

Chapter 600 Parts, Form, and Content of Application

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601 Content of Provisional and Nonprovisional Applications [R-1]

35 U.S.C. 111. Application

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner.

(2) CONTENTS.—Such application shall include—

- (A) a specification as prescribed by section 112 of this title;
- (B) a drawing as prescribed by section 113 of this title; and
- (C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.—(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee was unavoidable or unintentional.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) ABANDONMENT.—**>Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.<

(6) OTHER BASIS FOR PROVISIONAL APPLICATION.—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Commissioner, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) APPLICABLE PROVISIONS.—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

37 CFR 1.51. General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

(b) A complete application filed under § 1.53(b) comprises:

- (1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;
- (2) An oath or declaration, see § 1.63 and § 1.68;
- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) The prescribed filing fee, see § 1.16.

(c) A complete provisional application filed under § 1.53(c) comprises:

- (1) A cover sheet identifying:
 - (i) The application as a provisional application,
 - (ii) The name or names of the inventor or inventors, (see § 1.41(a)(2)),
 - (iii) The residence of each named inventor,
 - (iv) The title of the invention,
 - (v) The name and registration number of the attorney or agent (if applicable),
 - (vi) The docket number used by the person filing the application to identify the application (if applicable),
 - (vii) The correspondence address, and
 - (viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);
- (2) A specification as prescribed by the first paragraph of 35 U.S.C. 112, see § 1.71;

- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) The prescribed filing fee, see § 1.16.

(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See § 1.97 and § 1.98. No information disclosure statement may be filed in a provisional application.

GUIDELINES FOR DRAFTING A NONPROVISIONAL PATENT APPLICATION UNDER 35 U.S.C. 111(a)

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use. See also 37 CFR 1.77 and MPEP § 608.01(a).

Arrangement and Contents of the Specification

The following order of arrangement is preferable in framing the specification. Except for the reference to the "microfiche appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading.

- (A) Title of the invention.
- (B) Cross-reference to related applications.
- (C) Statement regarding federally sponsored research or development.
- (D) Reference to a "Microfiche appendix." (See 37 CFR 1.96 (c)).
- (E) Background of the invention.
 - (1) Field of the invention.
 - (2) Description of related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98.
- (F) Brief summary of the invention.
- (G) Brief description of the several views of the drawing.
- (H) Detailed description of the invention.
- (I) Claim(s) (commencing on a separate sheet).
- (J) Abstract of the Disclosure (commencing on a separate sheet).
- (K) Drawings.
- (L) Sequence Listing (See 37 CFR 1.821 through 1.825).

Content

(A) *Title of the Invention:* (See 37 CFR 1.72(a).) The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive preferably from two to seven words.

(B) *Cross-Reference to Related Applications:* (See 37 CFR 1.78 and MPEP § 201.11.)

(C) *Statement Regarding Federally Sponsored Research or Development:* (See MPEP § 310).

(D) *Reference to a "Microfiche Appendix":* (See 37 CFR 1.96(c) and MPEP § 608.05). The total number of microfiche and total number of frames should be specified.

(E) *Background of the Invention:* The specification should set forth the Background of the Invention in two parts:

(1) *Field of the Invention:* A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention. This item may also be titled "Technical Field".

(2) *Description of the Related Art Including Information Disclosed Under 37 CFR 1.97 and 1.98:* A paragraph(s) describing to the extent practical the information known to the applicant, including references to specific documents where appropriate. Where applicable, the problems involved in the information disclosed which are solved by the applicant's invention, should be indicated. This item may also be titled "Background Information".

(F) *Brief Summary of the Invention:* A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the art (and preferably indicated in the Background of the Invention). In chemical cases the summary should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(G) *Brief Description of the Several Views of the Drawing(s):* A reference to and brief description of each Figure in the drawing(s) as set forth in 37 CFR 1.74.

(H) *Detailed Description of the Invention:* A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to adequately and accurately describe the invention.

Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field to which the invention pertains, form a part of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely

known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(I) *Claim(s)*: (See 37 CFR 1.75 and MPEP § 608.01(m).) The claim or claims must commence on a separate sheet. See 37 CFR 1.52(b). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate sub-combinations or related steps.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive. All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable. Where separate species are claimed, the claims of like species should be grouped together where possible. Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. Such a claim is to be considered a combination claim and should be drafted with this thought in mind.

In drafting claims in accordance with 37 CFR 1.75(e), the preamble is to be considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

(J) *Abstract of the Disclosure*: (See 37 CFR 1.72(b) and MPEP § 608.01(b).) The abstract must commence on a separate sheet. See 37 CFR 1.52(b).

(K) *Drawings*: (See 37 CFR 1.81 and 37 CFR 1.83-1.85, and MPEP § 608.02).

(L) *Sequence Listing*: (See 37 CFR 1.821-1.825).

Oath or Declaration

(See 37 CFR 1.63, 1.68, and 1.69.) Where one or more previously filed foreign applications are cited or mentioned in the oath or declaration, complete identifying data, including the application number as well as the country and date of filing, should be provided.

GUIDELINES FOR DRAFTING A PROVISIONAL APPLICATION UNDER 35 U.S.C. 111(b)

A provisional application should preferably conform to the arrangement guidelines for nonprovisional applications. The specification must, however, comply with the first paragraph of 35 U.S.C. 112 and refer to drawings, where necessary for an understanding of the invention. Unlike an application filed under 35 U.S.C. 111(a), a provisional application does not need claims. Furthermore, no oath or declaration is required. See MPEP § 201.04(b).

A cover sheet providing identifying information is required for a complete provisional application. In accordance with 37 CFR 1.51(c)(1) the cover sheet must state that it is for a provisional application, it must identify and give the residence of the inventor or inventors, and it must give a title of the invention. The cover sheet must also give the name and registration number of the attorney or agent (if applicable), the docket number used by the person filing the application (if applicable) and the correspondence address. If there is a governmental interest, the cover sheet must include a statement as to rights to inventions made under Federally sponsored research and development (See MPEP § 310). 37 CFR 1.51(c)(1)(viii) requires the name of the Government agency and the contract number, if the invention was developed by or while under contract with an agency of the U.S. Government.

Unlike applications filed under 35 U.S.C. 111(a), provisional applications should not include an information disclosure statement. See 37 CFR 1.51(d). Since no substantive examination is made, such statements are unnecessary. The Office will not accept an information disclosure statement in a provisional application. Any such statement received, will be returned or disposed of at the convenience of the Office.

This cover sheet information enables the Office to prepare a proper filing receipt and provides the Office of Initial Patent Examining (OIPE) with most of the information needed to process the provisional application. See MPEP § 201.04(b) for a sample cover sheet.

THE APPLICATION

The specification must be filed in or translated into the English language and must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent. Except for the drawing, the application papers (specification, including claims, abstract, oath or declaration, and all papers which are to become part of the permanent records of the Patent and Trademark Office) must have each page plainly written on only one side of a sheet of paper. The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). Each sheet must include a

top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch) and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced. The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers should be centrally located above or, preferably, below the text. See 37 CFR 1.52(b) and MPEP § 608.01.

The parts of the application may be included in a single document.

Determination of completeness of an application is covered in MPEP § 506 and § 601.01 - § 601.01(g).

The elements of the application are secured together in a file wrapper, bearing appropriate identifying data including the application number and filing date (MPEP § 719).

Note

Provisional applications, MPEP § 201.04(b).

Divisional applications, MPEP § 201.06.

Continuation applications, MPEP § 201.07.

Continued prosecution applications,
MPEP § 201.06(d).

Reissue applications, MPEP § 1401.

Design applications, MPEP Chapter 1500.

Plant applications, MPEP Chapter 1600.

Reexamination, MPEP Chapter 2200.

A model, exhibit, or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (37 CFR 1.91 and 1.93, MPEP § 608.03).

37 CFR 1.59. Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) Information, other than what is excluded by paragraph (a)(2) of this section, may be requested to be expunged and returned to applicant upon petition under this paragraph and payment of the petition fee set forth in § 1.17(i). Any petition to expunge and return information from an application must establish to the satisfaction of the Commissioner that the return of the information is appropriate.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see § 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

See, however, MPEP § 201.14(c), § 604.04(a), and § 724.05 with regard to the return of papers. Copies of an

application will be provided by the PTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e), (f) and (g)).

All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example "Proposed Class 2, subclass 129."

601.01 Complete Application

37 CFR 1.53. Application number, filing date, and completion of application.

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application or a continuation or divisional application naming an inventor not named in the prior application) must be filed under this paragraph.

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1) or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section,

(i) Provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earliest of:

(A) Abandonment of the application filed under paragraph (b) of this section;

(B) Payment of the issue fee on the application filed under paragraph (b) of this section;

(C) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or

(D) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(ii) The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under paragraph (b) of this section.

(3) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (non-provisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is either:

(A) Complete as defined by § 1.51(b) ; or

(B) The national stage of an international application in compliance with 35 U.S.C. 371; and

(ii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(b)(5) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in § 1.16; and

(ii) Any additional § 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application.

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior

application on the date the application under this paragraph was filed, except by way of a petition under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

(9) Envelopes containing only requests and fees for filing an application under this paragraph should be marked "Box CPA." Requests for an application under this paragraph filed by facsimile transmission should be clearly marked "Box CPA."

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph. Any petition under this paragraph must be accompanied by the fee set forth in § 1.17(i) in an application filed under paragraphs (b) or (d) of this section, and the fee set forth in § 1.17(q) in an application filed under paragraph (c) of this section. In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in § 1.21(n), will be refunded.

(f) *Completion of application subsequent to filing - Nonprovisional (including continued prosecution) application.* If an application which has been accorded a filing date pursuant to paragraph (b) of this section, including a continuation, divisional, or continuation-in-part application, does not include the appropriate filing fee or an oath or declaration by the

applicant pursuant to § 1.63 or § 1.175, or, if an application which has been accorded a filing date pursuant to paragraph (d) of this section does not include the appropriate filing fee, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to file the fee, oath or declaration, and the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application may be disposed of. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (e) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, the oath or declaration in an application under paragraph (b) of this section, and the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(g) *Completion of application subsequent to filing - Provisional application.* If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(c)(1), applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to file the fee, cover sheet, and the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. If the required filing fee is not timely paid, the application may be disposed of. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (e) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet, and the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application.

(h) *Subsequent treatment of application - Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is 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).

37 CFR 1.53 relates to application numbers, filing dates, and completion of applications. 37 CFR 1.53(a) indicates that an application number is assigned for identification purposes to any paper which purports to be an application for a patent, even if the application is incomplete or informal. The remaining sections of 37 CFR 1.53 treat nonprovisional applications filed under 35 U.S.C. 111(a) separately from provisional applications filed under 35 U.S.C. 111(b).

37 CFR 1.53(d) sets forth the filing date requirements for a continued prosecution application (CPA). A CPA is a

nonprovisional application which must be filed on or after December 1, 1997. Only a continuation or divisional application (but not a continuation-in-part) may be filed as a CPA. See MPEP § 201.06(d).

601.01(a) Nonprovisional Applications Filed Under 35 U.S.C. 111(a) [R-1]

The procedure for filing a nonprovisional application under 35 U.S.C. 111(a) is set forth in 37 CFR 1.53(b) and 37 CFR 1.53(d). 37 CFR 1.53(b) may be used to file any original, reissue, or substitute nonprovisional application and any continuing application, i.e., continuation, divisional, or continuation-in-part. Under 37 CFR 1.53(b), a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the Patent and Trademark Office. Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.

37 CFR 1.53(d) may be used to file either a continuation or a divisional application (but not a continuation-in-part) of a prior nonprovisional application. The prior nonprovisional application must be either (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Any application filed under 37 CFR 1.53(d) must disclose and claim only subject matter disclosed in the prior nonprovisional application and must name as inventors the same or less than all of the inventors named in the prior nonprovisional application. Under 37 CFR 1.53(d), the filing date assigned is the date on which a request, on a separate paper, for an application under 37 CFR 1.53(d) is filed. An application filed under 37 CFR 1.53(d) must be filed before the earliest of:

- (A) payment of the issue fee on the prior application, unless a petition under 37 CFR 1.313(b)(5) is granted in the prior application;
- (B) abandonment of the prior application; or
- (C) termination of proceedings on the prior application.

The filing fee for an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d) and the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. However, no amendment may introduce new matter into the disclosure of an application after its filing date.

37 CFR 1.53(e) provides for notifying applicant of any application which is incomplete under 37 CFR 1.53(b) or 37 CFR 1.53(d) and giving the applicant a time period to

correct any omission. If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee set forth in 37 CFR 1.21(n) will be retained from any refund of a filing fee.

37 CFR 1.53(f) provides that, where a filing date has been assigned to an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d), the applicant will be notified if a correspondence address has been provided and be given a period of time in which to file the missing fee, oath or declaration, and to pay the surcharge due in order to prevent abandonment of the application. The time period usually set is 2 months from the date of notification by the Patent and Trademark Office. This time period may be extended under 37 CFR 1.136(a).

If the required basic filing fee is not timely paid, or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid within 1 year of the date of mailing of the notification, the application will be disposed of. The notification under 37 CFR 1.53(f) may be made simultaneously with any notification pursuant to 37 CFR 1.53(e). If no correspondence address is included in the application, applicant has 2 months from the filing date to file the fee, oath or declaration and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application or one year from the filing date to pay the processing and retention fee set forth in 37 CFR 1.21(l) to prevent disposal of the application.

Copies of an application will be provided by the PTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e) and (f)). The basic filing fee or the processing and retention fee must be paid in a nonprovisional application, if any claim for benefits under 35 U.S.C. 120, 121, or 365(c) based on that application is made in a subsequently filed copending nonprovisional application. 37 CFR 1.78(a)(1).

37 CFR 1.53(h) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received. 37 CFR 1.53(j) indicates that international applications filed under the Patent Cooperation Treaty which designate the United States of America are considered to have a United States filing date under PCT Article 11(3), except as provided in 35 U.S.C. 102(e), on the date the requirements of PCT Article 11(1) (i) to (iii) are met.

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53(b), a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR

1.81(a), which is filed in the Patent and Trademark Office. If an application which has been accorded a filing date does not include the appropriate filing fee or oath or declaration, applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application.

Applicants should submit a copy of the notice(s) to file missing parts and the notice(s) of incomplete applications with the reply submitted to the Patent and Trademark Office. Applicants should also include the application number on all correspondence to the Office. These measures will aid the Office in matching papers to applications, thereby expediting the processing of applications.

In order for the Office to so notify the applicant, a correspondence address must also be provided in the application. The address may be different from the post office address of the applicant. For example, the address of applicant's registered attorney or agent may be used as the correspondence address. If applicant fails to provide the Office with a correspondence address, the Office will be unable to provide applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e). In such a case, applicant will be considered to have constructive notice as of the filing date that the application must be completed within 2 months from the filing date before abandonment occurs per 37 CFR 1.53(f). This time period may be extended pursuant to 37 CFR 1.136.

The oath or declaration filed in reply to such a notice under 37 CFR 1.53(f) must be executed by the inventors and must identify the specification and any amendment filed with the specification which is intended to be part of the original disclosure. If an amendment is filed with the oath or declaration filed after the filing date of the application, it may be identified in the oath or declaration but may not include new matter. No new matter may be included after the filing date of the application. See MPEP § 608.04(b). If the oath or declaration improperly refers to an amendment containing new matter, a supplemental oath or declaration will be required pursuant to 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under 37 CFR 1.53(b) is filed and is referred to in the original oath or declaration filed with or after the application, it constitutes a part of the original application papers and the question of new matter is not considered. Similarly, if the application papers are altered prior to execution of the oath or declaration and the filing of the application, new matter is not a consideration since the alteration is considered as part of the original disclosure.

An amendment which adds additional disclosure submitted with a request for a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has “reviewed and understands” in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under former 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

37 CFR 1.63 requires that an oath or declaration identify the specification to which it is directed. The declaration form suggested by the Office includes spaces for filling in the names of the inventors, title of invention, application number, filing date, foreign priority application information and United States priority application information. While this information should be provided, it is not essential that all of these spaces be filled in in order to adequately identify the specification in compliance with 37 CFR 1.63(a)(2).

The following combinations of information supplied in an oath or declaration filed on the application filing date with a specification are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with identification requirement of 37 CFR 1.63:

(A) name of inventor(s), and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration on filing;

(B) name of inventor(s), and attorney docket number which was on the specification as filed; or

(C) name of inventor(s), and title which was on the specification as filed.

Filing dates are now granted on applications filed without an oath or declaration in compliance with 37 CFR 1.63, the oath or declaration being filed later with a surcharge. The following combinations of information supplied in an oath or declaration filed after the filed date are acceptable as minimums for identifying a specification and compliance with any one of the items below will be accepted as complying with the identification requirement of 37 CFR 1.63:

(A) application number (consisting of the series code and the serial number, e.g., 08/123,456);

(B) serial number and filing date;

(C) attorney docket number which was on the specification as filed;

(D) title which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) title which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date. Absent any statement(s) to the contrary, it will be presumed that the application filed in the PTO is the application which the inventor(s) executed by signing the oath or declaration.

Form Paragraphs 6.05 and 6.05.20 may be used to notify applicant that the oath or declaration is defective because the specification has not been adequately identified.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.20 Specification Not Identified

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a).

Examiner Note:

*This paragraph must be preceded by form paragraph 6.05.

Any specification that is filed attached to an oath or declaration on a date later than the application filing date will not be compared with the specification submitted on filing. Absent any statement(s) to the contrary, the “attached” specification will be presumed to be a copy of the specification and any amendments thereto which were filed in the Office in order to obtain a filing date for the application.

Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under 37 CFR 1.183 accompanied by a petition fee (37 CFR 1.17(h)).

Further an oath or declaration attached to a cover letter referencing an incorrect application may not become associated with the correct application and, therefore, could result in the abandonment of the correct application.

Supplemental oaths or declarations in accordance with 37 CFR 1.67 will be required in applications in which the oaths or declarations are not in compliance with the other requirements of 37 CFR 1.63 but contain sufficient

information to identify the specifications to which they apply as detailed above.

A copy, such as a photocopy or facsimile transmission, of an originally executed oath or declaration is acceptable and may be filed (see MPEP § 502.01). In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original. See 37 CFR 1.4(d)(1)(ii).

See MPEP § 1896 for the identification requirements for a declaration filed in a U.S. national stage application filed under 35 U.S.C. 371.

The periods of time within which applicant must complete the application may be extended under the provisions of 37 CFR 1.136. Applications which are not completed in a timely manner will be abandoned.

601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b) [R-1]

A provisional application will be given a filing date in accordance with 37 CFR 1.53(c) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in 37 CFR 1.53(c) parallel the requirements for a nonprovisional application set forth in 37 CFR 1.53(b), except that no claim is required. Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

When the specification or drawing are omitted, 37 CFR 1.53(e) requires that the applicant be notified and given a time period in which to submit the missing element to complete the filing. **>See MPEP § 601.01(f) and § 601.01(g) for treatment of applications filed without drawings, or filed without all figures of drawings, respectively.<

37 CFR 1.53(c)(1) requires all provisional applications be filed with a cover sheet or cover letter identifying the application as a provisional application. The Office will treat an application as having been filed under paragraph (b), unless the application is clearly identified as a provisional application. A provisional application, which is identified as such, but which does not have a complete cover sheet as required by 37 CFR 1.51(c)(1) will be treated as a provisional application. However, the complete cover sheet and a surcharge will be required to be submitted at a later date in conformance with 37 CFR 1.53(g).

When the provisional application does not have a complete cover sheet or the appropriate fee, the applicant will be notified pursuant to 37 CFR 1.53(g) and given a time period in which to provide the necessary fee or cover sheet and to pay the surcharge as set forth in 37 CFR 1.16(l) in

order to prevent abandonment of the application. The time period will usually be set at 2 months from the date of notification. This time period may be extended under 37 CFR 1.136(a). If the filing fee is not timely paid, the provisional application will be disposed of. If no correspondence address has been provided, applicant has 2 months from the filing date to file the basic filing fee, cover sheet, and to pay the surcharge as set forth in 37 CFR 1.16(l) in order to prevent abandonment of the provisional application. Copies of a provisional application will be provided by the PTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the provisional application has been disposed of (see 37 CFR 1.53(e) and (g)).

The basic filing fee must be paid in a provisional application, if any claim for benefits under 35 U.S.C. 119(e) based on that application is made in a subsequently filed copending nonprovisional application. 37 CFR 1.78(a)(3).

37 CFR 1.53(e)(2) requires that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in 37 CFR 1.17(q) (see MPEP § 506.02).

601.01(c) Conversion to a Provisional Application

An application filed under 37 CFR 1.53(b) may be converted to a provisional application in accordance with the procedure described in 37 CFR 1.53(c)(2). The procedure requires the filing of a petition requesting the conversion and the petition fee set forth in 37 CFR 1.17(q). Filing of the petition in the application is required prior to the abandonment of the 37 CFR 1.53(b) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 37 CFR 1.53(b) application, or the filing of a request for a statutory invention registration under 37 CFR 1.293, whichever event is earlier. The grant of any such petition does not entitle applicant to a refund of the fees properly paid in the application filed under 37 CFR 1.53(b).

601.01(d) Application Filed Without All Pages of Specification

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the pages of specification are present in the application. If the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Items" indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification.

The mailing of a “Notice of Omitted Items” will permit the applicant to either: (1) promptly establish prior receipt in the PTO of the page(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the page(s) was in fact deposited in the PTO with the application papers must, within 2 months from the date of the “Notice of Omitted Item(s)”, file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i) (37 CFR 1.17(q) for a provisional application), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the page(s) was in fact received by the PTO with the application papers deposited on filing. An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within 2 months from the date of the “Notice of Omitted Item(s)”, file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the later filing date (37 CFR 1.181(f)).

An applicant willing to accept the application as deposited in the PTO need not respond to the “Notice of Omitted Items,” and the failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the “Notice of Omitted Item(s)” (37 CFR 1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the PTO. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted page(s). Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

If the application does not contain anything that can be construed as a written description, OIPE will mail a Notice of Incomplete Application (PTO-1123) indicating that the application lacks the specification required by 35 U.S.C. 112. Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i) (37 CFR 1.17(q) for a provisional application), asserting that: (1) the missing specification was submitted; or (2) the application papers as deposited contain an adequate written description under 35 U.S.C. 112. The petition under 37 CFR 1.53(e) must be accompanied by sufficient evidence (37 CFR 1.181(b)) to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in

the PTO of the missing specification). Alternatively, applicant may submit the omitted specification, including at least one claim in a nonprovisional application, accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the specification being submitted and accept the date of such submission as the application filing date.

Original claims form part of the original disclosure and provide their own written description. See *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). As such, an application that contains at least one claim, but does not contain anything which can be construed as a written description of such claim(s), would be unusual.

In instances in which a “Notice of Incomplete Application” has been mailed, further action by applicant is necessary for the application to be accorded a filing date. As such, the application will be retained in OIPE to await such action. Unless applicant either completes the application or files a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i) (37 CFR 1.17(g) for a provisional application), within the period set in the “Notice of Incomplete Application,” the application will be processed as an incomplete application under 37 CFR 1.53(e).

In instances in which a “Notice of Omitted Items” has been mailed, the application will be retained in OIPE for a period of 2 months from the mailing date of “Notice of Omitted Items” to permit applicant to either: (1) establish prior receipt in the PTO of the page(s) or drawing(s) at issue; or (2) promptly submit the omitted page(s) or drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. As an applicant may, but is not required to, reply to such a “Notice of Omitted Items,” extensions of time under 37 CFR 1.136 will not be applicable to this 2-month time period.

