.17 Rejection, 35 U.S.C. 102(c), Abandonment of Invention

Claim (1) rejected under 35 U.S.C. 102(c) because the invention has been abandoned.

Examiner Note:

1. A full explanation of the evidence establishing an abandonment of the invention must be provided. See MPEP 706.03(s).
2. This paragraph must be preceded by paragraphs 7.07 and 7.10.

7.18 Rejection, 35 U.S.C. 102(d), Foreign Patenting

Claim [1] rejected under 35 U.S.C. 102(d) as being barred by applicant's [2].

Examiner Note:

1. In bracket 2, identify the foreign document.
2. This paragraph must be preceded by paragraphs 7.07 and 7.11.

7.19 Rejection, 35 U.S.C. 102(f), Applicant not the Inventor

Claim [1] rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

Examiner Note:

1. An explanation of the supporting evidence establishing that applicant was not the inventor must be provided.
2. This paragraph must be preceded by paragraphs 7.07 and 7.13.

35 U.S.C. 103 (OBVIOUSNESS)

In contrast, 35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more others. After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious.

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, e.g., (1) Where the propriety of a 35 U.S.C. 102 rejection depends on a particular interpretation of a claim; (2) where a claim is met only in terms by a reference which does not disclose the inventive concept involved; or (3) where the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration. Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections; i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

The Court of Customs and Patent Appeals has held that expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 139 USPQ 297, 51 CCPA 747 (1963); In re Flint, 141 USPQ 299, 51 CCPA 1230 (1964).

This Court has also held that when a claim is rejected under 35 U.S.C. 103, a limitation which is considered to be indefinite cannot be properly disregarded. If a limitation in a claim is considered to be indefinite, the claim should be rejected under 35 U.S.C. 112, second paragraph. In re Wilson, 165 USPQ 494, 57 CCPA 1029 (1970). Note also In re Steele, 134 USPQ 292, 49 CCPA 1295 (1962). See § 706.03(d).

Where a reference is relied on to support a rejection, whether or not in a "minor capacity that reference should be positively included in the statement of the rejection. See In re Hoch, 166 USPQ 406, 57 CCPA 1292, footnote 3 (1970).

Where the last day of the year dated from the date of publication falls on a Saturday, Sunday or Federal holiday, the publication is not a statutory bar under 35 U.S.C. 102(b) if the application was filed on the next succeeding business day Ex parte Olah and Kuhn, 131 USPQ 41 (Bd. App. 1960). It should also be noted that a magazine is effective as a printed publication under 35 U.S.C. 102(b) as of the date it reached the addressee and not the date it was placed in the mail. *Protein Foundation Inc.* v. *Brenner,* 151 USPQ 561 (D.C.D.C. 1966).

A U.S. patent may be a reference against an application even though the patent date is after the United States filing date of the application, provided the United States filing date of the patent is prior to the United States filing date of the application. It is proper to use such a patent as a basic or an auxiliary reference and such patents may be used together as basic and auxiliary references. This doctrine arose in *Alexander Milburn Co.* v. *Davis-Bournonville Co.,* 1926 C.D. 303; 344 O.G. 817; and was enacted into law by 35 U.S.C. 102(e). It was held applicable to rejections under 35 U.S.C. 103 by the U.S. Supreme Court in *Hazeltine Research, Inc. et al.* v. *Brenner,* 147 USPQ 429 (1965). See also section 715.01.

Public Law 92-34 provided for situations caused by the postal emergency which began on March 18, 1970 and ended on or about March 30, 1970. This law allows the applicant to claim an earlier filing date if delay in filing was caused by the emergency. Such earlier filing dates were printed on the patents along with the actual filing dates whenever it was possible. However, patents issued with earlier filing dates claimed under Public Law 92-34 are effective as prior art under 35 U.S.C. 102(e) only as of their actual filing dates and not as of such claimed earlier filing

dates. The details of the procedure to claim the earlier date appeared at 889 O.G. 1064.

For the proper way to cite a patent issued after the filing of the application in which it is being cited, see § 707.05(e).

Form Paragraphs 7.20–7.23 and 7.27 should be used when making a rejection under 35 U.S.C. 103.

7.20 Statement of Statutory Basis, 35 U.S.C. 103

The following is a quotation of U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Examiner Note:

1. This paragraph must precede paragraph 7.21 and 7.22.
2. This paragraph should only be used ONCE in a given Office action, and acts as a heading for all subsequent rejections under 35 U.S.C. 103.

7.21 Rejection, 35 U.S.C. 103

Claim [1] rejection under 35 U.S.C. 103 as being unpatentable over [2].

Examiner Note:

1. This paragraph must be preceded by paragraph 7.20.
2. An explanation of the rejection applying the Graham v. Deere test must be provided.

7.22 Rejection, 35 U.S.C. 103, Further in View of

Claim [1] rejected under 35 U.S.C. 103 as being unpatentable over [2] as applied to claim [3] above, and further in view of [4].

Examiner Note:

1. This paragraph must be preceded by paragraph 7.21.
2. An explanation of the rejection applying the Graham v. Deere test must be provided.

7.23 Graham v. Deere, Test for Obviousness

The factual inquires set forth in Graham v. John Deere Co., 383 U.S.C. 1, 86 S Ct. 684, 15 L Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and
3. Resolving the level of ordinary skill in the pertinent art.

Examiner Note:

This paragraph may be used, if appropriate, in response to an argument of the use of Graham vs. Deere.

7.27 Rejection, 35 U.S.C. 102 or 103

Claim [1] rejected under 35 U.S.C. 102 [2] as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over [3].

Examiner Note:

1. This paragraph is *not* intended to be commonly used as a substitute for a rejection under 35 U.S.C. 102. In other words, the Examiner should make a single rejection under either 35 U.S.C. 102 or 35 U.S.C. 103 wherever possible using appropriate form paragraphs 7.15–7.19, 7.21 and 7.22. The relatively rare circumstances where this paragraph may be used are as follows:

a. It is appropriate when the interpretation of the claim(s) is or may be in dispute, i.e. given one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103 is appropriate.

b. It is also appropriate when the examiner cannot determine whether or not the reference product inherently possesses properties which anticipate or render obvious the claim product but has basis for shifting the burden of proof to applicant as in In re Fitzgerald et al, 205 USPQ 594.

c. Another appropriate use is the situation when the reference teaches a small genus which places a claimed species in the possession of the public as in In re Schaumann, 197 USPQ 5, and the species would be obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. 102.

2. In each case above a full explanation should follow the rejection.

3. In bracket 2, insert the appropriate 102 paragraph letter.

4. This paragraph must be preceded by paragraph 7.07, one or more of paragraphs 7.08–7.14 as appropriate, and paragraph 7.20.

706.02(a) Establishing "Well Known" Prior Art

Things believed to be known to those skilled in the art are often asserted by the examiner to be "well known" or "matters of common knowledge". If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm, 1942 C.D. 589; 543 O.G. 440. If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the reference must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the afidavits of the applicant and other persons. See 37 CFR 1.107.

Failure of the applicant to seasonably challenge such assertions establishes them as admitted prior art. See In re Gunther, 1942 C.D. 332; 538 O.G. 744; In re Chevenard, 1944 C.D. 141; 500 O.G. 196. This applies also to assertions of the Board. In re Selmi, 1946 C.D. 525; 591 O.G. 160; In re Fischer, 1942 C.D. 295; 538 O.G. 503.

For further views on judicial notice, see In re Ahlert, 57 CCPA 1023, 165 USPQ 418 (1970) (assertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work); In re Boon, 58 CCPA 1035, 169 USPQ 231 (1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice); and In re Barr, 58 CCPA 1389, 170 USPQ 330 (1971) (involved references held not a sufficient basis for taking judicial notice that involved controverted phrases are art-recognized).

706.02(b) Admissions by Applicant

37 CFR 1.106 Rejection of claims.

* * * * *

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to § 1.107.

The examiner may rely upon admissions by the applicant in the specification or in other papers filed in the application in rejecting claims. However, the examiner may not rely upon § 1.106(c) in a manner in-

consistent with In re Ruff, et al., 45 CCPA 1037, 118 USPQ 340 (CCPA 1958) and decisions subsequent thereto.

706.03 Rejections Not Based on Prior Art

The primary object of the examination of an application is to determine whether or not the claims define a patentable advance over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to non-prior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some sterotyped expression.

Rejections not based on prior art are explained in §§ 706.03(a) to 706.03(z). IF THE LANGUAGE IN THE FORM PARAGRAPHS ARE INCORPORATED IN THE LETTER TO STATE THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

Appropriate Form Paragraphs 7.30–7.36 should be used when making rejections under 35 U.S.C. 112.

7.30 Disclosure Objected to 35 U.S.C. 112, 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

The specification is objected to under 35 U.S.C. 112, first paragraph, as [1].

Examiner Note:

1. Use this paragraph when the deficiencies in the specification are more than minor informalities (for minor informalities, see paragraph 7.29).
2. In bracket 1, explain in general terms the deficiency, such as:
   a. failing to provide an adequate written description of the invention.
   b. failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure.
   c. failing to present a best mode of carrying out the invention.

FOR NEW MATTER SITUATIONS

   d. the specification, as originally filed, does not provide support for the invention as is now claimed.

(See also form paragraph 7.28).

3. A full explanation of the specific deficiencies must be provided at the end of this paragraph.
4. Use paragraph 7.31 for a rejection of claims based on the deficiencies set forth in this paragraph.

7.31 Rejection, 35 U.S.C. 112, 1st Paragraph, Disclosure

Claim (1) rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

Examiner Note:

Supply further explanation if appropriate. New matter rejections should be made under this section of the statute when the claims depend upon the new matter.

7.32 Rejection, 35 U.S.C. 112, Paragraph, Scope of Claim Problem

Claim (1) rejected under 35 U.S.C. 112, first paragraph, as the disclosure in enabling only for claims limited in accordance with the disclosure at (2) of the specification. See MPEP 706.03(n) and 706.03(z).

Examiner Note:

Use this paragraph when the specification is enabling for a portion of the subject matter claimed but the enablement is not commensurate in scope with the claims. In bracket 2, insert page, pages or specific portion of the specification. Insert the basis for asserting that the specification is not enabling for the entire scope of the claim at the end of the paragraph.

7.33 Rejection, 35 U.S.C. 112, 1st & 2nd Paragraphs

Claim (1) rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner Note:

This paragraph should not be used when it is appropriate to make one or more separate rejections under the first and/or the second paragraph of 35 U.S.C. 112. In other words, separate rejections under either the first paragraph or the second paragraph of 35 U.S.C. 112 are preferred. This paragraph should only be used when either the first or second paragraph of 35 U.S.C. 112 could be applicable, but due to some question of interpretation, uncertainty exists as to whether the claimed invention is insufficiently described in the enabling teachings of the specification or the claim language is indefinite.

A full explanation should be provided with this rejection.

7.34 Rejection, 35 U.S.C. 112, 2nd Paragraph

Claim (1) rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Examiner Note:

1. Use this paragraph when claims are vague, indefinite, confusing, incorrect or cannot be understood.
2. Add a full explanation of the rejection.
3. See also 17.07.

7.35 Rejection, 35 U.S.C. 112, "Omnibus claims"

Claim (1) rejected for obviously failing to particularly point out and distinctly claim the invention as required by 35 U.S.C. 112, second paragraph.

Examiner Note:

1. Use this paragraph to reject an "Omnibus type claim". No further explanation is necessary.
2. See MPEP 1320.04(b) for cancellation of such a claim by examiner's amendment.

7.36 Rejection, 35 U.S.C. 112, 4th Paragraph

Claim (1) rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Examiner Note:

1. an explanation of what is in the claim and why it does not constitute a further limitation should be given.
2. for a rejection of hybrid claims, see MPEP 608.01(n).

706.03(a) Nonstatutory Subject Matter

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

The term "process" as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

See § 2105 for patentability of microorganisms and § 2110 for patentability of mathematical algorithms or computer programs.

Use Form Paragraphs 7.04 and 7.05 to reject under 35 U.S.C. 101.

7.04 Statement of Statutory Basis, 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Examiner Note:

This paragraph must precede the first use of 35 U.S.C. 101.

7.05 Rejection, 35 U.S.C. 101, Utility, Non-Statutory

Claims [1] rejected under 35 U.S.C. 101 because [2].

Examiner Note:

1. In bracket 2, insert the appropriate basis for the rejection, such as:

(a) the claimed invention is directed to non-statutory subject matter;

(b) the claimed invention lacks patentable utility;

(c) the invention as disclosed is inoperative and therefore lacks utility.

2. Explain the rejection following the recitation of the statute.

3. See MPEP 608.01(p) and 706.03(p) for other situations.

4. This paragraph must be preceded by paragraph 7.04.

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the Statute follow:

PRINTED MATTER

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as *not being within the statutory classes.* See In re Miller, 164 USPQ 46, 57 CCPA 809 (1969); Ex parte Gwinn, 112 USPQ 439 (Bd. App. 1955); and In re Jones, 153 USPQ 77, 54 CCPA 1218 (1967).

NATURALLY OCCURRING ARTICLE

Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture." A shrimp with the head and disgestive tract removed is an example. Ex parte Grayson, 51 USPQ 413.

METHOD OF DOING BUSINESS

Though seemingly within the category of a process or method, a method of doing business can be rejected as not being within the statutory classes. See Hotel Security Checking Co. v. Lorraine Co., 160 Fed. 467 and In re Wait, 24 USPQ 88, 22 CCPA 822 (1934).

SCIENTIFIC PRINCIPLE

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. O'Reilly v. Morse, 15 Howard 62.

This subject matter is further limited by the Atomic Energy Act explained in § 706.03(b).

706.03(b) Barred by Atomic Energy Act

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181a) thereof reads in part as follows:

No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms "atomic energy" and "special nuclear material" are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181c and d) set up categories of pending applications relating to atomic energy that must be brought to the attention of the Department of Energy. Under 37 CFR 1.14(c), applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Department of Energy and the Department will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by the Atomic Energy Act.

All applications received in the Patent and Trademark Office are screened by Group 220 personnel, under 37 CFR 1.14(c), in order for the Commissioner to fulfill his responsibilities under section 151(d) (42 U.S.C. 2181d) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review in Group 220.

All rejections based upon sections 151(a)(42 U.S.C. 2181a), 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by Group 220 personnel.

706.03(c) Functional

See Ex parte Ball et al., 1953 C.D. 4; 675 O.G. 5: In re Arbeit et al., 1953 C.D. 409; 677 O.G. 843 and Ex parte Stanley, 121 USPQ 621.

35 U.S.C. 112. Specification. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other

multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The last paragraph of 35 U.S.C. 112 has the effect of prohibiting the rejection of a claim for a combination of elements (or steps) on the ground that the claim distinguishes from the prior art solely in an element (or step) defined as a "means" (or "step") coupled with a statement of function. However this provision of the last paragraph must always be considered as subordinate to the provision of paragraph 2 that the claim particularly point out and distinctly claim the subject matter. If a claim is found to contain language approved by the last paragraph such claim should always be tested additionally for compliance with paragraph 2 and if it fails to comply with the requirements of paragraph 2, the claim should be so rejected and the reasons fully stated.

The last paragraph of 35 U.S.C. 112 makes no change in the established practice of rejecting claims as *functional* in situations such as the following:

1. A claim which contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of the functional language in the claim. An example of a claim of this character may be found in In re Fuller, 1929 C.D. 172; 388 O.G. 279. The claim reads:

> A woolen cloth having a tendency to wear rough rather than smooth.

2. A claim which recites only a single means and thus encompasses all possible means for performing a desired function. For an example, see the following claim in Ex parte Bullock, 1907 C.D. 93; 127 O.G. 1580:

> In a device of the class described, means for transferring clothes-carrying rods from one position and depositing them on a suitable support.

Note the following cases:

1. In re Hutchinson, 69 USPQ 138, 33 CCPA 879 (1946), the terms "adapted for use in" and "adapted to be adhered to" were held not to constitute a limitation in any patentable sense.

2. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957), the functional "whereby" statement was held not to define any structure and accordingly could not serve to distinguish.

3. In re Boller, 141 USPQ 740, 51 CCPA 1484 (1964), the term "volatile neutralizing agent" was held to be patentably effective and commensurate with the breadth of the disclosed invention.

4. In re Land and Rogers, 151 USPQ 621 (1966), the expression "adapted to be rendered diffusible in said liquid composition only after at least substantial development" was given weight.

5. In re Halleck, 164 USPQ 647, 57 CCPA 954 (1970), the term "an effective amount" was held not objectionable.

6. In re Swinehart and Sfiligoj, 169 USPQ 226 (1971), held that the meaning of "transparent to infra-red rays" is sufficiently clear.

7. In re Barr et al., 170 USPQ 330, 58 CCPA 1388 (1971), held that the expression "incapable of forming a dye with said oxidized developing agent," set forth definite boundaries.

706.03(d) Vague and Indefinite

When the examiner is satisfied that patentable novelty is disclosed and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable novelty with a *reasonable* degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

The fact that a claim is broad does not necessaily justify a rejection on the ground that the claim is vague and indefinite or incomplete. In non-chemical cases, a claim may, in general, be drawn as broadly as permitted by the prior art.

The rejection of a claim as *indefinite* would appear to present no difficulties. On occasion, however, a great deal or effort is required to explain just what is wrong with the claim, when writing the examiner's letter, Although cooperation with the attorney is to be commended, undue time should not be spent trying to guess what the attorney was trying to say in the claim. Sometimes, a rejection as indefinite plus the statement that a certain line is meaningless is sufficient. The examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction.

The mere inclusion of reference numerals in a claim otherwise allowable is not a ground for rejection. But see Ex parte Osborne, 1900 C.D. 137; 92 O.G. 1797.

Alternative expressions such as "brake or locking device" may make a claim indefinite if the limitation covers two different elements. If two equivalent parts are referred to such as "rods or bars", the alternative expression may be considered proper.

The inclusion of a negative limitation shall not, in itself, be considered a sufficient basis for objection to or rejection of a claim. However, if such a limitation renders the claim unduly broad or indefinite or otherwise results in a failure to point out the invention in the manner contemplated by 35 U.S.C. 112, and appropriate rejection should be made.

Generally speaking, the inclusion of (1) negative limitations and (2) alternative expressions, provided that the alternatively expressed elements are basically equivalents for the purpose of the invention, are permitted if no uncertainty or ambiguity with respect to the question of scope or breadth of the claim is presented.

The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to *reasonably* determine the scope. It is applicant's responsibility to select proper wording of the claim,

except to the extent that the selection of words makes the claims indefinite. Under no circumstances should a claim be rejected merely because the examiner prefers a different choice of wording.

Still another way in which a claim can be indefinite is where a *non sequitur* occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference or *no antecedent* in the claim to a lever. An *indirect limitation* also affords a ground of rejection as indefinite. If a "lever" is set forth and, later in the claim, "said aluminum lever" is recited, the claim is rejected as indefinite.

Rejections for indefiniteness were affirmed in In re Cohn, 169 USPQ 95 (CCPA 1971); In re Hammack, 166 USPQ 209 (CCPA 1970); and In re Collier 158 USPQ 266 (CCPA 1968).

Rejections for indefiniteness were reversed in In re Castaing, 166 USPQ 550 (CCPA 1970); In re Fisher, 166 USPQ 18 (CCPA, 1970); and In re Wakefield, 164 USPQ 636 (CCPA, 1970).

706.03(e) Product by Process

An article may be claimed by a process of making it provided it is definite. In re Moeller, 1941 C.D. 316; 48 USPQ 542; 28 CCPA 932; In re Luck, 177 USPQ 523 (CCPA 1973); In re Steppan, 156 USPQ 143 (CCPA 1967); and In re Pilkington, 162 USPQ 145 (CCPA 1969).

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the staute is appropriate. As a practical matter, the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessmann, 180 USPQ 324 (CCPA1974).

Where an applicant's product in incapable of description by product claims which are of different scope, he is entitled to product-by-process claims that recite his novel process of manufacture as a hedge against the possibility that his broader product claims may be invalidated. In re Hughes, 182 USPQ 106 (CCPA 1974).

The fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope, Ex parte Pantzer and Feier, 176 USPQ 141 (Board of Appeals, 1972).

706.03(f) Incomplete

A claim can be rejected as incomplete if it omits essential elements, steps or necessary structural cooperative relationship of elements, such omission amounting to a gap between the elements, steps or necessary structural connections. Greater latitude is permissible with respect to the definition in a claim of matters not essential to novelty or operability than with respect to matters essential thereto. See also § 706.03(d).

706.03(g) Prolix

Claims are rejected as *prolix* when they contain long recitations or unimportant details which hide or obscure the invention. Ex parte Iagan, 1911 C.D. 10; 162 O.G. 538, expresses the thought that very long detailed claims setting forth so many elements that invention cannot possibly reside in the combination should be rejected as prolix. See also In re Ludwick, 1925 C.D. 306; 339 O.G. 393.

706.03(h) Nonstatutory Claim

Some applications when filed contain an omnibus claim such as "A device substantially as shown and described".

Such a claim can be rejected as follows:

Claim —— is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112.

For cancellation of such a claim be examiner's amendment, see § 1302.04(b).

706.03(i) Aggregation

Rejections on the ground of aggregation should be based upon a lack of cooperation between the elements of the claim. Many decisions and some legal writers extend the term to include old and exhausted combinations (§ 706.03(j)). Confusion as to what is meant can be avoided be treating all claims which include more than one element as combinations (patentable or unpatentable) if there is actural cooperation between the elements, and as aggregations if there is no cooperation.

Example of aggregation: A washing machine associated with a dial telephone.

Example of old combination: An improved carburetor claimed in combination with a gasoline engine.

A claim is not necessarily aggregative because the various elements do not function simultaneously. A typewriter, for example, is a good combination. See also In re Worrest, 40 CCPA 804, 96 USPQ 381 (1953). Neither is a claim necessarily aggregative merely because elements which do cooperate are set forth in specific detail.

A rejection on aggregation should be made only after consideration of the court's comments in In re Gustafson, 51 CCPA 1358, 141 USPQ 585 (1964).

706.03(j) Old Combination

The rejection on the ground of old combination (synonymous with "exhausted combination") requires the citation of a reference, but is treated here because of its relation to aggregation. The reference (not a combination of references, of course) is cited, not to anticipate the claim, but to anticipate the broad combination set forth in the claim. Moreover, the cooper-

ation and result between the elements in the reference must be the same as it is in the claim.

A rejection on the ground of old combination should be made whenever proper. Whether subcombination claims have been presented or allowed in the same application, or whether other grounds for rejection of the combination claims exist, are not determinative of the propriety of this rejection. The rejection is proper when a single reference discloses broadly a combination of the same elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. *Ex parte* Silverstein, 125 USPQ 238. The fact that an applicant has improved one element of a combination which may be *per se* patentable does not entitle him or her to a claim to the improved element in combination with old elements where the elements perform no new function in the claimed combination. In re Hall, 41 CCPA 759.

Example: An improved (specifically recited) carburetor claimed in combination with a gasoline engine. A reference is cited which shows a carburetor combined with a gasoline engine. This shows the broad combination to be old. Both in the reference and in the claimed combination, the cooperation between the carburetor and engine is the same and the end result is the same. The claimed combination is an inprovement over the prior art only because of the improved carburetor. The carburetor has separate status, since entire subclasses are devoted to carburetors, claimed as such. A reference is preferably cited to show the separate status and development. (See § 904.01 (d).)

Old combination rejections ordinarily are based on 35 U.S.C. 112 (failure to point out the invention). The rejection should make it clear exactly what the combination is and why it is thought that any improved element does not modify the action of the combination. A suggested form for use in making an old combination rejection is as follows:

"Claim 1 is rejected under 35 U.S.C. 112 as being drawn to the old combination of a bell, a battery and a switch connected in series by wire conductors. This combination is shown to be old by the patent to Jones which discloses broadly the same elements funtionally interrelated in the same elements functionally interrelated in the same manner to produce substantially the same results. The combination of claim 1 differs from that shown in Jones in setting forth a specific construction of the battery itself. Since the latter does not modify the action of the other elements recited in the claim in any material manner, no new combination is seen to exist. In re Hall, 100 USPQ 46; 41 CCPA 759; 208 F. 2d 370; 680 O.G.5."

See also Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545, 37 USPQ 1 (1938); In re McCabe, 48 CCPA 881, 129 USPQ 149 (1961) (discussion of claim 13); and particularly In re Bernhart, 57 CCPA 737, 163 USPQ 611 (1969).

706.03(k) Duplicate Claims; Double Patenting

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. Also, it is possible to reject one claim on an allowed claim if they differ only by subject matter old in the art. The latter ground of rejection is set forth in the following paragraph quoted from Ex parte Whitelaw, 1915 C.D. 18; 219 O.G. 1237:

"Claim 54 is not patentable over claim 51 and claims 53, 55 and 56 are not patentable over claim 50 in view of Comstock, No. 590,657, which shows that it is old to employ an engine-casing in tools of this character. The claims held patentable are considered as fully covering applicant's invention, and applicant cannot be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function."

This rejection (the ex parte Whitelaw doctrine) is usually not applied if there are only a few claims in the application.

Situations related to that given above are as follows:

Where there is a common assignee for two or more applications by different inventors, and the applications contain conflicting claims, see § 804.03.

Double Patenting

Where there are conflicting claims in different applications of the same inventor, one of which is assigned, see § 304.

Where the same inventor has two or more applications for species or for related inventions, see Chapter 800, particularly §§ 804–804.02, 806.04(h), 822 and 822.01 for double patenting rejections of inventions not patentable over each other.

See Form Paragraph 7.06 for the working of a 35 U.S.C. 101 double patenting rejection.

7.06 Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of applicant's [3]. This is a double patenting rejection.

Examiner Note:

1. In bracket 2, fill in the specific claims used as the basis for the rejection.

2. In bracket 3, insert either the U.S. Patent No. or the copending application Serial No.

3. This paragraph must be preceded by paragraph 7.04.

4. Do not use this paragraph for an obviousness type double patenting rejection. See paragraphs 7.24–7.26.

APPLICATION FILED UNDER 35 U.S.C. 121

The Commissioner has determined that under 35 U.S.C. 121, the Patent and Trademark Office cannot reject a divisional application on the parent patent if the divisional application is filed as a result of a requirement for restriction made by the Office even though the requirement for restriction relates to species. In re Joyce, 1958 C.D. 2; 115 USPQ 412. See also In re Herrick et al., 1958 C.D. 1; 115 USPQ 412 where the Commissioner ruled that a requirement for restriction should not be made in an application claiming more than five species if the examiner is of the opinion that the various species are obviously unpatentable over one another.

706.03(l) Multiplicity

37 CFR 1.75(b). More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

An unreasonable number of claims; that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection on the ground of *multiplicity*. A rejection on this ground should include all the claims in the case inasmuch as it relates to confusion of the issue.

To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Appeals prior to an examination on the merits of at least some of the claims presented, the examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his or her judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits. The examiner should be reasonable in setting the number to afford the applicant some latitude in claiming the invention.

The earlier views of the Court of Customs and Patent Appeals set forth in In re Chandler, 117 USPQ 361, 45 CCPA 911 (1958) and In re Chandler, 138 USPQ 138, 50 CCPA 1422 (1963) have been somewhat revised by its views in In re Flint, 162 USPQ 228, 56 CCPA 1300 (1969) and In re Wakefield, 164 USPQ 636, 57 CCPA 959 (1970).

If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. Note § 408. The examiner should request selection of a specified number of claims for purposes of examination.

If time for consideration is requested arrangements should be made for a second telephone call, preferably within three working days.

When claims are selected, a formal multiplicity rejection is made, including a complete record of the telephone interview, followed by an action on the selected claims.

When applicant refuses to comply with the telephone request, a formal multiplicity rejection is ma[illegible]

The applicant's response to a formal multiplicity rejection of the examiner, to be complete, must either:

1. Reduce the number of claims presented to those selected previously by telephone, or if no previous selection has been made to a number not exceeding the number specified by the examiner in the Office action, thus overcoming the rejection based upon the ground of multiplicity, or

2. In the event of a traverse of said rejection applicant, besides specifically pointing out the supposed errors of the multiplicity rejection is required to confirm the selection previously made by telephone, or if no previous selection has been made, select certain claims for purpose of examination, the number of which is not greater than the number specified by the examiner.

If the rejection on multiplicity is adhered to, all claims retained will be included in such rejection and the selected claims only will be additionally examined on their merits. This procedure preserves applicant's right to have the rejection on multiplicity reviewed by the Board of Appeals.

See also § 706.03(k).

706.03(m) Nonelected Inventions

See §§ 821 to 821.03 for treatment of claims held to be drawn to non-elected inventions.

706.03(n) Correspondence of Claim and Disclosure

37 CFR 1.117. Amendment and revision required. The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

Another category of rejections not based on the prior art is based upon the relation of the rejected claim to the disclosure. In chemical cases, a claim may be so broad as to not be supported by disclosure, in which case it is rejected as unwarranted by the disclosure. If averments in a claim do not correspond to the averments or disclosure in the specification, a rejection on the ground of inaccuracy may be in order. It must be kept in mind that an original claim is part of the disclosure and might adequately set forth subject matter which is completely absent from the specification. Applicant is required in such an instance to add the subject matter to the specification. Whenever an objection or rejection is made based on incomplete disclosure, the examiner should in the interest of expeditious prosecution call attention to 37 CFR 1.118.

When an amendment is filed in response to an objection or rejection based on incomplete disclosure, a study of the entire application is often necessary to determine whether or not "new matter" is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure.

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See § 608.01(l)

See §706.03(z) for rejection on undue breadth.

706.03(o) New Matter

35 U.S.C. 132. Notice of rejection; reexamination.

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, In re Rasmussen, 650 F2d 1212 (CCPA, 1981). New matter includes not only the addition of wholly unsupported subject matter, but also, adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See §§ 608.04 to 608.04(c).

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. 35 U.S.C. 132 should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting to add new disclosure to that originally disclosed on filing.

If new matter is added to the specification, it should be objected to by using Form Paragraph 7.28.

7.28 Objection to New Matter Added to Specification

The amendment filed [1] is objected to under 35 U.S.C. 132 because it introduces new matter into the specification. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: [2]

Applicant is required to cancel the new matter in the response to this Office action.

Examiner Note:

1. In bracket 2, fill in the page and line numbers involved and provide an appropiate explanation your position if appropriate.

2. If new matter is also added to the claims, an objection to the specification should be made under 35 U.S.C. 112, first paragraph, using form paragraph 7.30, example d; as well as a rejection using form paragraph 7.31.

706.03(p) No Utility

A rejection on the ground of *lack of utility* includes the more specific grounds of *inoperativeness, involving perpetual motion, frivolous, fraudulent, against public policy.* The statutory basis for this rejection is 35 U.S.C. 101. See §608.01(p).

706.03(q) Obvious Method

In view of a decision of the U.S. Court of Customs and Patent Appeals, process claims should no longer be rejected on a theory that once the article or composition produced thereby is conceived, anyone skilled in the art would at once be aware of a method of making it, In re Kuehl, 177 USPQ 250 (1973).

A process may be unpatentable, however, even if the product produced therefrom is patentable, In re Kanter, 158 USPQ 331 (CCPA 1968). The mere substitution of a new starting material in an otherwise conventional process may well be obvious in the absence of some unobvious result in the process itself, In re Kanter, 158, USPQ 331; In re Neugebauer et al., 141 USPQ 205 (CCPA 1964); Corning Glass Works et al. v. Brenner, 175 USPQ 516 (D.C. Cir. 1972).

However, the use of a specific mineral oil in a process was held to be material in In re Schneider et al., 179 USPQ 46 (CCPA 1973).

706.03(r) Mere Function of Machine

In view of the decision of the Court of Customs and Patent Appeals in In re Tarczy-Hornoch appearing at 158 USPQ 141, process or method claims are not subject to rejection by Patent and Trademark Office examiners solely on the ground that they define the inherent function of a disclosed machine or apparatus.

706.03(s) Statutory Bar

Another category of rejections not based on the prior art finds a basis in some prior act of applicant, as a result of which the claim is denied him.

Abandonment of Invention

Under 35 U.S.C. 102(c), abandonment of the "invention" (as distinguished from abandonment of an application) results in loss of right to a patent. Note In re Gibbs et al., 168 USPQ 578 (CCPA 1971).

Own Prior Foreign Patent

Extract from 35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless—

* * * * *

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

The statute above quoted establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country:

(1) The foreign application must be filed more than one year before the filing in the United States.

(2) It must be filed by the applicant, his or her legal representatives or assigns.

(3) The foreign patent or inventor's certificate must be actually granted (e.g., by sealing of the papers in Great Britain) before the filing in the United States or, since foreign procedures differ, the act from which it can be said that the invention was patented, has occured. It need not be published. *Ex parte* Gruschwitz et al., 138 USPQ 505 discusses the meaning of "patented" as applied to German procedures.

(4) The same invention must be involved.

If such a foreign patent or inventor's certificate is discovered by the examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of *statutory bar.*

Submission to Library Unnecessary

Applications should not be submitted as a routine matter to the library to ascertain if the foreign appli-

cation has become a patent. Since the foreign patent to be a bar under 35 U.S.C. 102(d) must have been granted before the filing date in this county, the probability of the foreign patent having issued after the date of execution of the original oath and before the U.S. filing date is so slight as to make such a search ordinarily unproductive.

FOREIGN FILING WITHOUT LICENSE

35 U.S.C. 182. Abandonment of invention for unauthorized disclosure. The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

35 U.S.C. 184. Filing of application in foreign country. Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for registration of a utility model, industrial design, or model in respect of an invention made in this country. A license should not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions therof.

