

MANUAL OF
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EXAMINING
PROCEDURE

ORIGINAL EDITION



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

Instructions Regarding Revision No. 5

This revision consists of replacement pages for the title page in the front of the Manual and entire Chapter 1800.

Additions to the text of Sections 1801 - 1897 are indicated by arrows (> <) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. Sections 1898.01 - 1898.08(a) are new sections and do not indicate additions or deletions.

Louis O. Maassel, Editor
Manual of Patent Examining Procedure



Revision 4, October 1986

U. S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Washington, D.C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
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MANUAL OF PATENT EXAMINING PROCEDURE
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Patent and Trademark Office
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MANUAL OF PATENT EXAMINING PROCEDURE
Fifth Edition

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This revision consists of replacement pages for the title page and page (v) in the front of the Manual and entire Chapters 1100 and 1800. A new Chapter 2300 is being added which is directed to the revised interference proceedings under Public Law 98-622. Chapter 2300 should be inserted following page 2200-64.

Additions to the text are indicated by arrows ( ) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by three asterisks (***) where more than one word was deleted.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

Revision 2, December 1985

U. S. DEPARTMENT OF COMMERCE
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MANUAL OF PATENT EXAMINING PROCEDURE
Fifth Edition

Instructions Regarding Revision No. 1

This revision consists of replacement pages for the title page and page (v) in the front of the Manual and of additional pages L-1 through L-42, R-1 through R-122 and T-1 through T-58 which should be inserted in the back of the Manual following page A-9 and before the Index (page I-1).

This revision adds the full text of the patent law, title 35, United States Code, the rules relating to patents in title 37, Code of Federal Regulations, and the Patent Cooperation Treaty.

Future revisions will revise the various Chapters of the Manual.

Louis O. Maassel, Editor
Manual of Patent Examining
Procedure

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MANUAL OF PATENT EXAMINING PROCEDURE

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

Employees of the Patent and Trademark Office should direct their requests for the Manual, revisions and binders to the Patent Academy.

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Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations.

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

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

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

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

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

Contents

		Page
Introduction		1
Chapter 100	Secrecy and Access	100-1
200	Types, Cross-Noting, and Status of Application	200-1
300	Ownership and Assignment	300-1
400	Representative of Inventor or Owner	400-1
500	Receipt and Handling of Mail and Papers	500-1
600	Parts, Form and Content of Application	600-1
700	Examination of Applications	700-1
800	Restriction; Double Patenting	800-1
900	Prior Art, Classification, Search	600-1
1000	Matters Decided by Various Patent and Trademark Office Officials	1000-1
1100	Interference	1100-1
1200	Appeal	1200-1
1300	Allowance and Issue	1300-1
1400	Correction of Patents	1400-1
1500	Design Patents	1500-1
1600	Plant Patents	1600-1
1700	Miscellaneous	1700-1
1800	Patent Cooperation Treaty	1800-1
1900	Protest	1900-1
2000	Duty of Disclosure; Rejecting and Striking of Applications	2000-1
2100	Patentability	2100-1
2200	Citation of Prior Art and Reexamination	2200-1
2300	Interference Proceedings under Public Law 98-622	2300-1
Appendix I	Partial List of Trademarks	A-1
Appendix II	List of Decisions Cited	A-5
Appendix L	Patent Laws	L-1
Appendix R	Patent Rules	R-1
Appendix T	Patent Treaties	T-1
Index		I-1

Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent and Trademark Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent and Trademark Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1374, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into substantially its present form. The patent law is Title 35 of the United States Code which governs all cases in the Patent and Trademark Office. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31.

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

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents and Trademarks, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

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

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

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

These rules and amendments thereto are published in the Federal Register and in the *Official Gazette*. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, called sections, are numbered with the Part number and a decimal point prefixed to the rule number. A booklet entitled "37 Code of Federal Regulations,"

published by the Office of the Federal Register, contains all of the patent rules as well as trademark rules and copyright rules. Persons desiring a copy of the patent rules should order a copy of "Title 37, Code of Federal Regulations" from the Superintendent of Documents.

The primary function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. The Rules of Practice govern the examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

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

Decisions

In addition to the statutory regulations, the actions taken by the examiner in the examination of applications for patents are to great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

Publications Available from Superintendent of Documents

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

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

Annual Indexes. An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts

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are sold separately. Price varies from year to year, depending upon size of the publication. An annual Index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

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

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

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

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

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

Patent Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office. An alphabetically and a geographical-

ly arranged listing of patent attorneys and agents registered to practice before the U.S. Patent and Trademark Office.

Title 37—Code of Federal Regulations. Compilation of the rules of practice of the U.S. Patent and Trademark Office.

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

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

Patents. Copies of the specification and drawings of all patents are available at one dollar each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and subclasses. Price is based upon size of publication.

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