Unless applicant timely files a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the required petition fee, the application will maintain the filing date as of the date of deposit of the application papers in the PTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the PTO on the date of deposit. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate examining group for examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the “Notice of Omitted Item(s)” may be dismissed as untimely. 37 CFR

1.181(f). Under the adopted procedure, the PTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted page(s) or drawing(s) in a nonprovisional application and request the date of such submission as the application filing date as: (1) according the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and (2) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

The submission of omitted page(s) or drawing(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) with any omitted page(s) or drawing(s), which is a cost effective alternative in instances in which a nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the PTO's desire to minimize the processing of provisional applications, the PTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

601.01(e) Nonprovisional Application Filed Without At Least One Claim [R-1]

35 U.S.C. 111(a)(2) requires that an application for patent include, *inter alia*, "a specification as prescribed by section 112 of this title," and 35 U.S.C. 111(a)(4) provides that the "filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." 35 U.S.C. 112, first paragraph, provides, in part, that "[t]he specification shall contain a written description of the invention," and 35 U.S.C. 112, second paragraph, provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Also, the

Court of Appeals for the Federal Circuit stated in *Litton Systems, Inc. v. Whirlpool Corp.*:

Both statute, 35 U.S.C. 111 [(a)], and federal regulations, 37 CFR 1.51 [(b)], make clear the requirement that an application for a patent *must* include . . . a specification and claims. . . . The omission of any *one* of these component parts makes a patent application incomplete and thus not entitled to a filing date.

728 F.2d 1423, 1437, 221 USPQ 97, 105 (Fed. Cir. 1984)(citing *Gearon v. United States*, 121 F. Supp 652, 654, 101 USPQ 460, 461 (Ct. Cl. 1954), *cert. denied*, 348 U.S. 942, 104 USPQ 409 (1955))(emphasis in the original).

Therefore, in an application filed under 35 U.S.C. 111(a), a claim is a statutory requirement for according a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that "[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application." Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

If a nonprovisional application does not contain at least one claim, >or is accompanied by a preliminary amendment which cancels all claims and fails to simultaneously submit any new claim(s),< a "Notice of Incomplete Application" will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. See >*Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1333, 47 USPQ2d 1225, 1234 (Fed. Cir. 1998);< *In re Mattson*, 208 USPQ 168 (Comm'r Pat. 1980). An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

As 37 CFR 1.53(c)(2) permits the conversion of an application filed under 35 U.S.C. 111(a) to an application under 35 U.S.C. 111(b), an applicant in an application, other than for a design patent, filed under 35 U.S.C. 111(a) on or after June 8, 1995, without at least one claim has the alternative of filing a petition under 37 CFR 1.53(c)(2) to convert such application into an application under 35 U.S.C. 111(b), which does not require a claim to be entitled to its date of deposit as a filing date. Such a petition, however, must be filed prior to the expiration of 12 months after the date of deposit of the application under 35 U.S.C. 111(a), and comply with the other requirements of 37 CFR 1.53(c)(2). See MPEP § 601.01(c).

The treatment of an application subsequent to the mailing of a “Notice of Incomplete Application” is discussed in MPEP § 601.01(d).

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(2)(B) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113 of this title” and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the “filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 113 (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.”

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications. Other situations in which drawings are usually not considered necessary for the understanding of the invention under 35 U.S.C. 113 (first sentence) are:

(A) *Coated articles or products*: where the invention resides solely in coating or impregnating a conventional sheet (e.g., paper or cloth, or an article of known and conventional character with a particular composition), unless significant details of structure or arrangement are involved in the article claims;

(B) *Articles made from a particular material or composition*: where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims;

(C) *Laminated structures*: where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims; or

(D) *Articles, apparatus, or systems where sole distinguishing feature is presence of a particular material*: where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims, for example:

(1) A hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

(2) Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular material.

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate examining group determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the PTO. The application will be returned to the Office of Initial Patent Examination (OIPE) for mailing of a “Notice of Incomplete Application.”

If a nonprovisional application does not have at least one claim directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, or a provisional application does not have at least some disclosure directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, and is filed without drawings, OIPE will mail a “Notice of Incomplete Application” indicating that the application lacks drawings and that 35 U.S.C. 113 (first sentence) requires a drawing where necessary for the understanding of the subject matter sought to be patented.

Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i) (37 CFR 1.17(q) for a provisional application), asserting that (1) the drawing(s) at issue was submitted, or (2) the drawing(s) is not necessary under 35 U.S.C. 113 (first sentence) for a filing date. The petition must be accompanied by sufficient evidence to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in the PTO of the drawing(s) at issue). Alternatively, applicant may submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to the drawing(s) being submitted and accept the date of such submission as the application filing date.

In design applications, OIPE will mail a “Notice of Incomplete Application” indicating that the application lacks the drawings required under 35 U.S.C. 113 (first sentence). The applicant may: (1) promptly file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i), asserting that the missing drawing(s) was submitted; or (2) promptly submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 and accept the date of such submission as the application filing date. 37 CFR 1.153(a) provides that the claim in a design application “shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” As such, petitions under 37 CFR 1.53(e) asserting that drawings are unnecessary under 35 U.S.C. 113 (first sentence) for a filing date in a design application will not be found persuasive.

The treatment of an application subsequent to the mailing of a “Notice of Incomplete Application” is discussed in MPEP § 601.01(d).

601.01(g) Applications Filed Without All Figures of Drawings [R-1]

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a “Notice of Omitted Item(s)” indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification.

The mailing of a “Notice of Omitted Item(s)” will permit the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the PTO with the application papers must, within 2 months from the date of the “Notice of Omitted Item(s),” file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(i) (37 CFR 1.17(q) for a provisional application), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the PTO with the application papers deposited on filing. An applicant desiring to submit the omitted drawings in a nonprovisional application and

accept the date of such submission as the application filing date must, within 2 months from the date of the “Notice of Omitted Item(s),” file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(h), requesting the later filing date (37 CFR 1.181(f)).

An applicant willing to accept the application as deposited in the PTO need not respond to the “Notice of Omitted Item(s),” and the failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the required petition fee as discussed above within 2 months of the date of the “Notice of Omitted Item(s)” (37 CFR 1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the PTO. Amendment of the specification is required in a nonprovisional application to cancel all references to the omitted drawing, both in the brief and detailed descriptions of the drawings and including any reference numerals shown only in the omitted drawings. In addition, a separate letter is required in a nonprovisional application to renumber the drawing figures consecutively (showing the proposed changes in red ink), if necessary, and amendment of the specification is required to correct the references to the drawing figures to correspond with any relabeled drawing figures, both in the brief and detailed descriptions of the drawings. Such amendment and correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

The treatment of an application subsequent to the mailing of a “Notice of Omitted Item(s)” is discussed in MPEP § 601.01(d).

>Applications are often filed with drawings with several views of the invention where the views are labeled using a number-letter combination, e.g., Fig. 1A, Fig. 1B, and Fig. 1C. OIPE will not mail a “Notice of Omitted Item(s)” if a figure which is referred to in the specification by a particular number cannot be located among the drawings, if the drawings include at least one figure labeled with that particular number in combination with a letter. For example, if the drawings show Figures 1A, 1B, and 1C and the brief description of the drawings refers only to Figure 1, this is an error in the specification which must be corrected, rather than an application filed without all figures of drawings.<

601.01(h) Forms

The following forms used by the Office of Initial Patent Examination (OIPE) to notify applicants of defects are reproduced on the following pages.

"Notice of Omitted Item(s) in a Nonprovisional Application Filed Under 37 CFR 1.53(b)," Form PTO-1669;

"Notice to File Missing Parts of Application - Filing Date Granted" Form PTO-1533;

"Notice of Incomplete Nonprovisional Application Under 37 CFR 1.53(b)," Form PTO-1123;

"Notice to File Missing Parts of Application, No Filing Date," Form PTO-1532;

"Notice of Informal Application" Form PTO-152;

"Notice To File Corrected Application Papers Filing Date Granted," Form PTO-1660;

"Notice of Omitted Item(s) in a Provisional Application Filed Under 37 CFR 1.53(c)," Form PTO-1672.

"Notice to File Missing Parts of Provisional Application Filed Under 37 CFR 1.53(c) Filing Date Granted" Form PTO-1627;

"Notice of Incomplete Provisional Application Under 37 CFR 1.53(c)," Form PTO-1626;

"Notice to File Missing Parts of Provisional Application Filed Under 37 CFR 1.53(c), No Filing Date," Form PTO-1628;

"Notice of Improper Application Filed Under 37 CFR 1.60," Form PTO-1534;

"Notice to File Missing Parts of Application Filed Under 37 CFR 1.60 Filing Date Granted;" Form PTO-1607;

"Notice to File Missing Parts of Application Filed Under 37 CFR 1.60 No Filing Date," Form PTO-1608; and

"Notice of Improper FWC Filing Under 37 CFR 1.62 No Filing Date Granted," Form PTO-1673.



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

APPLICATION NUMBER FILING/RECEIPT DATE FIRST NAMED APPLICANT ATTY. DOCKET NO./TITLE

DATE MAILED:

**NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION
 FILED UNDER 37 CFR 1.53(b)**

A filing date has been assigned to the above-identified application papers; however, the following item(s) appear to have been omitted from the application:

1. Pages _____ of the specification (description and claims).
 2. Figures _____ described the specification.
 3. Other: _____

Should applicant contend that the above-noted item(s) was in fact deposited in the Patent and Trademark Office (PTO) with the application papers, a copy of this Notice and a petition (and \$130.00 petition fee (37 CFR 1.17(i)), which will be refunded if it is determined that the item was in fact received by the PTO) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) were filed in the PTO as the filing date of the above-identified application, a copy of this Notice, the omitted items (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the \$130.00 petition fee (37 CFR 1.17(h)) requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the PTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136 (a) or (b).** In the absence of a timely petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the PTO, and original application papers (*i.e.*, the original disclosure of the invention) will include only those application papers present in the PTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option III), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabelled drawing figures, is required. Any drawing changes should be accompanied by a copy of the drawing figures showing the proposed changes in red ink. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

Enclosed:

- "Notice to File Missing Parts of Application," Form PTO-1533.
 Other: _____

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202
 FORM PTO-1669 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY



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

APPLICATION NUMBER FILING/RECEIPT DATE FIRST NAMED APPLICANT ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION
Filing Date Granted

An Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). **If any of items 1 or 3 through 5 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(e) of \$65.00 for a small entity in compliance with 37 CFR 1.27, or \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.**

If all required items on this form are filed within the period set above, the total amount owed by applicant as a small entity (statement filed) non-small entity is \$ _____.

1. The statutory basic filing fee is:
 missing.
 insufficient.

Applicant must submit \$ _____ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).

2. Additional claim fees of

\$ _____ for _____ independent claims over 3.

\$ _____ for _____ dependent claims over 20.

\$ _____ for multiple dependent claim surcharge.

Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.

3. The oath or declaration:

is missing or unexecuted.

does not cover the newly submitted items.

does not identify the application to which it applies.

does not include the city and state or foreign country of applicant's residence.

An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date is required.

4. The signature(s) to the oath or declaration is/are by a person other than inventor or person qualified under 37 CFR 1.42, 1.43, or 1.47.

A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

5. The signature of the following joint inventor(s) is missing from the oath or declaration:

An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).

7. Your filing receipt was mailed in error because your check was returned without payment.

7. The application does not comply with the Sequence Rules.

See attached "Notice to Comply with Sequence Rules 37 CFR 1.821 - 1.825."

8. OTHER: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202



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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

**NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION
 UNDER 37 CFR 1.53(b)**

A filing date has NOT been assigned to the above identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items, unless otherwise indicated, **must** be submitted within **TWO MONTHS** of the date of this Notice, or proceedings on the application will be terminated (37 CFR 1.53(e)).

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the items required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

1. The specification (description and claims):
- a. is missing.
 - b. does not include a written description of the invention.
 - c. does not include at least one claim as prescribed by 35 U.S.C. 112.
A complete specification (including at least one claim in a nonprovisional application) as prescribed by 35 U.S.C. 112 is required.
2. The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented."
Applicant should reconsider whether drawings are necessary under 35 U.S.C. 113 (first sentence).
3. OTHER: _____

Additional observations on the above-identified application papers:

1. Pages _____ of the specification are missing.
2. Figures _____ described in the specification are missing.

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

Enclosed:

- "General Information Concerning Patents." See page _____.
- "Notice to File Missing Parts of Application," Form PTO-1532.
- "Checklist for Patent Applications."
- Other: _____

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1123 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION
No Filing Date
(Enclosure to Form PTO-1123)

The required items noted below SHOULD be filed along with any items required on the "Notice of Incomplete Application." The filing date of this application will be the date of receipt of the items required on the "Notice of Incomplete Application." The items noted below must be filed no later than TWO MONTHS FROM THE FILING DATE ACCORDED THIS APPLICATION. If any of items 1 and 3 through 5 below are submitted after the filing date accorded this application, the SURCHARGE set forth in 37 CFR 1.16(e) of \$65.00 for a small entity in compliance with 37 CFR 1.27, or \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.

If all required items on this form and on the "Notice of Incomplete Application" are filed together, the total amount owed by applicant as a small entity (statement filed) non-small is \$ _____.

1. The statutory basic filing fee is:
- missing or unexecuted.
 - insufficient.
- Applicant must submit \$ _____ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).
2. Additional claim fees of
- \$ _____ for _____ independent claims over 3.
 - \$ _____ for _____ dependent claims over 20.
 - \$ _____ for multiple dependent claim surcharge.
- Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.
3. The oath or declaration:
- is missing or unexecuted.
 - does not cover the items required on "Notice of Incomplete Application."
 - does not identify the application to which it applies.
 - does not include the post office address and the city and state or foreign country of applicant's residence.
- An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and filing date is required.
4. The signature(s) to the oath or declaration is/are by a person other than the inventor or person qualified under 37 CFR 1.42, 1.43, or 1.47.
- A properly signed oath or declaration in compliance with 37 CFR 1.63, referring to the above Application Number and filing date is required.
5. The signature of the following joint inventor(s) is missing from the oath or declaration:
- _____
- An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and filing date, is required.
6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).
7. The application does not comply with the Sequence Rules.
- See attached "Notice to Comply with Sequence Rules 37 CFR 1.821 - 1.825."
8. Other: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
FORM PTO-1532 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY



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

Application Number:

Attachment to Paper Number:

NOTICE OF INFORMAL APPLICATION

This application is considered to be informal since it does not comply with the regulations for the reason(s) indicated below. The period within which to correct the informalities noted below and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the application number is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

- 1. does not identify the residence (*e.g., city and either state or foreign country*) of each inventor.
- 2. does not identify each inventor by full name, including the family name and at least one given name without abbreviation.
- 3. does not identify the complete post office address of each inventor.
- 4. does not identify the citizenship of each inventor.
- 5. does not state whether the inventor is a sole or joint inventor.
- 6. does not state that the person making the oath or declaration:
 - has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - believes the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
 - acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
- 7. does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.
- 8. does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (*37 CFR 1.63(e)*).
- 9. contains non-initialed alterations (*37 CFR 1.52(c)*).

B. Applicant is required to provide:

- 1. Proof of authority of the legal representative under 37 CFR 1.44.
- 2. An abstract in compliance with 37 CFR 1.72(b).

C. **OTHER:** _____



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

| | | | |
|--------------------|---------------------|-----------------------|------------------------|
| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE TO FILE CORRECTED APPLICATION PAPERS
Filing Date Granted

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to correct the informalities indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

1. An Abstract, commencing on a separate sheet (37 CFR 1.72(b)).
2. The Claim(s) commencing on a separate sheet (37 CFR 1.75(h)).
3. A substitute specification in compliance with 37 CFR 1.52 because:
- All sheets must be the same size and either A4 (21 cm x 29.7 cm) or 8-1/2" x 11".
 - Papers are not flexible, strong, smooth, non-shiny, durable, and white.
 - Papers are not typewritten or mechanically printed in permanent dark ink on one side.
 - Papers contain hand lettering.
 - Papers contain improper margins. *Each sheet must have a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (3/4").*
 - Line spacing on the sheets is not 1-1/2 or double-spaced.
 - The pages of specification including the abstract and claims are not consecutively numbered starting with the number "1."
 - The pages of specification do not contain page numbers centrally located within the top or, preferably, bottom margin.
4. Substitute drawings in compliance with 37 CFR 1.84 because:
- The drawings or copy of drawings are not suitable for electronic reproduction.
 - All drawing sheets must be the same size and either A4 (21 cm x 29.7 cm) or 8-1/2" x 11".
 - Each sheet must include a top and left margin of at least 2.5 cm (1"), a right margin of at least 1.5 cm (9/16") and a bottom margin of at least 1.0 cm (3/8").
5. Page(s) _____ are not of sufficient clarity, contrast and quality for electronic reproduction. *New typewritten or mechanically printed pages of sufficient clarity, contrast and quality for electronic reproduction, together with a statement that the new pages contain the same material as those on deposit are required.*
6. An new oath or declaration in compliance with 37 CFR 1.63 setting forth the residence (city and state or foreign country) of each applicant (or legal representative under 37 CFR 1.42 or 1.43 of each applicant).
7. An English translation of the non-English language application, the \$130.00 fee set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).
8. OTHER: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1660 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY



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

APPLICATION NUMBER FILING/RECEIPT DATE FIRST NAMED APPLICANT ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF OMITTED ITEM(S) IN A PROVISIONAL APPLICATION
FILED UNDER 37 CFR 1.53(c)

A filing date has been assigned to the above-identified PROVISIONAL APPLICATION; however, the following item(s) appear to have been omitted from the application:

- 1. Pages of the specification (description and claims).
2. Figures described in the specification.
3. Other:

Should applicant contend that the above-noted item(s) was in fact deposited in the Patent and Trademark Office (PTO) with the provisional application papers, a copy of this Notice and a petition (and \$50.00 petition fee (37 CFR 1.17(q)), which will be refunded if it is determined that the item was in fact received by the PTO), with evidence of such deposit must be filed within TWO MONTHS of the date of this Notice.

The failure to file a petition (and petition fee) within TWO MONTHS of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the provisional application as deposited in the PTO. THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136 (a) or (b). In the absence of a timely petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the PTO, and original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the PTO on the date of deposit.

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

- Enclosed:
"Notice to File Missing Parts of Provisional Application," Form PTO-1670.
Other:

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
FORM PTO-1672 (Rev. 7/97) PART 1 - ATTORNEY/APPLICANT COPY



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

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| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
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DATE MAILED:

NOTICE TO FILE MISSING PARTS OF PROVISIONAL APPLICATION
Filed Under 37 CFR 1.53(c)
Filing Date Granted

An Application Number and Filing Date have been assigned to this provisional application. The items indicated below, however, are missing. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). **If any of items 1 or 2 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(l) of \$25.00 for a small entity in compliance with 37 CFR 1.27, or \$50.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.**

If all required items on this form are filed within the period set above, the total amount owed by applicant as a small entity (statement filed) non-small entity is \$_____.

1. The statutory provisional application basic filing fee is:
- missing.
 - insufficient.
- Applicant must submit \$_____ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
2. The provisional application cover sheet under 37 CFR 1.51(c)(1) is required identifying:
- either the city and state or city and foreign country of the residence of each inventor.
 - the title of the invention.
3. The application was filed in a language other than English.
Applicant must file an English translation of the application, the \$130.00 set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).
4. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21 (m)).
5. Your filing receipt was mailed in error because your check was returned without payment.
6. The drawings contained in the application cannot be scanned or properly stored because they:
- do not comply with the size requirements (8 1/2 by 11 inches or 21.0 by 29.7 cm).
 - are not clear enough or in permanent ink.
7. The specification cannot be scanned or properly stored. Page(s)
- _____ do not contain writing on only one side of the page.
 - _____ do not comply with the size requirements (8 1/2 by 11 inches or 21.0 by 29.7 cm).
 - _____ are not clear enough or in permanent ink.
- Replacement page(s), together with a statement that the replacement page(s) contain no new matter, are required.*
8. Other: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1627 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY



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

APPLICATION NUMBER

FILING/RECEIPT DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF INCOMPLETE PROVISIONAL APPLICATION
UNDER 37 CFR 1.53(c)

A filing date has NOT been assigned to the above-identified PROVISIONAL APPLICATION papers for the reason(s) indicated below.

All of the items noted below, unless otherwise indicated, **must** be submitted within **TWO MONTHS** of the date of this Notice, or proceedings on the application will be terminated (37 CFR 1.53(e)).

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the items required were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$50.00 petition fee. (37 CFR 1.17(q)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

1. The specification (written description) is missing.
A complete specification as prescribed by 35 U.S.C. 112, first paragraph, is required.
2. The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented."
 Applicant should reconsider whether drawings are necessary under 35 U.S.C. 113 (first sentence).
3. Other: _____

Additional observations on the above-identified application papers:

1. Pages _____ of the specification are missing.
2. Figures _____ described in the specification are missing.

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

Enclosed:

- "General Information Concerning Patents." See page _____.
- "Notice to File Missing Parts of Provisional Application," Form PTO-1628.
- "Checklist for Patent Applications."
- Other: _____

A copy of this notice MUST be returned with the reply.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1626 (Rev 7/97)

PART 1 - ATTORNEY/APPLICANT COPY


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|------------------------|

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF PROVISIONAL APPLICATION
Filed Under 37 CFR 1.53(c)
No Filing Date
(Enclosure to Form PTO-1626)

The required items noted below SHOULD be filed along with any items required on the "Notice of Incomplete Provisional Application." The filing date of this PROVISIONAL APPLICATION will be the date of receipt of the items required on the "Notice of Incomplete Provisional Application." The items noted below must be filed no later than TWO MONTHS FROM THE FILING DATE ACCORDED THIS APPLICATION. **If items 1 or 2 below are submitted after the filing date accorded this application, the SURCHARGE set forth in 37 CFR 1.16(l) of \$25.00 for a small entity in compliance with 37 CFR 1.27, or \$50.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.**

If all required items on this form and on the "Notice of Incomplete Application" are filed together, the total amount owed by applicant as a small entity (statement filed) non-small entity is \$_____.

1. The statutory provisional application basic filing fee is:
- missing.
 - insufficient.
- Applicant must submit \$_____ to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
2. The provisional application cover sheet under 37 CFR 1.51(c)(1) is required identifying:
- either the city and state or city and foreign country of the residence of each inventor.
 - the title of the invention.
3. The application was filed in a language other than English.
- Applicant must file an English translation of the application, the \$130.00 set forth in 37 CFR 1.17(k), unless previously submitted, and a statement that the translation is accurate (37 CFR 1.52(d)).*
4. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21 (m)).
5. Your filing receipt was mailed in error because your check was returned without payment.
6. The drawings contained in the application cannot be scanned or properly stored because they:
- do not comply with the size requirements (8 1/2 by 11 inches or 21.0 by 29.7 cm).
 - are not clear enough or in permanent ink.
7. The specification cannot be scanned or properly stored. Page(s)
- _____ do not contain writing on only one side of the page.
 - _____ do not comply with the size requirements (8 1/2 by 11 inches or 21.0 by 29.7 cm).
 - _____ are not clear enough or in permanent ink.
- Replacement page(s), together with a statement that the replacement page(s) contain no new matter, are required.*
8. OTHER: _____

Direct the reply and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
FORM PTO-1628 (Rev. 7/97)

PART 1 - ATTORNEY/APPLICANT COPY



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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|---------------------------|
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DATE MAILED:

NOTICE OF IMPROPER APPLICATION FILED UNDER 37 CFR 1.60

A filing date has NOT been assigned to the above-identified application since 37 CFR 1.60 has not been complied with for the reason(s) indicated below.