335 U.S.C. 185. Patent barred for filing without license. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

If, upon examining an application, the examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for six months, and if the invention apparently was made in this country, he shall refer the application to Licensing and Review Section of Group 220, calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the examining group for prosecution on the merits. When it is otherwise in condition for allowance, the application will be again submitted to Licensing and Review Section of Group 220 unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under 35 U.S.C. 185, Licensing and Review Section of Group 220 will request transfer of the application to it.

OTHER STATUTORY BARS

Claims to an invention in public use or on sale in the United States more than twelve months before the effective U.S. filing date are rejected. 35 U.S.C. 102(b). See chapter 2100.

706.03(t) Other Assigned Application

As pointed out in § 304, assignment of one of several overlapping applications of the same inventor may give rise to a ground of rejection. See also §§ 305 and 706.03(k).

706.03(u) Disclaimer

Claims may be rejected on the ground that applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant's failure:

(a) to make claims suggested for interference with another application under 37 CFR 1.203 (§ 1101.01(m)),

(b) to copy a claim from a patent when suggested by the examiner (§ 1101.02(f)), or

(c) to respond or appeal, within the time limit fixed, to the examiner's rejection of claims copied from a patent (see 37 CFR 1.206(b) and § 1101.02(f)).

The rejection on disclaimer applies to all claims not patentably distinct from the disclaimed subject matter as well as to the claims directly involved.

Rejections based on disclaimer should be made by using one of Form Paragraphs 7.46–7.49.

7.46 Rejection, Disclaimer

Claim (1) rejected on the ground that applicant has disclaimed the claimed subject matter by failing to copy the suggested claim(s) for interference purposes. This constitutes a concession that the subject matter of the claim(s) is the prior invention of another in this country. See MPEP 1101.01(l).

Examiner Note:

1. This paragraph is applicable when the suggested claim(s) is (are) from, or based on another application.
2. See next paragraph for 103 type rejections.

7.47 Rejection, 35 U.S.C. 103 Disclaimer

Claim [1] rejected under 35 U.S.C 103 as being unpatentable over [2]. Applicant has failed to copy the suggested claim(s) for interference purposes. This constitutes a concession that the subject matter of the claim(s) is the prior invention of another in this country and is thus prior art to the applicant under 35 U.S.C. 103. See MPED 1101.01(l).

Examiner Note:

(1) insert, for example, the following in bracket 2: "the suggested claim(s) in view of [reference]"

(2) a further explanation is necessary as to how the suggested claims(s) is (are) modified by the reference to arrive at the claimed invention.

3. This paragraph is applicable when the suggested claim(s) is (are) from, or based on, another application.

7.48 Failure To Copy Claims From Patent

Claim [1] rejected under 35 U.S.C. [2] on claim [3] of Patent [4]. Failure to copy claims for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter

of law, the patentee is the first inventor in this country. In re Oguie, 186 USPQ 227 (CCPA 1975).

Examiner Note:

This paragraph should be used only after applicant has been notified that interference proceedings must be instituted before the claims can be allowed and applicant has refused to copy the claims.

In bracket 2, insert 102(g) or 102(g)/103.

In bracket 4, insert the patent number, "in view of" another reference may also be inserted here. When the rejection is under 35 U.S.C. 103, basis for finding obviousness should be included. For interferences involving obvious variants, see Aelony et al. v. Arni et al., 192 USPQ 486 (CCPA 1978).

7.49 Rejection, Disclaimer, Failure to Appeal

Claim [1] rejected on the ground that applicant has disclaimed the subject matter involved for failure to respond or appeal from the examiner's rejection of claims(s) copied from a patent within the time limit fixed (see 37 CFR 1.206(b) and § 1101.02(f) of the MPE).

706.03(v) After Interference or Public Use Proceeding

For rejections following an interference, see §§ 1109 to 1110.

The outcome of public use proceedings may also be the basis of a rejection. (See 37 CFR 1.292) (Note: In re Kaslow, 217 USPQ 1089, CAFC 1983).

Upon termination of a public use proceeding including a case also involved in interference, in order for a prompt resumption of the interference proceedings, a notice should be sent to the Board of Patent Interferences notifying them of the disposition of the public use proceeding.

706.03(w) Res Judicata

Res Judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of res judicata rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision.

The timely filing of a second application copending with an earlier application does not preclude the use of *res judicata* as a ground of rejection for the second application claims.

When making a rejection on *res judicata*, action should ordinarily be made also on the basis of prior art, especially in continuing applications.

In most situations the same prior art which was relied upon in the earlier decision would again be applicable.

In the following cases a rejection of a claim on the ground of res judicata was sustained where it based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

Edgerton v. Kingland, 75 USPQ 307 (D.C. Cir., 1947).

In re Swarc, 138 USPQ 208, 50 CCPA 1571 (1963).

In re Katz, 167 USPQ 487, 58 CCPA 713 (1970), (prior decision by District Court).

In the following cases for various reasons, res judicata rejections were reversed.

In re Fried, 136 USPQ 429, 50 CCPA 954 (1963) (differences in claims).

In re Szwarc, 138 USPQ 208, 50 CCPA 1571 (1963) (differences in claim).

In re Hellbaum, 152 USPQ 571, 54 CCPA 1051 (1967) (differences in claims).

In re Herr, 153 USPQ 548, 54 CCPA 1315 (1967) (same claims, new evidence, prior decision by CCPA).

In re Kaghan, 156 USPQ 130, 55 CCPA 844 (1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner "to simplify the issue", differences in claims; holding of waiver based on language in MPEP at the time).

In re Craig, 162 USPQ 157, 56 CCPA 1438 (1969) (Board of Appeals held second set of claims patentable over prior art).

In re Fisher, 166 USPQ 18, 57 CCPA 1099 (1970) (difference in claims).

In re Russell, 169 USPQ 426, 58 CCPA 1081 (1971) (new evidence, rejection on prior art reversed by court).

In re Ackermann, 170 USPQ 340, 58 CCPA 1405 (1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court).

Plastic Contact Lens Co. v. Gottschalk, 179 USPQ 262 (D.C Cir., 1973) (follows In re Kaghan).

706.03(x) Reissue

The examination of reissue applications is covered in Chapter 1400.

35 U.S.C. 251 forbids the granting of a reissue "enlarging the scope of the claims of the original patent" unless the reissue is applied for within two years from the grant of the original patent. This is an absolute bar and cannot be excused. This prohibition has been interpreted to apply to any claim which is broader in any respect than the claims of the original patent. Such claims may be rejected as being barred by 35 U.S.C. 251. However, when the reissue is applied for within two years, the examiner does not go into the question of undue delay.

The same section permits the filing of a reissue application by the assignee of the entire interest only in cases where it does not "enlarge the scope of the claims of the original patent". Such claims which do enlarge the scope may also be rejected as barred by the statute.

A *defective reissue* oath affords a ground for rejecting all the claims in the reissue application. See § 1444.

Note that a reissue application is "special" and remains so even if applicant does not make a prompt response.

706.03(y) Improper Markush Group

Ex parte Markush, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is

commensurate in scope with the field which the applicant desires to cover. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology are most frequently claimed under the Markush formula but purely mechanical features or process steps may also be claimed by using the Markush style of claiming, see Ex parte Head, 214 USPQ 551 (Bd. Appl's 1981); In re Gaubert, 187 USPQ 664 (CCPA 1975) and In re Harnisch, 206 USPQ 300 (CCPA 1980). It is improper to use the term "comprising" instead of "consisting of". Ex parte Dotter, 12 USPQ 382. Regarding the normally prohibited inclusion of Markush claims of varying scope in the same case, see Ex parte Burke, 1934 C.D. 5; 441 O.G. 509.

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made. This practice with respect to Markush claims of diminishing scope is being continued.

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (§ 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper.

SUBGENUS CLAIM

A situation may occur in which a patentee has presented a number of examples which, in the examiner's opinion, are sufficiently representative to support a generic claim and yet a court may subsequently hold the claim invalid on the ground of undue breadth. Where this happens the patentee is often limited to species claims which may not provide him with suitable protection.

The allowance of a Markush-type claim under a true genus claim would appear to be beneficial to the applicant without imposing any undue burden on the Patent and Trademark Office or in any way detracting from the rights of the public. Such a subgenus claim would enable the applicant to claim all the disclosed operative embodiments and afford him an intermediate level of protection in the event the true genus claims should be subsequently held invalid.

The examiners are therefore instructed not to reject a Markush-type claim merely because of the presence of a true genus claim embracive thereof.

See also §§ 608.01(p) and 715.03.

See § 803 for restriction practice re Markush-type claims.

706.03(z) Undue Breadth

In applications directed to inventions in arts where results are predictable, broad claims may properly be supported by the disclosure of a single species. In re Vickers et al., 1944 C.D. 324; 61 USPQ 122: In re Cook and Merigold, 169 USPQ 298.

However, in applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. In re Sol, 1938 C.D. 723; 497 O.G. 546. This is because in arts such as chemistry it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 1940 C.D. 351; 518 O.G. 255 gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases", 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail.

A single means claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt (218 USPQ 195, CAFC 1983).

706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See Ex parte Grier, 1923 C.D. 27; 309 O.G. 223; Ex parte Hay, 1909 C.D. 18; 139 O.G. 197.

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.

Because it is unusual to reject a previously allowed claim, the examiner should point out in his letter that

the claim now being rejected was previously allowed by using Form Paragraph 7.50.

7.50 Claims Allowed, Now Rejected, New Art

The indicated allowability of claim [1] is withdrawn in view of the newly discovered prior art to [2]. The delay in citation of this art is regretted. Rejections based on the newly discovered prior art follow.

Examiner Note:

1. In bracket 2, insert the name(s) of the newly discovered prior art.

706.05 Rejection After Allowance of Application

See § 1308.01 for a rejection based on a reference.

For rejection of claims in an allowed case which has failed to make the date of a senior application in correspondence under 37 CFR 1.202, see § 1101.01(i).

706.06 Rejection of Claims Copied From Patent

See § 1101.02(f).

706.07 Final Rejection

37 CFR 1.113. Final rejection or action.

(a) On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirement or objection as to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination; i.e., either an allowance of the case or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection", present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her case. But the applicant who dallies in the prosecution of his or her case, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes not the Rules of Practice confer any right on an applicant to an extended prosecution. Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3.

Statement of Grounds

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's response. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

7.39 Action Is Final

This action is made final. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Examiner Note:

1. This paragraph should not be used in reissue litigation cases (SSP-1 month) or in reexamination proceedings (SSP-2 months).

2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in a reexamination proceeding.

The Office action first page form PTOL-326 should be used in all Office actions up to and including final rejections.

A final rejection must be signed by a primary examiner.

For amendments filed after final rejection, see §§ 714.12 and 714.13

For final rejection practice in reexamination proceedings see § 2271.

706.07(a) Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, or newly cited art, of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonable have been expected to be claimed. See Sections 904 et seq. For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be responded to by an amendment supplying the omitted element.

See § 809.02(a) for actions which indicate generic claims not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

Form paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment.

7.40 Action Is Final, Necessitated by Amendment

Applicant's amendment necessitated new grounds of rejection. Accordingly, *this action is made final.* See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Examiner Note:

1. This paragraph should not be used in reissue litigation cases (SSP–1 month) or in reexamination proceedings (SSP–2 months).

2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in a reexamination proceeding.

706.07(b) Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application.

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry for one of the following reasons:

(1) New issues were raised that required further consideration and/or search, or

(2) The issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A First Action Final rejection should be made by using form paragraph 7.41.

7.41 Action Is Final, First Action

This is a [1] of applicant's earlier application S.N. [2]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, *this action is made final* even though it is a first action in this case. See MPEP 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY

PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Examiner Note:

1. Insert Continuation or Substitute, as appropriate, in "bracket 1".

2. See MPEP 706.07(b).

3. This paragraph should not be used in reissue litigation cases (SSP-1 month) or in reexamination proceedings (SSP-2 months).

4. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in a reexamination proceeding.

706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the case is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Appeals. It is reviewable by petition under 37 CFR 1.181.

706.07(d) Final Rejection, Withdrawal of, Premature

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he should withdraw the finality of the rejection.

Form Paragraph 7.42 should be used when withdrawing a Final Rejection.

7.42 Withdrawal of Final Rejection

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and the finality of that action is withdrawn.

706.07(e) Withdrawal of Final Rejection, General

See §§ 714.12 and 714.13, Amendments after final rejection.

Once a final rejection that is not premature has been entered in a case, it should not be withdrawn at the applicant's or patent owner's request except on a showing under 37 CFR 1.116(b). Further amendment or argument will be considered in certain instances. An amendment that will place the case either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a).

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

New grounds of rejection made in an Office action reopening prosecution after the filing of an appeal brief require the approval of the supervisory primary examiner. See § 1002.02(d).

706.07(f) Time for Response to Final Rejection

On October 1, 1982, pursuant to Public Law 97-247, the Office discontinued the practice of extending for one month the shortened statutory period for response to a final rejection upon the filing of a timely first response to a final rejection (37 CFR 1.116). Since October 1, 1982, applicants are able to obtain additional time for a first or subsequent response to a final rejection by petitioning under 37 CFR 1.136(a), and paying the appropriate fee, provided the additional time does not exceed the six month statutory period.

Present practice encourages the early filing of any first response after a final rejection. To encourage continued filing of early first responses after a final rejection and to take care of any situations in which the examiner does not timely respond to a first response after final rejection which is filed early during the period for response, the Office has changed the manner in which the period for response is set on any final rejection mailed after February 27, 1983.

1. *All* final rejections setting a three (3) month shortened statutory period (SSP) for response should contain one of the Form Paragraphs (7.39; 7.40; 7.41) advising applicant the *if* the response is filed within two (2) months of the date of the final Office action, the shortened statutory period will expire at three (3) months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable response period will be established. In no event can the statutory period for response expire later than six (6) months from the date of the final rejection.

2. If the paragraph setting a variable response period is inadvertently *not* included in the final Office action, the SSP for response will end three (3) months from the date of the final Office action and cannot be extended other than by making a petition and paying a fee pursuant to 37 CFR 1.136(a). However, if an advisory action (including an examiner's amendment) is mailed in such a case where the response to the final action has been filed within two (2) months, the examiner should vacate the original SSP and reset the period for response to correspond with the Office policy set forth at 1027 OG 71. See paragraph (6) below.

3. This procedure of setting a variable response period in the final rejection dependent on when applciant files a first response to a final office action does

not apply to situations where an SSP less than three (3) months is set—e.g. reissue litigation cases (1 month SSP) or any reexamination case.

Advisory Actions

4. Where the final Office action sets a variable response period as set forth in paragraph 1 above, *AND* applicant files a *complete first* response to the final Office action within two (2) months of the date of the final Office action, the examiner must determine if the

a. Response puts the application in condition for allowance—then the application should be processed as an allowance and no extension fees are due.

b. Response puts the application in condition for allowance except for matters of form which the examiner can change *without* authorization from applicant, MPEP 1302.04—then the application should be amended as required and processed as an allowance and no extension fees are due.

c. Response does not put the application in condition for allownace—then the advisory action should inform applicant that the SSP for response expires three (3) months from the date of the final rejection or as of the mailing date of the advisory action, whichever is later.

If PTOL-303 form is used: (1) Draw a line through the top two (2) lines relating to the period for response *and* (2) use Form Paragraph 7.67.1 in the advisory action.

If PTOL-303 is not used, then use Form Paragraph 7.67.1 on all advisory actions where a first complete response has been filed within two (2) months of the date of the final Office action.

5. Where the final Office action sets a variable response period as set forth in paragraph 1 above, *and* applicant does *NOT* file a complete first response to the final Office action within two (2) months, examiners should use the content of Form Paragraph 7.67.

6. Where the final Office action does *not* set a variable response period as set forth in paragraph 1 above, *AND* applicant does file a complete first response to the final Office action within two (2) months, and if an advisory action (which may include an examiner's amendment) is necessary and cannot be mailed within three (3) months of the final Office action, the examiner should vacate the original SSP and reset the response period to expire on the mailing date of the advisory action by using form paragraph 7.67.2. In no case can the statutory period for response expire later than six (6) months from the date of the final Office action. Note that Form Paragraph 7.67.2 can be used with the advisory action (perferable) or after the advisory action is mailed to correct the error of not setting a variable response period.

7. When an advisory action properly contains either Form Paragraph 7.67.1 or 7.67.2, the time for applicant to take further action (including the calculation of extension fees under 37 CFR 1.136(a) begins to run three (3) months from the date of the final rejection, or from the date of the advisory action, whichever is later. Extension fees cannot be prorated for portions of a month. In no event can the statutory period for response expire later than six (6) months from the date of the final rejection.

Examiner's Amendments

8. Where a complete first response to a final Office action has been filed within two (2) months of the final Office action, an examiner's amendment to put the application in condition for allowance may be made without the payment of extension fees if the examiner's amendment is a part of the first advisory action, because the examiner's amendment will either set (7.67.1) or reset (7.67.2) the period for response to expire on the date the examiner's amendment is mailed if it is mailed more than three (3) months from the date of the final Office action.

9. Where a complete first response to a final Office action has not been filed within two (2) months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the three (3) month shortened statutory period or within an extended period for response that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a).

10. An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g. when an examiner's amendment is necessary after the shortened statutory period for response has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be made of record in the application file by the examiner by way of an Interview Record form dated before the extended period expires. The authorization should also be made or record in an examiner's amendment by indicating the name of the person making the authorization, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged to the deposit account. *SAMPLE:* An extension of time under 37 CFR 1.136(a) is required to place this application in condition for allowance. During a telephone conversation conducted on (date), John Doe (attorney for applicant) requested an extension of time for——months and authorized the Commissioner to charge Deposit Account No. —— the required fee of $——for this extension.

Practice After Final

11. Responses after final should be processed and considered promptly by all Office personnel.

12. Responses after final should not be considered by the examiner unless they are filed within the SSP

or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 1.136(a)). This requirement also applies to supplemental responses filed after the first response.

13. Interviews may be conducted after final within the six (6) month Statutory period for response *without* the payment of an extension fee.

14. Formal matters which are identified for the first time after a response is made to a final Office action and which require action by applicant to correct may be required in an *Ex Parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the response puts the application in condition for allowance except for the correction of formal matters—the correction of which had not yet been required by the examiner.

15. If prosecution is to be reopened after a final Office action has been responded to, the finality of the previous Office action should be withdrawn to avoid the issue of abandonment and the payment of extension fees. For example, if a new reference comes to the attention of the examiner which renders unpatentable a claim indicated to be allowable, the Office action should begin with a statement to the effect: The finality of the Office action mailed is hereby withdrawn in view of the new ground of rejection set forth below. Form Paragraph 7.42 could be used in addition to this statement.

Form Paragraph 7.67.1

7.67.1 Advisory After Final, Heading, 1st Response Filed Within 2 Months

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

Examiner Note:

This paragraph should be used in all advisory actions if:

1. it was the *first* response to the final rejection, and
2. it was filed within 2 months.

If a notice of appeal has been filed, also use paragraph 7.68.

Form Paragraph 7.67.2

7.67.2 Advisory After Final, Heading, No Variable SSP Set in Final

Since the first response to the Final Office action has been filed within two (2) months of the mailing date of that action and the advisory action was not mailed within three (3) months of that date, the three (3) month shortened statutory period for response set in the Final Office action is hereby vacated and reset to expire as of the mailing date of the advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the Official Gazette at 1027 OG 71, February 8, 1983. In no event, however, will the statutory period for response expire later than six (6) months from the date of the Final Office action. Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

Examiner Note:

1. This paragraph should be used in all advisory actions where:

a. the response is a first response to the final action;

b. the response was filed within two months of the mailing date of the final; *and*

c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraph 7.39–7.41.

2. If the final action set a variable SSP, do not use this paragraph. Use paragraph 7.67.1.

3. If a notice of appeal has been filed, also use paragraph 7.68.

Under the changed procedure, if an applicant initially responds within two months from the date of mailing of any final rejection setting a three-month shortened statutory period for response and the Office does not mail an advisory action until after the end of the three-month shortened statutory period, the period for response for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond six months from the date of the final rejection. This procedure will apply only to a first response to a final rejection and has been implemented by including the following language in each final rejection mailed after February 27, 1983:

"A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION."

For example, if applicant initially responds within two months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of three months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of three months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the three-month period. If the examiner, however, does not mail an advisory action until after the end of three months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

707 Examiner's Letter or Action

37 CFR 1.104. Nature of examination; examiner's action (a) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objec-

tion or requirement will be stated and such information or references will be given as may be useful in aiding the applicant or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(c) An international-type search will be made in all national applications filed on and after June 1, 1978.

(d) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee. See § 1.21 (e) for amount of fee for perparation of international-type search report.

NOTE.—The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

For Office actions in reexamination proceedings see § 2260.

Under the current first action procedure, the examiner signifies on the action form PTOL-326 certain information including the period set for response, any attachments, and a "summary of action," the position taken on all claims.

Current procedure also allows the examiner, in the exercise of his professional judgment to indicate that a discussion with applicant's or patent owner's representative may result in agreements whereby the application or patent under reexamination may be placed in condition for allowance and that the examiner will telephone the representative within about two weeks. Under this practice the applicant's or patent owner's representative can be adequately prepared to conduct such a discussion. Any resulting amendment may be made either by the applicant's or patent owner's attorney or agent or by the examiner in an examiner's amendment. It should be recognized that when extensive amendments are necessary it would be preferable if they were filed by the attorney or agent of record, thereby reducing the professional and clerical workload in the Office and also providing the file wrapper with a better record, including applicant's arguments for allowability as required by 37 CFR 1.111.

The list of references cited appears on a separate form, Notice of References Cited, PTO-892 (copy in § 707.05) attached to applicant's copies of the action. Where applicable, Notice of Informal Patent Drawings, PTO-948 and Notice of Informal Patent Application, PTO-152 are attached to the first action.

The attachments have the same paper number and are to be considered as part of the Office action.

Replies to Office actions should include the 3-digit art unit number and the examiner's name to expedite handling within the Office.

In accordance with the Patent Law, "Whenever, on examination, any claim for a patent is rejected or any objection . . . made", notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included. For rejections under section 103, the way in which a reference is modified or plural references are combined should be set out.

In exceptional cases, as to satisfy the more stringent requirements under 37 CFR 1.106(b), and in pro se cases where the inventor is unfamiliar with the patent law and practice, a more complete explanation may be needed.

Objections to the disclosure, explanation of references cited but not applied, indication of allowable subject matter, requirements (including requirements for restriction if space is available) and any other pertinent comments may be included.

Summary sheet PTOL-326, which serves as the first page of the Office action, is to be used with all first actions and will identify any allowed claims.

707.01 Primary Examiner Indicates Action for New Assistant

After the search has been completed, action is taken in the light of the references found. Where the assistant examiner has been in the Office but a short time, it is the duty of the primary examiner to go into the case thoroughly. The usual procedure is for the assistant examiner to explain the invention and discuss the references which he regards as most pertinent. The primary examiner may indicate the action to be taken, whether restriction or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, he or she may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

707.02(a) Cases Up for Third Action and Five-Year Cases

The supervisory primary examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory primary examiners are expected to personally check on the pendency of every application which is up for the third or subsequent official action with a view to finally concluding its prosecution.

Any case that has been pending five years should be carefully studied by the supervisory primary examiner and every effort made to terminate its prosection. In order to accomplish this result, the case is to be considered "special" by the examiner.

707.04 Initial Sentence

The "First Page of Action" form PTOL-326 contains an initial sentence which indicates the status of that action, as, "This application has been examined" if it is the first action in the case, or, "Responsive to communication filed——." Other papers received, such as supplemental amendments, affidavits, new drawing, etc., should be separately mentioned.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D C 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/123456	02/02/82	John E. Doe	DOC-2345

Turner & Pollard
Suite 263
324 Elm Street
Boston, Mass. 11111

EXAMINER	
Thesz	
ART UNIT	PAPER NUMBER
233	2

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

[X] This application has been examined [ ] Responsive to communication filed on _____ [ ] This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), --- days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [X] Notice of References Cited by Examiner, PTO-892.
2. [ ] Notice re Patent Drawing, PTO-948.
3. [ ] Notice of Art Cited by Applicant, PTO-1449
4. [ ] Notice of Informal Patent Application, Form PTO-152
5. [ ] Information on How to Effect Drawing Changes, PTO-1474
6. [ ] _____

Part II SUMMARY OF ACTION

1. [X] Claims 1-11 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. [ ] Claims _____ have been cancelled.
3. [ ] Claims _____ are allowed.
4. [X] Claims 1-8 are rejected.
5. [X] Claims 9-11 are objected to.
6. [ ] Claims _____ are subject to restriction or election requirement.
7. [ ] This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. [ ] Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. [ ] The corrected or substitute drawings have been received on _____. These drawings are [ ] acceptable; [ ] not acceptable (see explanation).
10. [ ] The [ ] proposed drawing correction and/or the [ ] proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been [ ] approved by the examiner. [ ] disapproved by the examiner (see explanation).
11. [X] The proposed drawing correction, filed 6-1-82, has been [X] approved. [ ] disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. [X] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received [X] not been received [ ] been filed in parent application, serial no. _____; filed on _____.
13. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. [ ] Other

PTOL-326 (Rev. 7-82) EXAMINER'S ACTION

FORM PTO-892 (REV. 3-78) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

SERIAL NO.	GROUP ART UNIT	ATTACHMENT TO PAPER NUMBER
999,998	425	3

APPLICANT(S): STRUCK et al

U.S. PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
	A	2,717,874	9-1955	VERAIN	21	102RX	
*	B	2,572,144	10-1951	HEALY	340	71X	
	C	2,137,376	11-1938	ALTORFER	21	DIG. 2	
	D	T881,002	12-1970	JONES	96	1.6	
	E	PP 2,400	5-1964	BOERNER	Plant	20	
	F	B 207,272	1-1975	DAVIDSON	75	1	
	G	1,671,843	5-1928	SCOTT	15	104.01R	
	H	D238,404	1-1976	OWENS	D6	5	1-13-1972
	I	DRe 24,841	6-1960	ROCHÉ	D8	189	
	J	Re 18,406	4-1932	MARINSKY	24	205.16C	
*	K	3,035,319	5-1962	WOLFF	24	274WBX	

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SHTS. DWG.	PERTINENT PP. SPEC.
	L	136,113	1-1950	AUSTRALIA	Paper Products	24	1340A		
	M	Add 34,662	11-1934	FRANCE	LORENZ	26	15R	1	4-7
	N	19,421 of 1913		United Kingdom	CROSSE	26	51.6		
*	O	1,345,890	7-19-63	GERMANY	MUTHER	19	6		
	P	683,125	3-1964	CANADA	FISHBURNE	100	216	1-5	1-19
	Q								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R Chemical Abstracts, Vol. 75, No. 20, Nov. 15, 1971, p. 163, abstract no. 120218K, Shetulev, D.I., "Surface Effects During Metal Fatigue", Copy in Group 120 Library

S (5008400) Winslow, C.E.A., Fresh Air and Ventilation, E.P. Dutton, N.Y., 1926, P.97-112, TH 7653 W5, 315-22

T Ballistic Missile + Aerospace Technology, Vol. 3, Academic Press, N.Y., 1964, TL 78759, p. 199, 150-108

U Carbowax + Polyethylene Glycols, Carbide Chemical Corporation, 1946, p. 5, Copy in Group 120 Library

EXAMINER	DATE
Richard STONE	4-10-76

* A copy of this reference is not being furnished with this office action.
(See Manual of Patent Examining Procedure, section 707.05 (a).)

A preliminary amendment in a new case should be acknowledged by adding a sentence such as "The amendments filed (date) has been received."

707.05 Citation of References

During the examination of an application or reexamination of a patent the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained.

Form Paragraph 7.96 may be used as an introductory sentence.

7.96 Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent ot applicant's disclosure.

Examiner Note:

When such prior art is cited, its pertinence should be explained in accordance with MPEP 707.05.

Allowed applications should generally contain a citation of pertinent prior art for printing in the patent, even if no claim presented during the prosecution was considered unpatentable over such prior art. Only in those instances where a proper search has not revealed any prior art relevant to the claimed invention is it appropriate to send a case to issue with no art cited. In the case where no prior art is cited, the examiner must write "None" on a form PTO-892 and insert it in the file wrapper. Where references have been cited during the prosecution of parent applications and a continuing application, having no newly cited references, is ready for allowance, the cited references of the parent applications should be listed on a form PTO-892. The form should then be placed in the file of the continuing application. See Section 1302.12.

In all continuing applications, the parent applications should be reviewed for pertinent prior art.

37 CFR 1.107. Citation of references. (a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees, and the classes of inventions must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

707.05(a) Copies of Cited References

Copies of cited references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the examiner during the prosecution.

Copies of references which are cited at the time of allowance, in Ex parte Quayle actions, and by applicant in accordance with §§ 609, 707.05(b) and 708.02 are *not* furnished to applicant with the Office action. Additionally, copies of references cited in continuation applications if they had been previously cited in the parent application are not furnished. The examiner should check the left hand column of form PTO-892 if a copy of the reference is not to be furnished to the applicant.

In the rare instance where no art is cited in a continuation application, all the references cited during the prosecuton of the parent application will be listed at allowance for printing in the patent.

To assist in providing copies of references, the examiner should:

(a) Write the citation of the references on form PTO-892, "Notice of References Cited"

(b) Place the form PTO-892 in the front of the file wrapper.

(c) Include in the application file wrapper all of the references cited by the examiner which are to be furnished to the applicant and which have been obtained from the classified search file with the exception of "Jumbo" patents (any U.S. patent in excess of 40 pages). Box on the form PTO-892. Copies of "Jumbo" patents will be ordered by the clerical staff.

(d) Make two copies of each reference which is to be supplied and which has been located in a place other than the classified search file (i.e. textbooks, bound magazines, personal search material, etc.). Using red ink identify one copy as the "File Copy" and the other copy as the "Applicant's Copy". Both copies should be placed in the application file wrapper.

(e) Turn the application in to the Docket Clerk for counting. Any application which is handed in without all of the required references will be returned to the examiner. The missing reference(s) should be obtained and the file returned to the Docket Clerk as quickly as possible.

In the case of design applications, procedures are the same as set forth in section 707.05 (a)-(g) except that less than the entire disclosure of a cited U.S utility patent may be supplied with the action by the Design Group. Copies of all sheets of drawings relied on and of the first page of the specification are furnished without charge. Any other subject matter, including additional pages of specification relied on by the examiner will also be provided without charge. Where an applicant desires a complete copy of a cited U.S. utility patent it may be obtained through the Customer Services Division at the usual charge.

707.05(b) Citation of Related Art by Applicants

Section 609 sets forth positive guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the Patent and Trademark Office.

All citations of prior art or other material submitted in accordance with the guidelines of § 609 and submit-

ted before all claims have been indicated as allowable will be fully considered by the examiner.

While the Patent and Trademark Office will not knowingly ignore any prior art which might anticipate or suggest the claimed invention, no assurance can be given that cited art or other material not submitted in accordance with these guidelines will be considered by the examiner.

Submitted citations will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing pertinent prior art of which they may be aware, whether or not such are is cited by the applicant.

Prior art submitted by applicant in the manner provided in § 609 will not be supplied with an Office action, but unless it is listed on a form PTO-1449, it will be listed on the form PTO-892, "Notice of References Cited," along with other prior art relied upon by the examiner during the examination. Accordingly, the examiner should check the space on form PTO-892 to indicated that no copy of that reference need be furnished to the applicant. Only that prior art listed by the examiner on form PTO-892 will be printed on the patent.

However, if the prior art is submitted in a mnner which does not comply with the § 609 guidelines, it is not necessry to list all cited prior art on form PTO-892 in order to make the citations of record. This is because the complete listing of applicant's citations will be in the application file and will be available for inspection by the public after issuance of the patent with notations as indicated under item C or § 717.05. The examiner may state that all the prior art cited by applicant has been considered, even if it was submited in a manner which does not fully comply with the requirements of this section.

707.05(c) Order of Listing

In citing references for the first time, the identifying data of the citation should be placed on form PTO-892 "Notice of References Cited", a copy of which will be attached to the Office action. No distinction is to be made between references on which a claim is rejected and those formerly referred to as "pertinent". With the exception of applicant submitted citations (§§ 707.05(b) and 708.02), the pertinent features of references which are not used as a basis for rejection, shall be pointed out briefly.

See § 1302.12.

707.05(d) Reference Cited in Subsequent Actions

Where an applicant in an amendatory paper refers to a reference which is subsequently relied upon by the examiner, such reference shall be cited by the examiner in the usual manner.

707.05(e) Data Used in Citing References

37 CFR 1.107 (§§ 707.05 and 901.05(a)) requires the examiner to give certain data when citing references. The patent number, patent date, name of the patentee, class and subclass and the filing date, if appropriated, must be given in the citation of U.S. patents. This information is listed on the "Notice of References Cited" form PTO-892 (Copy at § 707.05). See § 901.04 for details concerning the various series of U.S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U.S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

If the patent date of a U.S. patent is after and the effective filing date of the patent is before the effective U.S. filing date of the application, the filing date of the patent must be set forth along with the citation of the patent. This calls attention to the fact that the particular patent relied on is a reference because of its filing date and not its patent date. Similarly, when the reference is a continuation-in-part of an earlier-filed application which discloses the anticipatory matter and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated.

In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See § 707.05(a).

Cross-References

Official cross-references should be marked "X".

Foreign Patents and Published Applications

In citing foreign patents, the patent number, citation date, name of the country, name of the patentee, and class and subclass must be given.

In actions where references are furnished, and (1) less than the entire disclosure is relied upon, the sheet and page numbers specifically relied upon and the total number of sheets of drawing and pages of specification must be included (except applicant submitted citations); (2) the entire disclosure is relied upon, the total number of sheets and pages are not included, and the appropriate columns on PTO-892 are left blank.