All of the items noted below, unless otherwise indicated, must be submitted within TWO MONTHS FROM THE DATE OF THIS NOTICE, or the application may be returned or otherwise disposed of. Any fee which has been submitted will be refunded less a \$130.00 handling fee (37 CFR 1.60(c)).

The filing date will be the date of receipt of the items required below unless otherwise indicated. Any assertions that the items required below were submitted, or explaining the delay in supplying the omitted items, must be by way of petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

1. A copy of the specification (description and claims) filed in the parent application:
- is missing.
 - has page(s) _____ missing.
 - has the description of the invention missing.
 - has claim(s) _____ missing.
2. A copy of the drawings as filed in the parent application is missing.
3. A copy of any amendments referred to in the oath or declaration filed to complete the parent application is missing.
4. A statement that the application papers filed are a true copy of the prior application and that no amendments referred to in the oath or declaration filed in the prior application introduced new matter is missing. Such statement must be made by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the United States Patent and Trademark Office.
5. OTHER:

Direct the response and any questions about this notice to "Attention: Box Missing Parts."

Enclosed:

- "Notice to File Missing Parts of Application Filed Under 37 CFR 1.60" Form PTO-1608.
- "Checklist for Patent Applications."
- Other:

A copy of this notice MUST be returned with the response.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1534 (REV.7-96)

PART 1-ATTORNEY/APPLICANT COPY

★ U.S. GPO: 1996-404-496.



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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|---------------------------|
|--------------------|---------------------|-----------------------|---------------------------|

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION FILED UNDER 37 CFR 1.60
Filing Date Granted

A filing date has been granted to this application filed under 37 CFR 1.60. However, the items indicated below are missing. The required items and fees identified below must be timely submitted ALONG WITH THE PAYMENT OF A SURCHARGE for items 1 and 3 of \$_____ for a large entity or small entity in compliance with 37 CFR 1.27 (37 CFR 1.16 (e)). Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

If all required items on this form are filed within the period set above, the total amount owed by applicant as a large entity, small entity (verified statement filed), is \$_____.

1. The statutory basic filing fee is:
- missing.
 - insufficient.
- Applicant must submit \$_____, to complete the basic filing fee and/or file a verified small entity statement claiming such status (37 CFR 1.27).
2. Additional claim fees of \$_____, including any multiple dependent claim fees, are required. Applicant must either submit the additional claim fees or cancel the additional claims for which fees are due.
3. The application was filed under 37 CFR 1.60. The copy of the executed oath or declaration from the prior application is missing. A copy of the oath or declaration filed to complete the prior application is required.
4. The application does not comply with the Sequence Rules. See attached "Notice to Comply with Sequence Rules 37CFR 1.821-1.825."
5. OTHER:

Direct the response and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the response.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202



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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
|--------------------|---------------------|-----------------------|---------------------------|
|--------------------|---------------------|-----------------------|---------------------------|

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION FILED UNDER 37 CFR 1.60
No Filing Date
(Enclosure to Form PTO-1534)

Required items 1-4 below SHOULD be filed, if possible, with any items required on the enclosed "Notice of Improper Application." If concurrent filing of all required items is not possible, the items listed below must be filed no later than TWO MONTHS from the filing date accorded this application. The filing date will be the date of receipt of the items required on the "Notice of Improper Application." If items 1 and 3 below are submitted after the filing date, THE PAYMENT OF A SURCHARGE OF \$_____ for a large entity small entity (in compliance with 37 CFR 1.27) is required (37 CFR 1.16(e)).

Applicant must file all the required items indicated below within TWO MONTHS from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

If all required items noted on this form and on the "Notice of Improper Application" are filed together, the total amount owed by applicant as a large entity small entity (verified statement filed) is \$_____.

1. The statutory basic filing fee is:
- missing.
 - insufficient.
- Applicant must submit \$_____ to complete the basic filing fee and/or file a verified small entity statement claiming such status (37 CFR 1.27).
2. Additional claim fees of \$_____, including any required multiple dependent claim fees, are required.
 Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
3. The application was filed under 37 CFR 1.60. The copy of the executed oath or declaration from the prior application is missing.
 A copy of the executed oath or declaration filed in the prior complete application is required.
4. The application does not comply with the Sequence Rules.
 See attached "Notice to Comply with Sequence Rules 37 CFR 1.821-1.825."
5. OTHER:

Direct the response and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the response.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1608 (REV. 7-96)

★ U.S. GPO: 1998-404-496/40535

PART 1-ATTORNEY/APPLICANT COPY



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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO./TITLE |
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DATE MAILED:

NOTICE OF IMPROPER FWC FILING UNDER 37 CFR 1.62
No Filing Date Granted

The above-identified application was deposited under 37 CFR 1.62 as a file wrapper continuing application, but is improper and has not been granted a filing date for reasons shown below:

The filing date will be the date of receipt of the items required below unless otherwise indicated, provided the items are filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. Any assertions that the items required below were submitted or are not necessary for a filing date must be by way of petition directed to the attention of the Office of Assistant Commissioner for Patents. Any such petition must be accompanied by the \$150.00 petition fee (37 CFR 1.17(i)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

All of the below-noted omissions and/or any petition must be submitted within TWO MONTHS of the date of this notice (37 CFR 1.181(f)) or the application may be returned or otherwise disposed of and the filing fee, if submitted, will be refunded less the \$130.00 handling fee (37 CFR 1.21(n)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.

1. The application does not include the correct application number, or serial number and filing date, of the prior application.
2. The application, which is not a continuation-in-part, was not filed by the same or less than all the inventors named in the prior application and no petition for correction of inventorship was filed.
3. The application does not identify the names of all the inventors (37 CFR 1.41 (a)). The application uses "et al" but only one inventor was named in the prior application.
4. The request does not include a signature of the inventor(s), assignee of the entire interest, or registered attorney or agent.
5. The application was not filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application:
- a) The issue fee was paid on the prior application on _____.
- b) The prior application was abandoned, or proceedings terminated on _____.
- c) The prior application was abandoned by the filing of application number on _____ on _____ under 37 CFR 1.62.

6. OTHER:

Direct the response and any questions about this notice to "Attention: Box Missing Parts."

A copy of this notice MUST be returned with the response.

Customer Service Center
 Initial Patent Examination Division (703) 308-1202

FORM PTO-1673 (REV 7-96)

PART 1-ATTORNEY/APPLICANT COPY

★ U.S. GPO: 1996-404-496/40524

601.02 Power of Attorney or Authorization of Agent

The attorney's or agent's full post office address (including ZIP code number) must be given in every power of attorney or authority of agent. The telephone number of the attorney or agent should also be included in the power. The prompt delivery of communications will thereby be facilitated.

Usually a power of attorney or authorization of agent is incorporated in the oath or declaration form. (See MPEP § 402.)

601.03 Change of Correspondence Address

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the Patent and Trademark Office of the new correspondence address (including ZIP code number). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See MPEP § 403 for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be filed in one of the applications affected, provided that the notice includes an authorization for the public to inspect and copy the original notice in the event one of the applications containing a copy matures into a patent and the application containing the original paper is either pending or has become abandoned. Alternatively, the paper containing the original signature may be retained by applicant. See MPEP § 502.02. The copies submitted in each affected application must identify where the original paper is located.

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application

filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR 1.63(d)(4).

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

The obligation (see 37 CFR 10.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

601.04 National Stage Requirements of the United States as a Designated Office

See MPEP Chapter 1800, especially MPEP § 1893.01 for requirements for entry into the national stage before the Designated Office or Elected Office under the Patent Cooperation Treaty (PCT).

602 Original Oath or Declaration

35 U.S.C. 25. Declaration in lieu of oath.

(a) The Commissioner may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Commissioner may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

35 U.S.C. 26. Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

35 U.S.C. 115. Oath of the applicant.

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. Such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in the title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

37 CFR 1.63. Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of an application must:

- (1) Be executed in accordance with either § 1.66 or § 1.68;
- (2) Identify the specification to which it is directed;
- (3) Identify each inventor by: full name, including the family name, and at least one given name without abbreviation together with any other given name or initial, and the residence, post office address and country of citizenship of each inventor; and
- (4) State whether the inventor is a sole or joint inventor of the invention claimed.

(b) In addition to meeting the requirements of paragraph (a), the oath or declaration must state that the person making the oath or declaration,

- (1) Has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;
- (2) Believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
- (3) Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

(c) In addition to meeting the requirements of paragraphs (a) and (b) of this section, the oath or declaration in any application in which a claim for foreign priority is made pursuant to § 1.55 must identify the foreign application for patent or inventor's certificate on which priority is claimed, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

(d)(1)A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

- (i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
- (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;
- (iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and
- (iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

- (i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and
- (ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney (or authorization of agent) or correspondence address was changed during the prosecution of the prior application, the change in power of attorney (or authorization of agent) or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney (or authorization of agent) or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application. The oath or declaration in any continuation-in-part application must also state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

37 CFR 1.68. Declaration in lieu of oath.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

18 U.S.C. 1001. Statements or entries generally.

Whoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than \$10,000 or imprisoned not more than five years, or both.

STATUTORY DECLARATIONS

Patent and Trademark Office personnel are authorized to accept a statutory declaration under 28 U.S.C. 1746 filed in the Patent and Trademark Office in lieu of an “oath” or declaration under 35 U.S.C. 25 and 37 CFR 1.68, provided that the statutory declaration otherwise complies with the requirements of law.

Section 1746 of Title 28 of the United States Code provides:

Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required to be supported, evidenced, established, or proved by sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1]If executed without the United States:

“I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature).”

[2]If executed within the United States its territories, possessions, or commonwealths:

“I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature).”

Oaths and declarations submitted in applications filed after May 1, 1975 must make reference to applications for inventor's certificates on which priority is claimed and any filed prior to the filing date of an application on which priority is claimed.

A 37 CFR 1.68 declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration. It must, however, since it is an integral part of the application, be maintained together therewith.

By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for “any document to be filed in the Patent and Trademark Office”.

The filing of a written declaration is acceptable in lieu of an original application oath that is informal.

If all foreign applications have been filed within 12 months of the U.S. filing date, applicant is required only

to recite the first such foreign application of which priority is claimed, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed prior to the application on which priority is claimed. It is required to give the foreign application number and name of the country or office in which filed, as well as the filing date of the first filed foreign application.

In the oath, the jurat must be filled out, and the word “sole” or “only” must appear if there is but one inventor, and “joint” if two or more inventors.

When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that he or she does verily believe himself or herself to be the original, first and joint inventor together with “A” or “A & B, etc.” as the facts may be.

A seal is usually impressed on an oath. See MPEP § 604 and § 604.01 and 37 CFR 1.66. However, oaths executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina, and Virginia need not be impressed with a seal.

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath or declaration is required, 37 CFR 1.67, MPEP § 603.

A provisional application does not require an oath or declaration to be complete. See 37 CFR 1.51(c).

The following form paragraphs may be used to indicate errors in the oath or declaration.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.01 Improper Execution

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.04 Sole or Joint Designation Omitted

It does not state whether the inventor is a sole or joint inventor of the invention claimed.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.05 “Reviewed and Understands” Statement Omitted

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.06 Original and First Omitted

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.07 Duty To Disclose Omitted

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.08 Identification of Foreign Applications Omitted

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.09 Duty To Disclose in C-I-P Omitted

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.15 Not in Permanent Ink

The [I] is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).

Examiner Note:

1. In bracket 1, insert either signature or oath/declaration.
2. This paragraph must be preceded by form paragraph 6.05.
3. If other portions of the disclosure are not in permanent ink, use form paragraph 6.32.

¶ 6.05.16 Non-Initialed/Non-Dated Alterations

Non-initialed and/or non - dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.17 Declaration Clause Omitted

The clause regarding “willful false statements ...” required by 37 CFR 1.68 has been omitted.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

Please type a plus sign (+) inside this box →

PTO/SB/01 (12-97)

Approved for use through 9/30/00. OMB 0651-0032

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

| | | |
|--|--------------------------|---|
| DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63) <input type="checkbox"/> Declaration Submitted with Initial Filing OR <input type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required) | Attorney Docket Number | |
| | First Named Inventor | |
| | <i>COMPLETE IF KNOWN</i> | |
| | Application Number | / |
| | Filing Date | |
| | Group Art Unit | |
| Examiner Name | | |

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

the specification of which *(Title of the invention)*

is attached hereto
OR
 was filed on (MM/DD/YYYY) as United States Application Number or PCT International Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

| Prior Foreign Application Number(s) | Country | Foreign Filing Date (MM/DD/YYYY) | Priority Not Claimed | Certified Copy Attached? | |
|-------------------------------------|---------|----------------------------------|--------------------------|--------------------------|--------------------------|
| | | | | YES | NO |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| | | | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

| Application Number(s) | Filing Date (MM/DD/YYYY) |
|-----------------------|--------------------------|
| | |

Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box →

PTO/SB/01 (12-97)

Approved for use through 9/30/00. OMB 0651-0032

Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C. 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

| U.S. Parent Application or PCT Parent Number | Parent Filing Date (MM/DD/YYYY) | Parent Patent Number (if applicable) |
|--|---------------------------------|--------------------------------------|
| | | |

 Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

 Customer Number OR Registered practitioner(s) name/registration number listed below

Place Customer Number Bar Code Label here

| Name | Registration Number | Name | Registration Number |
|------|---------------------|------|---------------------|
| | | | |

 Additional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB/02C attached hereto.
Direct all correspondence to: Customer Number or Bar Code Label OR Correspondence address below

| | | | |
|---------|-----------|-----|--|
| Name | | | |
| Address | | | |
| Address | | | |
| City | State | ZIP | |
| Country | Telephone | Fax | |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; 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 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: A petition has been filed for this unsigned inventor

| | |
|--|------------------------|
| Given Name (first and middle (if any)) | Family Name or Surname |
| | |

| | | | | | |
|----------------------|-------|---------|--|-------------|--|
| Inventor's Signature | | | | Date | |
| Residence: City | State | Country | | Citizenship | |
| Post Office Address | | | | | |
| Post Office Address | | | | | |
| City | State | ZIP | | Country | |

 Additional inventors are being named on the ___ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto

602.01 Oath Cannot Be Amended

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper and a new oath or declaration is not necessary.

For example, if the oath does not set forth evidence that the notary was acting within his or her jurisdiction at the time he or she administered the oath, a certificate of the notary that the oath was taken within his or her jurisdiction will correct the deficiency. See MPEP § 602 and § 604.02.

Applicant may be so advised by using Form Paragraph 6.03.

¶ 6.03 Oath, Declaration Cannot Be Amended

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

1. This form paragraph is intended primarily for use in **pro se** applications.
2. Use form paragraph 6.05 and one or more of form paragraphs 6.05.01 to 6.05.20 for a defective oath or declaration in a case where there is a power of attorney.

602.02 New Oath or Substitute for Original

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the application number and the date of filing. Any one of the combinations of information identified in MPEP § 601.01(a) as acceptable for an oath or declaration filed after the filing date may be used.

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

602.03 Defective Oath or Declaration

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that

the same be remedied. Applicant may be informed of deficiencies in the declaration or oath by Form Paragraphs 6.05 and 6.05.01 - 6.05.20.

The following Form Paragraph 6.05 must be used to introduce one or more of Form Paragraphs 6.05.01 - 6.05.20, which explain errors in the oath or declaration.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

However, when an application is otherwise ready for issue, an examiner with full signatory authority may waive the following minor deficiencies:

Minor deficiencies in the body of the oath or declaration where the deficiencies are self-evidently cured in the rest of the oath or declaration, as in an oath or declaration of plural inventors couched in plural terms except for use of “sole inventors” is asserted. *In re Searles*, 422 F.2d 431, 437, 164 USPQ 623, 628 (CCPA 1970).

If the above is waived, the examiner with full signatory authority should write in the margin of the declaration or oath a notation such as “Reference to the sole inventor rather than joint inventors waived; Application ready for issue.” and his or her initials and the date.

Of course, requirements of the statute, e.g., that the applicant state his or her citizenship or believes himself or herself to be the original and first inventor or that the oath be administered before a person authorized to administer oaths or that a declaration pursuant to 35 U.S.C. 25 or 28 U.S.C. 1746 contain the language required therein, cannot be waived.

If the defect cannot be waived, Form Paragraph 6.46 should be used when the application is allowable.

¶ 6.46 Application Allowed, Substitute Declaration Needed

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth [1]. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the “Notice of Allowability” (PTOL-37 or PTO-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the following in the upper right hand corner: Issue Batch Number, date of the “Notice of Allowance” (PTOL-85), and application number.

Examiner Note:

In the bracket, insert appropriate information, e.g., --in this communication--, --in the Office action mailed _____--, or --in the PTO-152 attached to Paper No. ____--.

602.04 Foreign Executed Oath

An oath executed in a foreign country must be properly authenticated. See MPEP § 604 and 37 CFR 1.66.

Where the authority of the foreign officer is not certified, Form Paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.13 may be used.

¶ 6.05.13 Authority of Foreign Officer Not Certified

It does not include an apostille, a consular certificate, or the position of authority of the officer signing an apostille or consular certificate, see 37 CFR 1.66(a).

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

602.04(a) Foreign Executed Oath Is Ribbioned to Other Application Papers

37 CFR 1.66. *Officers authorized to administer oaths.*

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribbioned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Where the papers are not properly ribbioned, use Form Paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.14.

¶ 6.05.14 No Ribbon Properly Attached

It does not have a ribbon properly attached.

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

U.S. ACCESSION TO HAGUE CONVENTION ABOLISHING THE REQUIREMENT OF LEGALIZATION FOR FOREIGN PUBLIC DOCUMENTS

On Oct. 15, 1981, the Hague "Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries as parties to the Convention. Subsequently, additional countries have become parties to the Convention. The Convention applies to any document submitted to the United States Patent and Trademark Office for filing or recording, which is sworn to or acknowledged by a notary public in any one of the member countries. The Convention abolishes the certification of the authority of the notary public in a member country by a diplomatic or consular officer of the United States and substitutes certification by a special certificate, or apostille, executed by an officer of the member country. Accordingly, the Office will accept for filing or recording a document sworn to or acknowledged before a notary public in a member country if the document bears, or has appended to it, an apostille certifying the notary's authority. The requirement for a diplomatic or consular certificate, specified in 37 CFR 1.66, will not apply to a document sworn to or acknowledged before a notary public in a member country if an apostille is used.

The member countries that are parties to the Convention are:

Andorra, Angola¹, Anguilla, Antigua and Barbuda, Argentina, Armenia², Aruba, Australia, Austria, Bahamas, Barbados, Belarus², Belgium, Belize, Bermuda, Bosnia-Herzegovina³, Botswana, British Antarctic Territory, British Virgin Islands, Brunei, Cayman Islands, Comoros Islands (formerly Moroni)¹, Croatia³, Cyprus, Djibouti (formerly Affars and Issas)¹, Dominica¹, El Salvador, Falkland Islands, Fiji, Finland, France, French Guiana, French Polynesia, Guadeloupe, Germany, Gibraltar, Greece, Grenada¹, Guernsey (Bailiwick of), Hong Kong, Hungary, Isle of Man, Israel, Italy, Japan, Jersey (Bailiwick of), Kiribati (formerly Gilbert Islands)¹, Latvia, Lesotho, Liechtenstein, Luxembourg, Macedonia³, Malawi, Malta, Marshall Islands, Martinique, Mauritius, Mexico, Montserrat, Mozambique¹, Netherlands, Netherlands Antilles (Curaçao, Bonaire, St. Martin, St. Eustatius and Saba), New Caledonia, Norway, Panama, Portugal, Reunion, Russian Federation², St. Christopher (Kitts) and Nevis, St. Georgia and South Sandwich Islands, St. Helena, St. Lucia, St. Pierre and Miquelon, St. Vincent and the Grenadines, San Marino, Seychelles, Slovenia³, Solomon Islands (formerly British Solomon Islands)¹, South Africa, Spain, Suriname,

Swaziland, Switzerland, Tonga, Turkey, Turks and Caicos, Tuvalu (formerly Ellice Islands)¹, United Kingdom, United States, Vanuatu (formerly New Hebrides)¹, Wallis and Futuna.

The Convention prescribes the following form for the apostille:

Model of Certificate

The certificate will be in the form of a square with sides at least 9 centimeters long.

| APOSTILLE (Convention de La Haye du Oct. 5, 1961) | |
|---|----------------------|
| 1. Country | |
| This public document | |
| 2. has been signed by | |
| 3. acting in the capacity of | |
| 4. bears the seal/stamp of | |
| Certified | |
| 5. at | |
| 6. the | |
| 7. by | |
| 8. No. | |
| 9. Seal/stamp: | 10. Signature: |
| | |

Note that a declaration in lieu of application oath (37 CFR 1.68) need not be ribboned to the other papers. It must, however, be maintained together therewith.

602.05 Oath or Declaration — Date of Execution

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale (that is when the date of execution is more than 3 months prior to the filing date of the applica-

tion) or where the date of execution has been omitted. However, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56.

602.05(a) Oath or Declaration in Continuation and Divisional Applications [R-1]

A continuation or divisional application filed under 37 CFR 1.53(b) (other than a continuation-in-part (CIP)) may be filed with a copy of the oath or declaration from the prior nonprovisional application. See 37 CFR 1.63(d)(1)(iv).

A copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application even if the oath or declaration identifies the application number of the prior application. However, if such a copy of the oath or declaration is filed after the filing date of the continuation or divisional application and an application number has been assigned to the continuation or divisional application (see 37 CFR 1.5(a)), the cover letter accompanying the oath or declaration should identify the application number of the continuation or divisional application. The cover letter should also indicate that the oath or declaration submitted is a copy of the oath or declaration from a prior application to avoid the oath or declaration being incorrectly matched with the prior application file. Furthermore, applicant should also label the copy of the oath or declaration with the application number of the continuation or divisional application in the event that the cover letter is separated from the copy of the oath or declaration.

A copy of the oath or declaration from a prior nonprovisional application may be filed in a continuation or divisional application even if the specification for the continuation or divisional application is different from that of the prior application, in that revisions have been made to clarify the text or other changes have been made provided the changes do not constitute new matter relative to the prior application. If the examiner determines that the continuation or divisional application contains new matter relative to the prior application, the examiner should >so< notify the applicant in the next Office action * >. The examiner should also (1) require< a new oath or declaration

¹This country achieved independence. No declaration has been made on the continuation in force of the Convention.

²On September 4, 1991, the Union of Soviet Socialist Republics (USSR) deposited an instrument of accession to the Convention. The Convention was to have entered into force for the USSR on April 1, 1992. Prior to that date, the USSR dissolved. Three members of the Newly Independent States (NIS), the Russian Federation, the Belarus Republic and Armenia have informed the depositary for the Convention that the Convention applies in those jurisdiction. It is not clear whether other NIS countries are applying the Convention. Even if other NIS countries were to consider the Convention to apply, it may not be operational. Each jurisdiction must designate an authority competent to issue the Convention certificate (apostille) before the Convention can be operational.

³Former Yugoslavia was a party to the Convention. Slovenia, Macedonia, Bosnia-Herzegovina and Croatia have informed the depositary that they consider the Convention to apply and have designated a competent authority to issue the Convention certificate (apostille).

**>along with the< surcharge set forth in 37 CFR 1.16(e) **>; (2) require a petition under 37 CFR 1.182 with the required petition fee, requesting that the copy of the oath or declaration filed with the application be disregarded and the application be treated as an application filed without an oath or declaration under 37 CFR 1.53(f); and (3) indicate< that the application should be redesignated as a continuation-in-part.

A continuation or divisional application of a prior application accorded status under 37 CFR 1.47 will be accorded status under 37 CFR 1.47 if a copy of the decision according 37 CFR 1.47 status in the prior application is filed in the continuation or divisional application, unless an oath or declaration signed by all of the inventors is included upon filing the continuation or divisional application. An oath or declaration in an application accorded status under 37 CFR 1.47 is generally not signed by all of the inventors. Accordingly, if a copy of an oath or declaration of a prior application is submitted in a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration omits the signature of one or more inventors, the Office of Initial Patent Examination (OIPE) should send a "Notice to File Missing Parts" requiring the signature of the nonsigning inventor, unless a copy of the decision according status under 37 CFR 1.47 is also included at the time of filing of the continuation or divisional application. If OIPE mails such a Notice, a copy of the decision according status under 37 CFR 1.47, together with a surcharge under 37 CFR 1.16(e) for its late filing, will be an acceptable reply to the Notice. Alternatively, applicant may submit an oath or declaration signed by the previously nonsigning inventor together with the surcharge set forth in 37 CFR 1.16(e) in reply to the Notice.

If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under 37 CFR 1.53(b), the continuation or divisional application may either be filed (1) with a copy of an oath or declaration from a prior application and a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application (see 37 CFR 1.63(d)), or (2) a newly executed oath or declaration naming the correct inventive entity. If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under 37 CFR 1.53(d), the request for filing the continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application (see 37 CFR 1.53(d)(4)).

A continuation or divisional application filed under 37 CFR 1.53(b) of a prior application in which a petition

under 37 CFR 1.48 to add an inventor was filed should be filed with a copy of the executed declaration naming the correct inventive entity from the prior application or a newly executed declaration naming the correct inventive entity. A copy of any decision under 37 CFR 1.48 from the prior application is not required to be filed in the continuation or divisional application.

602.06 Non-English Oath or Declaration

37 CFR 1.69. Foreign language oaths and declarations.

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is a form provided or approved by the Patent and Trademark Office, it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

37 CFR 1.69 requires that oaths and declarations be in a language which is understood by the individual making the oath or declaration, i.e., a language which the individual comprehends. If the individual comprehends the English language, he or she should preferably use it. If the individual cannot comprehend the English language, any oath or declaration must be in a language which the individual can comprehend. If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him or her so that he or she is able to understand them.

The Office will accept a single non-English language oath or declaration where there are joint inventors, of which only some understand English but all understand the non-English language of the oath or declaration.

602.07 Oath or Declaration Filed in United States as a Designated Office

See MPEP § 1893.01.

603 Supplemental Oath or Declaration

37 CFR 1.67. Supplemental oath or declaration.

(a) A supplemental oath or declaration meeting the requirements of § 1.63 may be required to be filed to correct any deficiencies or inaccuracies present in an earlier filed oath or declaration.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment

which includes new matter. No new matter may be introduced into a non-provisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c) A supplemental oath or declaration meeting the requirements of § 1.63 must also be filed if the application was altered after the oath or declaration was signed or if the oath or declaration was signed: (1) In blank; (2) Without review thereof by the person making the oath or declaration; or (3) Without review of the specification, including the claims, as required by § 1.63(b)(1).

37 CFR 1.67 requires in the supplemental oath or declaration substantially all the data called for in 37 CFR 1.63 for the original oath or declaration. As to the purpose to be served by the supplemental oath or declaration, the examiner should bear in mind that it cannot be availed of to introduce new matter into an application.

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, it is possible that the requirement may be suspended or waived in accordance with 37 CFR 1.183.

A new oath may be required by using Form Paragraph 6.06.

¶ 6.06 *New Oath for Subject Matter Not Originally Claimed*

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP § 608.01(d) and 1302, and 37 CFR 1.73.

603.01 Supplemental Oath or Declaration Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 F. 158 (2d Cir. 1921), many supplemental oaths and declarations covering the claims in the case have been filed after the case is allowed. Such oaths and declarations may be filed as a matter of right and when received they will be placed in the file by the Office of Patent Publication, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under 37 CFR 1.312, since they make no change in the wording of the papers on file. See MPEP § 714.16.

604 Administration or Execution of Oath

37 CFR 1.66. *Officers authorized to administer oaths.*

(a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country, may be made before any diplomatic or consular officer of

the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

See MPEP § 602.04(a) for foreign executed oath.

604.01 Seal

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his or her official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in MPEP § 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the examiner should require proof of authority. Depending on the jurisdiction, the seal may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

See also MPEP § 602.04(a) on foreign executed oath and seal. In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina, and Virginia.

¶ 6.05 *Oath or Declaration Defective, Heading*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.11 *Notary Signature*

It does not include the notary's signature, or the notary's signature is in the wrong place.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.12 *Notary Seal and Venue Omitted*

It does not include the notary's seal and venue.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

604.02 Venue

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on the oath. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given either in the venue or in the body of the jurat. Otherwise, a new oath or declaration, or a certificate of the notary that the oath was taken within his or her jurisdiction, must be required. *Ex parte Delavoye*, 1906 C.D. 320, 124 O.G. 626 (Comm'r Pat. 1906); *Ex parte Irwin*, 1928 C.D. 13, 367 O.G. 701 (Comm'r Pat. 1928).

Form Paragraph 6.07 may be used where the venue is not shown.

¶ 6.07 Lack of Venue

The oath lacks the statement of venue. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by application number and filing date, or a certificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Where the seal and venue differ, applicant should be notified by using the "Notice of Informal Application" form.

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

- (A) All judge advocates of the Army and Air Force;
- (B) All law specialists;
- (C) All summary courts-martial;
- (D) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;

(E) All commanding officers of the Navy and Coast Guard;

(F) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and

(G) All other persons designated by regulations of the armed forces or by statute.

(H) The signature without seal of any such person acting as notary, together with the title of his office, shall be *prima facie* evidence of his authority.

604.04 Consul

On Oct. 15, 1981, the "Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries as parties to the Convention. Subsequently, additional countries have become parties to the conventions. See MPEP § 604.04(a).

When the oath is made in a foreign country not a member of the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. See 37 CFR 1.66, MPEP § 604. This proof may be through an intermediary, e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

604.04(a) Consul – Omission of Certificate

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer of the United States and whose authority is not authenticated or accompanied with an apostille certifying the notary's authority (see MPEP § 602.04(a)), the application is nevertheless accepted for purposes of examination. The examiner, in the first Office action, should note this informality and require authentication of the oath by an appropriate diplomatic or consular officer, the filing of proper apostille, or a declaration (37 CFR 1.68).

Form Paragraph 6.08 may be used to notify applicant.

¶ 6.08 Consul-Omission of Certificate

The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. If, however, authentication of the original oath is desired, applicant should request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the

oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent and Trademark Office. See MPEP §§ 602.01 and 602.02.

At the time of the next Office action, the request for return of the oath, together with the application file and the copy of the oath, is submitted to the Group Director. If the request is approved by the Group Director, the oath will be returned to the applicant by the examining group. A copy of the original oath will be retained in the file.

604.06 By Attorney in Case

The language of 37 CFR 1.66 and 35 U.S.C. 115 is such that an attorney in the case is not barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his or her authority and jurisdiction and will not knowingly jeopardize his or her client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action is to require a new oath or declaration and refer the file to the Office of Enrollment and Discipline. (*Riegger v. Beierl*, 1910 C.D. 12, 150 O.G. 826 (Comm'r Pat. 1910)). See 37 CFR 1.66 and MPEP § 604.

605 Applicant [R-1]

37 CFR 1.41. Applicant for patent.

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by § 1.51(c)(1). If a cover sheet as prescribed by § 1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(c), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(q) is filed supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by § 1.63 or a provisional application filed without a cover sheet as prescribed by § 1.51(c)(1), the name or names of person or persons believed to be the actual inventor or inventors should be provided for identification purposes when the application papers pursuant to § 1.53(b) or (c) are filed. If no name of a person believed to be an actual inventor is so provided, the application should include an applicant identifier consisting of alphanumeric characters.

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43, or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may file an application for patent on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

37 CFR 1.45. Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

>

(1) They did not physically work together or at the same time,<

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

37 CFR 1.41 and 37 CFR 1.53 were amended effective December 1, 1997, to remove the requirement that the name(s) of the inventor(s) be identified in the application papers in order to accord the application a filing date. 37 CFR 1.41(a)(1) now defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63, except as provided for in 37 CFR 1.53(d)(3) and 37 CFR 1.63(d). The oath or declaration may be filed on the filing date of the application or on a later date. If an oath or declaration is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to 37 CFR 1.53(b), unless a petition under 37 CFR 1.41(a) accompanied by the fee set forth in 37 CFR 1.17(i) is filed supplying the name or names of the inventor or inventors.

Where no inventor(s) is named on filing, the Office requests that an alphanumeric identifier be submitted for the application. The use of very short identifiers should be avoided to prevent confusion. Without supplying at least a unique identifying name the Office may have no ability or only a delayed ability to match any papers submitted after filing of the application and before issuance of an identifying application number with the application file. Any identifier used that is not an inventor's name should be specific, alphanumeric characters of reasonable length, and should

be presented in such a manner that it is clear to application processing personnel what the identifier is and where it is to be found. It is strongly suggested that applications filed without an executed oath or declaration under 37 CFR 1.63 or 37 CFR 1.175 include the name of the person(s) believed to be the inventor for identification purposes. Failure to apprise the Office of the application identifier being used may result in applicants having to resubmit papers that could not be matched with the application and proof of the earlier receipt of such papers where submission was time dependent.

For correction of inventorship, see MPEP § 201.03.

37 CFR 1.46. Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

This section concerns filing by the actual inventor. If the application is filed by another, see MPEP § 409.03.

For assignments of application by inventor, see MPEP § 301. For an inventor who is dead or insane, see MPEP § 409.

605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant, in a nonprovisional application, to state his or her citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement, but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

Form Paragraphs 6.05 and 6.05.03 may be used to notify applicant that the applicant's citizenship is omitted.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.03 Citizenship Omitted

It does not identify the citizenship of each inventor.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05

605.02 Applicant's Residence [R-1]

Applicant's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with 37 CFR 1.63. In the case of an applicant who is in one of the U.S. Armed Services, a statement to that effect is sufficient as to residence. For change of residence, see MPEP § 719.02(b). Applicant's residence must be included on the cover sheet for a provisional application.

If the residence is not included in the oath or declaration as filed, the Office of Initial Patent Examination (OIPE) will normally so indicate on a form PTO-152, "Notice of Informal Application," so as to require a new oath or declaration when the form is sent out with an Office action. If the examiner notes that the residence has not been included in the oath or declaration, Form Paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.02 should be used.

¶ 6.05.02 Residence Omitted

It does not identify the city and either state or foreign country of residence of each inventor.

Examiner Note:

* This paragraph must be preceded by form paragraph 6.05.

605.03 Applicant's Post Office Address

For nonprovisional applications filed prior to December 1, 1997, each applicant's post office address was required by 37 CFR 1.33(a) to be supplied on the oath or declaration, if not stated elsewhere in the application. Effective December 1, 1997, 37 CFR 1.63 has been amended to require the post office address of each inventor to be stated in the oath or declaration. Applicant's post office address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the post office address. The post office address should include the ZIP Code designation.

The object of requiring each applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

If an oath or declaration was filed prior to December 1, 1997 and the post office address was incomplete or omitted from the oath or declaration, attachment form PTO-152, "Notice of Informal Application" or Form Paragraph

6.09.01 may be used to notify applicant of the deficiency of the post office address.

¶ 6.09.01 Post Office Address Omitted, Residence Given

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Examiner Note:

1. This form paragraph should only be used where the Post Office address has been omitted in an oath or declaration filed prior to December 1, 1997. Use form paragraphs 6.05 and 6.05.19 if the oath or declaration was filed on or after December 1, 1997.
2. If both the post office address and residence are incomplete, not uniform or omitted, use form paragraphs 6.05 and 6.05.02.

Oaths or declarations filed on or after December 1, 1997 must include the post office address of each inventor. 37 CFR 1.63(a)(3). The Office of Initial Patent Examination (OIPE) will normally indicate the omission of an inventor's post office address on attachment form PTO-152, "Notice of Informal Application," requiring a new oath or declaration when the form is sent out with an Office action. If the examiner notes that the post office address has not been included in an oath or declaration filed on or after December 1, 1997, other than a copy of an oath or declaration from a prior application which complied with 37 CFR 1.63 at the time that it was originally filed, Form Paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.19 may be used to notify applicant that the post office address has been omitted from the oath or declaration.

¶ 6.05.19 Post Office Address Omitted

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

605.04(a) Applicant's Signature and Name [R-1]

37 CFR 1.64. Person making oath or declaration.

(a) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, or 1.47.

(b) If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state.

EXECUTION OF OATHS OR DECLARATIONS OF PATENT APPLICATIONS

United States patent applications which have not been prepared and executed in accordance with the requirements of Title 35 of the United States Code and Title 37 of the Code of Federal Regulations may be abandoned. Although

the statute and the rules have been in existence for many years, the Office continues to receive a number of applications which have been improperly executed and/or filed. Since the improper execution and/or filing of patent applications can ultimately result in a loss of rights, it is appropriate to emphasize the importance of proper execution and filing.

It is improper for an applicant to sign an oath or declaration which is not attached to or does not identify a specification and/or claims.

Attached does not necessarily mean that all the papers must be literally fastened. It is sufficient that the specification, including the claims, and the oath or declaration are physically located together at the time of execution. Physical connection is not required. Copies of declarations are accepted. See MPEP § 502.01 and § 502.02.

The provisions of 35 U.S.C. 363 for filing an international application under the Patent Cooperation Treaty (PCT) which designates the United States and thereby has the effect of a regularly filed United States national application, except as provided in 35 U.S.C. 102(e), are somewhat different than the provisions of 35 U.S.C. 111. The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.497.

37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121."

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant. This provision should particularly be brought to the attention of foreign applicants by their United States counsel since the United States law and practice in this area may differ from that in other countries.

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether noninitialed and/or nondated alterations were made before or after signing of the oath or

declaration but will require a new oath or declaration. Form Paragraph 6.02.01 may be used to call noninitialed and/or nondated alterations to applicant's attention.

¶ 6.02.01 *Non-Initialed and/or Non-Dated Alterations in Application Papers*

The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required.

The signing and execution by the applicant of oaths or declarations in certain >continuation or divisional< applications may be omitted*. See< MPEP § 201.06 and § 201.07.

For the signature on a reply, see MPEP § 714.01(a) to § 714.01(d).

>EXECUTION OF OATH OR DECLARATION ON BEHALF OF INVENTOR

The oath or declaration required by 35 U.S.C. 115 must be signed by all of the actual inventors, except under limited circumstances. 35 U.S.C. 116 provides that joint inventors can sign on behalf of an inventor who cannot be reached or refuses to join. See MPEP § 409.03(a). 35 U.S.C. 117 provides that the legal representative of a deceased or incapacitated inventor can sign on behalf of the inventor. See MPEP § 409.01 and § 409.02. 35 U.S.C. 118 provides that a party with proprietary interest in the invention claimed in an application can sign on behalf of the inventor, if the inventor cannot be reached or refuses to join in the filing of the application. See MPEP § 409.03(b) and § 409.03(f). The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so. *Opinion of Hon. Edward Bates*, 10 Op. Atty. Gen. 137 (1861). See also *Staeger v. Commissioner of Patents and Trademarks*, 189 USPQ 272 (D.D.C. 1976) and *In re Striker*, 182 USPQ 507 (PTO Solicitor 1973) (In each case, an oath or declaration signed by the attorney on behalf of the inventor was defective because the attorney did not have a proprietary interest in the invention.).<

605.04(b) One Full Given Name Required

37 CFR 1.63(a)(3) requires that each inventor be identified by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial in the oath or declaration. For example, if the applicant's full name is "John Paul Doe," either "John P. Doe" or "J. Paul Doe" is acceptable.

Form Paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.18 may be used to notify applicant that the oath or declaration is defective because the full given name of each inventor has not been adequately stated.

¶ 6.05.18 *Full Given Name Is Not Set Forth*

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

In an application where the name is typewritten with a *middle name* or *initial*, but the signature is without such middle name or initial, the typewritten version of the name will be used. Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee. The petition should be directed to the attention of the Office of Petitions. Upon granting of the petition, the application should be sent to the Office of Initial Patent Examination (OIPE) for correction of its records, unless the application is an 09/ series application, in which case the application should be sent to the assigned examining group for correction to the PALM bib-data sheet by the examining group's technical support staff. If the application is assigned, it will be forwarded by OIPE or the examining group's technical support staff to the Assignment Division for a change in the assignment record.

When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. The Patent and Trademark Office should simply be notified of the error and reference to the notification paper will be made on the previously filed oath or declaration by the Office.

When any correction or change is effected, the file should be sent to OIPE for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. ___ for inventorship changes." See MPEP §§ 201.03 and 605.04(g).

605.04(c) Inventor Changes Name

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. The petition should be directed to the attention of the Office of Petitions. The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

If the petition is granted, the application should be sent to the Office of Initial Patent Examination (OIPE) for change of name on the file wrapper and in the PALM data-

base, unless the application is an 09/ series application, in which case the application should be sent to the assigned examining group for correction to the PALM bib-data sheet by the examining group's technical support staff. If the application is assigned, applicant should submit a corrected assignment document along with a cover sheet and the recording fee as set forth in 37 CFR 1.21(h) to the Assignment Division for a change in the assignment record.

605.04(d) Applicant Unable to Write

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

605.04(e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr.", in connection with his signature. The title will not appear in the printed patent.

605.04(f) Signature on Joint Applications - Order of Names

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration.

In those instances where the joint applicants file separate oaths or declarations, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing.

605.04(g) Correction of Inventorship

When the Office is notified of a typographical or transliteration error in the spelling of an inventor's name, or a petition is granted approving a correction or a change in the order of the names of the inventors, or inventors are added or deleted under 37 CFR 1.48, the change should be noted in red ink in the left margin of the original oath or declara-

tion. The notation should read "See Paper No. ____ for inventorship changes." The application (other than 09/ series applications) should be sent to the Office of Initial Patent Examination (OIPE) for correction on the file wrapper label and the PALM database regarding the inventorship. A brief explanation on an "Application Division Data Base Routing Slip" (available from the examining group technical support staff) should accompany the application file to OIPE. For 09/ series applications, the examiner should have the examining group's technical support staff enter the correction in the PALM database and print a new PALM bib-data sheet, which will then be placed in the file wrapper.

605.05 Administrator, Executor, or Other Legal Representative

In an application filed by a legal representative of the inventor, the specification should not be written in the first person.

For prosecution by administrator or executor, see MPEP § 409.01(a).

For prosecution by heirs, see MPEP § 409.01(a) and § 409.01(d).

For prosecution by representative of legally incapacitated inventor, see MPEP § 409.02.

For prosecution by other than inventor, see MPEP § 409.03.

605.07 Joint Inventors [R-1]

35 U.S.C. 116. Inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

35 U.S.C. 116, as amended by Public Law 98-622, recognizes the realities of modern team research. A research project may include many inventions. Some inventions may have contributions made by individuals who are not involved in other, related inventions.

35 U.S.C. 116 allows inventors to apply for a patent jointly even though

(A) they did not physically work together or at the same time,

(B) each did not make the same type or amount of contribution, or

(C) each did not make a contribution to the subject matter of every claim of the patent.

Items (A) and (B) adopt the rationale stated in decisions such as *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967).

Item (C) adopts the rationale of cases such as *SAB Industrie AB v. Bendix Corp.*, 199 USPQ 95 (E.D. Va. 1978).

With regard to item (A), see *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co.*, 973 F.2d 911, 916-17, 23 USPQ 2d 1921, 1925-26 (Fed. Cir. 1992) (some quantum of collaboration or connection is required in order for persons to be “joint” inventors under 35 U.S.C. 116, and thus individuals who are completely ignorant of what each other has done until years after their individual independent efforts cannot be considered joint inventors).

Like other patent applications, jointly filed applications are subject to the requirements of 35 U.S.C. 121 that an application be directed to only a single invention. If more than one invention is included in the application, the examiner may require the application to be restricted to one of the inventions. In such a case, a “divisional” application complying with 35 U.S.C. 120 would be entitled to the benefit of the earlier filing date of the original application.

It is possible that different claims of an application or patent may have different dates of inventions even though the patent covers only one independent and distinct invention within the meaning of 35 U.S.C. 121. When necessary, the Patent and Trademark Office or a court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

GUIDELINES

37 CFR 1.45. Joint inventors.

(b) Inventors may apply for a patent jointly even though

- (1) They did not physically work together or at the same time,
- (2) Each inventor did not make the same type or amount of contribution, or
- (3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

Since provisional applications may be filed without claims, 37 CFR 1.45(c) states that each inventor named in a joint provisional application must have made a contribution to the subject matter disclosed in the application.

The significant features resulting from the amendments to 35 U.S.C. 116 by Public Law 98-622 are the following:

(A) The joint inventors do not have to separately “sign the application,” but only need apply for the patent jointly and make the required oath or declaration by signing the same; this is a clarification, but not a change in current practice.

(B) Inventors may apply for a patent jointly even though “they did not work together or at the same time,” thereby clarifying (a) that it is not necessary that the inventors physically work together on a project, and (b) that one inventor may “take a step at one time, the other an approach at different times.” (*Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967)).

(C) Inventors may apply for a patent jointly even though “each did not make the same type or amount of contribution,” thereby clarifying the “fact that each of the inventors play a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem.” *Monsanto Co. v. Kamp*, 269 F. Supp. at 824, 154 USPQ at 262.

(D) Inventors may apply for a patent jointly even though “each did not make a contribution to the subject matter of every claim of the patent.”

(E) Inventors may apply for a patent jointly as long as each inventor made a contribution, i.e., was an inventor or joint inventor, of the subject matter of at least one claim of the patent; there is no requirement that all the inventors be joint inventors of the subject matter of any one claim.

(F) If an application by joint inventors includes more than one independent and distinct invention, restriction may be required with the possible result of a necessity to change the inventorship named in the application if the elected invention was not the invention of all the originally named inventors.

(G) The amendment to 35 U.S.C. 116 increases the likelihood that different claims of an application or patent may have different dates of invention; when necessary the Office or court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

Pending nonprovisional applications will be permitted to be amended by complying with 37 CFR 1.48 to add claims to inventions by inventors not named when the application was filed as long as such inventions were disclosed in the application as filed since 37 CFR 1.48 permits correction of inventorship where the correct inventor or inventors are not named in an application for patent through error without any deceptive intention on the part of the person being added as an inventor. This is specially covered in 37 CFR 1.48(c).

Under 35 U.S.C. 116, an examiner may reject claims under 35 U.S.C. 102(f) only in circumstances where a named inventor is not the inventor of at least one claim in the application; no rejection under 35 U.S.C. 102(f) is appropriate if a named inventor made a contribution to the invention defined in any claim of the application.

Under 35 U.S.C. 116, considered in conjunction with 35 U.S.C. 103(c), a rejection may be appropriate under 35 U.S.C. 102(f)/103 where the subject matter, i.e., prior art, and the claimed invention were not owned by, or subject to an obligation of assignment to, the same person at the time the invention was made.

Applicants are responsible for correcting, and are required to correct, the inventorship in compliance with 37 CFR 1.48 when the application is amended to change the claims so that one (or more) of the named inventors is no longer an inventor of the subject matter of a claim remaining in the application.