Publications such as German allowed applications and Belgian and Netherlands printed specifications should be similarly handled. If the total number of sheets and pages in any publication *to be furnished* (other than U.S. patents) exceeds 15, the authorizing signature of the supervisory primary examiner is required. Applicants who desire a copy of the complete foreign patent or of the portion not "relied on" must order it in the usual manner.

See § 901.05(a) for a chart in which foreign language terms indicative of foreign patent and publication dates to be cited are listed.

Publications

See § 711.06(a) for citation of abstracts, abbreviatures and defensive publications. See § 901.06(c) for citation of Alien Property Custodian publications.

In citing a publication, sufficient information should be given to determine the identity and facilitate the

location of the publication. For books the data required by § 1.107 (§ 707.05) with the specific pages relied on identified together with the SCIENTIFIC LIBRARY call number will suffice. The call number appears on the "spine" of the book if the book is thick enough and, in any event, on the back of the title page. Books on interlibrary loan will be marked with the call numbers of the other library, of course. THIS NUMBER SHOULD NOT BE CITED. The same convention should be followed in citing articles from periodicals. The call number should be cited for periodicals owned by the Scientific Library, but not for periodicals borrowed from other libraries. In citing periodicals, information sufficient to identify the article includes the author(s) and title of the article and the title, volume number issue number, date, and pages of the periodical. If the copy relied upon is located only in the group making the action (there may be no call number), the additional information, "Copy in Group——" should be given.

Examples of nonpatent biblographical citations:

1. For books:

Winslow. C. E. A. *Fresh Air and Ventilation.* N.Y., E. P. Dutton, 1926. p. 97–112. TI17653.W5.

2. For parts of books:

Smith, J. F. "Patent Searching." *In:* Singer, T.E.R., *Information and Communication Practice in Industry* (New York, Reinhold, 1958), pp. 157–165. T 175.S5.

3. For encyclopedia articles:

Calvert, R. "Patents (Patent Law)." *In: Encyclopedia of Chemical Technology* (1952 ed.), vol. 9, pp. 868–890. Ref. TP9.E68.

4. For sections of handbooks:

Machinery's Handbook, 16th ed. New York, International Press, 1959. pp. 1526–1527. TJ151.M3 1959.

5. For periodical articles:

Noyes, W. A. "A Climate for Basic Chemical Research."

Chemical & Engineering News, vol. 38, no. 42 (Oct. 17, 1960), pp. 91–95. TP1.I418.

NOTE: DO NOT abbreviate titles of books or periodicals. A citation to P.S.E.B.M. is meaningless. References are to be cited so that anyone reading a patent may identify and retrieve the publications cited. Give as much bibliographic information as possible, but at least enough to identify the publication. For books, minimal information includes the author, title and date. For periodicals, at least the title of the periodical, the volume number, date and pages should be given. These minimal citations may be made ONLY IF the complete bibliographic details are unknown or unavailable.

If the original publication is located outside the Office, the examiner should immediately order a photocopy of at least the portion relied upon and indicate the class and subclass in which it will be filled. The Office action MUST designate this class and subclass.

707.05(f) Effective Dates of Declassified Printed Matter

In using declassified material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. See Ex parte Harris et al., 79 USPQ 439. If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Department of Commerce.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit or declaration under 37 CFR 1.131.

707.05(g) Incorrect Citation of References

Where an error in citation of a reference is brought to the attention of the Office by applicant, a letter correcting the error and restarting the previous period for response, together with a correct copy of the reference, is sent to applicant. Where the error is discovered by the examiner, applicant is also notified and the period for response restarted. In either case, the examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his or here initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given. See § 710.06.

Form PTOL–316 is used to correct an erroneous citation or an erroneously furnished reference. Clerical instructions are outlined in the Manual of Clerical Procedures, § 410.C (2) and (3).

Form Paragraphs 7.81–7.83 may be used to correct citations or copies of references cited.

7.81 Heading, Supplying Correct Reference Citation or Copy

THE PERIOD FOR RESPONSE OF [1] SET IN THE LAST OFFICE ACTION IS RESTARTED TO BEGIN WITH THE DATE OF THIS LETTER.

Examiner Note:

This paragraph must precede paragraph 7.82 and/or paragraph 7.83.

7.82 Correction of Citation of Reference

Applicant's request for a corrected reference citation from the last Office action is acknowledged. The corrected citation is as follows: [1]

Examiner Note:

1. Use paragraph 7.81 with this paragraph.
2. Use paragraph 7.83 to furnish a correct reference copy.
3. In bracket 1, give the full and correct reference citation. See MPEP 707.05(g)

7.83 Correct Reference Copy Supplied

Applicant's request for a correct copy of a reference cited in the last Office action is acknowledged. Enclosed is a correct copy of the [1].

Examiner Note:

1. In bracket 1, list the reference copy of copies being supplied.
2. Use paragraph 7.81 with this Paragraph.
3. Use paragraph 7.82 to supply a corrected reference citation.

In any case otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation on an examiner's amendment form PTOL-37.

If a FOREIGN patent is incorrectly cited: for example, the wrong country is indicated or the country omitted from the citation, the General Reference Branch of the Scientific Library may be helpful. The date and number of the patent are often sufficient to determine the correct country which granted the patent.

To correct a citation prior to mailing, see the Manual of Clerical Procedures, § 410.C(1).

707.06 Citation of Decisions, Orders, Memorandums and Notices

In citing court decisions, the U.S., C.C.P.A. or Federal Reporter citation should be given in addition to the USPQ citation, when it is convenient to do so.

The citation of manuscript decisions which are not available to the public should be avoided.

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Appeals which has not been published but which is available to the public in the patented file should be cited, as "Ex parte——, decision of the Board of Appeals, Patent No.———, paper No.——, ——— pages."

Decisions found only in patented files should be cited only when there is no published decision on the same point.

When a Commissioner's order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such a a specific issue of the *Journal of the Patent Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

707.07 Completeness and Clarity of Examiner's Action

37 CFR 1.105. Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

Form Paragraphs 7.37 and 7.38 may be used where applicant's arguments are not persuasive or moot.

7.37 Arguments Are Not Persuasive

Applicant's arguments filed [1] have been fully considered but they are not deemed to be persuasive.

Examiner Note:

The examiner must address all arguments which have not already been responded to in the rejection.

7.38 Arguments Are Moot Because of New Ground of Rejection

Applicant's arguments with respect to claim [1] have been considered but are deemed to be moot in view of the new grounds of rejection.

707.07(a) Complete Action on Formal Matters

Forms are placed in informal applications listing informalities noted by the Draftsman (Form PTO-948) and the Application Division (Form PTO-152). Each of these forms comprises an original for the file record and a copy to be mailed to applicant as a part of the examiner's first action. They are specifically referred to as attachments to the letter and are marked with its paper number. In every instance where these forms are to be used they should be mailed with the examiner's *first* letter, and any additional formal requirements which the examiner desires to make should be included in the *first* letter.

When any formal requirement is made in an examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to 37 CFR 1.111(b) and state that a complete response must either comply with all formal requirements or specifically traverse each requirement not complied with.

707.07(b) Requiring New Oath

See § 602.02.

707.07(c) Draftsman's Requirement

See §707.07(a); also §§608.02(a), (e), and (s).

707.07(d) Language To Be Used In Rejecting Claims

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

See §706.02 for language to be used.

Everything of a personal nature must be avoided. Whatever may be the examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he or she should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he or she express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

Although, not every ground of rejection may be categorically related to a specific section of the statue, §112 is considered as the more apt section for old combination rejection than §§102 or 103. Ex parte Des Granges, 864 O.G. 7122.

The examiner should, as a part of the first Office action on the merits, identify any claims which he or she judges, as presently recited, to be allowable and/or should suggest any way in which he or she considers that rejected claims may be amended to make them allowable. If the examiner does not do this, then by implication it will be understood by the applicant or his or her attorney or agent that in the examiner's opinion, as presently advised, there appears to be no allowable claim nor anything patentable in the subject matter to which the claims are directed.

IMPROPERLY EXPRESSED REJECTIONS

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

707.07(e) Note All Outstanding Requirements

In taking up an amended case for action the examiner should note in every letter all the requirements outstanding against the case. Every point in the prior action of an examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the *requirement.*

As soon as allowable subject matter is found, correction of all informalities then present should be *required.*

707.07(f) Answer All Material Traversed

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office action, the response (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent or the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Appeals will also be advised.

The importance of answering such arguments is illustrated by In re Herrmann et al., 1959 C.D. 159; 739 O.G. 549 where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

707.07(g) Piecemeal Examination

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See § 904.02.) Major technical rejections on grounds such as lack of proper disclosure, undue breadth serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claim thereof to a particular issue. These situations include the following:

(1) Where an application is too informal for a complete action on the merits; see § 702.01;

(2) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination; see § 706.03(l);

(3) Where there is a misjoinder of inventions and there has been no successful telephone request for election; see §§ 803, 806.02, 812.01;

(4) Where disclosure is directed to perpetual motion; not *Ex parte* Payne, 1904 C.D. 42; 108 O.G. 1049.

However, in such cases, the best prior art readily available should be cited and its pertinancy pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of *res judicata,* no *prima facie* showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accompanied by rejection on all other available grounds.

707.07(h) Notify of Inaccuracies in Amendment

See § 714.23.

707.07(i) Each Claim To Be Mentioned in Each Letter

In every letter each claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the case, its history through successive actions is thus easily traceable. Each action should conclude with a summary of all claims presented for examination.

Claims retained under 37 CFR 1.142 and claims retained under 1.146 should be treated as set out in §§ 821 to 821.03 and 809.02(c).

See § 1109.02 for treatment of claims in the application of losing party in interference.

The Index of Claims should be kept up to date as set forth in § 717.04.

707.07(j) State When Claims Are Allowable

Inventor Filed Applications

When, during the examination of a pro se case, it become apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner shall draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent.

Although this practice may be desirable and is permissible in any case where deemed appropriate by the examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

Allowable Except as to Form

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a cancelled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

Early Allowance of Claims

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

Form Paragraph 7.97 may be used to indicate allowance of claims.

7.97 Claims Are Allowable Over Prior Art

Claim [1] allowable over the prior art of record.

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the letter consecutively. This facilitates their indentification in the future prosecution of the case.

707.07(l) Comment on Examples

The results of the tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims should be rejected as being based on an insufficient disclosure under 35 U.S.C. 112, first paragraph, In re Borkowski et al, 164 USPQ 642 (CCPA 1970). The applicant must respond to the rejection or it will be repeated, for example, by providing the results of an actual test or example which has been conducted, or by providing relevant arguments that there is strong reason to believe that the result would be as predicted. Care should be taken that new matter is not entered into the application.

If questions are present as to operability or utility, consideration should be given to the applicability of a rejection under 35 U.S.C. 101.

707.08 Reviewing and Initialing by Assistant Examiner

The full surname of the examiner who prepares the Office action will, in all cases, be typed below the action. The telephone number below this should be called if the case is to be discussed or an interview arranged.

After the action is typed, the examiner who prepared the action reviews it for correctness. If this examiner does not have the authority to sign the action, he or she should initial above the typed name, and forward the action to the authorized signatory examiner for signing.

707.09 Signing by Primary or Other Authorized Examiner

Although only the original is signed, the word "Examiner" and the name of the signer should appear on the original and copies.

All letters and issues should be signed promptly.

707.10 Entry

The original, signed by the authorized examiner, is the copy which is placed in the file wrapper. The character of the action, its paper number and the date of mailing are entered in black ink on the outside of the file wrapper under "Contents".

707.11 Date

The date should not be typed when the letter is written, but should be stamped or printed on all copies of the letter after it has been signed by the authorized signatory examiner and the copies are about to be mailed.

707.12 Mailing

Copies of the examiner's action are mailed by the group after the original, initialed by the assistant examiner and signed by the authorized signatory examiner, has been placed in the file. After the copies are mailed the original is returned for placement in the file.

707.13 Returned Office Action

Letters are sometimes returned to the Office because the Post Office has not been able to deliver them. The examiner should use every reasonable means to ascertain the correct address and forward the letter again, after stamping it "remailed" with the date thereof and redirecting it if there be any reason to believe that the letter would reach applicant at such new address. If the Office letter was addressed to an attorney, a letter may be written to the inventor or assignee informing him or her of the returned letter. The period running against the application begins with the date of remailing. (Ex parte Gourtoff, 1924 C.D. 153, 329 O.G. 536.)

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. If the period dating from the remailing elapses with no communication from applicant, the case is forwarded to the Abandoned Files Unit.

708 Order of Examination

37 CFR 1.101. Order of examination. (a) Applications filed in the Patent and Trademark Office and accepted as complete applications are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to § 1.102 and those applications in which the Office has accepted a request for waiver of patent rights filed under § 1.139. International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met. However, unless a request has been filed under 35 U.S.C. 371(f), no action may be taken prior to 21 months from the priority date.

(b) Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended applications) shall be taken up for action in such order as shall be determined by the Commissioner.

Each examiner will give priority to that applicant in his or her docket, whether amended or new, which has the *oldest effective U.S. filing date.* Except as rare circumstances may justify group directors in granting individual exceptions, this basic policy applies to all applications.

The actual filing date of a continuation-in-part application is used for docketing purposes. However, the examiner may act on a continuation-in-part application by using the effective filing date, if desired.

If at any time an examiner determines that the "effective filing date" status of any application differs from what the records show, the clerk should be informed, who should promptly amend the records to show the correct status, with the date of correction.

The order of examination for each examiner is to give priority to reissue applications, with top priority to those in which litigation has been stayed (§ 1442.03), then to those special cases having a fixed 30 day due date, such as examiner's answers and decisions on motions. Most other cases in the "special" category (for example, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U.S. filing date among them normally controlling priority.

All amendments before final rejection should be responded to within two months of receipt.

Action on those applications in which the Office has accepted a request under 37 CFR 1.139 is suspended for the entire pendency, except for purposes relating to interference proceedings under 37 CFR 1.201(b) initiated within (5) five years of the earliest effective U.S. filing date.

708.01 List of Special Cases

37 CFR 1.102. Advancement of examination. (a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

Certain procedures by the examiners take precedence over actions even on special cases.

For example, all papers typed and ready for signature should be completed and mailed.

All issue cases returned with a "Printer Waiting" slip must be processed and returned within the period indicated.

Reissue applications, particularly those involved in stayed litigation, should be given priority.

Cases in which practice requires that the examiner act within 30 days, such as decisions on motion (§ 1105.06) and examiner's answers (§ 1208), necessarily take priority over special cases without specific time limits.

If an examiner has a case in which he or she is satisfied that it is in condition for allowance, or in which he or she is satisfied will have to be finally rejected, he or she should give such action forthwith instead of making the case await its turn.

The following is a list of special cases (those which are advanced out of turn for examination):

(a) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders (37 CFR 1.102).

(b) Cases made special as a result of a petition. (See § 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the Commissioner or an Assistant Commissioner) will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board of Appeals; and any interference in which such an application becomes involved shall, in like measure be considered special by all Office officials concerned.

(c) Applications for reissues, particularly those involved in stayed litigation (37 CFR 1.176).

(d) Applications remanded by an appellate tribunal for further action.

(e) An application, once taken up for action by an examiner according to its effective filing date, should be treated as special by an examiner, art unit or group to which it may subsequently be transferred; exemplary situations include new cases transferred as the result of a telephone election and cases transferred as the result of a timely response to any official action.

(f) Applications which appear to interfere with other applications previously considered and found to be allowable, or which will be placed in interference with an unexpired patent or patents (37 CFR 1.201).

(g) Applications ready for allowance, or ready for allowance except as to formal matters.

(h) Applications which are in condition for final rejection.

(i) Applications pending more than five years, incldng those which, by relation to a prior United States application, have an effective pendency of more than five years. See § 707.02(a).

(j) Reexamination Proceedings, § 2261.

See also §§ 714.13, 1207 and 1309.

708.02 Petition To Make Special

37 CFR 1.102 Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Commissioner to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

(c) A petition to make an application special may be filed without a fee if the basis for the petition is the applicant's age or health or that the invention will materially enhance the quality of the environment or materially contribute to the development or conservation of energy resources.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

New applications ordinarily are taken up for examination in the order of their effective United States filing dates. Certain exceptions are made by way of petitions to make special, which may be granted under the conditions set forth below.

I. MANUFACTURE

An application may be made special on the ground of prospective manufacture upon the filing of a petition accompanied by the fee under § 1.17(i) by the applicant or assignee alleging under oath or declaration:

1. The possession by the prospective manufacturer of sufficient presently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) to manufacture the invention in quantity or that sufficient capital and facilities will be made available if a patent is granted;

If the prospective manufacturer is an individual, there must be a corroborating affidavit from some responsible party, as for example, an officer of a bank, showing that said individual has the required available capital to manufacture;

2. That the prospective manufacturer will not manufacture, or will not increase present manufacture, unless certain that the patent will be granted;

3. That affiant obligates himself or herself or the prospective manufacturer, to manufacture the invention, in the United States or its possessions, in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities.

The attorney or agent of record in the application (or applicant, if not represented by an attorney or agent) must file an affidavit or declaration to show:

1. That the applicant or assignee has made or caused to be made a careful and thorough search of the prior art, or has a good knowledge of the pertinent prior art; and

2. That the applicant or assignee believes all of the claims in the application are allowable.

II. INFRINGEMENT

Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon payment of the fee under § 1.17(i) and the filing of a petition alleging facts under oath or declaration to show, or indicating why it is not possible to show; (1) that there is an infringing device or product actually on the market or method in use, (2) when the device, product or method alleged to infringe was first discovered to exist; supplemented by an affidavit or declaration of the applicant's attorney or agent to show, (3) that a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, (4) that, in his or her opinion, some of the claims are unquestionably infringed, (5) that he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art, and (6) that he or she believes all of the claims in the application are allowable.

Models or specimens of the infringing product or that of the application should not be submitted unless requested.

III. APPLICANT'S HEALTH

An application may be made special upon a petition by applicant accompanied by a showing as by a doctor's certificate, that the state of health of the applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course. No fee is required for such a petition, § 1.102(c).

IV. APPLICANT'S AGE

An application may be made special upon filing a petition including a showing, as by a birth certificate or the applicant's affidavit or declaration, that the applicant is 65 years of age, or more. No fee is required with such a petition, § 1.102(c).

V. ENVIRONMENTAL QUALITY

The Patent and Trademark Office will accord "special" status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements—air, water, and soil.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. Such petitions should be written, should identify the applications by serial number and filing date, and should be accompanied by affidavits or declarations under 37 CFR 1.102 by the applicant or his attorney or agent explaining how the inventions contribute to the restoration or maintenacne of one of these life-sustaining elements. No fee is required for such a petition, § 1.102(c).

VI. ENERGY

The Patent and Trademark Office will, on petition accord "special" status to all patent applications for inventions which materially contribute to (1) the discovery or development of energy resources, or (2) the more efficient utilization and conservation of energy resources. Examples of inventions in category (1) would be developments in fossil fuels (natural gas, coal, and petroleum), nuclear energy, solar energy, etc. Category (2) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc.

All applicants desiring to participate in this program should petition that their applications be accorded "special" status. Such petitions should be written, should identify the application by serial number and filing date, and should be accompanied by affidavits or declarations under 37 CFR 1.102 by the applicant or applicant's attorney or agent explaining how the invention materially contributes to category (1) or (2) set forth above. No fee is required for such a petition, § 1.102(c).

VII. INVENTIONS RELATING TO RECOMBINANT DNA

In recent years revolutionary genetic research has been conducted involving recombinant deoxyribonucleic acid ("recombinant DNA"). Recombinant DNA research appears to have extraordinary potential benefit for mankind. It has been suggested, for example, that research in this field might lead to ways of controlling or treating cancer and hereditary defects. The technology also has possible applications in agriculture and industry. It has been likened in importance to the discovery of nuclear fission and fusion. At the same time, concern has been expressed over the safety of this type of research. The National Institutes of Health (NIH) has released guidelines for the conduct of research concerning recombinant DNA. These "Guidelines for Research Involving Recombination DNA Molecules," were published in the *Federal Register* of July 7, 1976, 41 FR 27902-27943. NIH is sponsoring experimental work to identify possible hazards and safety practices and procedures.

In view of the exceptional importance of recombinant DNA and the desirability of prompt disclosure of developments in the field, the Patent and Trademark Office will accord "special" status to patent applications relating to safety of research in the field of recombinant DNA. Upon appropriate petition and payment of the fee under § 1.17(i), the Office will make special patent applications for inventions relating to safety of research in the field of recombinant DNA. Petitions for special status should be in writing, should identify the application by serial number and filing date, and should be accompanied by affidavits or declarations under 37 CFR 1.102 by the applicant, attorney or agent explaining the relationship of the invention to safety of research in the field of recombinant DNA research. Petitions must also include a statement that the NIH guidelines cited above, or as amended, are being followed in any experimentation in this field, except that the statement may include an explanation of any deviations considered essential to

avoid disclosure of proprietary information or loss of patent rights. The fee set forth under § 1.17(i) must also be paid.

VIII. Special Examining Procedure for Certain New Applications—Accelerated Examination

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent):

(a) Submits a written petition to make special accompanied by the fee set forth in § 1.17(i).

(b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to be nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent case. Each such application must meet on its own all requirements for the new special status.

(c) Submits a statements that a pre-examination search was made, and specifying whether by the inventor, attorney, agent, professional searchers, etc., and listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office or the former International Patent Institute at The Hague, Netherlands satisfies this requirement.

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims.

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references. Where applicant indicates an intention of overcoming one of the references by affidavit or declaration under 37 CFR 1.131, the affidavit or declaration must be submitted before the application is taken up for action, but in no event later than one month after request for special status.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request. If perfected, the request will then be granted.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

The special examining procedure of VIII (accelerated examination) involves the following procedures:

1. The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, decisions on motions, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The examiner's search will be restricted to the *subject matter encompassed by the claims.* A first action rejection will set a three-month shortened period for response.

2. During the three-month period for response, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. In order to afford the examiner time for reflective consideration before the interview, applicant or his representative should cause to be placed in the hands of the examiner at least one working day prior to the interview, a copy (clearly denoted as such) of the amendment that he proposes to file in response to the examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

3. Subsequent to the interview, or responsive to the examiner's first action if no interview was had, applicant will file the "record" response. The response at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as an improper response.

4. The examiner will, within one month from the date of receipt of applicant's formal response, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a three-month period for response, or a notice of allowance. The examiner's response to any amendment submitted after final rejection should be prompt and by way of form PTO-303 or PTO-327, by passing the case to issue, or by an examiner's answer should applicant choose to file an appeal brief at this time. The use of these forms is not intended to open the door to further prosecution. Of course, where relatively minor issues or deficiences might be easily resolved, the examiner may use the telephone to inform the applicant of such.

5. A personal interview after final Office action will not be permitted unless requested by the examiner. However, telephonic interviews will be permitted where appropriate for the purpose of correcting any minor matters which remain outstanding.

6. After allowance, these applications are given top priority for printing. See § 1309.

HANDLING OF PETITIONS TO MAKE SPECIAL

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is made of record in the application file, together with the decision thereon. The Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the "Contents" of the file. The decision will be accorded a separate paper number and similarly entered. To insure entries in the "Contents" in proper order, the clerk in the examining group will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. Note §§ 1002.02 (a), (c), and (j).

708.03 Examiner Tenders Resignation

Whenever an examiner tenders his or her resignation, the supervisory primary examiner should see that the remaining time as far as possible is used in winding up the old complicated cases or those with involved records and getting as many of his amended cases as possible ready for final disposition.

If the examiner has considerable experience in his or her particular art, it is also advantageous to the Office if he or she indicates (in pencil) in the file wrappers of cases in his or her docket, the field of search or other pertinent data that he considers appropriate.

709 Suspension of Action

37 CFR 1.103. Suspension of action. (a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i). Action will not be suspended when a response by the applicant to an Office action is required.

(b) If action by the Office on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

(c) Action by the examiner may be suspended by order of the Commissioner in the case of applications owned by the United States whenever publication of the invention by the granting of a patent thereon might be detrimental to the public safety or defense, at the request of the appropriate department or agency.

(d) Action on applications in which the Office has accepted a request filed under § 1.139 will be suspended for the entire pendency of these applications except for the purposes relating to proceedings under § 1.201(b).

Suspension of action (37 CFR 1.103) should not be confused with extension of time for reply (37 CFR 1.136). It is to be noted that a suspension of action applies to an impending Office action by the examiner whereas an extension of time for reply applies to action by the applicant. In other words, the action cannot be suspended in an application which contains an outstanding Office action or requirement awaiting response by the applicant. It is only the action by the examiner which can be suspended under 37 CFR 1.103.

Paragraph (b) of the rule provides for a suspension of Office action by the examiner on his or her own initiative, as in §§ 709.01 and 1101.01(i). The primary examiner may grant an initial suspension of action for a maximum period of six months. This time limitation applies to both suspensions granted at the request of the applicant and suspensions imposed *sua sponte* by the examiner. Any second or subsequent suspension of action in patent applications under 37 CFR 1.103 are decided by the group director. See § 1002.02(c), item 11.

Paragraph (d) of 37 CFR 1.103 is used in the Defensive Publication Program described in § 711.06.

Form Paragraphs 7.52–7.56 should be used in actions relating to suspension of action.

7.52 Suspension of Action, Waiting New Reference

A reference relevant to the examination of this application may soon become available. Ex parte prosecution is SUSPENDED FOR A PERIOD OF [1] MONTHS FROM THE DATE OF THIS LETTER. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

(1) Maximum period for suspension is 6 months.

(2) The Group Director should approve all second or subsequent suspensions.

7.53 Suspension of Action, Possible Interference

All claims are allowable. However, due to a potential interference, ex parte prosecution is SUSPENDED FOR A PERIOD OF [2] MONTHS FROM THE DATE OF THIS LETTER.

Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

Examiner Note:

(1) Maximum period for suspension is 6 months.

(2) The Group Director should approve all second or subsequent suspensions.

7.54 Suspension of Action, Applicant's Request

Pursuant to applicant's request filed on [1], action by the Office is suspended on this application under 37 CFR 1.103(a) for a period of [2] months. At the end of this period, applicant is required to notify the examiner and request continuance of prosecution or a further suspension. See MPEP 709.

Examiner Note:

(1) Maximum period of suspension is 6 months.

(2) Only the Group Director can grant second or subsequent suspensions.

7.55 Petition for Suspension, Not Sufficient

Applicant's petition for suspension of action in this application under 37 CFR 1.103(a) is denied because applicant has failed to present good and sufficient cause therefor.

Examiner Note:

(1) Elaboration is necessary unless no reasons have been set forth in the petition.

(2) If the petition is being denied for non-payment of the fee required under 37 CFR 1.17(i), use paragraph 7.99.

7.56 Petition for Suspension, Applicant's Response Due

Applicant's request for suspension of action in this application under 37 CFR 1.103(a) is denied as being improper. A suspension of action applies only to an impending action by the examiner. Action cannot be suspended in an application awaiting a response by the applicant. See MPEP 709.

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee

Examiners should not consider ex parte, when raised by an applicant, questions which are pending

before the Office in *inter partes* proceedings involving the same applicant. (See Ex parte Jones, 1924 C.D. 59; 327 O.G. 681.)

Because of this where one of several applications of the same inventor which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the applications not in the interference in accordance with Ex parte McCormick, 1904 C.D. 575; 113 O.G. 2508.

However, the better practice would appear to be to reject claims in an application related to another application in interference over the counts of the interference and in the event said claims are not cancelled in the outside application, prosecution of said application should be suspended pending the final determination of priority in the interference.

If, on the other hand applicant wishes to prosecute the outside application, and presents good reasons in support, prosecution should be continued. Ex parte Bullier, 1899 C.D. 155, 88 O.G. 1161; In re Seebach, 1937 C.D. 495, 484 O.G. 503; In re Hammell, 1964 C.D. 733, 808 O.G. 25. See § 1111.03.

See also § 804.03.

710 Period for Response

35 U.S.C. 133. Time for prosecuting application. Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

35 U.S.C. 267. Time for taking action in Government applications. Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

See Chapter 1200 for period for response when appeal is taken or court review sought.

710.01 Statutory Period

35 CFR 1.135. Abandonment for failure to respond within time limit.

(a) If an applicant of a patent application fails to respond within the time period provided under §§ 1.134 and 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to respond and to advance the case to final action, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See § 1.7.)

The maximum statutory period for response to an Office action is six months, 35 U.S.C. 133. Shortened periods are currently used in practically all cases, see § 710.02(b).

Section 1.135 provides that if no response is filed within the time set in the Office action under § 1.134 or as it may be extended under § 1.136, the application will be abandoned unless an Office action indicates that another consequence, such as diclaimer, will take place.

Paragraph (c) has been amended to add that applicant's reply must be a bona fide attempt to respond as well as to advance the case to final action in order for applicant to be given an opportunity to supply any omission.

710.01(a) Statutory Period, How Computed

The actual time taken for response is computed from the date stamped or printed on the Office action to the date of receipt by the Office of applicant's response. No cognizance is taken of fractions of a day and applicant's response is due on the corresponding day of the month six months or any lesser number of months specified after the Office action.

Response to an Office action with a 3 month shortened statutory period, dated November 30 is due on the following February 28 (or 29 if it is a leap year), while a response to an Office action dated February 28 is due on May 28 and not on the last day of May. Ex parte Messick, 1930 C.D. 6; 400 O.G. 3.

A one month extension of time extends the time for response to the date corresponding to the Office action date in the following month. For example, a response to an Office action mailed on January 31 with a 3 month shortened statutory period would be due on April 30. If a one month extension of time were given, the response would be due by May 31. The fact that April 30 may have been a Saturday, Sunday, or federal holiday has no effect on the extension of time. Where the period for response is extended by some time period other than "one month" or an even multiple thereof, the person granting the extension should indicate the *date* upon which the extended period for response will expire.

A thirty day period for response in the Office means thirty calendar days including Saturdays, Sundays and federal holidays. However, if the period ends on a Saturday, Sunday, or federal holiday, the response is timely if it is filed on the next succeeding business day.

The date of receipt of a response to an Office action is given by the "Office date" stamp which appears on the responding paper.

In some cases the examiner's letter does not determine the beginning of a statutory response period. In all cases where the statutory response period runs from the date of a previous action, a statement to that effect should be included.

Since extensions of time are available pursuant to § 1.136(a), it is incumbent upon applicants to recognize the date for response so that the proper fee for any extension will be submitted. Thus, the date upon which any response is due will normally be indicated

only in those instances where the provisions of § 1.136(a) are not available. See Chapter 2200 for reexamination proceedings.

710.02 Shortened Statutory Period and Time Limit Actions Computed

37 CFR 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a) If an applicant is required to respond within a non-statutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless (1) applicant is notified otherwise in an Office action or (2) the application is involved in an interference declared pursuant to § 1.207. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. In no case may an applicant respond later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available.

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragrraph (a) of this section are available. See § 1.245 for extension of time interference proceedings.

Section 1.136 implements 35 U.S.C. 41(a) (8) which directs the Commissioner to charge fees for extensions of time to take action in patent applications.

Under § 1.136 (35 U.S.C. 133) an applicant may be required to respond in a shorter period than six months, not less than 30 days. Some situations in which shortened periods for response are used are listed in § 710.02(b).

In other situations, for example, the rejection of a copied patent claim, the examiner may require applicant to respond on or before a specified date. These are known as time limit actions and are established under authority of 35 U.S.C. 6. Some situations in which time limits are set are noted in § 710.02(c). The time limit requirement should be typed in capital letters where required.

An indication of a shortened time for reply should appear prominently on the first page of all copies of actions in which a shortened time for reply has been set so that a person merely scanning the action can easily see it.

Section 1.136 provides for two distinct procedures to extend the period for action or response in particular situations. The procedure which is available for use in a particular situation will depend upon the circumstances. Paragraph 1.136(a) permits an applicant to file a petition for extension of time and a fee as in § 1.17 (a), (b), (c), or (d) up to four months after the end of the time period set to take action except (1) where prohibited by statute, (2) in interference proceedings, or (3) where applicant has been notified otherwise in an Office action. The petition and fee can be filed prior to or with the response. The filing of the petition and fee will extend the time period to take action up to four months dependent on the amount of the fee paid except in those circumstances noted above. Paragraph 1.136(a) will effectively reduce the amount of paperwork required by applicants and the Office since the extension will be effective upon filing of the petition and payment of the appropriate fee and without acknowledgment or action by the Office and since the petition and fee can be filed with the response. Paragraph (b) provides for requests for extensions of time upon a showing of sufficient cause when the procedure of paragraph (a) is not available. Although the petition and fee procedure of § 1.136(a) will normally be available within 4 months after a set period for response has expired, an extension request for cause under § 1.136(b) must be filed during the set period for response. Extensions of time in in interference proceedings are governed by § 1.245.

Shortened statutory periods and time limits are subject to the provisions of § 1.136(a) unless applicant is notified otherwise in an Office action. See Chapter 2200 for reexamination proceedings.

710.02(b) Shortened Statutory Period: Situations in Which Used

Under the authority given him by 35 U.S.C. 133 the Commissioner has directed the examiner to set a shortened period for response to every action. The length of the shortened statutory period to be used depends on the type of response required. Some specific cases of shortened statutory period for response to be given are:

THIRTY DAYS

Requirement for restriction or election of species—no claim rejected..... §§ 809.02(a) and 817.

TWO MONTHS

Winning party in terminated interference to reply to unanswered Office action..... § 1109.01

Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered Office action, final rejection or any other action, the primary examiner notifies the applicant of this fact. In this case response to the Office action is required within a shortened statutory period running from the date of such notice. See Ex parte Peterson, 1941 C.D. 8; 525 O.G. 3.