In requiring restriction in an application filed by joint inventors, the examiner should remind applicants of the necessity to correct the inventorship pursuant to 37 CFR 1.48 if an invention is elected and the claims to the invention of one or more inventors are canceled.

The examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until *it becomes necessary* to do so in order to properly examine the application.

If an application is filed with joint inventors, the examiner should assume that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, unless there is evidence to the contrary. If inventors of subject matter, not commonly owned at the time of the later invention, file a joint application, applicants have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made in order that the examiner may consider the applicability of >35 U.S.C. 102(e)/103, <35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103. The examiner should assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure. It should be pointed out that 35 U.S.C. 119(a) benefit may be claimed to any foreign application as long as the U.S. named inventor was the inventor of the foreign application invention and 35 U.S.C. 119(a)-(d) requirements are met. Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, the U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the foreign applications provided all the requirements of 35 U.S.C. 119(a)-(d) are met. One of the conditions for benefit under 35 U.S.C. 119(a) is that the foreign application must be for

“the same invention” as the application in the United States. Therefore, a claim in the U.S. application which relies on the combination of prior foreign applications may not be entitled to the benefit under 35 U.S.C. 119(a) if the subject matter of the claim is not sufficiently disclosed in the prior foreign application. *Cf. Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997). For example:

If foreign applicant A invents X and files a foreign application; foreign applicant B invents Y and files separate foreign application. A+B combine inventions X+Y and A and B are proper joint inventors under 35 U.S.C. 116 and file U.S. application to X+Y. The U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the foreign applications provided the requirements of 35 U.S.C. 119(a)-(d) are met.

606 Title of Invention

37 CFR 1.72. *Title and abstract.*

(a) The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

606.01 Examiner May Require Change in Title

Where the title is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. Form Paragraphs 6.11 and 6.11.01 may be used.

¶ 6.11 Title of Invention Is Not Descriptive

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Examiner Note:

If a change in the title of the invention is being suggested by the examiner, follow with form paragraph 6.11.01.

¶ 6.11.01 Title of Invention, Suggested Change

The following title is suggested: “ [1]”

This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the examiner may, at the time of allowance, change the title by examiner's amendment or by initialing, in red ink, either the face of the file wrapper or, for 09/ series applications, the PALM bib-data sheet.

If a change in title is the only change being made by the examiner at the time of allowance, a separate examiner's amendment need not be prepared. The change in title will be incorporated in the notice of allowance. This will be accomplished by placing an “X” in the designated box on

the notice of allowance form and entering thereunder the title as changed by the examiner.

However, if an examiner's amendment must be prepared for other reasons, any change in title will be incorporated therein.

Inasmuch as the words "improved," "improvement of," and "improvement in" are not considered as part of the title of an invention, the Patent and Trademark Office does not include these words at the beginning of the title of the invention.

607 Filing Fee

Patent application filing fees are set in accordance with 35 U.S.C. 41 and are listed in 37 CFR 1.16.

See MPEP § 608.01(n) for multiple dependent claims.

When filing a nonprovisional application, a basic fee entitles applicant to present 20 claims including not more than 3 claims in independent form. If claims in excess of the above are included at the time of filing, an additional fee is required for each independent claim in excess of three, and a fee is required for each claim in excess of 20 claims (whether independent or dependent). Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers, 37 CFR 1.75(c), and a separate fee is required in each application containing a proper multiple dependent claim. For an improper multiple dependent claim, the fee charged is that charged for a single dependent claim.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required.

The Office of Initial Patent Examination (OIPE) has been authorized to accept all applications, otherwise acceptable, if the basic fee is submitted, and to require payment of the deficiency within a stated period upon notification of the deficiency.

Amendments before the first action, or not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive thereto and the practice set forth in MPEP § 714.03 will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim or adds to the number of claims referred to in a multiple dependent claim, and the replacement of a claim by a claim of the same type, unless

it is a multiple dependent claim which refers to more prior claims, do not require any additional fees.

For purposes of determining the fee due the Patent and Trademark Office, a claim will be treated as dependent if it contains reference to one or more other claims in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact, is not a proper dependent claim, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancelation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, nonelected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

An amendment canceling claims accompanying the papers constituting the application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment. However, unentered claims will not be counted when calculating the fee due in subsequent amendments.

Amendments affecting the claims cannot serve as the basis for granting any refund.

See MPEP § 1415 for reissue application fees.

607.02 Returnability of Fees

37 CFR 1.26. Refunds.

(a) Any fee paid by actual mistake or in excess of that required will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account.

(b) [Reserved]

(c) If the Commissioner decides not to institute a reexamination proceeding, a refund of \$1,690 will be made to the requester of the proceeding. Reexamination requesters should indicate whether any refund should be made by check or by credit to a deposit account.

Since 37 CFR 1.26(a) precludes refund of an application filing fee when applicant desires to withdraw an applica-

tion, any request by applicant not to process or charge an application filing fee because the application was not intended to be filed must be in the form of a petition under 37 CFR 1.183 requesting suspension of the rules to the extent that the filing fee not be processed or charged. Any such petition must include the fee set forth in 37 CFR 1.17(h) and must be accompanied by an express abandonment of the application in accordance with 37 CFR 1.138. In order for such a petition to be granted, it must ordinarily be filed and acted upon prior to the date on which the application filing fee is processed or charged by the Office with regard to the application.

All questions pertaining to the return of fees are referred to the Refunds Section of the Receipts Division of the Office of Finance. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases. Such questions may also be treated, to the extent appropriate, in decisions on petition decided by various Patent and Trademark Office officials.

608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which protection is sought. All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. See also 37 CFR 1.121, subsections (a)(6) and (b)(2)(iii) and MPEP § 608.04.

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

The examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

For design application practice, see MPEP § 1504.

608.01 Specification [R-1]

35 U.S.C. 22. *Printing of papers filed.*

**>The Commissioner may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.<

37 CFR 1.71. *Detailed description and specification of the invention.*

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(o). The content of the notice must be limited to only those elements required by law. For example, “© 1983 John Doe” (17 U.S.C. 401) and “M John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to {copyright or mask work} protection. The {copyright or mask work} owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all {copyright or mask work} rights whatsoever.

>The specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention pertains to make and use the same. See 35 U.S.C. 112 and 37 CFR 1.71. If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01.

The specification does not require a date.<

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be canceled. See 37 CFR 1.78 and MPEP § 202.01.

>As the specification is never returned to applicant under any circumstances, the applicant should retain a line for line copy thereof, each line, preferably, having been

consecutively numbered on each page. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

Form Paragraph 7.29 may be used where the disclosure contains minor informalities.

¶ 7.29 *Disclosure Objected to, Minor Informalities*

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is required.

Examiner Note:

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology, numbering of elements, etc., which should be corrected. See form paragraphs 6.28 to 6.32 for specific informalities.

Form Paragraphs 6.29-6.31 should be used where appropriate.

¶ 6.29 *Specification, Spacing of Lines*

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

¶ 6.30 *Numerous Errors in Specification*

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: [1].

¶ 6.31 *Lengthy Specification, Jumbo Case*

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examiner Note:

This paragraph is applicable in so-called "Jumbo cases" (more than 20 pages, exclusive of claims).

PAPER REQUIREMENTS<

37 CFR 1.52. *Language, paper, writing, margins.*

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, non-shiny, durable, and white paper. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic reproduction by use of digital imaging and optical character recognition. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See § 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification when required by the Office.

(b) Except for drawings, the application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in this part) and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper, with the claim or claims commencing on a separate sheet and the abstract commencing on a separate sheet. See §§ 1.72(b) and 1.75(h). The sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced. The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. See § 1.84 for drawings.

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by § 1.121.

(d) An application may be filed in a language other than English. An English translation of the non-English-language application, a statement that the translation is accurate, and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

37 CFR 1.58. *Chemical and mathematical formulae and tables.*

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) [Reserved]

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Type-written characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (*e.g.*, elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

37 CFR 1.52(b) requires that the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced.

Except for drawings, all application papers (specification, including claims, abstract, oath or declaration, and other papers), and also papers subsequently filed, must have each page plainly written on only one side of a sheet

of paper. The claim or claims must commence on a separate sheet (37 CFR 1.75(h)) and the abstract must commence on a separate sheet (37 CFR 1.72(b)).

Except for drawings, all application papers which are to become a part of the permanent record of the Patent and Trademark Office must be on sheets of paper which are the same size and are either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). Each sheet must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch), and no holes should be made in the sheets as submitted.

Applicants must make every effort to file patent applications in a form that is clear and reproducible. If the papers are not of the required quality, substitute typewritten or mechanically printed papers of suitable quality will be required. See 37 CFR 1.125 for filing substitute typewritten or mechanically printed papers constituting a substitute specification required by the Office. >See also MPEP § 608.01(q).< All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly written either by a typewriter or mechanical printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, nonshiny, durable, and white paper. Typed, mimeographed, xeroprinted, multi-graphed or nonsmearing carbon copy forms of reproduction are acceptable.

Where an application is filed with papers that do not comply with 37 CFR 1.52(a) or (b), the Office of Initial Patent Examination will mail a "Notice to File Corrected Application Papers" (PTO 1660) indicating the deficiency and setting a time period within which the applicant must correct the deficiencies to avoid abandonment. The failure to submit application papers in compliance with 37 CFR 1.52(a) or (b) does not effect the grant of a filing date, and original application papers that do not comply with 37 CFR 1.52(a) or (b) will be retained in the application file as the original disclosure of the invention. The PTO will not return papers simply because they do not comply with 37 CFR 1.52(a) or (b).

Legibility includes ability to be photocopied and photomicrographed so that suitable reprints can be made and ability to be electronically reproduced by use of digital imaging and optical character recognition.. This requires a high contrast, with black lines and a white background. Gray lines and/or a gray background sharply reduce photo reproduction quality. Legibility of some application papers may become impaired due to abrasion or aging of the printed material during examination and ordinary handling of the file. It may be necessary to require that legible and

permanent copies be furnished at later stages after filing, particularly when preparing for issue.

Some of the patent application papers received by the Patent and Trademark Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

The paper used must have a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy, 37 CFR 1.52(a). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant by use of Form Paragraph 6.32 that it will be necessary for applicant to order a copy of the specification and claims to be made by the Patent and Trademark Office at the applicant's expense for incorporation in the file. It is not necessary to return this copy to applicant for signature.

¶ 6.32 Application on Easily Erasable Paper

The application papers are objected to because they are not a permanent copy as required by 37 CFR 1.52(a). Reference is made to [1].

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP § 608.01.

Examiner Note:

In the bracket, identify: 1) all of the specification; 2) certain pages of the specification; 3) particular claim(s); 4) the oath or declaration; 5) etc.

See *In re Benson*, 1959 C.D. 5, 744 O.G. 353 (Comm'r Pat. 1959). Reproductions prepared by heat-sensitive, hectographic, or spirit duplication processes are also not satisfactory.**

>ALTERATION OF APPLICATION PAPERS<

37 CFR 1.52(c) relating to interlineations and other alterations is strictly enforced. See *In re Swanberg*, 129 USPQ 364 (Comm'r Pat. 1960). >See also MPEP § 605.04(a).<

**

>CERTIFIED COPIES OF AN APPLICATION-AS-FILED

If an application-as-filed does not meet the sheet size/margin and quality requirements of 37 CFR 1.52 and 1.84(f) and (g), certified copies of such application may be illegible and/or ineffective as priority documents. When an applicant requests that the PTO provide a certified copy of an application-as-filed and pays the fee set forth in 37 CFR 1.19(b)(1), the PTO will make a copy of the application-as-filed from the records in the Patent Image Capturing System (PICS) database (or the microfilm database). If papers submitted in the application-as-filed are not legible, certi-

fied copies of the application as originally filed will not be legible.

The PTO performs exception processing when scanning application papers that do not comply with the sheet size/margin and quality requirements. If papers submitted in the application-as-filed (including any transmittal letter or cover sheet) do not meet the sheet size requirement of 37 CFR 1.52 and 1.84(f) (e.g., the papers are legal size (8 1/2 by 14 inches)), the PTO must reduce such papers to be able to image-scan the entire application and record it in the PICS database. In addition, if papers submitted in the application-as-filed do not meet the quality requirements of 37 CFR 1.52 (e.g., the papers are shiny or non-white), the PTO will attempt to enhance such papers before scanning to make the resulting electronic record in the PICS database more readable. However, if exception processing is required to make the PICS copy, certified copies of the application as originally filed may not be legible.

If application papers are filed that do not meet sheet size/margin and quality requirements, the PTO will require the applicant to file substitute papers that do comply with the requirements of 37 CFR 1.52 and 1.84(f) and (g). The substitute papers submitted in reply to the above-mentioned requirement will provide the PTO with an image- and OCR-scannable copy of the application for printing the application as a patent. However, the PTO will not treat application papers submitted after the filing date of an application as the original disclosure of the application for making a certified copy of the application-as-filed or any other purpose. That is, even if an applicant subsequently files substitute application papers that comply with 37 CFR 1.52 and then requests that the PTO provide a certified copy of an application-as-filed, paying the fee set forth in 37 CFR 1.19(b)(1), the PTO will still make a copy of the application-as-filed from the records in the PICS (or microfilm) database, and this database will not include the subsequently filed substitute papers.

If the certified copy of an application produced from the PICS (or microfilm) database is illegible, the applicant may pay the fee set forth in 37 CFR 1.19(b)(2) and request that the PTO obtain the application file and produce a certified copy of the application by photocopying the application-as-filed as contained in the application file. The special handling required to produce a certified copy of the application from the papers in the application file will also cause a delay in when a certified copy is available.<

USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using

printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

The initials S.I. stand for "Le Système International d'Unités," the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

FILING OF NON-ENGLISH LANGUAGE APPLICATIONS

37 CFR 1.52. Language, Paper, Writing, Margins.

(d) An application may be filed in a language other than English. An English translation of the non-English-language application, a statement that the translation is accurate, and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

The Patent and Trademark Office will accord a filing date to an application meeting the requirements of 35 U.S.C. 111(a), or a provisional application in accordance with 35 U.S.C. 111(b), even though some or all of the application papers, including the written description and the claims, is in a language other than English and hence does not comply with 37 CFR 1.52.

An English translation of the non-English language papers, a statement that the translation is accurate, the filing fee, the oath or declaration (if necessary) and fee set forth in 37 CFR 1.17(k) should either accompany the application papers or be filed in the Office within the time set by the Office.

A subsequently filed English translation must contain the complete identifying data for the application in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the original application papers be accompanied by a cover letter and a self-addressed return postcard, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether oath or declaration was filed and (e) amount and manner of paying the filing fee.

The translation must be a literal translation and must be accompanied by a statement that the translation is accurate. The translation must also be accompanied by a signed request from the applicant, his or her attorney or agent, asking that the English translation be used as the copy for examination purposes in the Office. If the English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary

amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. In the event the English translation is not timely filed in the Office, the application will be regarded as abandoned.

It should be recognized that this practice is intended for emergency situations to prevent loss of valuable rights and should not be routinely used for filing applications. There are at least two reasons why this should not be used on a routine basis. First, there are obvious dangers to applicant and the public if he or she fails to obtain a correct literal translation. Second, the filing of a large number of applications under the procedure will create significant administrative burdens on the Office.

ILLUSTRATIONS IN THE SPECIFICATION

Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 CFR 1.58(a), which permits tables and chemical formulas in the specification in lieu of formal drawings. The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 CFR 1.81 when an application contains graphs in the specification.

Since the December 7, 1976, issue of patents, all tables and mathematical equations and chemical formulas, or portions thereof, have been reproduced for printing by a computer process developed by the Data Base Contractor. Those portions of chemical formulas which cannot be reproduced by the process, such as dotted, curved, broken and wedge-shaped lines, must be drawn by hand on the photocomposed page. There are, however, some chemical structures which cannot be reproduced because they are either too complex or involve too many lines which cannot be generated by the computer process. The camera copy process, which is used to insert these types of structures onto the printed patent page, is both time consuming and costly to the Office. Because of the reduction factor and failure to comply with the guidelines set forth in 37 CFR 1.52(a) and 37 CFR 1.58(a) the reproduction of these structures is often poor.

Therefore, the specification, including any claims, may contain chemical formulas and mathematical equations, but should not contain drawings or flow diagrams or diagrammatic views of chemical structures. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112.

See MPEP § 601.01(d) for treatment of applications filed without all pages of the specification.

>HYPERLINKS AND OTHER FORMS OF BROWSER-EXECUTABLE CODE IN THE SPECIFICATION

Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in the text of the application. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "< >" and http:// followed by a URL address. When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent and the patent document is placed on the PTO web page, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another web page identified by the URL, if it exists, which could be a commercial web site. PTO policy does not permit the PTO to link to any commercial sites since the PTO exercises no control over the organization, views or accuracy of the information contained on these outside sites.

If hyperlinks and/or other forms of browser-executable code are embedded in the text of the patent application, examiners should object to the specification and indicate to applicants that the embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion. This requirement does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.

The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See MPEP 608.01(p), paragraph I regarding incorporation by reference.

Note that nucleotide and/or amino acid sequence data placed between the symbols "< >" are not considered to be hyperlinks and/or browser-executable code and therefore should not be objected to as being an improper incorporation by reference (see 37 CFR 1.821 – 1.825).

¶ 7.29.04 Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Examiner Note:

1. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols "< >" and http://followed by a URL address. Nucleotide and/or amino acid sequence data placed between the symbols "< >" are not considered to be hyperlinks and/or browser-executable code.

2. If the application attempts to incorporate essential subject matter into the patent application by reference to a hyperlink and/or other form of browser-executable code, see MPEP § 608.01.

3. The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO-1449 where the electronic document is identified by reference to a URL.<

608.01(a) Arrangement of Application

37 CFR 1.77. Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility Application Transmittal Form.
- (2) Fee Transmittal Form.
- (3) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention.
- (4) Cross-reference to related applications.
- (5) Statement regarding federally sponsored research or development.
- (6) Reference to a "Microfiche appendix." (See § 1.96 (c)). The total number of microfiche and total number of frames should be specified.
- (7) Background of the invention.
- (8) Brief summary of the invention.
- (9) Brief description of the several views of the drawing.
- (10) Detailed description of the invention.
- (11) Claim or claims.
- (12) Abstract of the Disclosure.
- (13) Drawings.
- (14) Executed oath or declaration.
- (15) Sequence Listing (See §§ 1.821 through 1.825).

(b) The elements set forth in paragraphs (a)(3) through (a)(5), (a)(7) through (a)(12) and (a)(15) of this section should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading.

For design patent specification, see MPEP § 1503.01.

For plant patent specification, see MPEP § 1605.

For reissue patent specification, see MPEP § 1411.

The following order of arrangement of specification elements is preferable in framing the nonprovisional specification and, except for the reference to a "Microfiche Appendix", each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading. It is recommended that provisional applications follow the same general format, although claims are not required.

- (A) Title of the Invention.
- (B) Cross-References to Related Applications.
- (C) Statement Regarding Federally Sponsored Research or Development.
- (D) Reference to a "Microfiche Appendix." (See 37 CFR 1.96.)
- (E) Background of the Invention.

- (1) Field of the Invention.
- (2) Description of the related art including information disclosed under 37 CFR 1.97 and 1.98.
- (F) Brief Summary of the Invention.
- (G) Brief Description of the Several Views of the Drawings.
- (H) Detailed Description of the Invention.
- (I) Claim or Claims.
- (J) Abstract of the Disclosure.
- (K) Drawings.
- (L) Sequence Listing (See 37 CFR 1.821-1.825).

Applicant (typically a *pro se*) may be advised of the proper arrangement by using Form Paragraph 6.01 or 6.02.

¶ 6.01 Arrangement of Specification

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to a "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
- (1) Field of the Invention.
- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

Examiner Note:

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in **pro se** applications.

¶ 6.02 Content of Specification

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a). The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research or Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37 CFR 1.96(c) and MPEP § 608.05. The total number of microfiche and the total number of frames should be specified.
- (e) Background of the Invention: The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(f) Brief Summary of the Invention: A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(g) Brief Description of the Several Views of the Drawing(s): A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(h) Detailed Description of the Invention: A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on a separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75.

(j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 250 words or less commencing on a separate sheet following the claims.

(k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.

(l) Sequence Listing: See 37 CFR 1.821-1.825.

Examiner Note:

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications. See also "pro se" form paragraphs in Chapter 1700 of the Manual of Patent Examining Form Paragraphs.

608.01(b) Abstract of the Disclosure

37 CFR 1.72. *Title and abstract.*

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims under the heading "Abstract of the Disclosure." The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract shall not be used for interpreting the scope of the claims.

In all applications which lack an abstract, the examiner in the first Office action should require the submission of an abstract directed to the technical disclosure in the specification. See Form Paragraph 6.12 (below). Applicants may use either "Abstract" or "Abstract of the Disclosure" as a heading.

If the abstract contained in the application does not comply with the guidelines, the examiner should point out the defect to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, and require compliance with the guidelines. Since the abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with paragraph 1 of 35 U.S.C. 112 (*In re Armbruster*, 512 F.2d 676, 678-79, 185 USPQ 152, 154 (CCPA 1975)), it would ordinarily be preferable that the applicant make the necessary changes to the abstract to bring it into compliance with the guidelines. See Form Paragraphs 6.13-6.16 (below).

Replies to such actions requiring either a new abstract or amendment to bring the abstract into compliance with the guidelines should be treated under 37 CFR 1.111(b) practice like any other formal matter. Any submission of a new abstract or amendment to an existing abstract should be carefully reviewed for introduction of new matter, 35 U.S.C. 132, MPEP § 608.04.

Upon passing the application to issue, the examiner should make certain that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines. The abstract shall be changed by the examiner's amendment in those instances where deemed necessary. This authority and responsibility of the examiner shall not be abridged by the desirability of having the applicant make the necessary corrections. For example, if the application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by examiner's amendment rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions.

Under current practice, in all instances where the application contains an abstract when sent to issue, the abstract will be printed on the patent.

GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

Background

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, 37 CFR 1.72(b).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to ascertain quickly the

character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

The abstract is not intended nor designated for use in interpreting the scope or meaning of the claims, 37 CFR 1.72(b).

Content

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Language and Format

The abstract must commence on a separate sheet, preferably following the claims, under the heading "Abstract of the Disclosure." Form Paragraph 6.16.01 (below) may be used if the abstract does not commence on a separate sheet.

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 250 words. The abstract should not exceed 25 lines of text.

Abstracts exceeding 25 lines of text should be checked to see that it does not exceed 250 words in length since the space provided for the abstract on the computer tape by the printer is limited. If the abstract cannot be placed on the computer tape because of its excessive length, the application will be returned to the examiner for preparation of a shorter abstract. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "This disclosure concerns," "The disclosure defined by this invention," "This disclosure describes," etc.

Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant's contribution to the art are most important in the preparation of the abstract. The review of the abstract for compliance with these guidelines, with any necessary editing and revision on allowance of the application, is the responsibility of the examiner.

Sample Abstracts

(1) A heart valve which has an annular valve body defining an orifice and a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or back-flow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

(2) A method for sealing whereby heat is applied to seal, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. The

bond is formed immediately after heating within a period of time for any one surface point less than the total time of exposure to heated air of that point. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

(3) Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 75°C under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

¶ 6.12 Abstract Missing (Background)

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Examiner Note:

For *pro se* applicant, consider form paragraphs 6.14 to 6.16.

¶ 6.13 Abstract Objected To: Minor Informalities

The abstract of the disclosure is objected to because [1]. Correction is required. See MPEP § 608.01(b).