Ex parte Quayle..... § 714.14

When an application is in condition for allowance, except as to matters of form, such as correction of specification, a new oath, etc., the case will be considered special and prompt action taken to require correction of formal matters. Such action should include an indication on first page form letter PTOL-326 that prosecution on the merits is closed in accordance with the decision in *Ex parte* Quayle, 1935 C.D. 11; 453 O.G. 213. A two month shortened statutory period for response should be set.

Multiplicity rejection—no other rejection... § 706.03(l)

A new ground of rejection in an examiner's answer on appeal..... § 1208.01

THREE MONTHS

To respond to any Office action on the merits.

PERIOD FOR RESPONSE RESTARTED

Incorrect citation by examiner—regardless of time remaining in original period..... § 710.06

The above periods may be changed under special, rarely occurring circumstances.

A shortened statutory period may not be less than 30 days (35 U.S.C. 133).

710.02(c) Time-Limit Actions: Situations in Which Used

As stated in § 710.02, 35 U.S.C. 6 provides authority for the Commissioner to establish rules and regulations for the conduct of proceedings in the Patent and Trademark Office. Among the rules are certain situations in which the examiner sets a time limit within which some specified action should be taken by applicant. Some situations in which a time limit is set are:

(a) A portion of 37 CFR 1.203(b) provides that in suggesting claims for interference:

The parties to whom the claims are suggested will be required to make those claims (i.e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared.

See § 1101.01(m).

(b) 37 CFR 1.206(b) provides:

37 CFR 1.206(b). Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

See § 1101.02(f).

(c) When the applicant has filed a response to an examiner's action but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given before the question of abandonment is considered. Accordingly, the examiner may give applicant one month or the remainder of the period for response, whichever is longer, under 37 CFR 1.135(c) to complete the response.

37 CFR 1.135(c). When action by the applicant is bona fide attempt to respond and to advance the case to final action and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

Under 37 CFR 1.135(c), the missing matter or lack of compliance must be considered by the examiner as being "inadvertently omitted". Once an inadvertent omission is brought to the attention of the applicant, the question of inadvertance no longer exists. Therefore, any further time to complete the response would not be appropriate under 37 CFR 1.135(c). Accordingly, no extension of time will be granted in these situations and § 1.136(a) is not applicable. See § 710.02(e).

See § 714.03.

(d) Applicant is given one month or the remainder of the period for response, whichever is longer, to remit any additional fees required for the submission of an amendment in response to an Office action.

See §§ 607 and 714.03.

(e) To correct an unsigned amendment, applicant is given the remainder of the period for response.

If a signed copy is filed after the period for response, an extension of time with fee under § 1.136(a) is required.

See § 714.01(a).

(f) Where an application is otherwise allowable but contains a traverse of a requirement to restrict, one month is given to cancel claims to the nonelected invention or species or take other appropriate action. See 37 CFR 1.141 and 1.144, and §§ 809.02(c) and 821.01.

710.02(d) Difference Between Shortened Statutory and Time-Limit Periods.

The distinction between a limited time for reply and a shortened statutory period under 37 CFR 1.136 should not be lost sight of. The penalty attaching to failure to reply with the time limit (from the suggestion of claims or the rejection of copied patent claims) is loss of the subject matter involved on the doctrine of disclaimer. A rejection on the ground of disclaimer is appealable. On the other hand, a complete failure to respond within the set statutory period results in abandonment of the entire application. This is not appealable, but a petition to revive may be granted if the delay was unavoidable. Further, where applicant responds a day or two after the time limit, this may be excused by the examiner if satisfactorily explained; but a response one day late in a case carrying a shortened statutory period under section 1.136, no matter what the excuse, results in abandonment; however, any extension of the period may be obtained under 37 CFR 1.136 provided the extension does not go beyond the six months' period from the date of the Office action. See also § 1101.02(f).

710.02(e) Extension of Time

37 CFR 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a) If an applicant is required to respond within a non-statutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless (1) applicant is notified otherwise in an Office action or (2) the application is involved in an interference declared pursuant to § 1.207. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. In no case may an applicant respond later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available.

(b) When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.245 for extension of time in interference proceedings.

Section 1.136 provides for two distinct procedures to extend the period for action or response in particular situations. The procedures which is available for use in a particular situation will depend upon the circumstances. Paragraph 1.136(a) permits an applicant to file a petition for extension of time and a fee as in § 1.17 (a), (b), (c), or (d) up to four months after the end of the time period set to take action except (1) where prohibited by statute, (2) in interference proceedings, or (3) where applicant has been notified otherwise in an Office action. The petition and fee can be filed prior to or with the response. The filing of the petition and fee will extend the time period to take action up to four months dependent on the amount of the fee paid except in those circumstances noted above. Paragraph 1.136(a) will effectively reduce the amount of paperwork required by applicants and the Office since the extension will be effective upon filing of the petition and payment of the appropriate fee and without acknowledgment or action by the Office and since the petition and fee can be filed with the response. Paragraph (b) provides for requests for extensions of time upon a showing of sufficient cause when the procedure of paragraph (a) is not available. Although the petition and fee procedure of § 1.136(a) will normally be available within 4 months after a set period for response has expired, an extension request for cause under § 1.136(b) must be filed during the set period for response. Extensions of time in interference proceedings are governed by § 1.245.

It should be very carefully noted that neither the primary examiner nor the commissioner has authority to extend the shortened statutory period unless a petition for the extension if filed. While the shortened period may be extended within the limits of the statutory six months' period, no extension can operate to extend the time beyond the six months.

Compare, however, 37 CFR 1.135(c) and § 714.03.

Any request under 37 CFR 1.136(b) for extension of time for reply must state a reason in support thereof. Such extensions will only be granted for sufficient cause and must be filed prior to the end of the set period for response.

Extensions of time with the payment of a fee pursuant to § 1.136 are possible in response to most Office actions of the examiner. The noted exceptions include 1) all extensions in a reexamination proceeding (see § 1.550(c) and § 2265), 2) all extensions during an interference proceeding (but not preparatory to an interference such as where a claim is suggested for interference), 3) those specific situations where an Office action states that the provisions of § 1.136(a) are not applicable, e.g., in reissue applications associated with litigation, or where an application in allowable condition has non-elected claims and time is set to cancel such claims, and 4) those limited instances where applicant is given time to comlete an incomplete response pursuant to § 1.135(c).

The fees for extensions of time are set forth in § 1.17(a)-(d) and are subject to a 50 per cent reduction for persons or concerns qualifying as a small entities. The fees itemized at § 1.17(a)-(d) are cumulative. Thus, if an applicant has paid a $50 extension fee for a one month extension of time and thereafter decides that additional one month (§ 1.17(b)) is needed, a fee of $100 would be the appropriate and proper fee ($150 less the amount paid ($50) for the first one month).

The statute at 35 U.S.C. 41(a)(8) requires the filing of a petition to extend the time and the appropriate fee. Such a petition need not be in any required format. A proper petition may be a mere sentence such as

> 'The applicant herewith petitions the Commissioner of Patents and Trademarks to extend the time for response to the Office action dated —— for —— month(s) from —— to ——. Submitted herewith is a check for —— to cover the cost of the extension [Please Charge my deposit account number —— in the amount of —— to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.]'

Where applicant desires to file a continuing application rather than a response to a given action by the examiner, it is appropriate to merely file a petition to extend the time along with the proper fee in the pending application and file the continuing application during the extension period. It is not necessary to file a response in the pending application. The petition plus fee provides the time for applicant to take whatever action is appropriate. Desirably, applicant should expressly abandon the prior application after the filing of the continuing application.

Where a response is filed after the set period for response has expired and no petition or fee accompanies it, the response will not be accepted as timely until the petition and the appropriate fee are submitted. The response, when filed late, must include both the petition and the fee. If either is missing, the response is not acceptable until such time as the missing petition or fee is submitted. For example, if an Office action sets a three month period for response and applicant responds in the fourth month and includes only the fee for a one month extension of time, the response is not acceptable until the petition is filed. If the petition is not filed until the fifth month, an additional fee for the second month extension would also be required in order to render the response timely.

When the provisions of § 1.136(a) are not applicable, extensions of time for cause pursuant to § 1.136(b) are possible. Any such extension must be filed on or

before the day on which action by the applicant is due. The mere filing of such a request will not effect any extension. All such requests are to be decided by the Group Director. No extension can operate to extend the time beyond the six month statutory period.

If a request for extension of time is filed in duplicate and accompanied by a stamped return-addressed envelope, the Office will indicate the action taken on the duplicate and return it promptly in the envelope. Utilization of this procedure is optional on the part of applicant. In this procedure, the action taken on the request should be noted on the original and on the copy which is to be returned. The notation on the original, which becomes a part of the file record, should be signed by the person granting or denying the extension, and the name and title of that person should also appear in the notation on the copy which is returned to the person requesting the extension.

When the request is granted, no further action by the Office is necessary. When the request is granted in part, the extent of the extension granted will be clearly indicated on both the original and on the copy which is to returned. When the request is denied, the reason for the denial will be indicated on both the original and on the copy which is to be returned or a formal decision letter giving the reason for the denial will be forwarded promptly after the mailing of the duplicate.

If the period for response is extended, the time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday or Federal holiday.

If the request for extension of time is granted, the due date is computed from the date stamped or printed on the action, as opposed to the original due date. See Section 710.01(a). For example, a response to an action with a 3 month shortened statutory period, dated November 30, is due on the following February 28 (or 29, if it is a leap year). If the period for response is extended an additional month, the response becomes due on March 30, not on March 28.

For purposes of convenience, a request for an extension of time may be personnally delivered and left with the appropirate area to become an official paper in the file without routing through the mail room. The person who accepts the request for an extension of time will have it date stamped.

If duplicate copies of a request for an extension of time under § 1.136(b) are hand delivered to an examining group, both copies are dated, either stamped approved or indicated as being approved in part or denied, and signed. The duplicate copy is returned to the delivering person regardless of whether the request was signed by a registered attorney or agent, either of record or acting in a representative capacity, the applicant or the assignee of record of the entire interest.

If the request for extension is not presented in duplicate, the applicant should be advised promptly by way of form letter PTOL-327 regarding action taken on the request so that the file record will be complete.

Form Paragraph 7.98 may be used where a response is filed late but an extension of time is possible.

7.98 Response is Late, Extension of Time Suggested

Applicant's response filed [1] was received in the Office of [2], which is after the expiration of the period for response set in the last Office action. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office action under 37 CFR 1.136(a).

Examiner Note:

Since the provisions of 37 CFR 1.136(a) do not apply to reexamination applications or to litigation related reissue applications, do not use this paragraph in these applications.

Final Rejection—Time for Response

On October 1, 1982, pursuant to Public Law 97-247, the Patent and Trademark Office discontinued the previous practice in patent applications of extending without fee the shortened statutory period for response to a final rejection upon the filing of a timely first response to a final rejection (37 CFR 1.116). Since Ocotober 1, 1982, applicants are able to obtain additional time for a first or subsequent response to a final rejection by petitioning and paying the appropriate fee under 37 CFR 1.136(a), provided the additional time does not exceed the six month statutory period.

In order to continue to encourage the early filing of any first response after a final rejection and to take care of any situations in which the examiner does not timely respond to a first response after final rejection which is filed early in the period for response, the Office has changed the manner in which the period for response is set on any final rejection mailed after February 27, 1983.

Under the changed procedure, if an applicant initially responds within two months from the date of mailing of any final rejection setting a three-month shortened statutroy period for response and the Office does not mail an advisory action until after the end of the three-month shortened statutory period, the period for response for purposes of deternining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond six months from the date of the final rejection. This procedure will apply only to a first response to a final rejection and has been implemented by including the following language in each final rejection mailed after February 27, 1983.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALUCLATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

For example, if applicant initially responds within two months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of three months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of three months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the three-month period. If the examiner, however, does not mail and advisory action until after the end of three months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

See also § 706.07(f).

EXTENSIONS OF TIME TO SUBMIT AFFIDAVITS AFTER FINAL REJECTION

Frequently, applicants request an extension of time, stating as a reason therefor that more time is needed in which to submit an affidavit. When such a request is filed after final rejection, the granting of the request for extension of time is without prejudice to the right of the examiner to question why the affidavit is now necessary and why it was not earlier presented. If applicant's showing is insufficient, the examiner may deny entry of the affidavit, notwithstanding the previous grant of an extension of time to submit it. The grant of an extension of time in these circumstances serves merely to keep the case from becoming abandoned while allowing the applicant the opportunity to present the affidavit or to take other appropriate action. Moreover, prosecution of the application to save it from abandonment must include such timely, complete and proper action as required by 37 CFR 1.113. The admission of the affidavit for purposes other than allowance of the application, or the refusal to admit the affidavit, and any proceedings relative, thereto, shall not operate to save the application from abandonment.

Implicit in the above practice is the fact that affidavits submitted after final rejection are subject to the same treatment as amendments submitted after final rejection. *In re Affidavit Filed After Final Rejection,* 152 USPQ 292, 1966 C.D. 53.

Failure to file a response during the shortened statutory period results in abandonment of the application.

REQUIREMENT FOR A RESPONSE UNDER 37 CFR 1.136 AND 1.137 WHERE A CONTINUING APPLICATION IS BEING FILED

In those instances where an extension of time or a revival of an abandoned application is sought solely for the purpose of filing a continuing application under 35 U.S.C. 120 and where the prior application is to be abandoned in favor of the continuing application, the filing of a response as required by 37 CFR 1.111, 1.113, 1.192 or other regulation is considered to be an unnecessary expenditure of resouces by the applicant. Accordingly, in these situations, the Patent and Trademark Office will accept the filing of a continuing application as a response under 37 CFR 1.136 or 1.137.

To facilitate processing by the Office, any such petition for extension of time or petition to revive should specifically refer to the filing of a continuing application and also include an express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

Extensions of time to appeal to the courts under § 1.304 is covered in § 1216.

710.04 Two Periods Running

There sometimes arises a situation where two different periods for response are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception, involving suggested claims, see § 1101.01(n).

710.04(a) Copying Patent Claims

Where, in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for response are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for response to the rejection (either first or final), established under 37 CFR 1.206(b). The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. (Ex parte Milton, 164 Ms. D. 1, 63 USPQ 132 and Ex parte Nelson, 164 Ms. D. 361, 26 J.P.O.S. 564.) See also § 1101.02(f).

710.05 Period Ending on Saturday, Sunday or a Federal Holiday

35 U.S.C. 21. Filing date and day for taking action. (b) When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

37 CFR 1.7. Times for taking action; expiration on Saturday, Sunday, or Federal holiday. Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday. See § 1.304 for time for appeal or for commencing civil action.

The Federal holidays are: New Year's Day, January 1; Washington's Birthday, the third Monday in February; Memorial Day, the last Monday in May; Independence Day, July 4; Labor Day, the first Monday in September; Columbus Day, the second Monday in October; Veteran's Day, November 11; Thanksgiving Day, the fourth Thursday in November; Christmas Day, December 25; Inauguration day (January 20, every four years). Whenever a Federal holiday falls on a Sunday, the following day (Monday) is also a Federal holiday, Ex. Order 10,358; 17 F.R. 5269; 5 U.S.C. 6103.

When a Federal holiday falls on a Saturday, the preceding day, Friday, is considered to be a Federal holiday and the Patent and Trademark Office will be closed for business on that day (5 U.S.C. 6103). Accordingly, any action or fee due on such a Federal holiday Friday or Saturday is to be considered timely if the action is taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a Federal holiday.

When an amendment is filed a day or two later than the expiration of the period fixed by satute, care should be taken to ascertain whether the last day of that period was Saturday, Sunday or a Federal holiday and if so, whether the amendment was filed or the fee paid on the next succeeding day which is not a Saturday, Sunday or a Federal holiday.

An amendment received on such succeeding day which was due on Saturday, Sunday or Federal holiday is endorsed on the file wrapper with the date of receipt. The Saturday, Sunday or Federal holiday is also indicated.

710.06 Miscellaneous Factors Determining Date

Where the citation of a reference is incorrect and this error is called to the attention of the Office before the expiration of the period for response, a new period for response starts from the date of the Office letter giving the correct citation and forwarding the correct copy. The previous period is restarted regardless of the time remaining. See § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to remail any action (§ 707.13), the action should be correspondingly redated, as it is the re-mailing date that establishes the beginning of the period for response. *Ex parte* Gourtoff, 1924 C.D. 153, 329 O.G. 536.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If for any other reason an Office action is defective in some matter necessary for a proper response, applicant's time to respond begins with the date of correction of such defect.

See §§ 505, 512 and 513 for Patent and Trademark Office practice on date stamping documents.

711 Abandonment

37 CFR 1.135. Abandonment for failure to respond within time limit. (a) If an applicant of a patent application fails to respond within the time period provided under §§ 1.134 and 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to respond and to advance the case to final action, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See § 1.7.)

37 CFR 1.138. Express abandonment. An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant himself or herself and the assignee of record, if any, identifying the application. Except as provided in § 1.262 an application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application, in accordance with 37 CFR 1.135 and 1.138, is one which is removed from the Office docket of pending cases through:

1. formal abandonment

   a. by the applicant (acquiesced in by the assignee if there be one), or

   b. by the attorney or agent of record including an associate attorney or agent appointed by the principal attorney or agent and whose power is of record but not including a registered attorney or agent acting in a representative capacity under 37 CFR 1.34(a); or

2. failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the case.

Where an applicant, himself or herself, formally abandons an application and there is a corporate assignee, the acquiescence must be made through an officer whose official position is indicated.

See § 712 for abandonment for failure to pay issue fee.

711.01 Express or Formal Abandonment

The applicant, the assignee of record and the attorney or agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the ap-

plicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to insure that the appropriate application is correctly identified in the letter of abandonment.

A letter of abandonment properly signed becomes effective when an appropriate official of the Office takes action thereon. When so recognized, the date of abandonment may be the date of recognition or a different date if so specified in the letter itself. For example, where a continuing application is filed with a request to abandon the prior application as of the filing date accorded the continuing application, the date of the abandonment of the prior application will be in accordance with the request once it is recognized.

Action in recognition of an express abandonment may take the form of an acknowledgment by the examiner or the Publishing Division of the receipt of the express abandonment, indicating that it is in compliance with 37 CFR 1.138. Alternatively, recognition may be no more than the transfer of drawings to a new application pursuant to instructions which include a request to abandon the application containing the drawings to be transferred (see 37 CFR 1.60 and § 608.02(i)).

It is suggested that divisional applications being submetted under 37 CFR 1.60 be reviewed before filing to ascertain whether the prior application should be abandoned. Care should be exercised in situations such as these as the Office looks on express abandonments as acts of deliberation, intentionally performed.

Applications may be expressly abandoned as provided for in § 1.138. When a letter expressly abandoning an application (not in issue) is received, the examiner should acknowledge receipt thereof, indicate whether it does or does not comply with the requirements of § 1.138.

Form Paragraph 7.88 may be used to acknowledge proper express abandonments.

7.88 Acknowledge Express Abandonment

This application is abandoned in view of the letter of express abandonment complying with 37 CFR 1.138 filed on [1].

If the letter expressly abandoning the application does comply with § 1.138, the examiner should respond by using form PTOL-327 and by checking the appropriate boxes which indicate that the letter is in compliance with § 1.138 and that the application is being forwarded to the Files Repository. The examiner's signature may appear at the bottom of the form. If such a letter does not comply with the requirements of § 1.138, a fully explanatory letter should be sent.

Form Paragraph 7.89 may be used to acknowledge improper express abandonments.

7.89 Letter of Express Abandonment, Improper

The letter filed on [1] does not comply with the requirements of 37 CFR 1.138, and therefore is not a proper letter of express abandonment.

Examiner Note:

The reasons why the letter fails to comply with Section 1.138 must be fully explained.

In view of the doctrine set forth in Ex parte Lasscell, 1884 C.D. 66, 29 O.G. 861, an amendment canceling all of the claims, even though said amendment is signed by the applicant himself and the assignee, is not an express abandonment. Such an amendment is regarded as non-responsive and should not be entered, and applicant should be notified as explained in §§ 714.03 to 714.05. But see § 608.02(i) for situation where application is abandoned along with transfer of drawings to a new application.

An attorney or agent not of record in an application may file a withdrawal of an appeal under § 1.34(a) except in those instances where such withdrawal would result in abandonment of the application. In such instances the withdrawal of appeal is in fact an express abandonment and does not comply with § 1.138.

After Notice of Allowance

Letters of abandonment of allowed applications are acknowledged by the Publishing Division.

Section 1.313 provides that an allowed application will not be withdrawn from issue except by approval of the Commissioner, and that after the issue fee has been paid and the patent to be issued has received its date and number, it will not be withdrawn for any reason except (1) mistake on the part of the Office, (2) a violation of § 1.56 or illegality in the application, (3) unpatentability of one or more claims, or (4) for interference. See §§ 711.05 and 1308. In cases where § 1.313 precludes giving effect to an express abandonment, the appropriate remedy is a petition, with fee, under § 1.183, showing an extraordinary situation where justice requires suspension of § 1.313.

The Defensive Publication Program is set forth in § 711.06.

Application in Interference

A written declaration of abandonment of the application signed only by an attorney or agent of record, when the application sought to be expressly or formally abandoned is the subject of an interference proceeding under 35 U.S.C. 135, is not effective to terminate the interference, and will not be considered until after ex parte prosecution is resumed. In order to be effective to terminate an interference proceeding, an abandonment of the application must be signed by the inventor in person with the written consent of the assignee where there has been an assignment, 37 CFR 1.262(b).

711.02 Failure To Take Required Action During Statutory Period

37 CFR 1.135(a) specifies that an application becomes abandoned if applicant "fails to prosecute" his or her application within the fixed statutory period. This failure may result either from

1. failure to respond within the statutory period, or
2. insufficiency of response, i.e., failure to take "complete and proper action, as the condition of the case may require" within the statutory period (§ 1.135(b)).

When an amendment is filed after the expiration of the statutory period, the case is abandoned and the remedy is to petition to revive it. The examiner should notify the applicant or attorney at once that the application has been abandoned by using form letter PTOL-327. The proper boxes on the form should be checked and the blanks for the dates of the proposed amendment and the Office action completed. The late amendment is endorsed on the file wrapper but not formally entered. (See § 714.17.)

Form Paragraph 7.90 may also be used.

7.90 Abandonment, Failure To Respond

This application is abandoned in view of applicant's failure to submit a response to the Office action mailed on [1] within the required period for response.

Examiner Note:

1. A letter of abandonment should not be mailed until after the period for requesting an extension of time under 37 CFR 1.136(a) has expired.

2. In "Pro se" cases see form paragraph 17.10.

To pass on questions of abandonment, it is essential that the examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant's response must reach the Office within the set shortened statutory period for reply dating from the date stamped or printed on the Office letter or within the extended time period obtained under § 1.136. (See §§ 710 to 710.06.)

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

An allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The petition should include sufficient data describing the procedures and controls utilized by the addressee when correspondence is received from the Patent and Trademark Office. If possible the addressee should also point out how these procedures and controls were followed in the situation at hand. The statements of fact setting forth the above must be verified by affidavit under oath before a Notary Public or, in the alternative, by declaration in accordance with 37 CFR 1.68. Prior to 1971, the only relief available to an applicant alleging the non-receipt of an Office communication, wherein the period for response had expired, was by way of a petition to revive. The Office was not receptive to treating such contentions as petitions for the withdrawal of the holding of abandonment regardless of the evidence presented in support of the contention that the Office action was not received. However, in 1971, the District Court, District of Columbia, in Delgar Inc. v. Schuyler, 172 USPQ 513, decided that the Commissioner should mail a new Notice of Allowance in view of the evidence presented in support of the contention that plaintiff's attorney never received the first Notice.

711.02(a) Insufficiency of Response

Abandonment may result from a situation where applicant's reply is within the period for response but is not fully responsive to the Office action. But see § 710.02(c), par. (c). See also §§ 714.02 to 714.04.

Form Paragraph 7.91 should be used to notify applicant of an insuffient response.

7.91 Reply is Not Fully Responsive, Extension of Time Suggested

Applicant's reply received [1] is not deemed to be fully responsive to the prior Office action because [2]. Since the period for response set in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the corrected response, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the response and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the six month statutory period.

Examiner Note:

1. The reasons why the examiner considers there to be a failure to take "complete and proper action" within the statutory period must be set forth in bracket 2.

2. If the response appears to be a bona fide attempt to respond with an inadvertent omission, do not use this paragraph. A time limit should be set to complete the response by using paragraph 7.95.

711.02(b) Special Situations Involving Abandonment

The following situations involving questions of abandonment often arise, and should be specially noted:

1. Copying claims from a patent when not suggested by the Patent and Trademark Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

2. A case may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Appeals. See §§ 1215.01 to 1215.04.

3. Likewise it may become abandoned through dismissal of appeal to C.A.F.C. or civil action, where there was not filed prior to such dismissal an amendment putting the case in condition for issue or fully responsive to the Board's decision. Abandonment results from failure to perfect an appeal as required by C.A.F.C. See §§ 1215.05 and 1216.01.

4. Where claims are suggested for interference near the end of the period for response running against the case, see § 1101.01(n).

5. When drawings are transferred under 37 CFR 1.88. See § 608.02(i).

711.02(c) Termination of Proceedings

"Termination of proceedings" is an expression found in 35 U.S.C. 120. As there stated, a second application is considered to be copending with an earlier case if it is filed before (a) the patenting, (b) the abandonment of, or (c) other termination of proceedings in the earlier case. "Before" has consistently been interpreted, in this context, to mean "not later than".

In each of the following situations, proceedings are terminated:

1. When the issue fee is not paid and the application is abandoned for failure to pay the issue fee, proceedings are terminated as of the date the issue fee was due and the application is the same as if it were abandoned on that date (but if the issue fee is later accepted, on petition, the application is revived). See § 712.

2. If an application is in interference involving all the claims present in the application as counts and the application loses the interference as to all the claims, then proceedings on that application are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

3. Proceedings are terminated in an application after decision by the Board of Appeals as explained in § 1214.06.

4. Proceedings are terminated after a decision by the court as explained in §§ 1215.05 and 1216.01.

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his or her application, applicant may either ask for reconsideration of such holding, if he or she disagrees with it on the basis that there is no abandonment in fact; or petition for revival under 37 CFR 1.137.

711.03(a) Holding Based on Insufficiency of Response

Applicant may deny that the response was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for response, he or she may reverse his or her holding as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. See also § 714.03.

711.03(b) Holding Based on Failure To Respond Within Period

When an amendment reaches the Patent and Trademark Office after the expiration of the period for response and there is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the examiner and the applicant may disagree as to the date on which the period for response commenced to run or ends. In this situation, as in the situation involving sufficiency of response, the applicant may take issue with the examiner and point out to him or her that his or her holding was erroneous.

711.03(c) Petitions Relating to Abandonment

37 CFR 1.137. Revival of abandoned application.

(a) An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by a showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee set forth in § 1.17(l). Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) An application unintentionally abandoned for failure to prosecute, except pursuant of § 1.53(d), may be revived as a pending application if the delay was unintentional. A petition to revive an unintentionally abandoned application must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition to revive under paragraph of this section which was filed within one year of the date of abandonment of the application. A petition to revive an unintentionally abandoned application must be accompanied by (1) a statement that the abandonment was unintentional, (2) a proposed response unless it has been previously filed, and (3) a petition fee as set forth in § 1.17(m). Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the abandonment was unintentional. The three month period set forth in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

(c) Any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application

Public Law 97-247 provided at 35 U.S.C. 41(a)7, a fee of $500 for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent unless the petition is filed under 35 U.S.C. 133 or 151 (revival based upon unavoidable delay), in which case the fee shall be $50. These fees are also expressly set forth in § 1.17(l) and §1.17(m) and provide for a 50% reduction for small entities.

The standard which is applied in situations where the delay resulting in abandonment is unavoidable is the same standard which has previously been applied prior to Public Law 97-247.

Section 1.17(m) provides a fee of $500 for filing each petition for revival, or for acceptance of the delayed payment of an issue fee, where the abandonment or the failure to pay the issue fee is unintentional. The standard which is applied is substantially less vigorous than the standard applied for unavoidable delay petitions. Generally, a statement that the abandonment was unintentional, plus the proper extension fee, and the proposed response is all that is required. A description of the circumstances surrounding the unintentional abandonment may be provided by applicant so that the record clearly reflects that the abandonment was unintentional. Where a question arises whether the abandonment was unintentional, additional information may be required. For example, a letter of express abandonment in the abandoned application would prompt a requirement for further information where the record does not make clear that such an abandonment was unintentional.

An applicant is not precluded from filing a petition based upon unintentional abandonment where a petition plus fee based upon unavoidable delay is unsuccessful. In such an instance, a petition to revive on the

ground of unintentional abandonment accompanied by the proper fee of $500 and the appropriate response could be filed. For this purpose, a mere statement that the abandonment was unintentional is all that is required.

In the instances where an application is abandoned and revival is based upon unintentional abandonment or unavoidable delay is desired solely for the purpose of continuity in order to effect the filing of a continuing application, it is not necessary to file the appropriate response. The filing of the continuing application will be accepted as the appropriate response in such situations. If revival is desired for other than the filing of a continuing application, a complete petition must include the proposed response which resulted in the holding of abandonment. To facilitate action, the petition to revive should include reference to the filing of the continuing application and a letter of express abandonment conditional upon the granting of the petition and of a filing date to the continuing application.

An application which is abandoned for failure to respond within a set period, and no extension fees are paid, would not require the payment of extension fees as a condition of revival.

Unavoidable Delay Petitions and Petitions To Withdraw the Holding of Abandonment

A decision on a petition to revive an abandoned application under § 1.137(a) is based solely on whether a satisfactory showing has been made that the delay was unavoidable (35 U.S.C. 133). A petition to revive is not considered unless the petition fee and a proposed response to the last Office action has been received (§ 1.137). While a response to a non-final action may be either an argument or an amendment under § 1.111, a response to a final action "must include cancellation of, or appeal from the rejection of, each claim so rejected" under § 1.113. Accordingly, in any case where a final rejection had been made, the proposed response required for consideration of a petition to revive must be either an appeal or an amendment that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance. When a notice of appeal is the appropriate response accompanying a petition to revive, the brief required by § 1.192 is due within the time set by the Commissioner in the response to the petition. In those situations where abandonment occurred because of the failure to file an appeal brief, the proposed response, required for consideration of a petition to revive, must include a brief accompanied by the proper fee.

Prior to 1971, the only relief available to an applicant alleging the non-receipt of an Office communication, wherein the period for response had expired, was by way of a petition to revive. The Office was not receptive to treating such contentions as petitions for the withdrawal of the holding of abandonment regardless of the evidence presented in support of the contention that the Office action was not received. However, in 1971, the District Court, District of Columbia, in Delgar Inc. v. Schuyler, 172 USPQ 513, decided that the Commissioner should mail a new Notice of Allowance in view of the evidence presented in support of the contention that plaintiff's attorney never received the first Notice.

While the decision may have been based on the fact that a petition to revive was not available in a case abandoned for failure to pay the issue fee, the reasoning of the court can appropriately be applied to cases abandoned for failure to prosecute. Accordingly, the form of relief provided in Delgar is hereby extended to cover the abandonment of an application for failure to respond to an Office action which was not received by the applicant or his or her representative. Henceforth, an allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed.

Inasmuch as there is a strong presumption of timely delivery to the addressee, the petition should include sufficient facts describing the procedures and controls utilized by the addressee when correspondence is received from the Patent and Trademark Office. If possible the addressee should also point out how these procedures and controls were followed in the situation at hand.

The statements of fact setting forth the above must be verified by affidavit under oath before a Notary Public or, in the alternative, by declaration in accordance with 37 CFR 1.68.

Where the application has been abandoned for an excessive period of time before the filing of such a petition, an appropriate terminal disclaimer may be required. (See § 203.08.)

It should also be recognized that a petition to revive an abandoned application under 37 CFR 1.137 alleging non-receipt of the Office action may also be treated as a request to withdraw the holding of abandonment. However, any petition fee, filed with a 37 CFR 1.137 petition so treated, may be returned or credited to petitioner's account by indicating in the decision that a request should be made to the Office of Finance.

The granting of a petition to revive does not serve in any way as a determination that the proposed response to the Office action is completely responsive. Revived applications are forwarded to the examiner to determine the completeness of the proposed response. Such applications must be taken up *Special*. If the examiner determines that the response is complete, he or she should promptly take the case up for action. If the proposed response is not a complete response to the last Office action, the examiner should write a letter to the applicant informing him or her of the specific defects in his or her response and set a one-month time limit for applicant to complete the response. If the applicant does not complete the response within the one-month limit, the application is again abandoned.

A petition to revive an abandoned application should not be confused with a petition from an examiner's holding of abandonment. Abandonment may result not only from insufficiency of response but also from entire failure to respond, within the statutory period following an Office action.

Where the holding of abandonment is predicated on the insufficiency of the response, or disagreement as to controlling dates the petition from such holding comes under § 1.181 and does not require a fee.

Form Paragraphs 7.92–7.94 may be used to inform applicants of withdrawal of abandonment.

7.92 Request To Withdraw Abandonment, No Showing of Abandonment in Fact

Applicant's request for reconsideration of the holding of abandonment filed on [1] has been considered. However, applicant has failed to show that there was no abandonment in fact, and the application stands abandoned.

If applicant's failure to prosecute was unintentional or can be shown to have been unavoidable, the proper course to follow is to request revival of the application under the conditions set forth in 37 CFR 1.137.