Examiner Note:

In bracket 1, indicate the informalities that should be corrected. Use this paragraph for minor informalities such as the inclusion of legal phraseology, undue length, etc.

¶ 6.14 Abstract of the Disclosure: Content

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of an apparatus should not be included in the abstract.

Examiner Note:

See form paragraph 6.16.

¶ 6.15 Abstract of the Disclosure: Chemical Cases

Applicant is reminded of the proper content of an abstract of the disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet.

¶ 6.16 Abstract of the Disclosure: Language

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Examiner Note:

See also form paragraph 6.14.

¶ 6.16.01 Abstract of the Disclosure: Placement

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Examiner Note:

This paragraph should only be used for applications filed on or after September 23, 1996.

608.01(c) Background of the Invention

The Background of the Invention ordinarily comprises two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).

608.01(d) Brief Summary of Invention*37 CFR 1.73. Summary of the invention.*

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

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly on point as applicable exclusively to the case at hand.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, MPEP § 1302.

608.01(e) Reservation Clauses Not Permitted*37 CFR 1.79. Reservation clauses not permitted.*

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

608.01(f) Brief Description of Drawings*37 CFR 1.74. Reference to drawings.*

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

The Office of Initial Patent Examination (OIPE) will review the specification, including the brief description, to determine whether all of the figures of drawings described in the specification are present. If the specification describes a figure which is not present in the drawings, the application will be treated as an application filed without

all figures of drawings in accordance with MPEP § 601.01(g), unless the application lacks any drawings, in which case the application will be treated as an application filed without drawings in accordance with MPEP § 601.01(f).

The examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used.

The specification must contain or be amended to contain proper reference to the existence of drawings executed in color as required by 37 CFR 1.84.

37 CFR 1.84. Standards for drawings.

(a) *Drawings.* There are two acceptable categories for presenting drawings in utility patent applications:

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings, or

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(i);

(ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

608.01(g) Detailed Description of Invention [R-1]

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by 37 CFR 1.71, MPEP § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts

or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See 37 CFR 1.75, MPEP § 608.01(i), § 608.01(o), and § 1302.01.

For completeness, see MPEP § 608.01(p).

USE OF SYMBOL “Phi” IN PATENT APPLICATION

The Greek letter “Phi” has long been used as a symbol in equations in all technical disciplines. It further has special uses which include the indication of an electrical phase or clocking signal as well as an angular measurement. The recognized symbols for the upper and lower case Greek Phi characters, however, do not appear on most typewriters. This apparently has led to the use of a symbol composed by first striking a zero key and then backspacing and striking the “cancel” or “slash” key to result in an approximation of accepted symbols for the Greek character Phi. In other instances, the symbol is composed using the upper or lower case letter “O” with the “cancel” or “slash” superimposed thereon by backspacing, or it is simply handwritten in a variety of styles. These expedients result in confusion because of the variety of type sizes and styles available on modern typewriters.

In recent years, the growth of data processing has seen the increasing use of this symbol (“O”) as the standard representation of zero. The “slashed” or “canceled” zero is used to indicate zero and avoid confusion with the upper case letter “O” in both text and drawings.

Thus, when the symbol “Ø” in one of its many variations, as discussed above, appears in patent applications being prepared for printing, confusion as to the intended meaning of the symbol arises. Those (such as examiners, attorneys, and applicants) working in the art can usually determine the intended meaning of this symbol because of their knowledge of the subject matter involved, but editors preparing these applications for printing have no such specialized knowledge and confusion arises as to which symbol to print. The result, at the very least, is delay until the intended meaning of the symbol can be ascertained.

Since the Office does not have the resources to conduct a technical editorial review of each application before printing, and in order to eliminate the problem of printing delays associated with the usage of these symbols, any question about the intended symbol will be resolved by the editorial staff of the Office of Patent Publication by printing the

symbol Ø whenever that symbol is used by the applicant. Any Certificate of Correction necessitated by the above practice will be at the patentee's expense (37 CFR 1.323) because the intended symbol was not accurately presented by the Greek upper or lower case Phi letters in the patent application.

608.01(h) Mode of Operation of Invention

The best mode contemplated by the inventor of carrying out his or her invention must be set forth in the description. See 35 U.S.C. 112. There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980).

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 USPQ2d 1737, 1742 (Fed. Cir. 1987); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974); *In re Gay*, 309 F.2d 708, 135 USPQ 311 (CCPA 1962). See 35 U.S.C. 112 and 37 CFR 1.71(b).

If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.

Patents have been held invalid in cases where the patentee did not disclose the best mode known to him. See *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 16 USPQ2d 1033 (Fed. Cir. 1990); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 8 USPQ2d 1692 (Fed. Cir. 1988); *Spectra-Physics, Inc. v. Coherent, Inc.*, 821 F.2d 1524, 3 USPQ2d 1737 (Fed. Cir. 1987).

For completeness, see MPEP § 608.01(p) and § 2165 to § 2165.04.

608.01(i) Claims*37 CFR 1.75. Claims*

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

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

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1)The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See § 1.58(a).)

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

For numbering of claims, see MPEP § 608.01(j).

For form of claims, see MPEP § 608.01(m).

For dependent claims, see MPEP § 608.01(n).

For examination of claims, see MPEP § 706.

For claims in excess of fee, see MPEP § 714.10.

608.01(j) Numbering of Claims*37 CFR 1.126. Numbering of claims.*

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the

highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

In a single claim case, the claim is not numbered.

Form Paragraph 6.17 may be used to notify applicant.

¶ 6.17 Numbering of Claims, 37 CFR 1.126

The numbering of claims is not accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim [1] been renumbered [2].

Examiner Note:

1. In bracket 1, insert appropriate claim number(s) and --has-- or --have --.
2. In bracket 2, insert correct claim number(s) and --, respectively -- if more than one claim is involved.

608.01(k) Statutory Requirement of Claims

35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he or she regards as his or her invention. The portion of the application in which he or she does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

608.01(l) Original Claims

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.

608.01(m) Form of Claims [R-1]

The claim or claims must commence on a separate sheet and should appear after the detailed description of the invention. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim",

"The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, 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.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive. All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable. Where separate species are claimed, the claims of like species should be grouped together where possible. Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art, see MPEP § 706.03.

The following form paragraphs may be used to object to the form of the claims.

¶ 6.18.01 Claims: Placement

The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

Examiner Note:

This paragraph should only be used for applications filed on or after September 23, 1996.

¶ 7.29.01 Claims Objected to, Minor Informalities

Claim[1] objected to because of the following informalities: [2]. Appropriate correction is required.

Examiner Note:

1. Use this form paragraph to point out minor informalities such as spelling errors, inconsistent terminology, etc., which should be corrected.
2. If the informalities render the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under 35 U.S.C. 112, second paragraph.

¶ 7.29.02 Claims Objected to, Reference Characters Not Enclosed Within Parentheses

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Examiner Note:

1. Use of this paragraph is optional. You may instead choose to correct the error yourself at time of allowance by informal examiner's amendment.
2. If the lack of parentheses renders the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under 35 U.S.C. 112, second paragraph.

¶ 7.29.03 Claims Objected to, Spacing of Lines

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Amendments to the claims must be in compliance with 37 CFR 1.121(a)(2). Form paragraphs 6.33 and 6.34 may be used to inform applicant of nonentry of amendments to the claims.

¶ 6.33 Amendment to the Claims, Addition of More Than 5 Words, 37 CFR 1.121

The reply filed on [1] is not fully responsive to the prior Office action and the amendment to the claims has not been entered, because the amendment requests the addition of more than five words in at least one claim. See 37 CFR 1.121(a)(2)(i) below:

(i)Instructions for insertions and deletions: A claim may be amended by specifying only the exact matter to be deleted or inserted by an amendment and the precise point where the deletion or insertion is to be made, where the changes are limited to:

(A)Deletions and/or

(B)The addition of no more than five (5) words in any one claim; or

The amendment to the claims should be made in accordance with 37 CFR 1.121(a)(2)(ii) which states:

(ii)Claim cancellation or rewriting: A claim may be amended by directions to cancel the claim or by rewriting such claim with underlining below the matter added and brackets around the matter

deleted. The rewriting of a claim in this form will be construed as directing the deletion of the previous version of that claim. If a previously rewritten claim is again rewritten, underlining and bracketing will be applied relative to the previous version of the claim, with the parenthetical expression “twice amended,” “three times amended,” *etc.*, following the original claim number. The original claim number followed by that parenthetical expression must be used for the rewritten claim. No interlineations or deletions of any prior amendment may appear in the currently submitted version of the claim. A claim canceled by amendment (not deleted and rewritten) can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

Since the above-mentioned reply appears to be *bona fide*, applicant is given TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply an amendment in compliance with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)**

Examiner Note:

1. In bracket 1, insert the filing date of the reply.

>

¶ 6.34 Amendment of the Claims, Use of Brackets or Underlining Unclear

Brackets or underlining are commonly used to indicate amendments or changes in the claims as provided in 37 CFR 1.121(a)(2)(ii) and are normally not intended to be printed in the published patent. In the reply filed [1], applicant has used [2] in such a manner that it is unclear to the examiner whether the [3] is intended to appear in the patent. The [4] is unclear because [5]. If underlining and/or bracketing is intended to appear in the claims in the published patent, such intention must be clearly indicated in applicant's reply to this notice.

Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply an amendment in compliance with 37 CFR 1.121 and this notice in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a)**.

Examiner Note:

1. See MPEP § 714.22 for the proper use of this form paragraph.
2. In brackets 2, 3, and 4, insert --underlining-- and/or --bracketing--.
3. In bracket 5, insert an explanation of why the underlining or bracketing is unclear.
4. When confronted by a proposed amendment to the claims which is unclear and the examiner cannot perform a meaningful and thorough search and examination of the claims, the examiner should attempt to seek clarification from the applicant. Before sending out an Office action or notice setting a new time period for reply, the examiner should first attempt to call the applicant to determine whether the applicant intends the underlining and/or bracketing to appear in the issued patent. The substance of the interview must be made of record. The above form paragraph restarting the time period should only be used in such cases where the examiner is unable to obtain clarification from the applicant by telephone.
5. This form paragraph should not be used in a reissue application or a reexamination proceeding.<

608.01(n) Dependent Claims [R-1]

I. MULTIPLE DEPENDENT CLAIMS

37 CFR 1.75. Claim(s).

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

The second paragraph of 35 U.S.C. 112 has been revised in view of the multiple dependent claim practice introduced by the Patent Cooperation Treaty. Thus 35 U.S.C. 112 authorizes multiple dependent claims in applications filed on and after January 24, 1978, as long as they are in the alternative form (e.g., “A machine according to claims 3 or 4, further comprising ---”). Cumulative claiming (e.g., “A machine according to claims 3 and 4, further comprising ---”) is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as “A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8” is improper. 35 U.S.C. 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using Form Paragraph 7.45.

¶ 7.45 Improper Multiple Dependent Claims

Claim [1] objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim [2]. See MPEP § 608.01(n). Accordingly, the claim [3] not been further treated on the merits.

Examiner Note:

1. In bracket 2, insert --should refer to other claims in the alternative only--, and/or, --cannot depend from any other multiple dependent claim--.
2. Use this paragraph rather than 35 U.S.C. 112, fifth paragraph.
3. In bracket 3, insert --has-- or --s have--.

Assume each claim example given below is from a different application.

A. Acceptable Multiple Dependent Claim Wording

Claim 5. A gadget according to claims 3 or 4, further comprising ---

Claim 5. A gadget as in any one of the preceding claims, in which ---

Claim 3. A gadget as in either claim 1 or claim 2, further comprising ---

Claim 4. A gadget as in claim 2 or 3, further comprising ---

Claim 16. A gadget as in claims 1, 7, 12, or 15, further comprising ---

Claim 5. A gadget as in any of the preceding claims, in which ---

Claim 8. A gadget as in one of claims 4-7, in which ---

Claim 5. A gadget as in any preceding claim, in which ---

Claim 10. A gadget as in any of claims 1-3 or 7-9, in which ---

Claim 11. A gadget as in any one of claims 1, 2, or 7-10 inclusive, in which ---

B. Unacceptable Multiple Dependent Claim Wording**1. Claim Does Not Refer Back in the Alternative Only**

Claim 5. A gadget according to claim 3 and 4, further comprising ---

Claim 9. A gadget according to claims 1-3, in which ---

Claim 9. A gadget as in claims 1 or 2 and 7 or 8, which ---

Claim 6. A gadget as in the preceding claims in which ---

Claim 6. A gadget as in claims 1, 2, 3, 4 and/or 5, in which ---

Claim 10. A gadget as in claims 1-3 or 7-9, in which ---

2. Claim Does Not Refer to a Preceding Claim

Claim 3. A gadget as in any of the following claims, in which ---

Claim 5. A gadget as in either claim 6 or claim 8, in which ---

3. Reference to Two Sets of Claims to Different Features

Claim 9. A gadget as in claim 1 or 4 made by the process of claims 5, 6, 7, or 8, in which ---

4. Reference Back to Another Multiple Dependent Claim

Claim 8. A gadget as in claim 5 (claim 5 is a multiple dependent claim) or claim 7, in which ---

35 U.S.C. 112 indicates that the limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately. Thus, a multiple dependent claim, as such, does not contain all the limitations of all the alternative claims to which it refers, but rather contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration. Hence, a multiple dependent claim must be considered in the same manner as a plurality of single dependent claims.

C. Restriction Practice

For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim. Also, some embodiments of a multiple dependent claim may be held withdrawn while other embodiments are considered on their merits.

D. Handling of Multiple Dependent Claims by the Office of Initial Patent Examination

The Office of Initial Patent Examination (OIPE) is responsible for verifying whether multiple dependent claims filed with the application are in proper alternative form, that they depend only upon prior independent or single dependent claims and also for calculating the amount of the filing fee. A new form, PTO-1360, has been designed to be used in conjunction with the current fee calculation form PTO-875.

E. Handling of Multiple Dependent Claims by the Examining Group Technical Support Staff

The examining group technical support staff is responsible for verifying compliance with the statute and rules of multiple dependent claims added by amendment and for calculating the amount of any additional fees required. This calculation should be performed on form PTO-1360.

There is no need for an examining group technical support staff to check the accuracy of the initial filing fee since

this has already been verified by the Office of Initial Patent Examination when granting the filing date.

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the amended claims. The applicant, or his or her attorney or agent, should be contacted to pay the additional fee. Where a letter is written in an insufficient fee situation, a copy of the multiple dependent claim fee calculation, form PTO-1360, should be included for applicant's information.

If an application filed prior to October 1, 1982, is amended on or after October 1, 1982, to include a proper multiple dependent claim for the first time, the fee set forth in § 1.16(d) must be paid.

If such an application contained a proper multiple dependent claim prior to October 1, 1982, the fee set forth in § 1.16(d) does not apply.

Where the examining group technical support staff notes that the reference to the prior claims is improper in an added or amended multiple dependent claim, a notation should be made in the left margin next to the claim itself and the number 1, which is inserted in the "Dep. Claim" column of that amendment on form PTO-1360, should be circled in order to call this matter to the examiner's attention.

F. Handling of Multiple Dependent Claims by the Examiner

Public Law 94-131, the implementing legislation for the Patent Cooperation Treaty amended 35 U.S.C. 112 to state that "a claim in dependent form shall contain a reference to a claim *previously set forth*." The requirement to refer to a previous claim had existed only in 37 CFR 1.75(c) before.

The following procedures are to be followed by examiners when faced with claims which refer to numerically succeeding claims:

If any series of dependent claims contains a claim with an improper reference to a numerically following claim which cannot be understood, the claim referring to a following claim should normally be objected to and not treated on the merits.

However, in situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, all claims

should be examined on the merits and no objection as to form need be made. In such cases, the examiner will renumber the claims into proper order at the time the application is allowed. (See Example B, below.)

Any unusual problems should be brought to the supervisor's attention.

Example A

(Claims 4 and 6 should be objected to as not being understood and should not be treated on the merits.)

1. Independent
2. Dependent on claim 5
3. Dependent on claim 2
4. "... as in any preceding claim"
5. Independent
6. Dependent on claim 4

Example B

Note: Parenthetical numerals represent the claim numbering for issue should all claims be allowed.

(All claims should be examined.)

1. (1) Independent
2. (5) Dependent on claim 5 (4)
3. (2) Dependent on claim 1 (1)
4. (3) Dependent on claim 3 (2)
5. (4) Dependent on either claim 1 (1) or claim 3 (2)

The following practice is followed by patent examiners when making reference to a dependent claim either singular or multiple:

(A) When identifying a singular dependent claim which does not include a reference to a multiple dependent claim, either directly or indirectly, reference should be made only to the number of the dependent claim.

(B) When identifying the embodiments included within a multiple dependent claim, or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, each embodiment should be identified by using the number of the claims involved, starting with the highest, *to the extent necessary* to specifically identify each embodiment.

(C) When all embodiments included within a multiple dependent claim or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, are subject to a common rejection, objection, or requirement, reference may be made only to the number of the dependent claim.

The following table illustrates the current practice where each embodiment of each claim must be treated on an individual basis:

| Claim No. | Claim dependency | Identification | |
|-----------|-------------------------|-------------------------------------|-------------------------|
| | | All claims | Approved practice |
| 1 | Independent | 1 | 1 |
| 2 | Depends from 1 | 2/1 | 2 |
| 3 | Depends from 2 | 3/2/1 | 3 |
| 4 | Depends from 2 or 3 | 4/2/1 4/3/2/1 | 4/2 4/3 |
| 5 | Depends from 3 | 5/3/2/1 | 5 |
| 6 | Depends from 2, 3, or 5 | 6/2/1 6/3/2/1 6/5/3/2/1 | 6/2 6/3 6/5 |
| 7 | Depends from 6 | 7/6/2/1 7/6/3/2/1 7/6/5/3/2/1 | 7/6/2 7/6/3 7/6/5 |

When all embodiments in a multiple dependent claim situation (claims 4, 6, and 7 above) are subject to a common rejection, objection, or requirements, reference may be made to the number of the individual dependent claim only. For example, if 4/2 and 4/3 were subject to a common ground of rejection, reference should be made only to claim 4 in the statement of that rejection.

The provisions of 35 U.S.C. 132 require that each Office action make it explicitly clear what rejection, objection and/or requirement is applied to each claim embodiment.

G Fees for Multiple Dependent Claims

1. Use of Form PTO-1360

To assist in the computation of the fees for multiple dependent claims, a separate "Multiple Dependent Claim Fee Calculation Sheet," form PTO-1360, has been designed for use with the current "Patent Application Fee Determination Record," form PTO-875. Form PTO-1360 will be placed in the file wrapper by the Office of Initial Patent Examination (OIPE) where multiple dependent claims are in the application as filed. If multiple dependent claims are not included upon filing, but are later added by amendment, the examining group technical support staff will place the form in the file wrapper. If there are multiple dependent claims in the application, the total number of independent and dependent claims for fee purposes will be calculated on

form PTO-1360 and the total number of claims and number of independent claims is then placed on form PTO-875 for final fee calculation purposes.

2. Calculation of Fees

(a) Proper Multiple Dependent Claim

35 U.S.C. 41(a), provides that claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.

(b) Improper Multiple Dependent Claim

If any multiple dependent claim is improper, OIPE may indicate that fact by placing an encircled numeral "1" in the "Dep. Claims" column of form PTO-1360. The fee for any improper multiple dependent claim, whether it is defective for either not being in the alternative form or for being directly or indirectly dependent on a prior multiple dependent claim, will only be one, since only an objection to the form of such a claim will normally be made. This procedure also greatly simplifies the calculation of fees. Any claim depending from an improper multiple dependent claim will also be considered to be improper and be counted as one dependent claim.

(c) Fee calculation example

| Claim No. | Ind. | Dep. |
|---------------------------------|----------|-----------|
| 1. Independent | 1 | |
| 2. Dependent on claim 1 | | 1 |
| 3. Dependent on claim 2 | | 1 |
| 4. Dependent on claim 2 or 3 | | 2 |
| 5. Dependent on claim 4 | | 2 |
| 6. Dependent on claim 5 | | 2 |
| 7. Dependent on claim 4, 5 or 6 | | ① |
| 8. Dependent on claim 7 | | ① |
| 9. Independent | 1 | |
| 10. Dependent on claim 1 or 9 | | 2 |
| 11. Dependent on claims 1 and 9 | | ① |
| Total | 2 | 13 |

i) Comments On Fee Calculation Example

Claim 1 — This is an independent claim; therefore, a numeral "1" is placed opposite claim number 1 in the "Ind." column.

Claim 2 — Since this is a claim dependent on a single independent claim, a numeral “1” is placed opposite claim number 2 of the “Dep.” column.

Claim 3 — Claim 3 is also a single dependent claim, so a numeral “1” is placed in the “Dep.” column.

Claim 4 — Claim 4 is a proper multiple dependent claim. It refers directly to two claims in the alternative, namely, claim 2 *or* 3. Therefore, a numeral “2” to indicate direct reference to two claims is placed in the “Dep.” column opposite claim number 4.

Claim 5 — This claim is a singularly dependent claim depending from a multiple dependent claim. For fee calculation purposes, such a claim is counted as being that number of claims to which direct reference is made in the multiple dependent claim from which it depends. In this case, the multiple dependent claim number 4 it depends from counts as 2 claims; therefore, claim 5 also counts as 2 claims. Accordingly, a numeral “2” is placed opposite claim number 5 in the “Dep.” column.

Claim 6 — Claim 6 depends indirectly from a multiple dependent claim 4. Since claim 4 counts as 2 claims, claim 6 also counts as 2 dependent claims. Consequently, a numeral “2” is placed in the “Dep.” column after claim 6.

Claim 7 — This claim is a multiple dependent claim since it refers to claims 4, 5, or 6. However, as can be seen by looking at the “2” in the “Dep.” column opposite claim 4, claim 7 depends from a multiple dependent claim. This practice is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Following the procedure for calculating fees for improper multiple dependent claims, a numeral “1” is placed in the “Dep.” column with a circle drawn around it to alert the examiner that the claim is improper.

Claim 8 — Claim 8 is improper since it depends from an improper claim. If the base claim is in error, this error cannot be corrected by adding additional claims depending therefrom. Therefore, a numeral “1” with a circle around it is placed in the “Dep.” column.

Claim 9 — Here again we have an independent claim which is always indicated with a numeral “1” in the “Ind.” column opposite the claim number.

Claim 10 — This claim refers to two independent claims in the alternative. A numeral “2” is, therefore, placed in the “Dep.” column opposite claim 10.

Claim 11 — Claim 11 is a dependent claim which refers to two claims in the conjunctive (“1” *and* “9”) rather than in the alternative (“1” *or* “9”). This form is improper under 35 U.S.C. 112 and 37 CFR 1.75(c). Accordingly, since claim 11 is improper, an encircled number “1” is placed in the “Dep.” column opposite Claim 11.

ii) Calculation of Fee in Fee Example

After the number of “Ind.” and “Dep.” claims are noted on form PTO-1360, each column is added. In this example, there are 2 independent claims and 13 dependent claims or a total of 15 claims. The number of independent and total claims can then be placed on form PTO-875 and the fee calculated.

II. TREATMENT OF IMPROPER DEPENDENT CLAIMS

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. The initial acceptance of a claim as a dependent claim does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be *canceled* as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. Where a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim or rewriting of such improper dependent claim in independent form. See *Ex parte Porter*, 25 USPQ2d 1144, 1147 (Bd. of Pat. App. & Inter. 1992) (A claim determined to be an improper dependent claim should be treated as a formal matter, in that the claim should be objected to and applicant should be required to cancel the claim (or replace the improper dependent claim with an independent claim) rather than treated by a rejection of the claim under 35 U.S.C. 112, fourth paragraph.). The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any *necessary* additional fee.

>Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims.<

Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using Form Paragraph 7.36.

¶ 7.36 Objection, 37 CFR 1.75(c), Improper Dependent Claim

Claim [1] objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s)

to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. [2].

Examiner Note:

1. In bracket 2, insert an explanation of what is in the claim and why it does not constitute a further limitation.
2. Note *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) for situations where a method claim is considered to be properly dependent upon a parent apparatus claim and should not be objected to or rejected under 35 U.S.C. 112, fourth paragraph. See also MPEP § 608.01(n), “Infringement Test” for dependent claims. The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim.

III. INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Thus, for example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a

particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways.

**

IV. CLAIM FORM AND ARRANGEMENT

A singular dependent claim 2 could read as follows:

2. The product of claim 1 in which

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said “dependent claim.” It should be kept in mind that a dependent claim may refer back to any preceding independent claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant’s sequence should not be changed. See MPEP § 608.01(j). Applicant may be so advised by using Form Paragraph 6.18.

¶ 6.18 Series of Singular Dependent Claims

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant’s sequence will not be changed. See MPEP § 608.01(n).

During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim. Accordingly, the numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

V. REJECTION AND OBJECTION

If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be objected to rather than rejected, if it is otherwise allowable.

Form Paragraph 7.43 can be used to state the objection.

¶ 7.43 *Objection to Claims, Allowable Subject Matter*

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

608.01(o) Basis for Claim Terminology in Description

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

The specification should be objected to if it does not provide proper antecedent basis for the claims by using Form Paragraph 7.44.

¶ 7.44 *Claimed Subject Matter Not in Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: [1]

608.01(p) Completeness [R-1]

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in MPEP § 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques, where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. *Markush* claims must be provided with support in the disclosure for each member of the *Markush* group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications.

For "Guidelines For Examination Of Applications For Compliance With The Utility Requirement of 35 U.S.C. 101," see MPEP § 706.03(a)(1).

For "General Principles Governing Utility Rejections," see MPEP § 2107.

For a discussion of the utility requirement under 35 U.S.C. 112, first paragraph, in drug cases, see MPEP § 2107.02 and § 2164.06(a).

For "Procedural Considerations Related to Rejections for Lack of Utility," see MPEP § 2107.01.

For "Special Considerations for Asserted Therapeutic or Pharmacological Utilities," see MPEP § 2107.02.

I. INCORPORATION BY REFERENCE

The Commissioner has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Commissioner has elected to exercise that discretion. Section A provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section B

provides guidance for incorporation by reference in benefit applications; i.e., those domestic (35 U.S.C. 120) or foreign (35 U.S.C. 119(a)) applications relied on to establish an earlier effective filing date.

A. *Review of Applications Which Are To Issue as Patents.*

An application as filed must be complete in itself in order to comply with 35 U.S.C. 112. Material nevertheless may be incorporated by reference, *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966). An application for a patent when filed may incorporate “essential material” by reference to (1) a U.S. patent or (2) a pending U.S. application, subject to the conditions set forth below.

“Essential material” is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates “essential material” by reference, or (4) a foreign application.

Nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications >however, hyperlinks and/or other forms of browser executable code cannot be incorporated by reference. See MPEP § 608.01<. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Application No. _____ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public

upon the referencing application issuing as a patent. See MPEP § 103).

1. Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be canceled by amendment and may be substituted by reference to a U.S. patent or an earlier filed pending U.S. application. The amendment must be accompanied by an affidavit or declaration signed by the applicant, or a practitioner representing the applicant, stating that the material canceled from the application is the same material that has been incorporated by reference.

If an application as filed incorporates essential material by reference to a U.S. patent or a pending and commonly owned U.S. application, applicant may be required prior to examination to furnish the Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the copy consists of the same material incorporated by reference in the referencing application. However, if a copy of a printed U.S. patent is furnished, no affidavit or declaration is required.

Prior to allowance of an application that incorporates essential material by reference to a pending U.S. application, the examiner shall determine if the referenced application has issued as a patent. If the referenced application has issued as a patent, the examiner shall enter the U.S. Patent No. of the referenced application in the specification of the referencing application (see MPEP § 1302.04). If the referenced application has not issued as a patent, applicant will be required to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating the amendatory material consists of the same material incorporated by reference in the referencing application.

2. Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated by reference to a foreign application or patent or to a publication will not be affected because of the reference. In such a case, the applicant will be required to amend the specification to include the material incorporated by reference. The following form paragraphs may be used.

¶ 6.19 *Incorporation by Reference, Foreign Patent or Application*

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same

material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

¶ 6.19.01 *Improper Incorporation by Reference, General*

The attempt to incorporate subject matter into this application by reference to [1] is improper because [2].

Examiner Note:

1. In bracket 1, identify the document such as an application or patent number or other identification.
2. In bracket 2, give reason why it is improper.

The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Reliance on a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See *In re Fried*, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date. *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarborough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

B. *Review of Applications Which Are Relied on To Establish an Earlier Effective Filing Date.*

The limitations on the material which may be incorporated by reference in U.S. patent applications which are to issue as U.S. patents do not apply to applications relied on only to establish an earlier effective filing date under 35 U.S.C. 119 or 35 U.S.C. 120. Neither 35 U.S.C. 119(a) nor 35 U.S.C. 120 places any restrictions or limitations as to how the claimed invention must be disclosed in the earlier application to comply with 35 U.S.C. 112, first paragraph. Accordingly, an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document. See *Ex parte Maziere*, 27 USPQ2d 1705, 1706-07 (Bd. Pat. App. & Inter. 1993).

The reason for incorporation by reference practice with respect to applications which are to issue as U.S. patents is to provide the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The same policy concern does not apply where the sole purpose for which an applicant relies on an earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application, is not critical in the case of a "benefit" application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by the first paragraph of 35 U.S.C. 112 so that benefit may be accorded. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

For problems arising from the designation of materials by trademarks and trade names, see MPEP § 608.01(v).

608.01(q) Substitute or Rewritten Specification [R-1]

37 CFR 1.125. Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

(1) A statement that the substitute specification includes no new matter; and

(2) A marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form Paragraph 6.28 may be used where the specification is in faulty English.

¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

37 CFR 1.125(a) applies to a substitute specification required by the Office. If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof be rewritten.

Form Paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

**>

¶ 6.28.01 Substitute Specification Required by Examiner

A substitute specification [1] the claims is required pursuant to 37 CFR 1.125(a) because [2].

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Examiner Note:

1. In bracket 1, insert either -- excluding-- or -- including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.

3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.

4. See also form paragraph 13.01 for partial rewritten specification.

5. 37 CFR 1.125(b) provides applicants with the right of entry of substitute specifications, under the conditions set forth in the section, in applications other than reissue applications (37 CFR 1.125(d)) that have not been required by the examiner.<

37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the applicant. A substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by (1) a statement that the substitute specification includes no new matter, and (2) a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. 37 CFR 1.125(b). The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of 37 CFR 1.125(b) are satisfied.

37 CFR 1.125(c) requires a substitute specification filed under 37 CFR 1.125(a) or (b) be submitted in clean form without markings as to amended material.

**

A substitute specification filed under 37 CFR 1.125(b) must be accompanied by a statement indicating that no new matter was included. 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 of 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. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(d).

A substitute specification **>which complies with 37 CFR 1.125 should normally be entered. The examiner should write "Enter" or "OK to Enter" and his or her initials in ink in the left margin of the first page of the substitute specification. A substitute specification which is denied entry should be so marked.

Form Paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under 37 CFR 1.125(b) has not been entered.

¶ 6.28.02 *Substitute Specification Filed Under 37 CFR 1.125(b) Not Entered.*

The substitute specification filed [1] has not been entered because it does not conform to 37 CFR 1.125(b) because: [2]

Examiner Note:

1. In bracket 2, insert statement of why the substitute specification is improper, for example:

- the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--;
- a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--;
- a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--;
- the substitute specification has been filed:
 - in a reissue application or in a reexamination proceeding, 37 CFR 1.125(d)-, or
 - after payment of the issue fee-, or
 - containing claims (to be amended)- --.

See MPEP § 714.20 regarding entry of amendments which include an unacceptable substitute specification.<

For new matter in amendment, see MPEP § 608.04.

For application prepared for issue, see MPEP § 1302.02.

608.01(r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, per se.

608.01(s) Restoration of Canceled Matter

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. 37 CFR 1.121(a)(1)(iii). A claim canceled by amendment, which was not deleted and rewritten, can be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. 37 CFR 1.121(a)(2)(ii). See MPEP § 714.24.

608.01(t) Use in Subsequent Application

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application. 37 CFR 1.79; MPEP § 608.01(e).

No part of a specification can normally be transferred to another application. Drawings may be transferred to another application only upon the granting of a petition filed under the provisions of 37 CFR 1.182.

608.01(u) Use of Formerly Filed Incomplete Application

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See MPEP § 506 and § 506.01.

608.01(v) Trademarks and Names Used in Trade

The expressions “trademarks” and “names used in trade” as used below have the following meanings:

Trademark: a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application.

TRADEMARKS

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some

physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941).

The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. *In re Metcalfe*, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969).

Where the identification of a trademark is introduced by amendment, it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks.

Form Paragraph 6.20 may be used.

¶ 6.20 Trademarks and Their Use

The use of the trademark [I] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Examiner Note:

Capitalize each letter of the word in the bracket or include a proper trademark symbol, such as TM or ® following the word.

The examiner should not permit the use of language such as “the product X (a descriptive name) commonly known as Y (trademark)” since such language does not bring out the fact that the latter is a trademark. Language such as “the

product X (a descriptive name) sold under the trademark Y” is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word “type”, e.g., “Band-Aid type bandage.”

In the event that the proprietary trademark is a “symbol or device” depicted in a drawing, either the brief description of the drawing or the detailed description of the drawing should specify that the “symbol or device” is a registered trademark of Company X.

The owner of a trademark may be identified in the specification.

Group directors should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See Appendix I for a partial listing of trademarks and the particular goods to which they apply.

INCLUSION OF COPYRIGHT OR MASK WORK NOTICE IN PATENTS

37 CFR 1.71. Detailed description and specification of the invention

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

37 CFR 1.84. Standards for drawings

(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth

in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

The Patent and Trademark Office will permit the inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, which discloses material on which copyright or mask work protection has previously been established, under the following conditions:

(A) The copyright or mask work notice must be placed adjacent to the copyright or mask work material. Therefore, the notice may appear at any appropriate portion of the patent application disclosure, including the drawing. However, if appearing in the drawing, the notice must comply with 37 CFR 1.84(s). If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under 37 CFR 1.84.

(B) The content of the notice must be limited to only those elements required by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited, and under current statutes, legally sufficient notices of copyright and mask work respectively.

(C) Inclusion of a copyright or mask work notice will be permitted only if the following authorization in 37 CFR 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any one of the patent disclosure, as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(D) Inclusion of a copyright or mask work notice after a Notice of Allowance has been mailed will be permitted only if the criteria of 37 CFR 1.312 have been satisfied.

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C) above does not include the specific language “(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent

document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records, ...” the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181.

608.02 Drawing [R-1]

35 U.S.C. 113. Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.81. Drawings required in patent application.

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

37 CFR 1.84. Standards for drawings.

(a) *Drawings.* There are two acceptable categories for presenting drawings in utility patent applications:

(1) *Black ink.* Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings, or

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in § 1.17(i);
- (ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

(b) Photographs.

(1) Black and white. Photographs are not ordinarily permitted in utility patent applications. However, the Office will accept photographs in utility patent applications only after the granting of a petition filed under this paragraph which requests that photographs be accepted. Any such petition must include the following:

(i) The fee set forth in § 1.17(i); and

(ii) Three (3) sets of photographs. Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawings are reproducible in the printed patent.

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

(c) Identification of drawings. Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawings a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page. In addition, a reference to the application number, or, if an application number has not been assigned, the inventor's name, may be included in the left-hand corner, provided that the reference appears within 1.5 cm. (5/8 inch) from the top of the sheet.

(d) Graphic forms in drawings. Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) Type of paper. Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, nonshiny, and durable. All sheets must be free from cracks, creases, and folds. Only one side of the sheet shall be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlinations. Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. See paragraph (b) of this section for other requirements for photographs.

(f) Size of paper. All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) Margins. The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two catercorner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

(h) Views. The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) Exploded views. Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) Partial views. When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) Sectional views. The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) Alternate position. A moved position may be shown by a broken line superimposed upon a suitable view if this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) Modified forms. Modified forms of construction must be shown in separate views.

(i) Arrangement of views. One view must not be placed upon another or within the outline of another. All views on the same sheet

should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) View for Official Gazette. One of the views should be suitable for publication in the *Official Gazette* as the illustration of the invention.

(k) Scale.

(1) The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Views of portions of the mechanism on a larger scale should be used when necessary to show details clearly. Two or more sheets may be used if one does not give sufficient room. The number of sheets should be kept to a minimum.

(2) When approved by the examiner, the scale of the drawing may be graphically represented. Indications such as "actual size" or "scale 1/2" on the drawings, are not permitted, since these lose their meaning with reproduction in a different format.

(3) Elements of the same view must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the view. Instead of showing elements in different proportion, a supplementary view may be added giving a larger-scale illustration of the element of the initial view. The enlarged element shown in the second view should be surrounded by a finely drawn or "dot-dash" circle in the first view indicating its location without obscuring the view.

(l) Character of lines, numbers, and letters. All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) Shading. The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the draw-

ing, subject to approval by the Office. They should contain as few words as possible.

(p) Numbers, letters, and reference characters.

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) Lead lines. Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) Arrows. Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) Copyright or Mask Work Notice. A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John Doe" (17 U.S.C. 401) and "M. John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

(t) Numbering of sheets of drawings. The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers

used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) Numbering of views.

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) Security markings. Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) Corrections. Any corrections on drawings submitted to the Office must be durable and permanent.

(x) Holes. No holes should be made by applicant in the drawing sheets.

>(See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)<

Drawings on paper are acceptable as long as they are in compliance with 37 CFR 1.84. Corrections thereto must be made in the form of replacement sheets since the Office does not release drawings for correction. See 37 CFR 1.85.

Good quality copies made on office copiers are acceptable if the lines are uniformly thick, black, and solid. Facsimile copies of drawings however, are not acceptable (37 CFR 1.6(d)(4)).

Drawings are currently accepted in two different size formats. It is, however, required that all drawings in a particular application be the same size for ease of handling and reproduction.

>For examples of proper drawings, in addition to selected rules of practice related to patent drawings and interpretations of those rules, see the "Guide for the Preparation of Patent Drawings" which is available from the Superintendent of Documents (see MPEP Introduction).

For information regarding certified copies of an application-as-filed which does not meet the sheet size/margin and quality requirements of 37 CFR 1.52, 1.84(f), and 1.84(g), see MPEP § 608.01.<

For design patent drawings, 37 CFR 1.152, see MPEP § 1503.02.

For plant patent drawings, 37 CFR 1.165, see MPEP § 1606.

For reissue application drawings, see MPEP § 1413.

For correction of drawings, see MPEP § 608.02(p). For prints, preparation and distribution, see MPEP § 508 and § 608.02(m). For prints, return of drawings, see MPEP § 608.02(y).

For pencil notations of classification and name or initials of assistant examiner to be placed on drawings, see MPEP § 719.03.

The filing of a divisional or continuation case under the provisions of 37 CFR 1.53(b) (unexecuted case) does not obviate the need for formal drawings. See MPEP § 608.02(b).

DEFINITIONS

A number of different terms are used when referring to drawings in patent applications. The following definitions are used in this Manual.

Original drawings: The drawing submitted with the application when filed. It may be either a formal or an informal drawing.

Substitute drawing: A drawing filed later than the filing date of an application. Usually submitted to replace an original informal drawing.

Formal drawing: A drawing in a form that complies with 37 CFR 1.84. Formal drawings are stamped "approved" by the Draftsperson.

Informal drawing: A drawing which does not comply with the form requirements of 37 CFR 1.84 >or which is declared as informal when filed<. Drawings may be informal because they are not on the proper size sheets, the quality of the lines is poor, or for other reasons such as the size of reference elements. Such objections are made by the *>Draftsperson< on form PTO-948. >A drawing declared as informal by the applicant when filed is not reviewed by the Draftsperson for compliance with 37 CFR 1.84. A substitute form PTO-948 is placed in the file to indicate that the drawings were filed as informal.<

Drawing print: This term is used for the white paper print prepared by the *>Scanning< Division of the Office of Initial Patent Examination (OIPE) of all original drawings. The drawing prints contain the **>application number near the left-hand margin.< Drawing prints should be placed on the top on the right-hand flap of the application file wrapper.

Interference print: This term is used to designate the copy prepared of the original drawings filed in file cabinets separate from the file wrappers and are used to make interference searches.

Plan: This term is used to illustrate the top view.

Elevation: This term is used to illustrate views showing the height of objects.

The following Form Paragraphs should be used when notifying applicants of drawing corrections.

¶ 6.38 Acknowledgment of Proposed Drawing Correction

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been [2].

Examiner Note:

1. In bracket 2, insert either --approved-- or --disapproved--.
2. If approved, form paragraph 6.39 and one or more of paragraphs 6.40 or 6.41 or 6.44 must follow.
3. If disapproved, an explanation must be provided.

¶ 6.38.01 Proposed Drawing Correction Disapproved, Changes Not Highlighted

The proposed drawing correction filed on [1] has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

¶ 6.38.02 Proposed Drawing Correction Disapproved, New Matter

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on [1] have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of [2].

Examiner Note:

In bracket 2, explain which feature(s) of the proposed drawing correction constitute(s) new matter.

¶ 6.39 PTO No Longer Makes Drawing Changes

The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

Examiner Note:

This paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

*¶ 6.40 Information on How To Effect Drawing Changes***INFORMATION ON HOW TO EFFECT DRAWING CHANGES****1. Correction of Informalities -- 37 CFR 1.85; 1097 O.G. 36**

New formal drawings must be filed with the changes incorporated therein. The art unit number, application number (including series code) and number of drawing sheets should be written on the reverse side of the drawings. Applicant may delay filing of the new drawings until receipt of the "Notice of Allowability" (PTOL-37 or PTO-37). If delayed, the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability" to avoid extension of time fees. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a) for filing the corrected drawings (but not for payment of the issue fee). The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the three month shortened statutory period set in the "Notice of Allowability". Within that three month period, two weeks should be allowed for

review of the new drawings by the Office. If a correction is determined to be unacceptable by the Office, applicant must arrange to have an acceptable correction re-submitted within the original three month period to avoid the necessity of obtaining an extension of time with extension fees. Therefore, applicant should file corrected drawings as soon as possible.

Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

¶ 6.41 Reminder That PTO No Longer Makes Drawing Changes

Applicant is reminded that the Patent and Trademark Office no longer makes drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in Paper No. [1], mailed on [2].

Examiner Note:

This paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes (i.e., either by way of form paragraph 6.40 or a PTO-948 has been previously sent).

¶ 6.42 Reminder That Applicant Must Make Drawing Changes

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in Paper No. [1], mailed on [2].

Examiner Note:

This paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes (i.e., by way of form paragraph 6.40 or a PTO-948 has been previously sent).

¶ 6.43 Drawings Contain Informalities, Application Allowed

The drawings filed on [1] are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required.

Examiner Note:

Use this paragraph when allowing the application, particularly at time of first action issue. Form paragraph 6.40 or 6.41 must follow.

¶ 6.44 Drawing Informalities Previously Indicated

In order to avoid abandonment, the drawing informalities noted in Paper No. [1], mailed on [2], must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Examiner Note:

Use this paragraph when allowing the application and applicant has previously been informed of informalities in the drawings.

¶ 6.47 Examiner's Amendment Involving Drawing Changes

The following changes to the drawings have been approved by the examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make these agreed upon drawing changes.

Examiner Note:

1. In bracket 1, insert the agreed upon drawing changes.
2. Form paragraphs 6.39 and 6.40 ****>**should follow, as appropriate<.

DRAWING SYMBOLS

37 CFR 1.84(n) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate, subject to approval by the Office. Also, suitable legends may be used, or may be

required, in proper cases. >For examples of suitable symbols and legends, see the "Guide for the Preparation of Patent Drawings" available from the Superintendent of Documents (see MPEP Introduction).<

The publications listed below have been reviewed by the Office and the symbols therein are considered to be generally acceptable in patent drawings. Although the Office will not "approve" all of the listed symbols as a group because their use and clarity must be decided on a case-by-case basis, these publications may be used as guides when selecting graphic symbols. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

These publications are available from the American National Standards Institute Inc., 11 West 42nd Street, New York, New York 10036.