7.93 Request To Withdraw Abandonment, Application Was Never Abandoned

Applicant's request for withdrawal of the holding of abandonment filed on [1], has been considered. It is apparent that the application was never actually abandoned in fact. The Notice of Abandonment is withdrawn.

Examiner Note:

This is not a revival of an abandoned application, but merely a holding that the case was never abandoned.

7.94 Restore to Pending—Late Association of Papers

The response filed [1] was not associated with the file of this application until after the Notice of Abandonment was mailed.

The response was timely filed. Accordingly, the Notice of Abandonment is vacated, and the application is restored to pending status, to receive further consideration by the examiner in the normal course of business.

Where the applicant acquiesces in the holding of abandonment, or where the petition from such holding is denied, applicant's only recourse, so far as concerns the particular case involved, is by petition to revive.

See § 712 for a petition for late payment of the issue fee.

Unintentional Abandonment

A decision on a petition to revive an unintentionally abandoned application under § 1.137(b) is based substantially on whether the statement that the abandonment was unintentional is present along with the required fee and the proposed response. Generally, nothing else is required unless there is reason to believe that the abandonment was intentional such as a letter of express abandonment being of record in the abandoned application. In such an instance, the Office might inquire as to the circumstances surrounding the abandonment in order to clarify that the abandonment was, in fact, unintentional.

If a petition to revive based upon unavoidable delay is unsuccessful, an applicant is not estopped to file a petition based upon unintentional abandonment so long as such petition is filed within one year of the date of abandonment of the application or within three months of the date of the first decision on a petition to revive based upon avoidable delay. The petition must include a statement that the abandonment was unintentional, a proposed response if not filed previously, and the required petition fee. The statement that the abandonment was unintentional must be verified if made by a person not registered to practice before the Office. The three month period referred to above which is measured from the date of the first decision on a petition to revive based upon unavoidable delay is extendable under § 1.136(a), but no further extensions under § 1.136(b) will be granted.

Any petitions to the Commissioner to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

Notification of Change of Address

Applications have become abandoned as a consequence of a change of correspondence address therein, where an Office action is mailed to the old, uncorrected address and fails to reach the addressee sufficiently early to permit filing of a timely response. One factor for consideration in deciding petitions under § 1.137 to revive such applications is the evidence degree of care that has been exercised in adhering to the requirement (see § 601.03) for prompt notification *in each concerned application* of the change of address. In such instances, the showing of the cause of unavoidable delay must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made, ordinarily will not be considered sufficient notification of a change of address. If no such notification was filed, or was filed belatedly, the showing must include an adequate explanation of that failure or delay. A showing that notification was made on a paper filed in the Patent and Trademark Office listing *plural* applications as being affected will not be considered to constitute a proper notification.

Office Action—Timely Response

The Patent and Trademark Office has in the past received an excessively large volume of petitions to revive based primarily on the late filing of amendments and other responses to official actions. Many of these petitions indicate that the late filing was due to unusual mail delays; however, the records generally show that the filing was only two or three days late.

In order to alleviate, for applicants and the Office, the problems and expenditures of time and effort occasioned by abandonments and petitions to revive, it is suggensted that unless the certificate of mailing provisions of § 1.8 or § 1.10 are used that responses to Office actions be mailed to the Patent and Trademark

Office at least one, and preferably two, week(s) prior to the expiration of the period within which a response is required. This suggestion is made in the interest of improving efficiency, thereby providing better service to the public.

Since § 1.136(a) now makes available to applicants essentially automatic extensions of time as long as the petition to extend the time and the fee are submitted, the number of such petitions to revive based upon the late filing of amendments and other responses should diminish considerably.

CONDITIONAL PETITION TO REVIVE

Since applications that become abandoned unintentionally present burdens to both the Patent and Trademark Office and the applicant, a simplified procedure has been devised to alleviate these burdens when the abandonment results from a delay in the mails. This procedure provides for an automatic petition to revive or petition to accept the delayed payment of issue fee.

It is suggested that when a communication, complying with the circumstances enumerated below, is mailed to the Patent and Trademark Office a conditional petition be attached to the communication if the Certificate of Mailing under 37 CFR 1.8 or 1.10 is not used. Note that the Certificate of Mailing procedure can only be used in the United States of America while the Conditional Petition To Revive Practice can be used in any country.

If the communication is received in the Patent and Trademark Office after the due date and the application becomes abandoned, the conditional petition will become effective, subject to the following requirements. The petition must include (1) an authorization to charge a deposit account for any required fees, including the petition fee, and (2) an oath or declaration signed by the person mailing the communication and also signed by the applicant or his or her registered attorney or agent. The wording of the petition is dependent on the type of mail service used to forward the communication.

(1) If first class or air mail service is used, the oath or declaration must state that communication and petition were either placed in the United States mail as first class mail, or placed in the mail outside the United States as air mail. Since mail handled in this manner may reasonably be expected to reach the Patent and Trademark Office within three days of posting, any mail delays beyond such time will be considered to constitute unavoidable delay and sufficient cause to grant a petition to revive (35 U.S.C. 133) or a petition to accept delayed payment of an issue fee (35 U.S.C. 151). For example, if a response was due in the Patent and Trademark Office on June 15, 1979, the communication and conditional petition must be posted no later than June 11, 1979 in order for the conditional petition to be effective. June 12, 1979 is not "more than three calendar days prior to the due date" which is June 15, 1979.

(2) If the "Post Office to Addressee Express Mail" service (see § 502) is used, the oath or declaration must state that the communication and petition were deposited at an Express Mail window no later than 5:00 p.m. on a day which is at least the day preceding the due date, and were requested to be mailed via the "Post Office to Addressee Express Mail" service. Since mail handled in this manner may reasonably be expected to reach the Patent and Trademark Office no later the 3:00 p.m. of the next workday following its deposit before 5:00 p.m. at any postal facility in the United States with an Express Mail window, any mail delays beyond such time will be considered to constitute unavoidable delay to grant a petition to revive (35 U.S.C. 133) or a petition to accept delayed payment of an issue fee (35 U.S.C. 151).

The circumstances under which this procedure may be used are those where the communication, if timely filed, (1) would be a proper and complete response to an action or request by the Patent and Trademark Office, and (2) would stop a period for response from continuing to run. Accordingly, this procedure would be appropriate for:

1. A response to a non-final Office action.
2. A response to a final Office action in the form of an amendment that cancels all rejected claims or otherwise prima facie places the application in condition for allowance.
3. A notice of appeal and requisite fee.
4. An appeal brief, in triplicate, and requisite fee.
5. An issue fee.

Categories 1–4 would include a conditional petition to revive. Category 5 would include a conditional petition to accept the delayed payment of the issue fee. The boxes on the below suggested format should be checked accordingly.

Examples for which this procedure would not be appropriate and will not apply include the following types of communications when they are forwarded to the Patent and Trademark Office.

1. Application papers.
2. A response to a final Office action other than that indicated in categories 2 and 3, above.
3. Extensions of time.
4. Petitions for delayed payment of the issue fee.
5. Amendments under 37 CFR 1.312.
6. Priority documents.

Normal petition practices are not affected in those situations where this procedure is either not elected or appropriate.

A suggested format for the conditional petition where the communication and petition are placed in the United States mail as first class mail, or placed in the mail outside the United States as air mail is shown below:

Applicant(s) ..... ☐ Petition to revive
Serial No. ..... ☐ Petition to accept delayed payment of issue fee

Date Filed .....
For .....

I hereby certify that the attached communication is being deposited in

☐ the United States mail as first class mail

☐ the mail outside the United States as air mail

in an envelope addressed to: Commissioner of Patents, and Trademarks, Washington, D.C. 20231, on ——, which date is more than three (3) calendar days prior to the due date from, (Location) by (Name of Individual).

In the event that such communication is not timely filed in the United States Patent and Trademark Office, it is requested that this paper be treated as a petition and that the:

☐ delay in prosecution be held unavoidable—35 U.S.C. 133.

☐ delayed payment of the fee be accepted—35 U.S.C. 151.

The petition fee required is authorized to be charged to Deposit Account No. —— in the name of ————.

The undersigned declare further that all statements made herein are true, based upon the best available information; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date_____ _____
(Signature of applicant or signature and registration number of Registered Representative)

And

Date_____ _____
(Signature of person mailing, if other than the above)

A suggested format for the conditional petition where the communication and petition are placed in the United States "Post Office to Addressee Express Mail", is shown below:

Applicant(s)..... ☐ Petition to revive
Serial No.....
Date Filed..... ☐ Petition to accept delayed payment of issue fee
Title.....

I hereby certify that the attached communication is being deposited at an "Express Mail" window in a United States Postal Service facility and intended it to be mailed using the Postal Service's "Post Office to Addressee Express Mail" service in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, prior to 5:00 p.m. on ————, which date is at least the day preceding the due date, at (Location) by (Name of individual)

In the event that such communication is not timely filed in the Patent and Trademark Office, it is requested that this paper be treated as a petition and that the:

☐ delay in prosecution be held unavoidable—35 U.S.C. 133.

☐ delayed payment of the fee be accepted—35 U.S.C. 151.

The petition fee required is authorized to be charged to Deposit Account No. ——— in the name of ————.

The undersigned declare further that all statements made herein are true, based upon the best available information; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date———— ————————————————
(Signature of applicant or signature and registration number of Registered Representative)

And

Date———— ————————————————
(Signature of person mailing, if other than the above)

The procedure for handling applications becoming abandoned due to late filing of a communication having a conditional petition attached thereto is as follows:

1. Forward the papers and the application file wrapper to the Office of the Deputy Assistant Commissioner for Patents.

2. Do not mail a form PTOL–327 or forward the file wrapper to the Abandoned File Unit.

3. In the event that the application is revived, the file wrapper will be returned to the forwarding group for further action.

In view of the availability of § 1.136(a), the Certificate of Mailing practice, and the Express Mail practice, the Conditional petition to revive practice is not expected to be used frequently.

711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding

37 CFR 1.181 states that the examiner "may be directed by the Commissioner to furnish a written statement within a specific time setting forth the reasons for this or her decision upon the matters averred in the petition, supplying a copy thereof to the petitioner". Office, however, the question is passed upon without a statement being requested, if the issue raised is clear from the record. Unless requested, such a statement should not be prepared. See § 1002.01.

711.04 Disposition of Abandoned Applications

Extract from 37 CFR 1.14(b). Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

As explained in § 1302.07, a retention label is used to indicate applications not to be destroyed.

711.04(a) Pulling and Forwarding Abandoned Applications

The files of abondoned applications are pulled and forwarded to the Files Repository on a bi-weekly basis.

They should be carefully scrutinized by the appropriate examiner to verify that they are actually abandoned. A check should be made of files containing a decision of the Board of Appeals for the presence of allowed claims to avoid their being erroneously sent to the Files Repository.

Although the abandoned files are not pulled until the period for which an extension of time under § 1.136(a) plus one month has expired, the date of the abandonment is the date the period for response expired. This is normally the end of the 3 month shortened statutory period.

711.04(b) Ordering of Patented and Abandoned Files

In examination of an application is is sometimes necessary to inspect the application papers of a previously patented or abandoned application. It is always necessary to do so in the examination of a reissue application.

Recently patented and abandoned files are stored at the Files Repository located near the other PTO buildings in Crystal City. Older files are housed in a warehouse located in Suitland, Maryland.

Patented and abandoned files are ordered by means of a PALM video display transaction. To place such an order, the examiner is required to imput his/her PALM location code, employee number, and patent number(s) and/or serial number(s) of the file(s) that are needed. After transmission of the request transaction by the examiner, a "response" screen appears on the video display terminal which informs him/her of the status of the request for each file. The examiner is informed that the request (1) is accepted; (2) is accepted, but for which the file is located at the Suitland warehouse (in which case delivery is increased); or that the request is not accepted since (3) the file is not located at the repository or warehouse; (4) a previous request for the file has not yet been filled; or (5) the patent or serial number imputted in not valid.

Periodically each day, personnel at the Files Repository perform a PALM print transaction which produces a list of all accepted requests in patent number order and, for requests for abandoned files, in serial number order. The printed record of each request is detached from the list when its associated file is found. It is then stapled to it. Throughout the day, periodic deliveries of files are made directly to the offices of their requestors by Files Repository personnel. Upon delivery of files at the various locations, files that are ready to be returned to the repository are picked-up.

With the exception of certain older files, the drawings of patented and abandoned files, if any, are now stored within their respective application file jackets. Since it is desired not to separate one from the other, both the file and its drawings are delivered when a file is ordered.

711.04(c) Notifying Applicants of Abandonment

The Patent Examining Corps currently mails to the correspondence address of record, a Notice of Abandonment Form PTOL-1432 in all applications which become abandoned in the Corps for failure to prosecute. However, in no case will mere failure to receive a notice of abandonment affect the status of an abandoned application.

This procedure should enable applicants to take appropriate and diligent action to reinstate an application inadvertently abandoned for failure to timely respond to an official communication. In most cases, a petition to revive under 37 CFR 1.137 will be appropriate remedy. It may be that a response to the Office action was mailed to the Office with a certificate of mailing declaration as a part thereof (§ 512) but was not received in the Office. In this instance, adequate relief may be available by means of a petition to withdraw the holding of abandonment.

In any instance, if action is not taken promptly after receiving the notice of abandonment, appropriate relief may not be granted. If a lack of diligent action is predicated on the contention that neither the Office action nor the notice of abandonment was received, one may presume that there is a problem with the correspondence address of record. Accordingly, attention is directed to §§ 402 and 601.03 dealing with changes of address. In essence, it is imperative that a paper notifying the Office of a change of address be filed promptly in each application in which the correspondence address is to be changed.

If an application is abandoned for more than 6 months a terminal disclaimer may be required (37 CFR 1.137(c)).

711.05 Letter of Abandonment Received After Application is Allowed

Receipt of a letter of abandonment while an application is allowed is acknowledged by the Publishing Division.

An express abandonment arriving after the issue fee has been paid and the patent to issue has received its date and number will not be accepted without a showing of one of the reasons indicated in 37 CFR 1.313(b), or else a showing under 37 CFR 1.183 justifying suspension of § 1.313.

711.06 Abstracts, Abbreviatures and Defensive Publications

Abstracts were prepared and published in accordance with the Notice of January 25, 1949, 619 O.G. 258. Each abstract includes a summary of the disclosure of the abandoned application, and in applications having drawings, a figure of the drawing. The publication of such abstracts was discontinued in 1953.

ABBREVIATURES

Abbreviatures were prepared and published in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviature contains a specific portion of the disclosure of the abandoned application, preferable a detailed representative claim, and, in applications having drawings, a figure of the drawing. The publication of such abbreviatures was discontinued in 1965.

DEFENSIVE PUBLICATIONS

37 CFR 1.139. Waiver of patent rights. An applicant may waive his rights to an enforceable patent based on a pending patent application by filing in the Patent and Trademark Office a written waiver of patent rights, a consent to the publication of an abstract, and authorization to open the complete application to inspection by the general public, and a declaration of abandonment signed by the applicant and the assignee of record or by the attorney or agent of record.

A. Defensive Publication Program

An applicant may request to have an abstract of the technical disclosure of his or her application published as a defensive publication abstract under § 1.139. The request may be filed only (1) while a pending application is awaiting the first Office action in that application or (2) within 8 months of the earliest effective U.S. filing date if a first Office action has been issued and responded to within said 8 month period. The application is laid open for public inspection and the ap-

plicant provisionally abandons the application, retaining rights to an interference for a limited period of five years from the earliest effective U.S. filing date.

The defensive publication of an application precludes a continuing application (divisional, continuation-in-part, or continuation) filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application unless a continuing application is filed within thirty (30) months after the earliest effective U.S. Filing date. Where a similar application is not filed until after expiration of the thirty (30) month period, the application is examined, but it may not claim the benefit of the earlier filing date of the defensive publication application. The examiner should require the cancellation of any claim or statement intended to obtain the benefit of the earlier filing date in such cases, objecting to its inclusion on the ground of estoppel.

If a first continuing application is filed within 30 months from the earliest U.S. effective filing date of the application published under the Defensive Publication Program, later copending continuing applications (such as divisions if restriction is required during the prosecution of the first continuing application) are not barred and may be filed during the pendency of the first continuing application, even though beyond the 30 month period, without loss of the right to claim the benefit of the filing date of the Defensive Publication application.

The approval of a request for defensive publication is made by the supervisory primary examiner.

An application having therein a request for defensive publication is taken up special by the examiner, and if acceptable, the application is processed promptly for publication of the abstract and opening of the application to the public. A request for defensive publication cannot be withdrawn after it has been approved by the supervisory primary examiner.

No fee is required for the defensive publication of an application.

The Defensive Publication Abstract and a selected figure of the drawing, if any, are published in the *Official Gazette.* Defensive Publication Search Copies, containing the defensive publication abstract and suitable drawings, if any, are provided for the application file, the Public Search Room and the examiner's search files.

The defensive publication application files are maintained in the Record Room after publication.

B. Requirement for a Statement Requesting Defensive Publication

A application may be considered for defensive publication provided applicant files a request under § 1.139 agreeing to the conditions for defensive publication. It is preferred that the request be filed as a separate paper. The statement requesting publication should: (1) be signed by the assignee of record, or by the attorney or agent of record, or by the applicant and the assignee of record, if any; (2) request the Commissioner to publish an abstract of the disclosure in the O.G.; (3) authorize the Commissioner to lay open to public inspection the complete application upon publication of the abstract in the O.G.; (4) expressly abandon the application to take effect 5 years from the earliest U.S. effective filing date of said application unless interference proceedings have been initiated within that period; and (5) waive all rights to an enforceable patent based on said application as well as on any continuing application filed more then 30 months after the earliest effective U.S. filing date of said application unless the continuing application was copending with an earlier continuing application which was filed within 30 months after the earliest effective U.S. filing date.

C. Requirements for Defensive Publication

The examiner should scan the disclosure of the application to the extent necessary to determine whether it is suitable for publication and should also ascertain that the abstract and the selected figure of the drawing, if any, adequately reflect the technical disclosure. The abstract should be entitled "Defensive Publication Abstract" and may contain up to 200 words and be an expanded version of the abstract required under 37 CFR 1.72(b).

The request for defensive publication is disapproved if (1) there is some informality in the application or drawings, (2) the requirements of the statement requesting defensive publication as described in B above have not been met, or (3) the subject matter of the application is not considered suitable for publication because: (a) it involves national security; (b) it is considered advertising, frivolous, scandalous, lacking utility, or against public policy, etc., or (c) the disclosure is clearly anticipated by readily available art, and publication would not add anything to the fund of public knowledge (matters of patentability are generally not considered and no search is made).

If there are defects in the request for defensive publication which cannot be corrected by Examiner's Amendment, the examiner should notify applicant in writing, usually giving the reasons for disapproval and indicating how corrections may be made. Applicant is given a period of one (1) month within which to make the necessary corrections. Failure to correct a defect as required results in nonacceptance for defensive publication, and in resumption of the prosecution of the application by the Office in its regular turn.

In those instances, however, where the subject matter is not suitable for publication, the request may be disapproved without explanation. Under these circumstances, the examiner's letter is first submitted to the group director for approval.

Petition may be taken to the Commissioner from the disapproval of a request for defensive publication.

Where the request is apparently fatally defective and involves subject matter not considered suitable for publication, for example, advertising, frivolous, lacking utility, etc., or is clearly anticipated by readily available art, the examiner should generally examine

the application and prepare a complete Office action when notifying applicant.

D. Formal Requirements of a Defensive Publication Application

Correction is required by the examiner of informalities listed by the Application Division and by the Draftsman before approval of the request for defensive publication. Informalities of the drawing are listed on the Notice of Informal Patent Drawings and defects of the application are noted on the Notice of Informal Patent Application. A letter notifying an applicant of the informalities in a request for defensive publication should end with the following paragraphs:

"The request for defensive publication has not been approved in view of the noted informalites. APPLICANT IS GIVEN ONE (1) MONTH WITHIN WHICH TO MAKE THE CORRECTIONS NECESSARY FOR PUBLICATION.

Failure to respond within the set period will result in resumption of the prosecution of the application in the normal manner."

Where the heading "Defensive Publication Abstract" has been omitted, it is inserted by a letter in the form of an Examiner's Amendment, as are other corrections to the abstract. The examiner has the authority to add to the abstract reference numerals of the figure selected for the O.G., and to designate a figure of the drawing for printing in the O.G., or to change the selection made by applicant by a letter in the form of an Examiner's Amendment.

Informalities noted by the Draftsman on the Notice of Informal Patent Drawings should be corrected where appropriate and should be handled as follows: The examiner notes in pencil in the left margin of the drawing the number of the figure selected for defensive publication in the O.G. and returns the drawing with the file to the draftsman for further consideration in view of the request under §1.139. Although the selected figure itself must meet all the drawing standards, the draftsman may waive requirements as to the remaining figures which need be formal only to the extent of being sufficiently clear for reproduction. The Draftsman will note on the drawing and all copies of the Notice of Informal Patent Drawings "Approved for Defensive Publication Only". (If the application is later passed to issue, *all* drawing informalities must be corrected). If the drawing correction requires authority from the applicant, the examiner notifies him in writing that the request under §1.139 is disapproved until authorization for correction is received.

E. Preparation of an Application for Defensive Publication

After determining that the application is acceptable for defensive publication the examiner indicates which papers, if any, are to be entered. Amendments accompanying the request are not entered until approved by the examiner. If filed after receipt of the request, amendments will be placed in the file, but will not be entered unless the subject matter of the amendment is in response to a requirement by the examiner.

The drawings of a published Defensive Publication may be transferred to a later application drawn to the same invention filed within 30 months of the earliest effective U.S. filing date of the Defensive Publication provided that no alterations whatsoever are to be made in the drawings. Applicant must submit a copy of the drawings to allow processing of the application if transfer is contemplated.

The designated spaces on the face of the file wrapper for class, subclass, claim for foreign priority and prior United States application data are appropriately completed. Place the number of claims in the "Claims Allowed" box on the file wrapper, but strike out the word "Allowed" by drawing a line through it.

The Defensive Publication Retention Label identifies Defensive Publication Applications only and is affixed by the examiner in the space on the file wrapper reserved for the retention label. Patent Issue Division completes the date of publishing and O.G. citation of the Defensive Publication Retention Label.

In the spaces titled "Prep. for Issue" and "Examined and Passed for Issue" the word "Issue" is changed to—Def. Publ.—by the examiner before signing. (The clerk's signature is not necessary).

The "blue issue" slip is used on defensive publication applications and is completed in the usual manner except that in the space designated for the Patent Number the examiner writes "Defensive Publication". Cross references are designated only in those subclasses where the examiner believes the subject matter will be of significant interest to warrant it.

With respect to the drawings the procedure is the same as for allowance and the examiner fills in the appropriate spaces on the margin, in the Draftsman's "Approved" stamp area.

F. Citation of Prior Art in a Defensive Publication Application

Since the defensive publication procedure makes the disclosure of an application available to the public, usually before it or any continuing application is patented, citation of prior art under 37 CFR 1.291 by any person or party is accepted for consideration in the event examination is subsequently conducted. Such citation is endorsed on the file wrapper "Contents" by the Record Room, for the convenience of the examiner when preparing the application or a continuing application of such an application for allowance.

G. Defensive Publication Application Interferences

During the five year period from its earliest U.S. effective filing date, interferences may be declared between defensive publication applications and other applications and/or patents in accordance with existing interference rules and procedures.

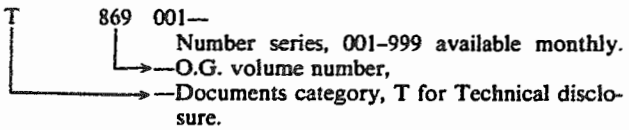
Examiners search the Defensive Publication Search Copies in the regular patent search files, when making patentability searches. Where the claims of a defen-

sive publication application recite substantially the same subject matter as the allowed claims, the allowed claims should be suggested for interference purposes to the defensive publication application if these claims would be allowable therin.

Abandonment of a defensive publication application will be stayed during the period beginning with the suggestion of claims or the filing of claims copied from a patent and ending with the termination of the interference proceedings or the mailing of a decision refusing the interference.

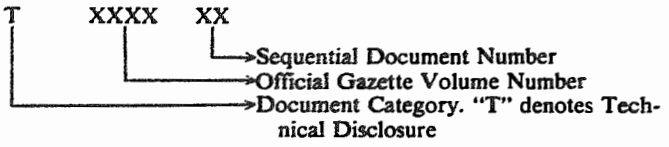
Termination of the interference in favor of the defensive publication application would render the express abandonment ineffective but would not result in the issuance of an enforceable patent. The examiner cancels by examiner's amendment all the calims in the case except those awarded to applicant and sends the case to issue. The Notice of Allowance in these cases will be accompanied by a statement informing the applicant that when the issue fee is remitted, a disclaimer of the entire term of the patent to be granted, must be included in accordance with 35 U.S.C. 253.

Distinct numbers are assigned to all Defensive Publications published December 16, 1969 through October 1980, for example.



For Defensive Publications published or and after November 4, 1980, a different numbering system is used.

The revised numbering system is as follows:



Defensive Publications are included in subclass lists and subscription orders. The distinct numbers are used for all official reference and document copy requirements.

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687.

711.06(a) Citation and Use of Abstracts, Abbreviatures and Defensive Publications as References

It is important that abstracts, abbreviatures and defensive publications (O.G. Defensive Publication and Defensive Publication Search Copy) be referred to as publications.

These printed publications are cited as prior art under 35 U.S.C. 102(a) or 102(b) effective from the date of publication in the Official Gazette. See Exparte Osmond, 191 USPQ 334(Bd. Appl. 1973) and In re Osmond, 191 USPQ 340, (Bd. Appl. 1976).

An application or portion thereof from which an abstract, abbreviature or defensive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 U.S.C. 102(a), effective from the actual date of filing in the United States.

These publications may be used alone or in combination with other prior art in rejecting claims under 35 U.S.C. 102 and 103.

Defensive Publictions are listed with "U.S. Patent Documents." Abstracts and Abbreviatures are listed under "Other References" in the citation thereof as follows:

(a) Abstracts and Abbreviatures

Brown, (abstract or abbreviature) of Serial No. ....., filed ....., published in O.G. ....., on (list classification).

(b) Applications or designated portions thereof abstracts, abbreviatures and defensive publications

Jones, Application Serial No. ....., filed ....., laid open to public inspection on ..... as noted at ..... O.G. (portion of application relied on) list classification; if any).

712 Abandonment for Failure To Pay Issue Fee

37 CFR 1.316. Application abandoned for failure to pay issue fee.

(a) If the issue fee is not paid within three months from the date of the notice of allowance, the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

(b) The Commissioner may accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if upon petition the delay in payment is shown to have been unavoidable. The petition to accept the delayed payment must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for delayed payment (§ 1.17(l)), and (3) a showing that the delay was unavoidable. Such showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(c) The Commissioner may, upon petition, accept the payment of the issue fee later than three months after the mailing of the notice of allowance as though no abandonment had ever occurred if the delay in payment was unintentional. The petition to accept the delayed payment must be filed within one year of the date on which the application became abandoned or be filed within three months of the date of the first decision on a petition under paragraph (b) of this section which was filed within one year of the date of abandonment of the application. The petition to accept the delayed payment must be accompanied by (1) the issue fee, unless it has been previously submitted, (2) the fee for unintentionally delayed payment (§ 1.17(m)), and (3) a statement that the delay was unintentional. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where the abandonment was unintentional. The three-month period from the date of the first decision referred to in this paragraph may be extended under the provisions of § 1.136(a), but no further extensions under § 1.136(b) will be granted. Petitions to the Commissioner under § 1.183 to waive any time periods for requesting revival of an unintentionally abandoned application will not be considered, but will be returned to the applicant.

(d) Any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment must be accom-

panied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application.

Section 41(a)7 establishes two different fees for filing petitions with different standards to accept the delayed payment of the fee for issuing a patent. The fees set forth in this section are due on filing the petition. Since the section provides for two alternative fees with different standards, the section permits the applicant seeking acceptance of a delayed payment of the fee for issuing a patent to choose one or the other of the fees and standards.

Under § 41(a)(7) the Commissioner has established time limits within which petitions under each of the different fees and standards can be filed. The section establishes a fee of $500 for filing each petition for acceptance of the delayed payment of an issue fee where the abandonment or the failure to pay the issue fee is unintentional. In order to prevent abuse and injury to the public the Commissioner can require a terminal disclaimer equivalent to the period of abandonment and require applicants to act promptly after becoming aware of the abandonment. 35 U.S.C. 41(a)(7) establishes a fee of $50 for filing a petition under section 151 of title 35 in accordance with standards previously in effect requiring that the delay in payment of the issue fee, be unavoidable. Under this section a petition accompanied by either a fee of $500 or a fee of $50 would not be granted where the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable. This section permits the Commissioner to have more discretion than previous law to accept late payment of the fee for issuing a patent in appropriate circumstances.

37 CFR 1.316 implements the statutory provisions of 35 U.S.C. 41(a) with regard to petition fees for revival of applications abandoned for failure to pay the issue fee. Paragraph (b) provides for petitions for revival with the fee in § 1.17(l) where the delay in payment was unavoidable, indicates that the petition must be promptly filed, and states when showings that the delay was unavoidable must be verified. Paragraph (c) provides for petitions for revival with the fee in § 1.17(m) where the delay was unintentional. Paragraph (c) also indicates when such petitions can be filed. Paragraph (d) requires a terminal disclaimer equivalent to the period of abandonment of the application where a petition under paragraph (b) of § 1.316 is not filed within six months of the date of abandonment.

713 Interviews

The personal appearance of an applicant, attorney, or agent before the examiner or a telephone conversation between such partys presenting matters for the latter's consideration is considered an interview.

713.01 General Policy, How Conducted

37 CFR 1.133. Interviews. (a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in §§ 1.111, 1.135.

Interviews are permissible on any working day except during periods of overtime work.

An interview should normally be arranged for in advance, as by letter, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present and available in the Office. When a second art unit is involved (Patentability Report), the availability of the second examiner should also be checked. (See § 705.01(f).) An appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be made.

When a telephone call is made to an examiner and it becomes evident that a lengthy discussion will ensue or that the examiner needs time to restudy the situation, the call should be terminated with an agreement that the examiner will call back at a specified time. Such a call and all other calls originated by the examiner should be made through the FTS (Federal Telecommunications System) even though a collect call had been authorized. It is helpful if amendments and other papers, such as the letter of transmittal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examiner may well justify his refusal of the interview at that time, particularly in an involved case.

An examiner's suggestion of allowable subject matter may justify indicating the possibility of an interview to acceleratae early agreement on allowable claims.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus the attorney when presenting himself or herself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted. It is desirable that the attorney or applicant indicate in advance what issues he or she desires to discuss at the interview.

Examiners should avoid unnecessary interruptions during interviews with attorneys or inventors. In this regard, examiners should notify their receptionist, immediately prior to an interview, to not complete incoming telephone calls unless such are of an emergency nature. As appropriate, examiners should familiarize themselves with the status and existing issues in an application or reexamination proceeding before an interview.

The examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the examiner. However, the examiner should attempt to identify issues and resolve differences during the interview as much as possible.

It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than thirty minutes. It is the duty of the primary examiner to see that an interview is not extended beyond a reasonable period even when he does not personally participate in the interview.

During an interview with an applicant who is prosecuting his or her own case and is not familiar with Office procedure the examiner may make suggestions that will advance the prosecution of this case; this lies wholly within his or her discretion. Too much time, however, should not be allowed for such interviews.

Examiners may grant one interview after final rejection. See § 713.09.

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Consideration of a field amendment may be had by hand delivery of a duplicate copy of said amendment.

Early communication of the results of the consideration should be made to applicant; if requested, indicate on attorney's copy any agreement; initial and date both copies.

Although entry of amendatory matter usually requires actual presence of the original paper, examiner and clerical processing should proceed as far as practicable based on the duplicate copy. The extent of processing will depend on each amendment.

The substance of any interview, whether in person or by telephone must be made of record in the application. See § 713.04.

Examination by Examiner Other Than the One Who Conducted the Interview

Sometimes the examiner who conducted the interview is transferred to another group or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See § 812.01 for a statement of telephone practice in restriction and election of species situations.

713.02 Interviews Prior to First Official Action

Prior to filing, no interview is permitted. However, in the examiner's discretion, a limited amount of time may be spent in indicating the field of search to an attorney, searcher or inventor.

A request for an interview prior to the first Office action is ordinarily granted in continuing or substitute applications. A request for an interview in all other applications before the first action is untimely and will not be acknowledged if written, or granted if oral; 37 C.F.R. 1.133 (a).

Searching in Group

Search in the group art unit should be permitted only with the consent of a primary examiner.

Expounding Patent Law

The Patent and Trademark Office cannot act as an expounder of the patent law, nor as a counsellor for individuals.

713.03 Interview for "Sounding Out" Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

713.04 Substance of Interview Must Be Made of Record

A complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See 37 CFR 1.133(b), § 713.01.

37 CFR 1.133 Interviews

* * * * *

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete writtten statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in §§ 1.111, 1.135.

§ 1.2 *Business to be transacted in writing.* All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete a two-sheet carbon interleaf Interview Summary Form for each interview held after January 1, 1978 where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks in neat handwritten form using a ball point pen. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in § 812.01, or pointing out typographical errors in Office actions or the like, are excluded from the interview recordation procedures below.

The Examiner Interview Summary Form PTOL—413 shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. The docket and serial register cards will not be updated to reflect interviews. In a personal interview, the duplicate copy of the Form is removed and given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the telephonic interview rather than with the next official communication.

The Form provides for recordation of the following information:

—Serial Number of the application
—Name of applicant
—Name of examiner
—Date of interview
—Type of interview (personal or telephonic)
—Name of participant(s) (applicant, attorney or agent, etc.)
—An indication whether or not an exhibit was shown or a demonstration conducted
—An identification of the claims discussed
—An identification of the specific prior art discussed
—An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.)
—The signature of the examiner who conducted the interview
—Names of other Patent and Trademark Office personnel present.

The Form also contains a statement reminding the applicant of his or her responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview in each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner will check a box at the bottom of the Form informing the applicant that he or she need not supplement the Form by submitting a separate record of the substance of the interview.

It should be noted, however, that the Interview Summary Form will not be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

The complete and proper recordation of the substance of any interview should include at least the following applicable items:

(1) A brief description of the nature of any exhibit shown or any demonstration conducted,
(2) an identification of the claims discussed,
(3) an identification of specific prior art discussed,
(4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form Completed by the examiner,
(5) the general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.
(6) a general indication of any other pertinent matters discussed, and

(7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete or accurate, the examiner will give the applicant one month from the date of the notifying letter or the remainder of any period for response, whichever is longer, to complete the response and thereby avoid abandonment of the application by using Form paragraph 7.84 (37 CFR 1.135(c)).

7.84 Amendment is Non-Responsive to Interview

The communication filed on [1] is non-responsive because it fails to include a complete or accurate record of the substance of the [2] interview. [3]

APPLICANT IS GIVEN A ONE MONTH TIME LIMIT FROM THE DATE OF THIS LETTER, OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION, WHICHEVER IS THE LONGER, TO COMPLETE THE RESPONSE. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b),

Examiner Note:
In bracket 2, insert the date of the interview.
In bracket 3, explain the deficiencies.

Examiner To Check For Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any argument or statement attributed to the examiner during the interview. If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should send a letter setting forth his or her version of the statement attributed to him or her.

If the record is complete and accurate, the examiner should place the indication "Interview record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

713.05 Interviews Prohibited or Granted, Special Situations

Saturday interviews, see § 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after a case has been passed to issue.

An interview may be appropriate before applicant's first response when the examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Office employees are forbidden to hold either oral or written communication with an unregistered or a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. See § 105.

Interviews are frequently requested by persons whose credentials are of such informal character that there is serious question as to whether such persons are entitled to any information under the provisions of 37 CFR 1.14. In general, interviews are not granted to persons who lack proper authority from the applicant or attorney of record in the form of a paper on file in the case or do not have in their possession a copy of the application file. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

However, interviews may be granted to registered individuals who are known to be the local representatives of the attorney in the case, even though a power of attorney to them is not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. (See § 408.)

If a registered individual seeking the interview has in his or her possession a copy of the application file, the examiner may accept his or her statement that he or she is authorized to represent the applicant under 37 CFR 1.34 or is the person named as the attorney of record.

Interviews normally should not be granted unless the requesting party has authority to bind the principal concerned.

The availability of personal interviews in the "Conference Period", which is the time between the filing of applicant's thorough first response and a concluding action by the the examiner, for attorneys resident or frequently in Washington is obvious. For other more remote, telephone interviews may prove valuable. However, present Office policy places great emphasis on telephone interviews initiated by the examiner to attorneys and agents of record. See § 408.

The examiner, by making a telephone call, may be able to suggest minor, probably quickly acceptable changes which would result in allowance. If there are *major* questions or suggestions, the call might state them concisely, and suggest a further telephone or personal interview, at a prearranged later time, giving applicant more time for consideration before discussing the points raised.

For an interview with an examiner who does not have negotiation authority, arrangements should always include an examiner who does have such authority, and who is familiar with the case, so that authoritative agreement may be reached at the time of the interview.

Grouped Interviews

For attorneys remote from Washington who prefer personal interviews, the grouped interview practice is effective. If in any case there is a prearranged interview, *with agreement to file a prompt supplemental amendment putting the case as nearly as may be in condition for concluding action,* prompt filing of the supplemental amendment gives the case special status, and brings it up for immediate special action.

713.06 No Inter Partes Questions Discussed Ex Parte

The examiner may not discuss inter partes questions *ex parte* with any of the interested parties. For this reason, the telephone number of the examiner should not be typed on decisions on motions or any other interference papers. See § 1111.01.

713.07 Exposure of Other Cases

Prior to an interview the examiner should arrange his or her desk so that all files, drawings and other papers, except those necessary in the interview, are placed out of view. See § 101.

713.08 Demonstration, Exhibits, Models

The invention in question may be exhibited or demonstrated during the interview by a model thereof. A model received by the examiner from the applicant or his or her attorney must be properly recorded on the "Contents" portion of the application file wrapper. See §§ 608.03 and 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office, (in the Washington area) with the approval of the supervisory primary examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, the intended purpose and content of the interview must be presented briefly, either orally or in writing. Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See § 714.13.

713.10 Interview Preceding Filing Amendment Under Section 1.312

After a case is sent to issue, it is technically no longer under the jurisdiction of the primary examiner, 37 CFR 1.312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under § 1.312 cannot be demanded as a matter of right.

Requests for interviews on cases already passed to issue should be granted only with specific approval of the group director upon a showing in writing of extraordinary circumstances.

714 Amendments, Applicant's Action

37 CFR 1.115. Amendment. The applicant may amend before or after the first examination and action, and also after the second or subsequent examination or reconsideration as specified in § 1.112 or when and as specifically required by the examiner. The patent owner may amend in accordance with §§ 1.510(e) and 1.530(b) prior to reexamination, and during reexamination proceedings in accordance with §§ 1.112 and 1.116.

See also § 714.12.

For amendments in reexamination proceedings see §§ 2250 and 2266.

714.01 Signatures to Amendments

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature. Note §§ 605.04 to 605.05(a) for a discussion of signatures to the application.

714.01(a) Unsigned or Improperly Signed Amendment

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies, for instance, where the amendment is signed by one only of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies (carbon or electrostatic) are filed, the signature must be applied after the copies are made. § 714.07.

An amendment filed with a copy of a signature rather than an original signature, may be entered if an accompanying transmittal letter contains a proper original signature.

When an unsigned or improperly signed amendment is received the amendment will be listed on the file wrapper, but not entered. The examiner will notify applicant of the status of the case, advising him or her to furnish a duplicate amendment properly signed or to ratify the amendment already filed. Applicant has either the time remaining in the period for response or may take advantage of the extension of time provisions of § 1.136(a), to file any supplemental response (37 CFR 1.135, § 711).

Applicants may be advised of unsigned amendments by use of Form Paragraph 6.35.

6.35 Amendment is Unsigned

The proposed [1] filed on [2] has not been entered because it is unsigned.

Applicant is given either the time remaining in the response period of the last Office action or a ONE month time limit from the date of this letter, whichever is the longer, within which to supply a duplicate paper or ratification, properly signed. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED UP TO A MAXIMUM OF 6 MONTHS.

Examiner Note:

In the first "bracket" insert (1) amendment (2) substitute Oath (3) substitute Declaration whichever is applicable.

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney of record, since he or she may have the authority to sign the amendment. Listings of local representatives of out-of-town attorneys are kept available in the various group directors' offices.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of 37 CFR § 1.347 or § 1.348 is not entered. The file and unentered amendment are submitted to the Office of the Solicitor for appropriate action.

714.01(c) Signed by Attorney Not of Record

See § 405.

A registered attorney or agent acting in a representative capacity under 37 CFR 1.34, may sign amendments even though he does not have a power of attorney in the application. See § 402.

714.01(d) Amendment Signed by Applicant But Not by Attorney of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to 37 CFR 1.33(a) in patent applications and to 37 CFR 1.33(c) in reexamination proceedings. Two copies of the action should be prepared, one being sent to the attorney and the other direct to applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

714.02 Must Be Fully Responsive

37 CFR 1.111. Reply by applicant or patent owner. (a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See §§ 1.135 and 1.136 for time for reply.)

In all cases where response to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete response must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matters and those touching the merits is not sharp, and the determination of the merits of a case may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

37 CFR 1.119. Amendment of claims. The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in § 1.121. The requirements of § 1.111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held non-responsive for that reason alone. (See 37 CFR 1.112, § 706.)

The prompt development of a clear issue requires that the responses of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See § 706.03(n).

An amendment attempting to "rewrite" a claim in the manner set forth in 37 CFR 1.121(b) may be held non-responsive if it uses parentheses, ( ), where brackets, [ ], are called for; see § 714.22.

Responses to requirements to restrict are treated under § 818.

714.03 Amendments Not Fully Responsive Action To Be Taken

If there is sufficient time remaining in the six-month statutory period or set shortened statutory period when applicant's amendment is found to be not fully responsive to the last Office action, a letter should at once be sent applicant pointing out wherein his or her amendment fails to fully respond coupled with a warning that the response must be completed within the time period in order to avoid the question of abandonment. See § 714.05.

Where a bona fide response to an examiner's action is filed before the expiration of a permisible period, but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted—such as an amendment or argument as to one or two of several claims involved or signature to the amendment—the examiner, as soon as he or she notes the omission, should require the applicant to complete his or her response within a specified time limit (usually one month) if the period has already expired or insufficient time is left to take action before the expiration of the period. If this is done the application should not be held abandoned even though the prescribed period has expired.

Under 37 CFR 1.135(c), the missing matter or lack of compliance must be considered by the examiner as

being "inadvertently omitted". Once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, any further time to complete the response would not be appropriate under 37 CFR 1.135(c). Accordingly no extensions of time can be granted in such situations.

Where there is an informality as to the fee in connection with an amendment presenting additional claims, the applicant is notified by the clerk on form PTOL-319. See §§607 and 714.10.

The examiner must exercise discretion in applying the practice under §1.135(c) to safeguard against abuses thereof.

The practice outlined above does not apply where there has been a deliberate omission of some necessary part of a complete response. For example, if an election of species has been required and applicant does not make election because he or she holds the requirement to be wrong, the amendment on its face is not a "bona fide attempt to advance the case to final action" (§ 1.135(c)), and the examiner is without authority to postpone decision as to abandonment.

If there is ample time for applicant's reply to be filed within the time period, no reference is made to the time for response other than to note in the letter that the response must be completed within the period for response dating from the last Office action or within any extension pursuant to § 1.136(a).

Form Paragraph 7.95 may be used where a bona fide response is not entirely responsive.

7.95 Non-Responsive Amendments

The communication filed on [1] is non-responsive to the prior Office action because [2]. Since the response appears to be bona fide, but through an apparent oversight or inadvertence failed to provide a complete response, applicant is required to complete the response within a time limit of one month from the date of this letter or within the time remaining in the response period of the last Office action, whichever is the longer. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136 (a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED UP TO A MAXIMUM OF 6 MONTHS.

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of a complete response.

Under such cases, the examiner has no authority to grant an extension if the period for response has expired. See form paragraph 7.91.

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. (See 37 CFR 1.111, § 714.02.)

An amendment failing to point out the patentable novelty which the applicant believes to exist in his case may be held to be nonresponsive and a time limit set to furnish a proper response if the statutory period has expired or almost expired (§ 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

714.05 Examiner Should Immediately Inspect

Actions by applicant, especially those filed near the end of the period for response, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the response within the period. See § 714.03.

All amended cases put on the examiner's desk should be inspected at once to determine:

If the amendment is properly signed (§ 714.01).

If the amendment has been filed within the statutory period, set shortened period or time limit (§ 710).

If the amendment is fully responsive. See §§ 714.03 and 714.04.

If the changes made by the amendment warrant transfer. See § 903.08(d).

If the case is special. See § 708.01.

If claims suggested to applicant for interference purposes have been inserted.

If there is a traverse of a requirement for restriction. See § 818.03(a).

If "easily erasable" paper has been used or other non-permanent method of preparation or reproduction. See § 714.07.

If applicant has cited references. See §§ 707.05(b) and 1302.12.

If a terminal disclaimer has been filed. See §§ 508.01, 804.02, 804.03 amd 1490.

If any matter involving security has been added. See § 107.01.

Action Crosses Amendment

A supplemental action is usually necessary when an amendment is filed on or before the mailing date of the regular action but reaches the examining group later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for response runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)".

714.06 Amendments Sent to Wrong Group

See § 508.01.

714.07 Amendments Not in Permanent Ink

37 CFR 1.52(a) requires "permanent ink or its equivalent in quality" to be used on papers which will become part of the record and In re Benson, 1959 C.D. 5, 744 O.G. 353, holds that documents on so-called "easily erasable" paper violate the requirement. The fact that § 1.52(a) has not been complied with may be discovered as soon as the amendment reaches the examining group or, later, when the case is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered

and is required to file a permanent copy within one month or to order a copy to be made by the Patent and Trademark Office at his or her expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate response within the one month period, a copy is made by the Patent and Trademark Office, applicant being notified and required to remit the charges or authorize charging them to his deposit account.

In the second instance, when the non-permanence of the amendment is discovered only when the case is reached for action, similar steps are taken, but action on the case is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

Office copier or good carbon copies on satisfactory paper are acceptable. But see In re Application Papers Filed Jan. 20, 1956, 706 O.G. 4. Although a good copy is acceptable, signatures must be applied after the copy is made.

See § 608.01 for more discussion on acceptable copies.

714.08 Telegraphic Amendment

When a telegraphic amendment is received, the telegram is placed in the file but not entered. If a properly signed formal amendment does not follow in due time, the applicant is notified that the telegram will not be accepted as a response to the former Office action. The time period for response to the Office action continues to run and is extendable under § 1.136.

The same test as to completeness of response applies to an amendment sent by telegraph as to one sent by mail. See § 714.02.

714.09 Amendments Before First Office Action

An amendment filed before the first Office action, but not filed along with the original application, does not enjoy the status of part of the original disclosure. See § 608.04(b). However, an application will be accorded a filing date based upon identification of the inventor(s) and the submission of a complete specification including claims and any required drawings. The oath or declaration and/or filing fee can be submitted later. Thus, in the instance where an application is filed without the oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. Any copy of the application as filed must include a copy of the amendment as well, particularly where certified copies for priority purposes are requested.

In the case of § 1.60 or § 1.62 (unexecuted) applications, an amendment to the specification stating that, "This application is a division (continuation) of application Serial No. ..... filed ....." and canceling any irrelevant claims as well as any preliminary amendment should accompany the application. Amendments should either accompany the application or be filed after the application has received its serial number and filing date. See § 201.06(a).

714.10 Claims Added in Excess of Filing Fee

The patent statute provides for the presentation of claims added in excess of the filing fee. On payment of an additional fee (see § 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action.

714.11 Amendment Filed During Interference Proceedings

See § 1111.05.

714.12 Amendments After Final Rejection or Action

37 CFR 1.116. Amendments after final action. (a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the applicaiton or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

Once a final rejection that is not premature has been entered in a case, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with § 1.116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See §§ 706.07(e), 714.13 and 1207.

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but is exceptional circumstances, a second personal interview may be initiated by the *examiner* if in his judgment this would materially assist in placing the application in condition for *allowance.*

Many of the difficulties encountered in ther prosection of patent applications after final rejection may be alleviated in each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he or she believes he

or she is entitled to the most detailed that he or she is willing to accept.

714.13 Amendments After Final Rejection or Action, Procedure Followed

Final Rejection—Time for Response

On October 1, 1982, pursuant to Public Law 97-247, the Patent and Trademark Office, discontinued the previous practice in patent applications of extending without fee the shortened statutory period for response to a final rejection upon the filing of a timely first response to a final rejection (37 CFR 1.116). Since October 1, 1982, applicants are able to obtain additional time for a first or subsequent response to a final rejection by petitioning and paying the appropriate fee under 37 CFR 1.136(a), provided the additional time does not exceed the six month statutory period.

In order to continue to encourage the early filing of any first response after a final rejection and to take care of any situation in which the examiner does not timely respond to a first response after final rejection which is filed early in the period for response, the Office is changing the manner in which the period for response is set on any final rejection mailed after February 27, 1983.

Under the changed procedure, if an applicant initially responds within two months from the date of mailing of any final rejection setting a three-month shortened statutory period for response and the Office does not mail an advisory action until after the end of the three-month shortened statutory period, the period for response for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond six months from the date of the final rejection. This procedure will apply only to a first response to a final rejection and will be implemented by including the following language in each final rejection mailed after February 27, 1983:

> A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of Form Paragraphs 7.39, 7.40 and 7.41. Form Paragraph 7.39 appears in § 706.07. Form Paragraph 7.40 appears in § 706.07(a). Form Paragraph 7.41 appears in § 706.07(b).

For example, if applicant initially responds within two months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of three months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of three months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the three-month period. If the examiner, however, does not mail an advisory action until after the end of three months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date.

Statutory periods set in Office actions mailed before February 28, 1983, are not be effected by this change in procedure.

Failure to file a response during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

Entry Not a Matter of Right

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see § 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under § 1.116(b) is expected in all amendments after final rejection. Failure to properly respond to the final rejection results in abandonment unless an amendment is entered in part (§ 714.20, items 3 and 4).

An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues for appeal, and/or (2) adopt examiner suggestions.

See also §§ 1207 and 1211.

Action by Examiner

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever, possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for

non-entry should be concisely expressed. For example:

(1) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(2) The claims, if amended as proposed, would avoid the rejection on the references. The amendment will be entered upon the filing of an appeal.

(3) The claims as amended present new issues requiring further consideration or search.

(4) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal; Ex parte Wirt, 1905 C.D. 247, 117 O.G. 599.

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper.

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Form letter PTOL-303 should be used to acknowledge receipt of a response from applicant after final rejection where such response is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. Examiners are expected to turn in their response to an amendment after final rejection within five days from the time the amendment reaches their desks. In those situations where the amendment reaches the examiner's desk after the expiration of the shortened statutory period, the examiner is expected to return his action to the clerical force within three days. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, *before preparing it for allowance,* applicant should be notified promptly of the allowability of all claims by means of form letter PTOL-327 or an examiner's amendment.

Such a letter is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for response expires.

If no appeal has been filed within the period for response and no amendment has been submitted to make the case allowable or which can be entered in part (see § 714.20), the case stands abandoned.

It should be noted that under 37 CFR. 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See § 1207 for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under 37 CFR 1.131 and 1.132 see §§ 715.09 and 716.

Form Paragraphs 7.67–7.80 are to be used when issuing advisory actions after a final rejection.

7.67 Advisory After Final, Heading, Before Appeal

THE PERIOD FOR RESPONSE [1] TO RUN [2] FROM THE DATE OF THE FINAL REJECTION. Any extension of time must be obtained by filing a petition under 47 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Examiner Note:

1. This paragraph should appear as a heading in all advisory actions prior to appeal. After appeal, use paragraph 7.68.
2. In Bracket 1, insert "continues" if applicant has not submitted a petition for an extension of time along with the appropriate fee under 37 CFR 1.136. If a proper extension has been requested under 37 CFR 1.136, insert "is extended to" in bracket 1.
3. In bracket 2, insert the statutory period, e.g. three months.

7.67.1 Advisory After Final Heading, 1st Response Filed Within 2 Months

The shortened statutory period for response expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for responses expires as set forth above.

Examiner Note:

This paragraph should be used in all advisory actions if:

1. it was the *first* to the final rejection, and
2. it was filed within 2 months.

If a notice of appeal has been filed, also use paragraph 7.68.

7.67.2 Advisory After Final, Heading, No Variable SSP Set in Final

Since the first response to the Final Office action has been filed within two (2) months of the mailing date of that action and the advisory action was not mailed within three (3) months of that date, the three (3) month shortened statutory period for response set in the Final Office action is hereby vacated and reset to expire as of the mailing date of the advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116" published in the Official Gazette at 1027 OG 71, February 8, 1983. In no event, however, will the statutory period for response expire later than six (6) months from the date of the Final Office action. Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

Examiner Note:

1. This paragraph should be used in all advisory actions where:
a. the responses is a first response to the final action;
b. the responses was filed within two months of the mailing date of the final; *and*
c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39–7.41.
2. If the final action set a variable SSP, do not use this paragraph. Use paragraph 7.67.1.
3. If a notice of appeal has been filed, also use paragraph 7.68.

7.68 Advisory After Final, Heading, After Appeal

An appeal under 37 CFR 1.191 was filed in this application on [1]. APPELLANT'S BRIEF IS DUE ON [2] IN ACCORDANCE WITH 37 CFR 1.192(a).

Examiner Note:

1. This paragraph must precede paragraph 7.70 if the amendment is entered.
2. This paragraph must precede paragraph 7.71 if the amendment is not entered.

7.69 Advisory After Final, Before Appeal, Amendment To Be Entered

The amendment filed [1] under 37 CFR 1.116 in response to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claims: [2]
Rejected claims: [3]
Claims objected to: [4]

Examiner Note:

1. This paragraph must be preceded by paragraph 7.67, 7.67.1, or 7.67.2.
2. In bracket 2–4, an explanation of any changes in the rejection necessitated by the amendment, a statement of reasons for allowance, or other appropriate information may be added following the listing of the claims.

7.70 Advisory After Final Appeal, Amendment Entered

The amendment filed [1] under 37 CFR 1.116 in response to the final rejection has been entered, but is not deemed to place the application in condition for allowance. The statute of the claims is as follows:

Allowed claims: [2]
Rejection claims: [3]
Claim objected to: [4]
The brief should be directed to the rejection of claim [5].

Examiner Note:

1. This paragraph must be preceded by paragraph 7.68
2. In bracket 2–4, an explanation of appropriate changes such as a change in the rejection or a statement of reasons for allowance, may be added following the listing of the claims.
3. In bracket 5, repeat claims identified in bracket 3.

7.71 Advisory After Final, Amendment not Entered

The amendment filed [1] under 37 CFR 1.116 in response to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

Examiner Note:

1. This paragraph must be preceeded by paragraph 7.67, 7.67.1 or 7.67.2 if an appeal has not been taken, or by paragraph 7.68 if an appeal has been taken.
2. One or more of the appropriate paragraphs 7.72–7.76 must diectly follow this paragraph.

7.72 Lacks Showing, Why Necessary and not Earlier Presented

There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

Examiner Note:

1. Paragraph 7.71 must precede this paragraph.
2. Do not use this paragraph as the sole reason for refusing entry of the amendment unless the situation is aggravated, in which case a full explanation is necessary.

7.73 Raise New Issues

The proposed amendment raises new issues that would require further consideration and/or search.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. The new issues must be fully explained.

7.74 Raises Issue of New Matter

The proposed amendment raises the issue of new matter.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. The new matter must be clearly identified.

7.75 Form for Appeal Not Improved

The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

Examiner Note:

This paragraph must be preceded by paragraph 7.71.

7.76 Additional Claims Presented

The proposed amendment presents additional claims without cancelling a corresponding number of finally rejected claims.

Examiner Note:

Paragraph 7.71 must precede this paragraph.

7.77 Accelerated Examining Procedure

This application has been examined under the accelerated examining procedure set forth in MPEP 708.02. Thus the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better for for appeal.

Examiner Note:

This paragraph must be preceded by paragraph 7.71.

7.78 Proposed New Claims Would Be Allowable

Claim [1] as proposed would be allowable if submitted in a separately filed amendment cancelling all non-allowed claims.

Examiner Note:

This paragraph must be preceded by paragraph 7.71.

7.79 Advisory After Final, Affidavit, Exhibit, or Request for Reconsideration Considered

The [1] has been entered and considered but does not overcome the rejection.

Examiner Note:

1. This paragraph must be preceded by either paragraph 7.67, 7.67.1, 7.67.2, or 7.68.
2. In bracket 1, insert either "affidavit", "declaration", "exhibit", or "request for reconsideration".
3. An explanation should follow.

7.80 Advisory After Final, Affidavit or Exhibit not Considered

The [1] will not be considered because good and sufficient reasons why it was not earlier presented have not been shown.

Examiner Note:

1. This paragraph must be preceded by either paragraph 7.67, 7.67.1, 7.67.2, or 7.68.
2. In bracket 1, insert either "affidavit", "declaration", "exhibit", or "request for reconsideration".
3. An explanation may follow where deemed appropriate.

HAND DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to an examining group. However, the examining group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a duplicate copy of such paper or a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), Serial No., filing date and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the group date stamp. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the examining group via the Mail Room.

The examining group will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by group personnel to the Office of Finance for processing and then made an offical paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand carried to the Cashier's Window, Room 2-1BO1, between the hours of 3:00 p.m. and 4:00 p.m.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Cashier's Window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

714.14 Amendments After Allowance of All Claims

Under the decision in Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213, after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See §§ 714.12 and 714.13.

See § 607 for additional fee requirements.

Use Form Paragraph 7.51 to issue an Ex parte Quayle action.

7.51 Quayle Action

This application is in condition for allowance except for the following formal matters: [1].

Prosecution on the merits is closed in accordance with the practice under ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE [2] FROM THE DATE OF THIS LETTER.

Examiner Note:

1. *Explain the matters that must be taken care of in "bracket 1".*
2. *In bracket 2, insert appropriate time period.*

714.15 Amendment Received in Examining Group After Mailing of Notice of Allowance

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under 37 CFR 1.312. Its entry is a matter of grace. For discussion of amendments filed under § 1.312, see §§ 714.16 to 714.16(e).

If, however, the amendment is filed in the Office prior to the mailing out of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it had the same standing in the case as though the notice had not been mailed. Where the case has not been closed to futher prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under § 1.312.

As above implied, the case will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosection of the merits of the case is a matter of grace and not of right (Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213). To this extent the practice affecting the status of an amendment received in the Office on the date of mailing the notice of allowance, as set forth in Ex parte Miller, 1922 C.D. 36; 305 O.G. 419, is modified.

714.16 Amendment After Notice of Allowance, 37 CFR 1.312

37 CFR 1.312. Amendments after allowance.

(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment pursuant to this paragraph filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The Commissioner has delegated the approval of recommendations under § 1.312(a) to the supervisory primary examiners.

A supplemental oath is not treated as an amendment under § 1.312, see § 603.01.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He or she can however, made examiner's amendments. (See § 1302.04) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims

from the application, without forwarding to the supervisiory primary examiner for approval.

Amendments other than those which merely embody the corretion of formal matters without changing the scope of the claims require approval by the supervisory primary examiner. The group director establishes group policy with respect to the treatment of amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent; namely, (1) that its disclosure be adequately clear, and (2) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under § 1.312 cannot be demanded as a matter of right. Prosecution of a case should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (1) to be needed for proper disclosure or protection of the invention, and (2) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of 37 CFR 1.111(c) (§ 714.02) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an ammendment under § 1.312, as in ordinary amendments. See §§ 713.04 and 713.10 regarding interviews. As to amendements affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show: (1) why the amendment is needed; (2) why the proposed amended or new claims require no additional search or examination; (3) why the claims are patentable and, (4) why they were not earlier presented.

NOT TO BE USED FOR CONTINUED PROSECUTION

Section 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient: (1) an additional search is required, or (2) more than a cursory review of the record is necessary, or (3) the amendment would involve materially added work on the part of the Office, e.g. checking excessive editorial changes in the specification or claims.

Where claims added by amendment under § 1.312 are all of the form of dependent claims, some of the usual reasons for non-entry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See §§ 607 and 714.16(c) for additional fee requirements.

AMENDMENTS FILED AFTER PAYMENT OF ISSUE FEE

37 CFR 1.312(b) provides that amendments under § 1.312 filed after the date the issue fee has been paid must include a petition and fee under § 1.17(i) and a showing of good and sufficient reasons why such an amendment is necessary and was not earlier presented. Such petitions are decided by the Group Director.

714.16(a) Amendments Under § 1.312, Copied Patent Claims

See § 1101.02(g) for the procedure to be followed when an amendment is received after notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See § 714.19 item (4).

See §§ 607 and 714.16(c) for additional fee requirements.

714.16(b) Amendments Under § 1.312 Filed With a Motion Under § 1.231

Where an amendment filed with a motion under § 1.231(a)(3) applies of a case in issue, the amendment is not entered unless and until the motion has been granted. See § 1105.03.

714.16(c) Amendments Under § 1.312, Additional Claims

If the amendment under § 1.312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the examiner unless accompanied by the full fee required. See § 607 and 35 U.S.C. 41.

714.16(d) Amendments Under § 1.312, Handling

AMENDMENTS AFFECTING THE DISCLOSURE OF THE SPECIFICATION, ADDING CLAIMS, OR CHANGING THE SCOPE OF ANY CLAIM

Amendments under § 1.312 are sent by the Correspondence and Mail Division to the Publishing Division which, in turn, forwards the proposed amendment, file, and drawing (if any) to the group which allowed the application. In the event that the class and subclass in which the application is classified has been transferred to another group after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other group and the Publishing Division notified. If the examiner who allowed the application is still employed in the Patent and Trademarke Office but not in said other group, he or she may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration.

The amendment is PROMPTLY considered by the examiner who indicates whether or not its entry is recommended by writing "Enter—312", "Do Not Enter" or "Enter In Part" thereon in red ink in the upper left corner.

If the amendment is favorably considered, it is entered and a notice of entry (PTOL-271) is prepared. No "Entry Recommended under Rule 312" stamp is

required on the amendment or on the notice of entry in view of the use of form (PTOL–271). The primary examiner indicates his or her recommendation by stamping and signing his or her name on the notice of entry form (PTOL–271).

Form Paragraph 7.85 may be used to indicate entry.

7.85 1.312 Amendment, Entered

The amendment filed on [1] under 37 CFR 1.312 has been entered.

Examiner Note:

Use this form for both Order 3311 amendments that do not affect the scope of the claims, and for other amendments being entered under 37 CFR 1.312.

If the examiner's recommendation is completely adverse, a report giving the reasons for non-entry is typed on the notice of disapproval (PTOL–271) and signed by the primary examiner.

Form Paragraph 7.87 may be used to indicate non-entry.

7.87 1.312 Amemdment, not Entered

The proposed amendment filed on [1] under 37 CFR 1.312 has not been entered. [2].

Examiner Note:

The reasons for non-entry should be specified.

In either case, whether the amendment is entered or not entered, the file, drawing, and unmailed notices are forwarded to the supervisory primary examiner for consideration, approval, and mailing.

For entry-in-part, see § 714.16(e).

The filling out of the appropriate form by the clerk does not signify that the amendment has been admitted; for, though actually entered it is not officially admitted unless and until approved by the supervisory primary examiner.

See §§ 607 and 714.16(c) for additional fee requirements.

Petitions to the Commissioner relating to the refusal to enter an amendment under § 1.312 and relating to entry of an amendment under § 1.312 filed after payment of the issue fee are decided by the group director.

If the § 1.312 amendment includes proposed drawing changes which are acceptable, the Office response should include Form Paragraph 6.48.

6.48 Drawing Changes in 1.312 Amendment

APPLICANT IS HEREBY GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE THREE MONTH PERIOD SET FOR PAYMENT OF THE ISSUE FEE (WHICHEVER IS LONGER) WITHIN WHICH THE CORRECTIONS TO THE DRAWINGS MUST BE EXECUTED, BY A BONDED COMMERCIAL DRAFTSMAN, AND THE CORRECTED DRAWINGS (OR THE SUBSTITUTE OR ADDITIONAL SHEET(S) OF DRAWINGS) RETURNED TO THE OFFICE.

Examiner Note:

Use with 1.312 amendment notice where there is a drawing correction proposal or request.

AMENDMENTS WHICH EMBODY MERELY THE CORRECTION OF FORMAL MATTERS IN THE SPECIFICATION, FORMAL CHANGES IN A CLAIM WITHOUT CHANGING THE SCOPE THEREOF, OR THE CANCELLATION OF CLAIMS

The examiner indicates approval of amendments concerning merely formal matters by writing "Enter Formal Matters Only" thereon. Such amendments do not require submission to the supervisory primary examiner prior to entry. See § 714.16. The notice of entry (PTOL–271) is date stamped and mailed by the examining group. If such amendments are disapproved either in whole or in part, they require the signature of the supervisory primary examiner.

714.16(e) Amendments Under § 1.312, Entry in Part

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under § 1.312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the case. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment.

The examiner should then submit a report (PTOL–271) recommending the entry of the acceptable portion of the amendment and the non-entry of the remaining portion together with his reasons therefor. The claims entered should be indicated by number in this report. Applicant may be notified by using Form Paragraph 7.86.

7.86 1.312 Amendment, Entered in Part

The amendment filed on [1] under 37 CFR 1.312 has been entered in part.[2]

Examiner Note:

When an amendment under Section 1.312 is proposed containing amendments to plural claims, some of which may be entered and some not, the acceptable claims should be entered. Indicate in bracket 2, which claims have and have not been entered.

Handling is similar to complete entry of a § 1.312 amendment.

Entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See §§ 607 and 714.16(c).

714.17 Amendment Filed After the Period for Response Has Expired

When an application is not prosecuted within the period set for response and thereafter an amendment is filed without a petition for extension of time and fee pursuant to 37 CFR 1.136(a), such amendment shall be endorsed on the file wrapper of the application, but not formally entered. The clerk shall immediately notify the applicant, by telephone and form letter PTOL–327, that the amendment was not filed within the time period and therefore cannot be entered and that the application is abandoned unless a petition for

extension of time and the appropriate fee are timely filed. See § 711.02.

A mere authorization to charge a deposit account for any fee required will not be considered to be a petition for an extension of time.

The Patent and Trademark Office has been receiving an excessively large volume of petitions to revive based primarily on the late filing of amendments and other responses to official actions. Many of these petitions indicate that the late filing was due to unusual mail delays; however, the records generally show that the filing was only two or three days late.

In order to alleviate, for applicants and the Office, the problems and expenditures of time and effort occasioned by abandonments and petitions to revive, it is suggested that responses to official action be mailed to the office at least one, and preferably two, week(s) prior to the expiration of the period within which a response is required or that the Certificate of Mailing procedure under 37 CFR 1.8 (§ 512) or § 1.10 (§ 513) be utilized. This suggestion is made in the interest of improving efficiency, thereby providing better service to the public.

714.18 Entry of Amendments

Amendments are stamped with the date of their receipt in the group. It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the group ("Group Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the appplicant with regard to his or her amendment.

All amendments received in the clerical sections are processed and with the applications delivered to the supervisory primary examiner for his or her review and distribution to the examiners.

Every mail delivery should be carefully screened to remove all amendments responding to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all cases where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these cases pass over the supervisory primary examiner's desk, he or she will be made aware of the need for any special treatment, if the situation so warrants. For example, the supervisory primary examiner will know whether or not the examiner in each case is on extended leave or otherwise incapable of moving the case within the required time periods (5 or 3 days; see § 714.13). In cases of this type, the applicant should receive an Office communication in sufficient time to adequately consider his or her next action if the case is not allowed. Consequently, the clerical handling will continue to be special when these cases are returned by the examiners to the clerical sections.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action." It is placed on the examiner's desk, and he or she is responsible for its proper disposal. The examiner should immediately inspect the amendment as set forth in § 714.05. After inspection, if no immediate or special action is required, the application awaits examination in regular order.

714.19 List of Amendments, Entry Denied

The following types of amendments are ordinarily denied entry:

1. An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in a case whose prosecution before the primary examiner has been closed, as where

(a) All claims have been allowed,

(b) All claims have been finally rejected (for exceptions see §§ 714.12, 714.13, and 714.20(4)),

(c) Some claims allowed and remainder finally rejected. See §§ 714.12 to 714.14.

2. Substitute specification that does not comply with 37 CFR 1.125. See §§ 608.01(q) and 714.20.

3. A patent claim suggested by the examiner and not presented within the time limit set or an extension thereof, unless entry is authorized by the Commissioner. See § 1101.02(f).

4. While copied patent claims are generally admitted even though the case is under final rejection or on appeal, under certain conditions, the claims may be refused entry. See § 1101.02(g).

5. An unsigned or improperly signed amendment or one signed by a disbarred attorney.

6. An amendment filed in the Patent and Trademark Office after the expiration of the statutory period or set time limit for response and any extension thereof. See § 714.17.

7. An amendment so worded that it cannot be entered with certain accuracy. See § 714.23.

8. An amendment cancelling all of the claims and presenting no substitute claim or claims. See § 711.01.

9. An amendment in a case no longer within the examiner's jurisdiction with certain exceptions in applications in issue, except on approval of the Commissioner. See § 714.16.

10. Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of non-entry because of alleged new matter, however, does not apply in the cae of amendments to the specification and claims. See §§ 608.04 and 706.03(o).

11. An amendatory paper containing objectionable remarks that, in the opinion of the examiner, brings it

within the condemnation of 37 CFR 1.3, will be submitted to the group director for return to applicant. See § 714.25 and § 1003, item 3. If the group director determines that the remarks are in violation of 37 CFR 1.3, he will return the paper.

12. Amendments not in permanent ink. Amendments on so-called "easily erasable paper." See § 714.07.

13. An amendment presenting claims (total and independent) in excess of the number previously paid for and not accompanied by the full fee for the claims or an authorization to charge the fee to a deposit account.

14. Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed. In re Willingham, 127 USPQ 211 (CCPA 1960).

15. An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the non-elected invention should not be entered. Such an amendment is non-responsive. Applicant should be notified as directed in §§ 714.03 and 714.05. See § 821.03.

While amendments falling within any of the foregoing categories should not be entered by the examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

714.20 List of Amendments Entered in Part

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for response. Thus,

(1) An "amendment" presenting an unacceptable substitute specification along with 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 paper should be entered. The case as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification is not necessary and therefore has not been entered. See also 37 CFR 1.125, and § 608.01(q).

Under current practice, substitute specifications may be voluntarily filed by the applicant if he or she desires. A substitute specification will normally be accepted by the Office even if it has not been required by the examiner. Substitute specifications will be accepted if applicant submits therewith a hand corrected copy of the portions of the original specification which are being added and deleted and a statement that the substitute specification includes no new matter and that the substitute specification includes the same changes as are indicated in the hand corrected original specification. Such statement must be a verified statement if made by a person not registered to practice before the Office. Additions should be indicated by underlining and deletions should be indicated between brackets. Examiners may also require a substitute specification where it is considered to be necessary.

However, any substitute page of the specification, or entire specifications filed must be accompanied by a statement indicating that no new matter was included. Such statement must be a verified statement if made by a person not registered to practice before the Office. See 37 CFR 1.125. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment to the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors.

(2) An amendment under 37 CFR 1.312, which in part is approved and in other part disapproved, is entered only as to the approved part. See § 714.16(e).

(3) In a case having all claims allowed and some formal defect noted, where an amendment is presented at or near the close of the statutory period curing the defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the procedure indicated in (3) is followed. After the statutory period has ended, the amendment in such a case will be entered only as to the formal matter and to any of the newly presented claims that may be deemed patentable.

(4) In an amendment accompaying a motion granted only in part, the amendment is entered only to the extent that the motion was granted. See § 1108.

NOTE. The examiner writes "Enter" in ink and his or her initials in the left margin opposite the enterable portions.

714.21 Amendments Inadvertently Entered, No Legal Effect

If the clerk inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as "Not Officially Entered".

If it is to be retained in the file an amendatory paper, even though not entered, should be given a paper number and listed on the file wrapper with the notation "Not Entered". See 37 CFR 1.3 and § 714.25, for an instance of a paper which may be returned.

714.22 Entry of Amendments, Directions for

37 CFR 1.121. Manner of making amendments. (a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to § 1.52), directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise privided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this section to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this section may be considered non-responsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this section shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended as specified in paragraph (a) of this section.

(f) Proposed amendments presented in patents involved in reexamination proceedings must be presented in the form of a full copy of the text of (1) each claim which is amended and (2) each paragraph of the description which is amended. Matter deleted from the patent shall be placed between brackets and matter added shall be underlined. Copies of the printed claims from the patent may be used with any additions being indicated by carets and deleted material being placed between brackets. Claims must not be renumbered and the numbering of the claims added for reexamination must follow the number of the highest numbered patent claim. No amendment may enlarge the scope of the claims of the patent. No new matter may be introduced into the patent.

The term "brackets" set forth in § 1.121(b) means angular brackets, thus: [ ]. It does not encompass and is to be distinguished from parentheses ( ). Any amendment using parentheses to indicate canceled matter in a claim rewritten under § 1.121(b) may be held nonresponsive in accordance with § 1.121(c).

Where, by amendment under § 1.121(b), a dependent claim is rewritten to be independent form, the subject matter from the prior independent claim should be considered to be "added" matter and should be underlined.

Section 1.121(f) requires a complete copy of any new or amended claim when presented during reexamination proceedings. See §§ 2221, 2250, and 2266.

Form Paragraphs 6.33 and 6.34 may be used to inform applicants if the amendments are not in proper format.

6.33 Amendment to the Claims, 37 CFR 1.121

The amendment to the claims has not been entered because it requests the addition of more than 5 words in any one claim. See 37 CFR 121(c) below:

A particular claim may be amended in the manner indicated in paragraph (a) of 37 CFR 1.121 to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to: (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of 37 CFR 1.121 may be considered nonresponsive and treated accordingly.

The amendment to the claims should be made in accordance with 37 CFR 1.121(b) which states:

Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

Applicant is given either the time remaining in the response period of the last Office action or a ONE month time limit from the date of this letter, whichever is the longer, within which to complete the response. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED UP TO A MAXIMUM OF 6 MONTHS.

6.34 Amendment to the Claims, Brackets or Underlining Cannot Be Used

The claims of this application contain underlining or brackets that are intended to appear in the printed patent or are properly part of the claimed material. The brackets or underlining are not intended to indicate amendments or changes in the claims. Under these conditions, proposed amendments to the claims may not be made by underlining words added or by bracketing words to be deleted. Accordingly, the proposed amendment to the claims has not been entered. See 37 CFR 1.21(d).

Applicant is given either the time remaining in the period for response set in the last Office action or a ONE month time limit from the date this letter, whichever is the longer, within which to complete the response. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION MAY BE EXTENDED UP TO A MAXIMUM OF 6 MONTHS.

714.23 Entry of Amendments, Directions for, Defective

The directions for the entry of an amendment may be defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line. If it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining group; and notation thereof, initialed in ink by the examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action the applicant should be informed of this alteration in the amendment and the entry of the amendment as thus amended. The applicant will also be informed of the nonentry of an amendment where

defective directions and context leave doubt as to the intent of applicant.

714.24 Amendment of Amendment

37 CFR 1.124. Amendment of amendments. When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.

However, where a relatively small amendment to a previous amendment can be made easily without causing the amendatory matter to be obscure or difficult to follow, such small amendment should be entered.

714.25 Discourtesy of Applicant or Attorney

37 CFR 1.3 Business to be conducted with decorum and courtesy. Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other employees must be made in communications separate from other papers.

All papers received in the Patent and Trademark Office should be briefly reviewed by the clerk, before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney is discourteous in the remarks or arguments in his amendment, either the discourtesy should be entirely ignored or the paper submitted to the group director with a view toward its being returned. See § 1003, item 3. If the group director determines that the remarks are in violation of 37 CFR 1.3, the group director will return the paper.

715 Swearing Back of Reference-Affidavit or Declaration Under §1.131

37 CFR 1.131. Affidavit or declaration of prior invention to overcome cited patent or publication. (a) When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant or the owner of the patent under reexamination shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication be more than one year prior to the date on which the applicant's or patent owners application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

NOTE THAT § 1.131 IS NOT APPLICABLE TO A REJECTION BASED ON A U.S. PATENT WHICH CLAIMS THE REJECTED INVENTION.

Any printed publication dated prior to an applicant's or patent owners' effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application or patent under reexamination.

Such a rejection may be overcome, in certain instances noted below, by filing of an affidavit or declaration under § 1.131, known as "swearing back" of the reference.

Affidavits or declarations under § 1.131 may be used:

(1) Where the date of the foreign patent or that of the publication is less than one year prior to applicant's or patent owner's effective filing date.

(2) Where the reference, a U.S. Patent, with a patent date less than one year prior to applicant's effective filing date, shows but does not claim the invention.

An affidavit or declaration under § 1.131 is not appropriate in the following situations:

(1) Where the reference publication date is more than one year back of applicant's or patent owner's effective filing date. Such a reference is a "statutory bar."

(2) Where the reference U.S. patent claims the invention. See § 1101.02(a).

(3) Where reference is a foreign patent for the same invention to applicant or patent owner or his or her legal representatives or assigns issued prior to the filing date of the domestic application or patent on an application filed more than twelve months prior to the filing date of the domestic application.

(4) Where the effective filing date of applicant's or patent owner's parent application or an International Convention proved filing date is prior to the effective date of the reference, an affidavit or declaration under 37 CFR 1.131 is unnecessary because the reference is not used. See §§ 201.11 to 201.15.

(5) Where the reference is a prior U.S. patent to the same entity, claiming the same invention, the question involved is one of "double patenting."

(6) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending, the question is one of dedication to the public. Note however In re Gibbs and Griffin, 168 USPQ 578 (CCPA 1971) which substantially did away with the dectrine of dedication.

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit or declaration is the date of amendment. In re Willien, 1935 C.D. 229, 24 USPQ 210.

It should be kept in mind that it is the *rejection* that is withdrawn and not the reference.

Form Paragraphs 7.57, 7.60, 7.61 and 7.64 may be used to respond to § 1.131 affidavits.

7.57 1.131 Affidavit, Ineffective, Heading

The [1] filed on [2] under 37 CFR 1.131 has been considered but is ineffective to overcome the [3] reference.

Examiner Note:

1. In bracket 1, insert either—affidavit—or—declaration.

2. This paragraph must be followed by one or more of paragraphs 7.58–7.63.

7.60 1.131 Affidavit, Reference is a Statutory Bar

The [1] reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131.

Examiner Note:
This paragraph must be preceded by paragraph 7.57.

7.61 1.131 Affidavit, Insufficient Evidence of Conception

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the [1] reference. While conception is the mental part of the inventive art, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See Mergenthaler v. Scudder 1897 C.D. 724, 81 O.G. 1417.

Examiner Note:
1. This paragraph must be preceded by paragraph 7.57.
2. An expansion of the deficiency in the showing of conception must be presented.
3. If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this paragraph should be followed by paragraph 7.62 and/or 7.63. If either diligence or a reduction to practice is established, a statement to that effect should follow this paragraph.

7.64 1.131 Affidavit, Effective to Withdraw Rejection

The [1] filed on [2] under 37 CFR 1.131 is sufficient to overcome the [3] reference.

715.01 Reference Claims Foreign Filing Date

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

* * * * *

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or".

37 CFR 1.53. Serial number, filing date, and completion of application.

* * * * *

(d) The filing date of an international applicatin designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

The effective date of a United States Patent for use as a prior art reference is not affected by the foreign filing date to which the patentee may be entitled under 35 U.S.C. 119. In re Hilmer, 833 O.G. 13, 149 USPQ 480 (CCPA 1966); Lily v. Brenner, 153 USPQ 95 (C.A.D.C. 1967). The reference patent is effective as of the date the application for it was filed in the United States (35 U.S.C. 102(e) and 103). Hazeltine Research, Inc. v. Brenner, 824 O.G. 8, 147 USPQ 429, 382 U.S. 252 (U.S. Supreme Court 1965).

715.01(a) Reference is a Joint Patent to Applicant and Another

When subject matter, disclosed but not claimed in a patent issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131. In re Strain, 1951 C.D. 252, 89 USPQ 156, 38 CCPA 933. Disclaimer by the other patentee should not be required. But see § 201.06.

715.01(b) Reference and Application Have Common Assignee

The mere fact that the reference patent which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under 37 CFR 1.131. The common assignee does not obtain any rights in this regard by virtue of common ownership which he would not have in the absence of common ownership. In re Beck 1946 C.D. 398, 590 O.G. 357; Pierce v. Watson, 124 USPQ 356; In re Frilette and Weisz, 162 USPQ 163.

715.01(c) Reference Is Publication of Applicant's Own Invention

Unless it is a statutory bar, a rejection on a publication may be overcome by a showing that it was published either by applicant himself or in his behalf, Ex parte Lemieux, 1957 C.D. 47; 725 O.G. 4; Ex parte Powell et al., 1938 C.D. 15, 489 O.G. 231.

Where the last day of the year dated from the date of publication falls on a Saturday, Sunday, or Federal holiday, the publication is not a statutory bar under 35 U.S.C. 102(b) if the application was filed on the next succeeding business day. Ex parte Olah and Kuhn, 131 USPQ 41 (Bd.App. 1960). It should also be noted that a magazine is effective as a printed publication under 35 U.S.C. 102(b) as of the date it reached the addressee and not the date it was placed in the mail. Protein Foundation Inc. v. Brenner, 151 USPQ 561 (D.C.D.C. 1966).

When the unclaimed subject matter of a patent is applicant's own invention, a rejection on that patent may be removed by the patentee filing an affidavit establishing the fact that he derived his knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent is based. In re Mathews, 161 USPQ 276, 56 CCPA 1033. In re Facius, 161 USPQ 294, 56 CCPA 1348. See also § 201.06.

Co-Authorship

Where the applicant is one of the co-authors of a publication, cited against his or her application, he or she is not required to file an affidavit or declaration under § 1.131. The publication may be removed as a reference by filing a disclaiming affidavit or declaration of the other authors. Ex parte Hirschler, 110 USPQ 384.

715.02 General Rule as to Generic Claims

A reference applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under § 1.131 showing comple-

tion of the invention of only a single species, within the genus, prior to the effective date of the reference (assuming, of course, that the reference is not a statutory bar or a patent claiming the same invention). See, however, § 715.03 for practice relative to chemical cases.

715.03 Practice Relative to Chemical Cases

In chemical cases, where generic claims have been rejected on a reference which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn unless the applicant is able to establish that he or she was in possession of the generic invention prior to the effective date of the reference. In other words, the affidavit or declaration under § 1.131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

The principle is well established in chemical cases, and in cases involving compositions of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a "generic claim." In re Steenbock, 1936 C.D. 594, 473 O.G. 495.

Where the only pertinent disclosure in the reference is a single species, which species is antedated by the affidavit or declaration, the reference is overcome. In re Stempel, 1957 C.D. 200, 717 O.G. 886.

Markush Type Claim

Where a claim reciting a Markush group is rejected on a reference disclosing but not claiming a specific member of the group, the reference cannot be avoided by an affidavit or declaration under § 1.131 showing different members of the group.

715.04 Who May Make Affidavit or Declaration

A. The inventor.

B. One of two joint inventors is accepted where suitable excuse is given for failure of the other applicant to sign. In re Carlson et al, 1936 C.D. 95, 462 O.G. 479.

C. The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261.

715.05 Patent Claiming Same Invention

When the reference in question is a noncommonly owned patent claiming the same invention as applicant and its issue date is less than one year prior to the filing date of the applicaiton being examined, applicant's remedy, if any, must be by way of 37 CFR 1.204 instead of 37 CFR 1.131. The examiner should therefore take note whether the status of the patent as a reference is that of a PATENT or a PUBLICATION. If the patent is claiming the same invention as the application, this fact should be noted in the Office action. The reference patent can then be overcome only by way of interference. Note, however, 35 U.S.C. 135, § 1101.02(f).

Form Paragraph 7.58 may be used to note such a situation in the office action.

7.58 1.131 AFFIDAVIT, INEFFECTIVE, CLAIMING SAME INVENTION

The [1] reference is a U.S. patent that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the patient is claiming the same invention. The patient can only be overcome by establishing priority of invention through interference proceedings. See MPEP 1101.02(g) for information on initiating interference proceedings.

Examiner Note:

1. If used to respond to the submission of a 1.131 affidavit, this paragraph must be preceded by paragraph 7.57.

2. This paragraph may be used without paragraph 7.57. when an affidavit under § 1.131 has not yet been filed, and the examiner desires to notify applicant that the submission of a 1.131 affidavit would be inappropriate.

715.07 Facts and Documentary Evidence

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. *FACTS*, not conclusions, must be alleged, and they must be shown by evidence in the form of exhibits accompanying the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(1) attached sketches;
(2) attached blueprints;
(3) attached photographs;
(4) attached reproductions of notebook entries;
(5) an accompanying model;
(6) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon.

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

The dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates he or she may merely allege that the acts referred to occurred prior to a specified date.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte* Saunders, 1883 C.D. 23, 23 O.G. 1224.

"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others." *Ex parte* Donovan, 1890 C.D. 109, 52 O.G. 309.

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception

and completion of invention IN THIS COUNTRY, at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a *constructive* reduction to practice, § 1.131).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE OR SHE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited, 1909 C.D. 498, 139 O.G. 991.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The facts to be established under § 1.131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his remedy is by appeal from the continued rejection.

Disclosure Documents (§ 1706) may be used as documentary evidence.

Form Paragraph 7.59 or 7.63 may be used where insufficent evidence is included in a § 1.131 affidavit.

7.59 1.131 Affidavit, Insufficient Evidence of Reduction to Practice Before Reference Date

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country prior to the effective date of the [1] reference.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.57.

2. An explanation of the lack of showing of the alleged reduction to practice must be provided.

7.63 1.131 Affidavit, Insufficient Evidence of Reduction To Practice After Reference Date

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country after the effective date of the [1] reference.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.57.

2. If the alleged reduction to practice is prior to the effective date of the reference, do not use this paragraph. See paragraph 7.59.

3. If the affidavit additionally fails to establish either conception or diligence, paragraphs 7.61 and/or 7.62 should precede this paragraph. If either conception or diligence is established, a statement to that effect should be included after this paragraph.

4. An explanation of the lack of showing of the alleged reduction to practice must be given.

715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733.

What is meant by diligence is brought out in Christie v. Seybold, 1893 C.D. 515, 64 O.G. 1650. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if his lack of activity is excused.

Note, however, that only diligence *before* reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" (Ex parte Merz, 75 USPQ 296) is not relevant to an affidavit or declaration under 37 CFR 1.131.

Form Paragraph 7.62 may be used to respond to a 1.131 affidavit where diligence is lacking.

7.62 1.131 Affidavit, Diligence Lacking

The evidence submitted is insufficient to establish diligence from a date prior to the effective date of [1] reference to a subsequent reduction to practice or to the filing of the application.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.57.

2. If the affidavit additionally fails to establish conception, this paragraph must also be preceded by paragraph 7.61. If the affidavit establishes conception, a statement to that effect should be added to this paragraph.

3. If the affidavit additionally fails to establish an alleged reduction to practice prior to the application filing date, this paragraph must be followed by paragraph 7.63. If such an alleged reduction to practice is established, a statement to that effect should be added to this paragraph.

4. An explanation of the reasons for a holding of non-diligence must be provided.

715.07(b) Interference Testimony Sometimes Used

In place of an affidavit or declaration the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of § 1.131 affidavit or declaration.

The part of the testimony to form the basis of priority over the reference should be pointed out. Ex parte Bowyer, 1939 C.D. 5, 42 USPQ 526.

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out *in this country.* See 35 U.S.C. 104.

35 U.S.C. § 104. Invention made abroad. In proceedings in the Patent and Trademark Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in sections 119 and 365 of this title. Where an invention was made by person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority

with respect to such invention as if the same had been made in the United States.

715.07(d) Disposition of Exhibits

Exhibits, such as those filed as part of an affidavit or declaration under 37 CFR 1.131, that are too bulky to be placed in the application file are retained in the examining group until the case is finally disposed of. When the case goes to issue (or abandonment) the exhibits are returned or otherwise disposed of. See § 608.03(a).

715.08 Passed Upon by Primary Examiner

The question of sufficiency of affidavits or declarations under § 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition to the Commissioner. Such petitions are answered by the group directors. (§ 1002.02(c), item 4(e))

Review on the merits of § 1.131 affidavit or declaration is to the Board of Appeals.

715.09 Seasonable Presentation

Affidavits or declarations under § 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted prior to a final rejection are considered timely.

An affidavit or declaration presented with a first response after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection is entered and considered without a showing under § 1.116(b). No other affidavit or declaration under § 1.131 presented after final rejection will be considered unless a satisfactory showing is made under §§ 1.116(b) or 1.195.

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his next succeeding action.

For affidavits or declarations under § 1.131 filed after appeal see § 1.195 and § 1212.

716 Affidavits or Declarations Traversing Rejections, Section 1.132

37 CFR 1.132. Affidavits or declarations traversing grounds of rejection. When any claim of an application or a patent under reexamination is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

NOTE THAT § 1.132 IS NOT APPLICABLE TO A REJECTION BASED ON A U.S. PATENT WHICH CLAIMS THE REJECTED INVENTION.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under § 1.132 for the purpose of traversing grounds of rejection, are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections: Ex parte Grosselin, 1896 C.D. 39, 76 O.G. 1573. The enumeration of rejections in the rule is merely exemplary. All affidavits or declarations presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

Affidavits or declarations under § 1.132 must be timely presented in order to be admitted. Affidavits and declarations submitted prior to a final rejection are considered timely.

An affidavit or declaration presented with a first response after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection is entered and considered without a showing under § 1.116(b). No other affidavit or declaration under § 1.132 presented after final rejection will considered unless a satisfactory showing is made under § 1.116(b) or § 1.195.

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in the next succeeding action.

Form Paragraph 7.65 or 7.66 should be used to comment on a § 1.132 affidavit.

7.65 1.132 Affidavit, Effective To Withdraw Rejection

The [1] under 37 CFR 1.132 filed [2] is sufficient to overcome the rejection of claim [3] based upon [4].

Examiner Note:

1. In bracket 1, insert either affidavit or declaration.
2. Indicate the filing date of the affidavit.
3. Indicate the claim or claims affected.
4. Indicate the rejection that has been overcome; i.e., insufficiency of disclosure, lack of utility, inoperativeness, a specific reference, etc. See MPEP 16.

7.66 1.132 Affidavit, Insufficient

The [1] under 37 CFR 1.132 filed [2] is insufficient to overcome the rejection of claim [3] based upon [4] as set forth in the last Office action because [5].

Examiner Note:

1. In bracket 1, insert either affidavit or declaration.
2. Indicate the filing date of the affidavit.
3. Indicate the claim or claims affected.
4. Identify the rejection that is being maintained.
5. Set forth in detail the reasons for the insufficiency; eg., untimely, fails to allege facts, not germane to the rejection at issue, not commensurate in scope with the claims, etc. See MPEP 716.

The following criteria are applicable to all affidavits or declarations submitted under § 1.132:

(1) Affidavits or declarations must be timely or seasonably filed to be entitled to consideration: In re Rothermel et al., 1960 C.D. 204, 125 USPQ 328. Affidavits or declarations not timely filed must meet the requirements of § 1.195.

(2) Affidavits or declarations must set forth facts, not merely conclusions: In re Pike et al., 1950 C.D. 105, 84 USPQ 235. The facts presented in the affidavits or declarations must be pertinent to the rejection: In re Renstrom, 1949 C.D. 306, 81 USPQ 390. Otherwise, the affidavits or declarations have no probative value.

(3) Affidavits or declarations should be scrutinized closely and the facts presented weighed with care. The affiant's or declarant's interest is a factor which may be considered, but the affidavit or declaration cannot be disregarded solely for that reason. In re McKenna et al., 1953 C.D. 251, 97 USPQ 348, 203 F.2d 717; Bullard & Co. v. Coe, 1945 C.D. 13, 64 USPQ 359, 147 F.2d 568.

Section 1.132 affidavits or declarations may be classified in five groups, and such affidavits or declarations must conform, in addition, to the established criteria and standards for the group into which they fall. These groups and the applicable standards are:

1. COMPARATIVE TESTS OR RESULTS

Affidavits or declarations comparing applicant's results with those of the prior art must relate to the reference relied upon and not other prior art—Blanchard v. Ooms, 1946 C.D. 22, 68 USPQ 314, 153 F.2d 651, and the comparison must be with disclosure identical (not similar) with that of the reference: In re Tatincloux, 1956 C.D. 102, 108 USPQ 125, 43 CCPA 722. Otherwise, the affidavits or declarations have no probative value.

Where the comparison is not identical with the reference disclosure, deviations thereform should be explained—In re Finley, 1949 C.D. 284, 81 USPQ 383, 36 CCPA 999 and if not explained should be noted and evaluated, and if significant, explanation should be required: In re Armstrong, 1960 C.D. 422, 126 USPQ 281, 47 CCPA 1084. Otherwise, the affidavits or declarations may be entitled to little weight.

Where the comparison shows unexpected results or advantages, it should be compared with the application disclosure, since recitals of the specification are controlling: Abbott v. Coe, 1940 C.D. 13, 109 F.2d 449; In re Rossi, 1957 C.D. 130, 112 USPQ 479, 44 CCPA 750. Advantages not disclosed carry little or no weight in establishing patentability.

Affidavits or declarations setting forth advantages and asserting that despite familiarity with the art, the claimed subject matter was not obvious to affiants or declarants, do not afford evidence of non-obviousness, where the advantages relied upon are merely those which would result from following the teaching of the prior art: In re Henrich, 1959 C.D. 353, 122 USPQ 388, 46 CCPA 933.

2. OPERABILITY OF APPLICANT'S DISCLOSURE

Since it is the examiner's duty to pass upon the operativeness of any invention which he or she is called upon the examine he or she is free to express an opinion on that question so long as reasons are given for such a holding with clarity and completeness. Therefore, the examiner need not support every rejection on inoperativeness with references, affidavits or declarations: In re Quattlebaum, 84 USPQ 383.

Affidavits or declarations attempting to show that the structure deemed inoperative was seen in operation by persons who vouch for its operability, are insufficient: In re Perrigo, 1931 C.D. 512, 48 F.2d 965.

Where the invention involved is of such a nature that it cannot be tested by known scientific principles, theoretical arguments in affidavit or declaration form are unacceptable, and the only satifactory manner of overcoming the rejection is to demonstrate the operability by construction and operation of the invention. Buck v. Oooms, 1947 C.D. 33, 72 USPQ 211, 159 F.2d 462; In re Chilowsky, 1956 C.D. 155, 108 USPQ 321, 43 CCPA 775.

3. INOPERABILITY OF REFERENCES

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability—Metropolitan Eng. Co. v. Coe, 1935 C.D. 54, 78 F.2d 199. examiners should not express any opinion on the operability of a patent. Therefore affidavits or declarations attacking the operability of a patent cited as a reference, though entitled to consideration, should be treated, not as conclusive of the factual matter presented, but rather as an expression of opinion by an expert in the art. In re Berry, 137 USPQ 353, 50 CCPA 1196, See also In re Lurelle Guild, 1953 C.D. 310, 98 USPQ 68. Opinion affidavits or declarations need not be given any weight. In re Pierce, 1930 C.D. 34, 35 F.2d 781; In re Reid, 1950 C.D. 194, 84 USPQ 478.

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. Bullard v. Coe, 1945 C.D. 13, 64 USPQ 359; In re Michalek, 1974 C.D. 458, 74 USPQ 107 34 CCPA 1124; In re Reid, 1950 C.D. 194, 84 USPQ 478, 37 CCPA 884.

Where the affidavit or declaration presented asserts inoperability in features of the patent which are not relied upon, the matter is of no concern: In re Wagner, 1939 C.D. 581, 26 CCPA 1193, 103 F.2d 414.

Where the affidavit or declaration asserts inoperability of the process disclosed in the reference for producing the claimed product, which product is fully disclosed in the reference, the matter is of no concern: In re Attwood, 1958 C.D. 204, 117 USPQ 184, 45 CCPA 824.

Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, the claims represented by applicant must distinguish from the alleged inoperative reference disclosure; otherwise the matter is of no concern: In re Crecelius, 1937 C.D. 112, 24 CCPA 718, 86 F.2d 399; In re Perrine, 1940 C.D. 465, 27 CCPA 1127, 111 F.2d 177; In re Crosby, 1947 C.D. 35, 71 USPQ 73, 34 CCPA 701.

Affidavit or declaration by patentee that he or she did not intend his device to be used as claimed by applicant is immaterial: In re Pio, 1955 C.D. 59, 104 USPQ 177, 42 CCPA 746.

4. Commercial Success and Other Considerations Bearing on Obviousness

Affidavits or declarations submitting evidence of commercial success, long-felt but unsolved needs, failure of others, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. The Court of Appeals for the Federal Circuit stated in Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might be utilized to give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 172 USPQ 126, 451 F.2d 1100 (CCPA 1971); *In re Fielder and Underwood*, 176 176 USPO 300, 471 F.2d 640 (CCPA 1973). The *Graham* v. *John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida* v. *Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Andersons-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57,163 673 (1969), where reliance was placed upon *A&P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann* v. *Johnston*, 425 U.S. 219, 189 U.S.P.Q 257, at 261 (1976) footnote 4.

The weight attached to evidence of commercial success, etc. by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States* v. *Adams*, 383 U.S. 39, 148 USPQ 479 (1966).

Evidence of commercial success, etc. must be commensurate in scope with the scope of the claims: *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (1971). Further, in considering evidence of commercial successs, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is *not* the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc,: *In re Mageli et al.*, 176 USPQ 305 (CCPA 1973); *In re Noznick et al.*, 178 USPQ 43 (CCPA 1973).

Similarly in considering evidence of long-felt but unsolved needs and failure of others, care should be taken to determine whether such failures were due to lack of interest or appreciation of an invention's potential or marketability rather than want of technical know-how: *Scully Signal Co.* v. *Electronics Corp. of America*, 196 USPQ 657(1st Cir. 1977).

Affidavits or declarations showing commercial success of a structure not related to the claimed subject matter has neither significance nor pertinence: In re Kulieke, 1960 C.D. 281. 125 USPQ 578.47 CCPA 943.

Affidavits or declarations attributing commercial success to the invention "described and claimed" or other equivalent indefinite language have little or no evidentiary value: *In re Troutman*, 1960 C.D. 308, 126 USPQ 56, 47 CCPA 308.

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, this action should include a simple statement to that effect, identifying the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.).

5. Sufficiency of Disclosure

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite: In re Smyth, 1951 C.D. 449, 90 USPQ 106, 38 CCPA 1130.

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered: In re Oppenauer, 1944 C.D. 587,62 USPQ 297, 31 CCPA 1248.

717 File Wrapper

717.01 Papers in File Wrapper

Papers that do not become a permanent part of the record should not be entered on the "Contents" of the file wrapper. No paper legally entered on the "Contents" should ever be withdrawn or returned to applicant without special authority of the Commissioner. Certain oaths executed abroad may be returned but a copy is retained in the file. See § 604.04(a).

717.01(a) Arrangement of Papers in File Wrapper

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order; that is, the communications with the latest "Mail Room" date is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the print is always kept on top for the conveniece of the examiner.

Where amendments are submitted in duplicate, the carbon copy is destroyed except where the duplicate is received within the time period for response and the original is late. In this latter situation both copies are placed in the file. The "original" (ribbon copy) is entered with reference made to the carbon copy.

At allowance, only those papers required by the printer are placed in the left side (center section) of the file wrapper.

The use of return self-addressed post cards as a receipt is covered in § 503.

717.01(b) Prints

The prints of the drawing are fastened inside the file wrapper by the Customer Services Division.

The white paper prints shall always be kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the date of their receipt in the office and given their appropriate paper number. Note § 608.02(m).

717.02 Data Entered on File Wrapper

See also §§ 707.10, 717.01.

If the examiner notices an error in any of the data originally entered on the file wrapper, he or she should have it corrected by the Application Division.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Division.

All of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the clerk of the group, the original entry being canceled but not erased.

717.02(b) Name or Residence of Inventor or Title Changed

The distinction between "residence" and Post Office address should not be lost sight of.

Section 605.04(c) explains the procedure to be followed concerning sending the application to the Application Division when applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

717.03 Classification During Examination

When a new case is received in an examining group, the classification of the case and the initials or name of the examiner who will examine it or other assigned docket designation are noted in pencil in the upper lefthand corner of the first sheet of the "heavy paper" print and in the designated spaces on the file wrapper. These notations should be kept current.

717.04 Index of Claims

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date 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 preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented. Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under § 1.121(b), the original claim number should not be striken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e. "Amend. 1"; if the claim is rewritten a second time, "Amend. 1" should be changed by striking out "1" and inserting "2" above it.

As any claim is canceled, a line in red ink should be drawn through its number.

A space is provided for completion by the examiner to indicate the date and type of each Office action together with the resulting status of each claim. A list of codes for identifying each type of Office action appears below the Index. At the time of allowance, the examiner places the final patent claim numbers in the column marked "Final".

717.05 Field of Search

In each action involving a search, the examiner shall endorse, on the flap of the file wrapper, the classes and subclasses and publications searched, the date when the search was made or was brought up to date and the examiner's initials, all entries being in BLACK INK. Great care should be taken inasmuch as this record is important to the history of the application.

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation. These procedures will also facilitate the printing of certain search data on patents.

Under the procedures, searches are separated into two categories and listed, as appropriate, in either the "SEARCHED" box or "SEARCHED NOTES" box on the file wrapper.

All file wrappers have the "SEARCH NOTES" box printed therein. If additional space is required, entries will be continued on the outside right flap of the file wrapper.

A. *"SEARCHED" Box Entries*

Search entries made here, except those for search updates (see item A.3 below), will be printed under "Field of Search" on the patent front page. Therefore, the following searches will be recorded in the "SEARCHED" box by the examiner along with the

date and the examiner's initials, according to the following guidelines:

1. *A complete search of a subclass,* including all United States and foreign patent documents and other publications placed therein.

   The complete classification (class and subclass) should be recorded.

Examples:	*(date)*	*(initials)*
424/270, 272, 273	2/10/76	CAP
224/42.1 F	2/10/76	CAP
214/DIG. 4	2/10/76	CAP
D3/32 R	2/10/76	CAP

2. *A limited search of a subclass.* for example, a search that is restrictred to an identifiable portion of the patent documents placed therein. If, however, only the publications in a subclass are searched, such an entry is to be made under "SEARCH NOTES" rather than under "SEARCHED." (See item B. 4 below.)

   The class and subclass, followed by the information defining the portion of the subclass searched-in parenthesis, should be recorded.

Examples:		
214/1 (U.S. only)	2/10/76	CAP
238/6 (1954 to date)	2/10/76	CAP

3. *An update of a search previously made.* This search entry will be recorded in a manner to indicate clearly which of the previously recorded searches have been updated, followed by the expression "(updated)." Search update entries, although recorded in the "SEARCHED" box, will not be printed.

Examples:		
424/270 (updated)	4/1/76	CAP
214/DIG, 4 (updated)	7/19/76	CAP
Above (updated)	7/27/76	CAP

When a search made in a parent application is updated during the examination of a continuing application, those searches updated, followed by "(updated from parent S.N. .....)" will be recorded. If the parent has been patented, the patent number "Pat. N. ....." Instead of serial number in the above phrase will be recorded

Example:			
273/29 BC	(updated from		
343/114.5	parent S.N. 495,123)...	4/27/78	CAP
116/DIG.47	(updated from		
D7/73, 74	parent Pat. N. 4,998,999).	2/10/76	CAP

4. *A mechanized search* of a file of documents in a specific art, conducted by using key terms to retrieve documents.

   Record the name of the mechanized search system as it appears in the following list and add the expression "MS File" to indicate mechanized search file.

Termatrex Systems:

Automatic Fuel Controls
Boots & Shoes
Chemical Testing
Combined Fasteners
Electrical Contact Materials
Surface Bonding Using Critical Metal

Edge-Notched Card System.

Fluid Devices

Punch Card Systems:

Electrolysis
Organometallics
Steroids

Computer Controlled Microfiche Search Systems (CCMSS):

A-D Convertors
Digital Data Processing Systems
Special Purpose Digital Processing Systems
364/200 MS file
364/900 MS file
526 MS file

Examples:		
Steroid MS File	2/12/76	CAP
A-D Convertors MS File	7/19/76	CAP

When conducting a search with a Termatrex or Edge-Notched Card System, the examiner should complete form PTO-1041 in two copies, recording all queries searched, even those which yield only non-relevant documents..

All documents returned by the system in response to a query which are not actually reviewed should have an "X" drawn through their associated access and patent numbers.

The examiner should place one copy of the form PTO-1041 in the application file on the right flap of the file wrapper.

The other copy of the form PTO-1041 should be forwarded to the Office of Search Systems (CP2-6D07) at or prior to the time of the mailing of the Office action.

When conducting a search with a Punched Card system the examiner should place in the application file the Code Sheet on which the terms searched have been marked along with the tape listing the documents retrieved. Any document not actually reviewed should have an "X" drawn through that document's number on the tape listing.

When conducting a search with the CCMSS search systems, a copy of the machine-printed search report which lists the extent of file and terms employed in conducting the search should be placed in the application file on the right hand flap of the file wrapper.

The list of tagged documents included thereon may have document numbers crossed out with an "X" when the document was tagged for recall for purposes other than the search being conducted.

B. *"SEARCH NOTES" Box Entries*

Entries made in the "SEARCH NOTES" box are of equal importance to those placed in the "SEARCHED" box; however, these entries are not

to be printed on any resulting patent. They are intended to complete the application file record of areas and/or documents considered by the examiner in his or her search. The examiner should record the following searches in this box and in the manner indicated, with each search dated and initialled:

1. A *cursory search*, or scanning, of a subclass, i.e., a search usually made to determine if the documents classified there are relevant. Record the classification, followed by "(cursory)".

Examples:

250/13 (cursory).....	2/10/76	CAP

2. A *consultation* with other examiners to determine if relevant search fields exist in their areas of expertise.

If the subclass is not searched, record the class and subclass discussed, followed by "(consulted)". This entry may also include the name of the examiner consulted and the art unit.

Examples:

24/separable fasteners (consulted).	2/11/76	CAP
24/separable fasteners (consulted J. Doe A.U. 351).	2/11/76	CAP
24/201 R-230 AV (consulted).....	7/9/76	CAP

3. A *search of a publication* not located within the classified patent file, e.g., a library search, a text book search, a Chemical Abstracts search, etc. Record according to the following for each type of literature search:

a. *Abstracting publications*, such as Chemical Abstracts—record name of publications, list terms consulted in index, and indicate period covered.

Examples:

Chem. Abs, Palladium hydride Jan-June 1975.	4/1/76	CAP
Eng. Index, Data Conversion Analog to Digital 1975.	4/1/76	CAP

b. *Periodicals*—list by title and period or volumes covered, as a appropriate.

Example:

Popular Mechanics, June-Dec. 1974.	4/1/76	CAP
Lubrication Engineering, vols. 20-24.	7/19/76	CAP

c. *Books*—list by title and author, edition or date, as appropriate.

Example:

Introduction to Hydraulic Fluids, Roger E. Hatton, 1962.	4/1/76	CAP

d. *Other types of literature* not specifically mentioned herein (i.e., catalogs, manufacturer's literature, private collections, etc.)

Record data as necessary to provide unique identification of material searched.

Example:

Sears Roebuck catalog, Spring-Summer, 1973.	5/7/76	CAP

Where a book or specific issue of a periodical is cited by the examiner, it is not necessary to list the specific book or periodical in the "SEARCH NOTES" box.

A cursory or browsing search through a number of materials that are found to be of real relevance may be indicated in a collective manner, e.g. "Browsed Sci. Libr. shelves under QA 76.5" or "Browsed text books in Sci. Libr. relating to ....." More detailed reviews or searches through books and periodicals or any search of terms in sbstracting publications should be specifically recorded, however.

e. *Computer Search in Scientific Library*—An online computerized literature searching service which uses key terms and index terms to locate relevant publications in many large bibliographic data bases is available in the Scientific Library. A member of the library staff is assigned to assist examiners in selecting key terms and to program the search.

There are two on-line search systems: the Lockheed Information System and the SDC Search Service. These search systems include many data bases such as the Derwent, the NTIS, etc.

Record the name of the data base searched.

Examples:

CHEMCON data base.....	5/7/76	CAP
METADEX data base.....	7/19/76	CAP

The search printout should be placed in the application file, attached to the right flap of the file wrapper.

The examiner should indicate which publications were reviewed by initialling and dating the copy of the printout in the left margin adjacent to each reviewed publication.

f. If only an abstract of a document was reviewed, the not "ck'ed abst." should be made next to the initials and date.

If the complete document was reviewed, the note "ck'ed doc." should be placed with the initials and date.

4. A search of only the *publications in a subclass.*

Record class and subclass followed by "(publications only)".

Examples:

43/56 (publications only.....	5/7/76	CAP
99/DIG. 15 (publications only)....	7/19/76	CAP

5. *A review of art cited in a parent application* or an original patent, as required for all continuing and reissue applications and reexamination proceedings, or a review of art cited in related applications or patents mentioned within the specification, such as those included to provide background of the invention.

Record the serial number of a parent application that is still pending or abandoned, followed by "refs. checked" or "refs. ck'ed". If for any reason not all of the references have been

checked because they are not available or clearly not revelant, such exceptions should be noted.

S. N. 495,123 refs. checked.....	2/10/76	CAP
S. N. 490,000 refs. checked.....	7/19/76	CAP
S. N. 480,111 refs. checked except for Greek patent to Kam.	8/3/76	CAP
S. N. 410,113 refs. not checked since the file was not available.	10/5/76	CAP

Record the patent number of a parent or related application that is now patented or of an original patent now being reissued with "refs. checked" or "refs. ck'ed".

Examples:

Pat. 3,900,000 refs. checked.....	7/19/76	CAP
Pat. 3,911,111 refs. ck'ed.....	7/19/76	CAP

C. *Not recorded*

The following indications should not be recorded in either of the search boxes, but should be noted in the application file as indicated below.

1. *Citations of information by applicants conforming to 37 CFR 1.98 and the practice thereunder.*

In each instance where all information referred to in a paper placed in the application file is considered, the examiner should place the notation "all ck'ed", the date, and his or her initials adjacent to the citation in ink. The citations must also be listed on form PTO-892 or initialed on form PTO-1449 submitted by applicant. See §§ 609 and 707.05(b).

2. *Citations of information by applicants not conforming to 37 CFR 1.98 and the practice thereunder.*

In each instance where an examiner considers, but does not cite on form PTO-802, specific information referred to in a paper placed in the application file, the examiner should place a notation in ink adjacent to each reference considered.

If all the references referred to in such a paper are reviewed, the examiner will place the notation "all ck'ed", the date, and his or her initials adjacent the citation in ink.

If included in the specification, the examiner should write the date and his or her initials in ink adjacent to any reference(s) checked and enter "checked" or ck'ed" in the left margin opposite the citation.

If presented in a separte paper or in the remarks of an amendment, the examiner's initials and "checked" or "ck'ed" should be entered adjacent to the citation(s) of wherever possible to indicate clearly those checked.

SEARCH NOTES

	Date	Ex'r
S.N. 495,123 refs. ck'd.	2/10/78	CAP
250/13 (cursory)	2/10/78	CAP
24/separable fasteners (consulted Zdlak, AU 351)	2/11/78	CAP
Chem. Abs., Palladium hydride, Jan.-June 1975	4/1/78	CAP
Popular Mechanics, June-Dec. 1974	4/1/78	CAP
Introduction to Hydraulic Fluids, Roger E. Hatton, 1962	4/1/78	CAP
43/56 (publications only)	5/7/78	CAP
CHEMCON data base	5/7/78	CAP

SEARCHED

Class	Sub	Date	Ex'r
D7	73, 74 (updated from current Pat. No. 3,999,999)	2/10/78	CAP
424	270	2/10/78	CAP
D3	32R		
214	1 (U.S. only)		
Steroids MS File		2/12/78	CAP
424	270 (updated)	4/1/78	CAP
100	99		

INTERFERENCE SEARCHED

Class	Sub	Date	Ex'r

PRINT CLAIM(S):

INDEX OF CLAIMS

Claim Final	Claim Original	Date	Claim Final	Claim Original	Date
	1			26	
	2			27	
	3			28	
	4			29	
	5			30	
	6			31	
	7			32	
	8			33	
	9			34	
	10			35	
	11			36	
	12			37	
	13			38	
	14			39	
	15			40	
	16			41	
	17			42	
	18			43	
	19			44	
	20			45	
	21			46	
	22			47	
	23			48	
	24			49	
	25			50	

SYMBOLS	STATUS
V	Rejected
=	Allowed
– (Through numeral)	Canceled
+	Restriction requirement
N	Nonelected invention or species
I	Interference
A	Appeal
O	Objected

717.06 Foreign Filing Dates

See §§ 201.14(c), 202.03 and 201.14(d).

717.07 Related Applications

The file wrapper should identify earlier filed related applications. See §§ 202.02 and 202.03.

720 Public Use Proceedings

37 CFR 1.292. Public use proceedings. (a) When a petition for the institution of public use proceedings, supported by affidavits or declarations and the fee set forth in § 1.17(j), is filed by one having information of the pendency of an application and is found, on reference to the primary examiner, to make a prima facie showing that the invention involved in an interference or claimed in an application believed to be on file had been in public use or on sale one year before the filing of the application, or before the date alleged by an interfering party in his or her preliminary statement or the date of invention established by such party, a hearing may be had before the Commissioner to determine whether a public user proceeding should be instituted. If instituted, times may be set for taking testimony, which shall be taken as provided by §§ 1.271 to 1.286. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers should either (1) reflect that a copy of the same has been served upon the applicant, or upon his attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible. The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file.

Public use proceedings are provided for in § 1.292. The institution of public use proceedings is discretionary with the Commissioner. This section is intended to provide guidance when a question concerning public use proceedings arises.

A petition and fee (37 CFR 1.17(j)) is required to initiate consideration of whether to institute a public use proceeding. The petitioner ordinarily has information concerning a pending application which claims, in whole or in part, subject matter that the petitioner alleges was in "public use" or "on sale" in this country more than one year prior to the effective United States filing date of the pending application (see 35 U.S.C., Section 119, 1st paragraph, and Section 120). He or she thus assets that a statutory bar (35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103) exists which prohibits the patenting of the subject matter of the application.

When public use petitions and accompanying papers are submitted they, or a notice in lieu thereof, will be entered in the application file. Duplicate copies should be submitted only when, after diligent effort, it has not been possible for petitioner to serve a copy of the petition on the applicant, his or her attorney or agent in which case the Office of the Solictor will attempt to get the duplicate copy to the applicant, his or her attorney or agent.

Notice of a petition for a public use proceeding will be entered in the file in lieu of the petition itself when the petition and the accompanying papers are to bulky to accompany the file. Any public use papers not physically entered in the file will be publicly available whenever the application file wrapper is available.

There are two types of public use proceedings: *ex parte* and *inter partes*. It is important to understand the difference. In the *ex parte* situation, the petitioner is not entitled, as a matter of right, to inspect the pending application. Thus, he or she stands in no better position than any other member of the public regarding access to the pending application. In the *inter partes* situation, either the petitioner is involved in an interference with the pending application, and now wishes to asset that the claims of the pending application (often the counts of the interference) are barred by public use or sale or the pending application is a reissue application. In the *inter partes* situation, the petitioner is privy to the contents of the pending application (§ 1.226 or § 1.11(b)). Thus, as pointed out below, the petitioner in the *inter partes* situation participates in the public use proceedings to a greater degree than in the *ex parte* situation. A petitioner who was once involved in a terminated interference with a pending application is no longer privy to the application contents and will accordingly be treated as an *ex parte* petitioner.

There may be cases where a public use petition has been filed in an application which has been restricted or is subject to a proper restriction requirement. If the petition alleges that subject matter covering both elected claims and non-elected claims is a statutory bar, only that part of the petition drawn to subject matter of the elected claims will be considered. However, if a public use proceeding is ultimately instituted, it will not necessarily be limited to the subject matter of the elected claims but may include the non-elected subject matter. Any evidence adduced on the non-elected subject matter may be used in any subsequent-filed application claiming subject matter without the requirement of a new fee (37 CFR 1.17(j)). The petitioner will not be heard regarding the appropriateness of any restriction requirement.

720.01 Preliminary Handling

A petition filed under § 1.292 should be forwarded to the Solicitor's Office, and served in accordance with § 1.292(b). In addition, all other papers filed relating to the petition or subsequent public use proceeding must be served in accordance with §§ 1.247 and 1.248. A member of the Solicitor's staff will ascertain whether the formal requirements of § 1.292 have been fulfilled. In particular, the petition will be reviewed to see if the alleged use or sale occurred more than one year before the effective filing date of the application, whether the petition contains affidavits and exhibits to establish the facts alleged, whether there is an offer to produce witnesses having knowledge of the public use or sale, and whether the papers have been filed in duplicate, or one copy has been served on applicant and whether the required fee has been tendered. The application file is ordered and its status ascertained so that appropriate action may be taken. Where the application is involved in an interference, the interference proceedings will not normally be suspended if the proceeding has entered the testimony period. Whether the interference proceeding is suspended for institution of the public use proceeding

is normally determined by the patent interference examiner.

In those *ex parte* situations where a petitioner cannot identify the pending application by serial number, the petition papers will be forwarded to the appropriate group director for an identification search. Once the application file(s) is located, it should be forwarded to the Solicitor's Office.

720.02 Examiner Determination of Prima Facie Showing

Once the Solicitor's staff member has determined that the petition meets the formal requirements of § 1.292, and the application's status warrants consideration of the petition, he will prepare a letter for the Assistant Commissioner for Patents, forwarding the petition and the application file to the examiner for determination of whether a *prima facie* case of public use or sale of claimed subject matter is established by the petition, regardless of whether a related interference is suspended. Any other papers that have been filed by the parties involved, such as a reply by the applicant or additional submissions by the petitioner, will also be forwarded to the examiner. Whether additional papers are accepted is within the discretion of the Solicitor's staff member. However, protracted paper filing is discouraged since the parties should endeavor to present their best case as to the *prima facie* showing at the earliest possible time. No oral hearings or interviews will be granted at this stage, and the examiner is cautioned not to answer any inquiries by the petitioner or applicant.

A *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103.

To make this determination, the examiner must identify exactly *what* was in public use or on sale, whether it was in use or on sale more than one year before the effective filing date, and whether the pending claims "read" on or are obvious over what has been shown to be in public use or on sale. On this last point, the examiner should compare all pending claims with the matter alleged to have been in use or on sale, not just the claims identified by petitioner.

In situations where the petition alleges only that the claims are obvious over subject matter asserted to be in public use or on sale, the petition should include prior art or other information on which it relies and explain how the prior art or other information in combination with the subject matter asserted to be in public use or on sale renders the claims obvious. The examiner is not expected to make a search of the prior art in evaluating the petition. If, however, the examiner determines that a *prima facie* case of anticipation under 35 U.S.C. 102(b) has not been established but, at the time of evaluating the petition, the examiner is aware of prior art or other information which, in his or her opinion, renders the claims obvious over the subject matter asserted to be in public use or on sale the examiner may determine that a *prima facie* case is made out, even if the petition alleged only that the claims were anticipated under 35 U.S.C. 102(b).

After having made his determination, the examiner will forward a memorandum to the Assistant Commissioner for patents, stating his or her findings and his or her decision as to whether a *prima facie* case has been established. The findings should include a summary of the alleged facts, a comparison of at least one claim with the device alleged to be in public use or sale, and any other pertinent facts which will aid the Assistant Commissioner in conducting the preliminary hearing. The report should be prepared in triplicate and addressed to the Assistant Commissioner for Patents.

720.03 Preliminary Hearing

Where the examiner concludes that a *prima facie* showing has not been established, both the petitioner and the applicant are so notified and the application proceedings are resumed without giving the parties an opportunity to be heard on the correctness of the examiner's decision. Where the examiner concludes that a *prima facie* case has been established, the Commissioner may hold a preliminary hearing. In such case, the parties will be notified by letter of the examiner's conclusion and of the time and date of the hearing. In *ex parte* cases, whether or not the examiner has concluded that a *prima facie* showing has been established, no copy of the examiner's memorandum to the Assistant Commissioner for Patents will be forwarded to the petitioner. However, in such cases where the petition covers restrictable subject matter and it is evident that petitioner is not aware of a restriction requirement which has been or may be made, petitioner will be informed that the examiner's conclusion is limited to elected subject matter. In an *inter partes* case the hearing will not normally be set until after suspension of the interference. The patent interference examiner will notify the Office of the Solicitor when the interference is suspended. While not so specifically captioned, the notification of this hearing amounts to an order to show cause why a public use proceeding should not be held. No new evidence is to be introduced or discussed at this hearing. The format of the hearing is established by the member of the Solicitor's staff, and the Assistant Commissioner for Patents presides. The examiner may attend as an observer only.

Where the hearing is held in the *ex parte* situation, great care will be taken to avoid discussion of any matters of the application file which are not already of knowledge to petitioner. Of course, applicant may of his or her own action or consent notify the petitioner of the nature of his or her claims or other related matters.

After the hearing is concluded, the Assistant Commissioner for Patents will decide whether public use proceedings are to be initiated, and he will send appropriate notice to the parties.

720.04 Public Use Proceeding Testimony

When the Assistant Commissioner for Patents decides to institute public use proceedings, the case is referred to the examiner who will conduct all futher proceedings. The fact that the affidavits and exhibits presented with the petition for institution of the public use proceedings have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established. The statutory bar can only be established by testimony taken in accordance with normal rules of evidence, including the right of cross-examination. The affidavits are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them.

The procedure for taking testimony in a public use proceeding is substantially the same as that for taking testimony in an interference. Normally, no representative of the Commissioner need be present at the taking of the testimony.

The examiner will set a schedule of times for taking testimony and for filing the record and briefs on the basis of the following:

Petitioner's testimony to close—60 days;

Rebuttal testimony by applicant to close—30 days later;

An original and one copy of the Record to be filed—30 days later;

Petitioner's brief to be filed—30 days later; and

Applicant's brief to be filed—20 days later. Upon proper showing, the examiner may grant appropriate extensions of time.

It is understood from the above scheduling of times that a given time period begins with the close of the previous period, and that the completion of testimony or the filing of the Record or a brief before the close of the corresponding period does not change its closing date. To avoid confusion, the examiner should indicate specific dates for the close of each period.

After all testimony has been filed, and briefs have been filed, or the time for filing applicant's brief has expired and he or she has not filed a brief, a time will be set for an oral hearing to be conducted by the examiner in *inter partes* cases. In *ex parte* cases, an oral hearing is ordinarily not held. In *inter partes* cases the hearing will be conducted substantially in accordance with § 1.256 except that oral argument will ordinarily be limited to one-half hour per side. Arguments are to be restricted to the evidence adduced and the related law. No new evidence will be accepted.

In all public use proceedings, whether the ultimate issue is anticipation under 35 U.S.C. 102(b) or obviousness over 35 U.S.C. 103, testimony will be limited to the issues of public use or on sale. No testimony will be received on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale.

720.05 Final Decision

The final decision of the examiner should be "analogous to that rendered by the * * * [Board of Patent Interferences] in an interference proceeding, analyzing the testimony and stating * * * conclusions * * *", *In re Townsend,* 1913 C.D. 55. In reaching his or her decision, the examiner is not bound by the prior finding that a *prima facie* case has been established.

If the examiner concludes that a public use or sale bar exists, he or she will enter a rejection to that effect in the application file, predicating that rejection on the evidence considered and the findings and decision reached in the public use proceeding. Where the application is involved in a suspended interference and the examiner's conclusion applies to one or more of the claims corresponding to the counts of the interference, the examiner must dissolve the interference under § 1.237 as to those counts on the basis of the public use or sale. The twenty-day period for arguments, referred to in § 1.237, is not applicable where the dissolution is based on the finding of public use, inasmuch as full consideration has already been given to the issue. Where the examiner concludes that there is no public use, or where the public use proceeding has been conducted concurrently with the interference proceeding, the examiner will address a memorandum to the patent interference examiner, notifying him or her of the examiner's decision in the public use proceeding. The interference will continue or be terminated in accordance with the action taken by the examiner. The examiner will enter the appropriate rejection after the application is returned to an *ex parte* status.

There is no review from the final decision of the examiner in the public use proceedings. A petition under § 1.181, requesting that the Commissioner exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex Parte Hartley,* 1908 C.D. 224. Once the application returns to its *ex parte* status, appellate review under 35 U.S.C. 134 and 141–145 may be had of any adverse decision rejecting claim(s), as a result of the examiner's decisions as to public use or sale.

724 Trade Secret, Confidential, and Protective Order Materials

Situations arise in which it becomes necessary, or desirable, for parties to proceedings in the Patent and Tradmark Office relating to pending patent applications to submit to the Office trade secret, confidential, and/or protective order materials. Such materials may include those which are subject to a protective or secrecy order issued by a court or by the International Trade Commissioner (ITC). While one submitting materials to the Office in relation to a pending patent application must generally assume that such materials will be made of record in the application and be made public, the Office is not unmindful of the difficulties this sometimes imposes. The Office is also cognizant of the sentiment expressed by the court in *In re Sarkar,* 197 USPQ 788 at 791 (CCPA 1978), which stated

"that wherever possible, trade secret law and patent laws should be administered in such manner that the

former will not deter an inventor from seeking the benefit of the latter, because, the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution."

Patent applications and protestors bringing information to the attention of the Office for use in the examination of applications, are frequently faced with the prospect of having legitimate trade secret, confidential, or protective order material disclosed to the public.

Inventors and others covered by 37 CFR 1.56(a) have a "duty to disclose to the Office information they are aware of which is material to the examination of the application." Section 1.56(a) states that

"[s]uch information is material where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent."

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as confidential material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to the examination" as defined in § 1.56(a).

Somewhat the same problem faces a protestor under 37 CFR 1.291(a) who believes that trade secret, confidential, or protective order material should be considered by the Office during the examination of an application.

In some circumstances, it may be possible to submit the information in such a manner that legitimate trade secrets, etc., will not be disclosed, e.g., by appropriate deletions of non-material portions of the information. This should be done only where there will be no loss of information material to the examination under 37 CFR 1.56(a).

724.01 Completeness of the Patent File Wrapper

It is the intent of the Office that the patent file wrapper be as complete as possible insofar as "material" information is concerned. The Office attempts to minimize the potential conflict between full disclosure of "material" information as required by § 1.56(a) and protection of trade secret, confidential, and protective order material to the extent possible.

The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, confidential material, and protective order material.

724.02 Method of Submitting Trade Secret, Confidential, and/or Protective Order Materials

Information which is considered by the party submitting the same to be either trade secret material or confidential material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Confidential" document or item, or as an item or document "Subject To Protective Order." If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the application to which it is directed, including the Office or area to which the envelope or container is directed.

Examples of appropriate labels for such an envelope or container are as follows:

A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADEMARK OFFICE EMPLOYEE.
In re Application of.....
Serial No.....
Filed:.....
For: (Title of Invention).....
Group Art Unit:.....
Examiner:.....

ATTENTION: (Current Location of Application)"

B. "CONFIDENTIAL MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADEMARK OFFICE EMPLOYEE.
In re Application of.....
Serial No.....
Filed:.....
For: (Title of Invention).....
Examiner:.....

ATTENTION: (Current Location of Application)"

C. "MATERIAL SUBJECT TO PROTECTIVE ORDER—NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED PATENT AND TRADEMARK OFFICE EMPLOYEE.

Tribunal Issuing Protective Order:.....
Civil Action or Other Identification No.:.....
Date of Order:.....
Current Status of Proceeding: (Pending, Stayed, etc.).....
In re application of:.....

Serial No.....
Filed:.....
For: (Title of Invention).....
Group Art Unit:.....
Examiner:.....

ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or confidential, or are subject to a protective order, and are being submitted for consideration under § 724. A petition under 37 CFR 1.182 and fee therefor (37 CFR 1.17(h)) to expunge the information, if found *not* to be "material to the examination of the application" as defined in 37 CFR 1.56(a), may also accompany the envelope, or container.

In order to ensure that such an envelope or container is not mishandled, either prior to reaching the Office, or in the Office, the envelope or container should preferably be hand-carried to the particular area to which it is directed and in which the application is pending at that time. If the application is then pending in an examining group the envelope or container should be hand-carried to the Office of the director of the examining group. The Office personnel receiving the envelope or container should be informed that it contains such material. If the envelope or container cannot be hand-carried to the Office it can be mailed to the Patent and Trademark Office in the normal manner, but that method of submission is not as desirable as hand-carrying the envelope or container to the Office or area involved.

724.03 Types of Trade Secret, Confidential, and/or Protective Order Materials Submitted under § 724.02

The types of materials or information contemplated for submission under § 724.02 include information "material to the examination of the application." but does not include information favorable to patentability. Thus, any trade secret, confidential, and/ or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56(a) can be submitted in accordance with § 724.02. Section 1.56(a) does not require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with § 724.02. If any trade secret, confidential and/or protective order materials are submitted in amendments, arguments in favor of patentability, affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the application and will not be given any special status.

Insofar as protestors under 37 CFR 1.291(a) and petitioners to strike applications under 37 CFR 1.56 are concerned, submissions can be made in accordance with § 724.02 if protestor or petitioner has access to the application involved. In such cases, of course, the requirements for service must be followed. The Office cannot ensure that the party or parties served will maintain the information secret. If the party or parties served find it necessary or desirable to comment on material submitted under § 724 before it is, or without its being, found "material to the examination," such comments should either (1) not disclose the details of the material or (2) be submitted in a separate paper under § 724.02.

724.04 Office Treatment and Handling of Materials Submitted under § 724.02

The exact methods of treating and handling materials submitted under § 724.02 will differ slightly depending upon whether the materials are submitted in an original application subject to the requirements of 35 U.S.C. 122 or whether the submission is made in a reissue application open to the public under 37 CFR 1.11(b). In either event, Office personnel must not disclose such materials to the public without authorization. Upon receipt of the submission the transmittal letter and the envelope or container will be date stamped and brought to the attention of the examiner or other Office employee responsible for evaluating the submission. The receipt of the transmittal letter and envelope or container will be noted on the "Contents" of the application file. In addition, the face of the application file will have the notation placed thereon to indicate that trade secret, confidential, or protective order material has been filed. The location of the material will also be specified. The words "TRADE SECRET MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" on the face of the file are sufficient to indicate the presence of trade secret material. Similar notations will be made for either confidential or protective order materials.

724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122

Any materials submitted under § 724.02 in an application covered by 35 U.S.C. 122 will be treated in the following manner:

1. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is "material to the examination of the application" as defined in 37 CFR 1.56(a).

2. If any portion or all of the submitted information is found "material to the examination" under 37 CFR 1.56(a) it will be cited in the next Office action, or other appropriate Office communication and will become a part of the file history, which upon issuance of the application as a patent would become available to the public.

3. If any portion or all of the submitted information is found *not* to be "material to the examination" under 37 CFR 1.56(a), the next Office action or other appropriate Office communication will so indicate without including the details of the submitted information.

4. If any portion or all of the submitted information is found *not* to be "material to the examination" under 37 CFR 1.56(a), that information will be resealed in its envelope or container and retained pending the possible filing of a petition to expunge the information.

5. Any petition to expunge the submitted information or any portion thereof will be treated in accordance with § 724.05.

724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)

Any materials submitted under § 724.02 in a reissue application open to the public under 37 CFR 1.11(b) will be treated in the following manner:

1. The submitted information will be maintained separate from the reissue application file and will not be publicly available until a determination has been made as to whether or not the information is "material to the examination of the application" as defined in 37 CFR 1.56(a).

2. The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is "material to the examination of application" as defined in 37 CFR 1.56(a).

3. If any portion or all of the submitted information is found "material to the examination" under 37 CFR 1.56(a) it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reissue application file and open to the public.

4. If any portion or all of the submitted information is found *not* to be "material to the examination" under 37 CFR 1.56(a), the next Office action or other appropriate, Office communication will so indicate without including in the communication the details of the submitted information.

5. If any portion or all of the submitted information is found *not* to be "material to the examination under 37 CFR 1.56(a), that information will be resealed in its envelope or container and retained separate from the application file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

6. Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked "Not Open To The Public" and Office personnel will not make such envelope or container available to any member of the public inspecting the reissue application file.

7. Any petition to expunge a portion or all of the submitted information will be treated in accordance with § 724.05.

724.05 Petition to Expunge Materials Submitted Under § 724.02

A petition to expunge information submitted under § 724.02 will be entertained only if the petition fee (37 CFR 1.17(h)) is filed and the information has been found *not* to be "material to the examination of the application" as defined in 37 CFR 1.56(a). If the information is found to be "material to the examination" any petition to expunge the information will be denied. Any such petition to expunge information submitted under § 724.02 and found *not* "material" should be directed to the Office of the Assistant Commissioner for Patents, Building 3–11A13. Such petition must contain:

1. A clear identification of the information to be expunged without disclosure of the details thereof.

2. A clear statement that the information to be expunged is trade secret material, confidential material, and/or subject to a protective order, and that the information has not been otherwise made public.

3. A clear identification of the application paper(s) which held that such information was *not* "material."

4. A commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted.

5. A statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information.

6. The fee (37 CFR 1.17(h)) for a petition under § 1.182.

Any such petition to expunge may accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the date on which the patent issues. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application is pending in the examining group and before it is transmitted to the Publishing Division. If, for any reason, a decision to expunge cannot be, or is not made prior to the date on which the patent issues any material then in the patent file will remain therein and be open to the public. Accordingly, it is important that both the submission of any material under § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process.