The publications reviewed are the following:

Y32.2-1970 Graphic Symbols for Electrical & Electronics Diagrams

Y32.10-1967 (R1994) Graphic Symbols for Fluid Power Diagrams

Y32.11-1961 (R1993) Graphic for Process Flow Diagrams in the Petroleum & Chemical Industries

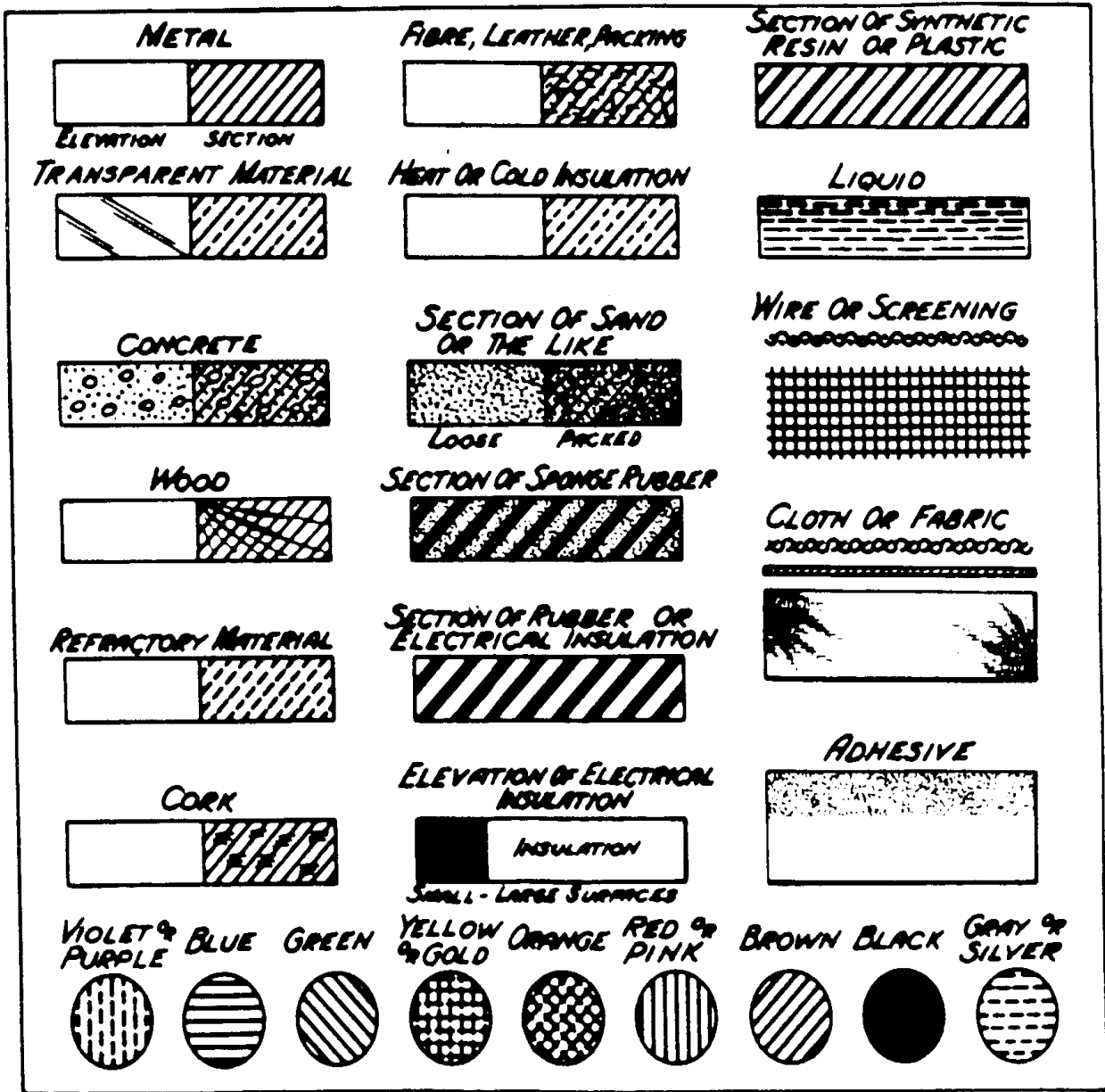
Y32.14-1962 Graphic Symbols for Logic Diagrams

Z32.2.3-1949 (R1994) Graphical Symbols for Pipe Fittings, Valves and Piping

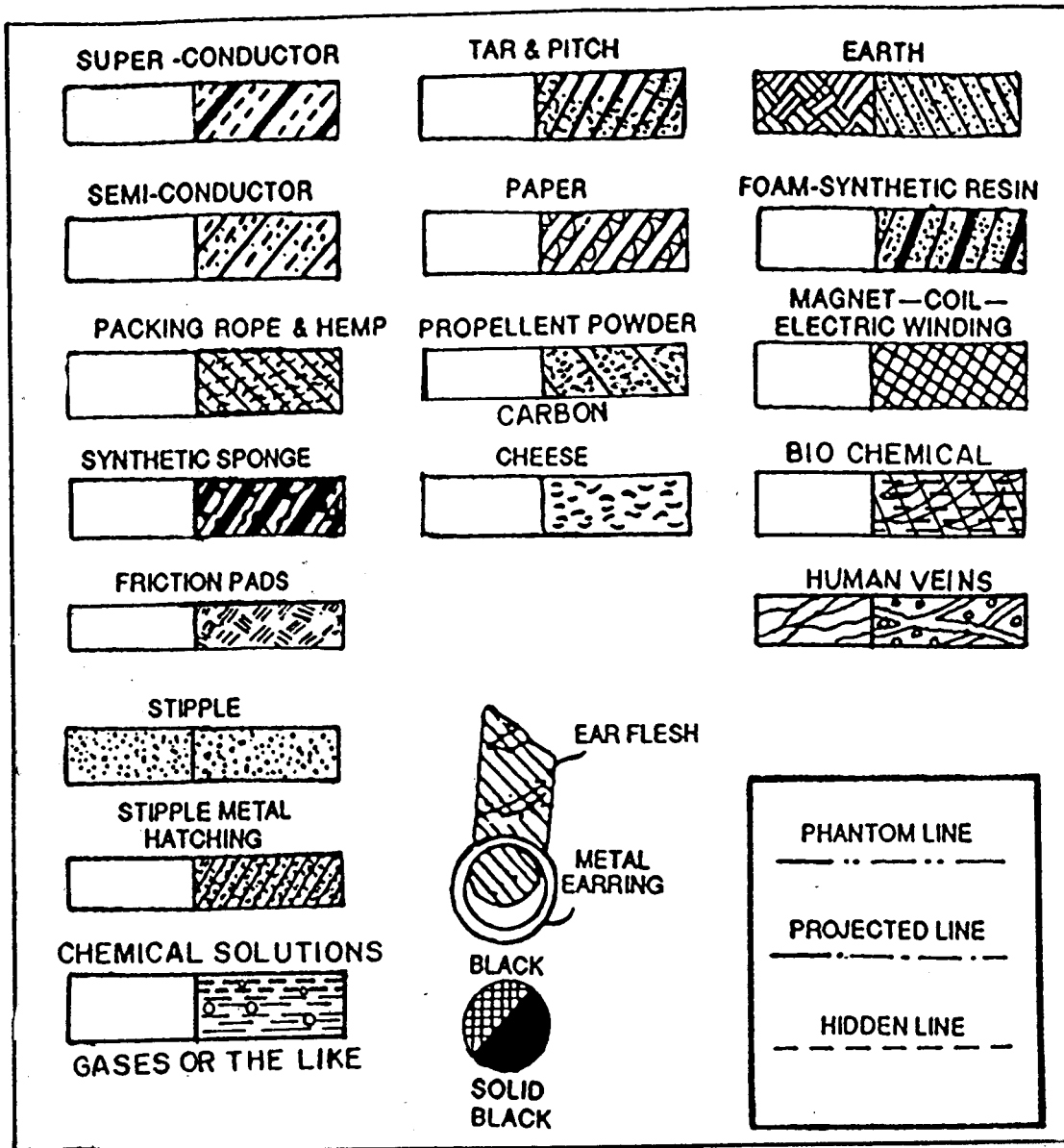
Z32.2.4-1949 (R1953) Graphic Symbols for Heating, Ventilating & Air Conditioning

Z32.2.6-1950 (R1993) Graphic Symbols for Heat-Power Apparatus

The following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional features is very helpful in making prior art searches.



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See MPEP § 601.01(f) for treatment of applications filed without drawings and MPEP § 601.01(g) for treatment of applications filed without all figures of drawings.

ILLUSTRATION SUBSEQUENTLY REQUIRED

The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under 37 CFR 1.81(c) or 37 CFR

1.83(c). In requiring such a drawing, the examiner should clearly indicate that the requirement is made under 37 CFR 1.81(c) or 37 CFR 1.83(c) and be careful not to state that he or she is doing so “because it is necessary for the understanding of the invention,” as that might give rise to an erroneous impression as to the completeness of the application as filed. Examiners making such requirements are to specifically require, as a part of the applicant's next reply, at least an ink sketch or permanent print of any drawing

proposed in reply to the requirement, even though no allowable subject matter is yet indicated. This will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See 37 CFR 1.121 and 37 CFR 1.81(d). The description should of course be amended to contain reference to the new illustration. This may obviate further correspondence where an amendment places the case in condition for allowance, except for the formal requirement relating to the drawing. In the event of a final determination that there is nothing patentable in the case, a formal drawing will not be required.

BLACK AND WHITE PHOTOGRAPHS

37 CFR 1.84. *Standards for drawings.*

(b) *Photographs.*

(1) *Black and white.* Photographs are not ordinarily permitted in utility patent applications. However, the Office will accept photographs in utility patent applications only after the granting of a petition filed under this paragraph which requests that photographs be accepted. Any such petition must include the following:

(i) The fee set forth in § 1.17(i); and

(ii) Three (3) sets of photographs. Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawings are reproducible in the printed patent.

Photographs ** or photomicrographs (not photolithographs or other reproductions of photographs made by using screens) printed on sensitized paper >are acceptable as final drawings,< in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings, e.g., crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

>Photographs submitted in lieu of ink drawings must comply with 37 CFR 1.84(b). However, the requirement of 37 CFR 1.84(b)(1) for a petition, petition fee, and three sets of black and white photographs has been waived. For black and white photographs, there is no requirement for a petition or petition fee, and only one set of photographs is required. See 1213 O.G. 108 (Aug. 4, 1998) and 1211 O.G. 34 (June 9, 1998).<

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth; tint, white, or be photographs mounted on proper size bristol board.

See MPEP § 1503.02 for discussion of photographs used in design patent applications.

COLOR DRAWINGS OR COLOR PHOTOGRAPHS

37 CFR 1.84. *Standards for drawings.*

(a) Drawings. There are two acceptable categories for presenting drawings in utility patent applications:

(2) *Color.* On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application or the subject matter of a statutory invention registration. The Patent and Trademark Office will accept color drawings in utility patent applications and statutory invention registrations only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in § 1.17(i);

(ii) Three (3) sets of color drawings; and

(iii) The specification must contain the following language as the first paragraph in that portion of the specification relating to the brief description of the drawing:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.

(b) Photographs.

(2) Color. Color photographs will be accepted in utility patent applications if the conditions for accepting color drawings have been satisfied. See paragraph (a)(2) of this section.

Limited use of color drawings in utility patent applications is provided for in 37 CFR 1.84(a)(2) and (b)(2). Unless a petition is filed and granted, the Draftsperson will not approve color drawings or color photographs in a utility or design patent application. The examiner must object to the color drawings or color photographs as being improper and require applicant either to cancel the drawings or to provide substitute black and white drawings.

Under 37 CFR 1.84(a)(2) and (b)(2), the applicant must file a petition with fee requesting acceptance of the color drawings or color photographs. The petition is decided by a Supervisory Patent Examiner. See MPEP § 1002.02(d).

Where color drawings or color photographs are filed in a continuing application, applicant must renew the petition under 37 CFR 1.84(a)(2) and (b)(2) even though a similar petition was filed in the prior application. Until the renewed petition is granted, the examiner must object to the color drawings or color photographs as being improper.

In light of the substantial administrative and economic burden associated with printing a utility patent with color drawings or color photographs, the patent copies which are

printed at issuance of the patent will depict the drawings in black and white only. However, a set of color drawings or color photographs will be attached to the Letters Patent. Moreover, copies of the patent with color drawings or color photographs attached thereto will be provided by the Patent and Trademark Office upon special request and payment of the fee necessary to recover the actual costs associated therewith.

Accordingly, the petition must also be accompanied by a proposed amendment to insert the following language as the first paragraph in the portion of the specification containing a brief description of the drawings:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

It is anticipated that such a petition will be granted only when the Patent and Trademark Office has determined that a color drawing or color photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

It is emphasized that a decision to grant the petition should not be regarded as an indication that color drawings or color photographs are necessary to comply with a statutory requirement. In this latter respect, clearly it is desirable to file any desired color drawings or color photographs as part of the original application papers in order to avoid issues concerning statutory defects (e.g., lack of enablement under 35 U.S.C. 112 or new matter under 35 U.S.C. 132). The filing of the petition, however, may be deferred until acceptable formal drawings are required by the examiner.

NOTIFYING APPLICANT

If the original drawings are informal but may be admitted for examination purposes, the Draftsperson indicates on a 2-part form, PTO-948, what the informalities are and that new corrected drawings are required. In either case, the informal drawings are accepted as satisfying the requirements of 37 CFR 1.51.

The examiners are directed to advise the applicants by way of form PTO-948 (see MPEP § 707.07(a)) in the first Office action of the conditions which the Draftsperson considers to render the drawing informal.

Drawing corrections should be made when the application is in condition for allowance unless the examiner requires correction at an earlier date.

If the examiner discovers a defect in the content of the drawing, the applicant should be notified by using a Form Paragraph, where appropriate.

¶ 6.21 *New Drawings, Competent Draftsperson*

New formal drawings are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

¶ 6.22 *Drawings Objected To*

The drawings are objected to because [1]. Correction is required.

Examiner Note:

Follow with paragraph 6.27, if appropriate.

¶ 6.22.01 *Drawings Objected To, Details Not Shown*

The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Examiner Note:

1. In bracket 1, identify the structural details not shown in the drawings.
2. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.02 *Drawings Objected to, Different Numbers Refer to Same Part*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters “ [1]” and “ [2]” have both been used to designate [3]. Correction is required.

Examiner Note:

1. In brackets 1 and 2, identify the numbers which refer to the same part.
2. In bracket 3, identify the part which is referred to by different numbers.
3. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.03 *Drawings Objected to, Different Parts Referred to by Same Number*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “ [1]” has been used to designate both [2] and [3]. Correction is required.

Examiner Note:

1. In bracket 1, identify the number which refers to the different parts.
2. In brackets 2 and 3, identify the parts which are referred to by the same number.
3. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.04 *Drawings Objected to, Incomplete*

The drawings are objected to under 37 CFR 1.83(b) because they are incomplete. 37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Correction is required.

Examiner Note:

1. Supply a full explanation, if it is not readily apparent how the drawings are incomplete.
2. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.05 Drawings Objected to, Modifications in Same Figure

The drawings are objected to under 37 CFR 1.84(h)(5) because Figure [1] show(s) modified forms of construction in the same view. Correction is required.

Examiner Note:

1. In *¶* 1, insert the appropriate Figure number(s).
2. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.06 Drawings Objected to, Reference Numbers Not in Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: [1]. Correction is required.

Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the drawings, including the page and line number where they first occur in the specification.
2. Follow with form paragraph 6.27, if appropriate.

¶ 6.22.07 Drawings Objected to, Reference Numbers Not in Specification

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: [1]. Correction is required.

Examiner Note:

1. In bracket 1, specify the reference characters which are not found in the specification, including the figure in which they occur.
2. Follow with form paragraph 6.27, if appropriate.

¶ 6.23 Subject Matter Admits of Illustration

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Examiner Note:

When requiring drawings before examination use form paragraph 6.23.01 with a PTOL-90 or PTO-90C form as a cover sheet.

¶ 6.23.01 Subject Matter Admits of Illustration (No Examination of Claims)

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to lack of an illustration of the invention resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

¶ 6.24 Informal Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

¶ 6.24.01 Color Photographs and Color Drawings, Petition Required

¶ Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) or **¶**(b)(2) is granted permitting their use as formal drawings. In the event applicant wishes to use the drawings currently on file as formal drawings, a petition must be filed for acceptance of the color photographs or color drawings as formal drawings. Any such petition must be accompanied by the appropriate fee as set forth in 37 CFR 1.17(i), three sets of color drawings or color photographs, as appropriate, and **¶** an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The file of this patent contains at least one drawing executed in color. Copies of this patent with color drawing(s) will be provided by the Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Examiner Note:

1. This form paragraph should be used after form paragraph 6.24 only if the application contains color photographs or color drawings as the drawings required by 37 CFR 1.81.

>

2. Do not use this form paragraph for black and white photographs. The requirement of 37 CFR 1.84(b)(1) for a petition, petition fee, and three sets of black and white photographs has been waived. For black and white photographs, there is no requirement for a petition or petition fee, and only one set of photographs is required. See 1213 O.G. 108 (Aug. 4, 1998) and 1211 O.G. 34 (June 9, 1999).

¶ 6.25.01 Formal Drawings Suggested, Allowable Subject Matter Indicated

Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

¶ 6.26 Informal Drawings Do Not Permit Examination

The informal drawings are not of sufficient quality to permit examination. Accordingly, new drawings are required in reply to this Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit new drawings will result in **ABANDONMENT** of the application.

Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to the poor quality of the drawings resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

¶ 6.27 Correction Held in Abeyance

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

DRAWING REQUIREMENTS

The first sentence of 35 U.S.C. 113 requires a drawing to be submitted upon filing where such drawing is necessary

for the understanding of the invention. In this situation, the lack of a drawing renders the application incomplete and, as such, the application cannot be given a filing date until the drawing is received. The second sentence of 35 U.S.C. 113 deals with the situation wherein a drawing is not necessary for the understanding of the invention, but the case admits of illustration and no drawing was submitted on filing. The lack of the drawing in this situation does not render the application incomplete but rather is treated much in the same manner as an informality. The examiner should require such drawings in almost all such instances. Such drawings could be required during the processing of the application but do not have to be furnished at the time the application is filed. The applicant is allowed at least 2 months from the date of the letter requiring drawings to submit them.

Handling of Drawing Requirements Under the First Sentence of 35 U.S.C. 113

The Office of Initial Patent Examination (OIPE) will make the initial decision in all new applications as to whether a drawing is “necessary” under the first sentence of 35 U.S.C. 113. A drawing will be considered necessary under the first sentence of 35 U.S.C. 113 in all cases where the drawing is referred to in the specification and one or more figures have been omitted.

The determination under 35 U.S.C. 113 (first sentence) as to when a drawing is necessary will be handled in OIPE according to the following procedure. OIPE will make the initial determination whether or not drawings are required for the understanding of the subject matter of the invention. ** When >no drawings are included in the application as filed and< drawings are required, the application is treated as incomplete and the applicant is so informed by OIPE. The filing date will not be granted and applicant will be notified to complete the application (37 CFR 1.53(e)). ** If a drawing is later furnished, a filing date may be granted as of the date of receipt of such drawing.

>An OIPE formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains:

- (1) at least one process claim including the term “process” or “method” in its introductory phrase;
- (2) at least one composition claim including the term “composition,” “compound,” “mixture” or “pharmaceutical” in its introductory phrase;
- (3) at least one claim directed to a coated article or product or to an article or product made from a particular material or composition (i.e., an article of known and conventional character (e.g., a table), coated with or made of a

particular composition (e.g., a specified polymer such as polyvinyl-chloride);

(4) at least one claim directed to a laminated article or product (i.e., a laminated article of known and conventional character (e.g., a table)); or

(5) at least one claim directed to an article, apparatus, or system where the sole distinguishing feature is the presence of a particular material e.g., a hydraulic system using a particular hydraulic fluid, or a conventional packaged suture using a particular material).

For a more complete explanation about when a drawing is required, see MPEP § 601.01(f). For applications submitted without all of the drawings described in the specification, see MPEP § 601.01(g).<

If an examiner feels that a filing date should not have been granted in an application because it does not contain drawings, the matter should be brought to the attention of the supervisory patent examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to OIPE with a typed, signed, and dated memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

608.02(a) New Drawing — When Required [R-1]

Utility and design patent applications should be taken up for the first Office action without a request for formal drawings unless the informal drawings are so unclear that they do not facilitate an understanding of the invention as to permit examination of the application. If at the time of the initial assignment of an application to an examiner's docket, or if at the time the application is taken up for action, the supervisory patent examiner believes the informal drawings to be of such a condition as to not permit reasonable examination of the application, applicant should be required to immediately submit formal drawings. However, if the informal drawings do * permit >reasonable< examination and the supervisory patent examiner believes the drawings are of such a character as to render the application defective under 35 U.S.C. 112, examination should begin immediately with a requirement for formal drawings and a rejection of the claims as not being in compliance with 35 U.S.C. 112, first paragraph, being made.

Formal drawings should be required when the application is allowed.

Forms PTOL-326 and PTOL-37 now provide items for requiring formal drawings.

Form Paragraph 6.45 may also be used to inform applicant that formal drawings are required.

¶ 6.45 Application Allowed, Formal Drawings Needed

Formal drawings are now required and must be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability" (PTOL-37 or PTO-37). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit the drawings will result in **ABANDONMENT** of the application. The drawings should be submitted as a separate paper with a transmittal letter which is addressed to the Official Draftsperson. The art unit number, application number and number of drawing sheets should be written on the reverse side of the drawings.

HANDLING OF DRAWING REQUIREMENTS UNDER THE SECOND SENTENCE OF 35 U.S.C. 113

35 U.S.C. 113 deals with the situation wherein the drawing is not necessary for the understanding of the invention, but the subject matter admits of illustration by a drawing and the applicant has not furnished a drawing. The lack of the drawing in this situation does not render the application incomplete but rather is treated as an informality. A filing date will be accorded with the original presentation of the papers, despite the absence of drawings. In these situations, a drawing or further illustration will normally be required by the examiner. This may be done in the first Office action or prior to examination in a separate letter. The examiner should require additional drawings, where appropriate, as early as possible since the possession of the additional drawings would facilitate the examination process. A separate letter requiring drawings may contain wording similar to the following:

The examiner has decided that the subject matter of this application admits of illustration by a drawing and that a drawing would facilitate the understanding of the subject matter disclosed. (Continue with a specific mention of those items of which drawings are desired.) Applicant is required to furnish a drawing under 37 CFR 1.81 (Incorporate in Office action or send a separate letter setting a 2-month period for reply.)

The applicant should be given at least 2 months from the date of a requirement to submit drawings made in a separate letter. If the requirement for drawings is included in an Office action, the time for supplying the additional drawings will be the same as the time for reply to the Office action.

RECEIPT OF DRAWING AFTER THE FILING DATE

If new matter is noticed by the examiner in a substitute or additional drawing, the drawing should not be entered. It should be objected to as containing new matter. A new drawing without such new matter may be required if the examiner feels a drawing is needed under 37 CFR 1.81 or 37 CFR 1.83. The examiner's decision would be reviewable by petition to the Commissioner under 37 CFR 1.181. The decision on such a petition would be handled by the Group Director.

UNTIMELY FILED DRAWINGS

If a drawing is not timely received in reply to a letter from the examiner who requires a drawing, the application becomes abandoned for failure to reply.

For the handling of additional, duplicate, or substitute drawings, see MPEP § 608.02(h).

608.02(b) Informal Drawings

37 CFR 1.85. Corrections to drawings.

(a) The requirements of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for reproduction, may be admitted for examination but in such case a new drawing must be furnished.

(b) The Patent and Trademark Office will not release drawings in applications having a filing date after January 1, 1989, or any drawings from any applications after January 1, 1991, for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) When corrected drawings are required to be submitted at the time of allowance, the applicant is required to submit acceptable drawings within three months from the mailing of the "Notice of Allowability." Within that three-month period, two weeks should be allowed for review of the drawings by the Drafting Branch. If the Office finds that correction is necessary, the applicant must submit a new corrected drawing to the Office within the original three-month period to avoid the necessity of obtaining an extension of time and paying the extension fee. Therefore, the applicant should file corrected drawings as soon as possible following the receipt of the Notice of Allowability. The provisions with respect to obtaining an extension of time relates only to the late filing of corrected drawings. The time limit for payment of the issue fee is a fixed three-month period which cannot be extended as set forth in 35 U.S.C. 151.

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PTO-948 or in an examiner's action, and that the drawing is admitted for examination purposes only (see MPEP § 707.07(a)). To be fully responsive, an amendment must include a request for drawing corrections when the application is allowed or an appeal is filed. See 37 CFR 1.111(b).

INFORMAL DRAWINGS

To expedite filing, applicants sometimes submit applications with informal drawings. Such applications are accepted by the Office of Initial Patent Examination (OIPE) for filing only, provided the informal drawings are readable and reproducible. Applicant is notified on Form PTO-948 or in an Office action that formal drawings, in compliance with 37 CFR 1.84 will be required when the application is allowed. Form Paragraph 6.24 may be used for this purpose.

¶ 6.24 Informal Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Alternatively, the examiner may check the appropriate box on the Office Action Summary, PTOL-326.

HANDLING OF NEW DRAWINGS

In those situations where an application is filed with informal drawings, applicants are requested to wait until they receive their "Notice of Draftsperson's Patent Drawing Review" form, PTO-948, or the first Office action utilizing form PTOL-326 or PTOL-37 from the group art unit before submitting the formal drawings. The letter of transmittal accompanying the formal drawings should identify the group art unit indicated on form PTO-948 or form PTOL-326. If the informal notification appears on form PTOL-37, the date of the mailing of the Notice of Allowance and Issue Fee as well as the Issue Batch Number must be given. Also, each sheet of the drawing should include the application number and group art unit in the upper right margin. In the past, some drawings have been misdirected because the group art unit indicated on the filing receipt was used rather than that indicated on the informal notice forms.

The Draftsperson is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the examiner is the judge as to the sufficiency of the showing. The drawings received with an application are inspected by the draftsperson. If the drawing is satisfactory, he or she stamps on each sheet "Approved by Draftsman" and checks the approved box on Form PTO-948. See also MPEP § 608.02.

RECEIPT OF SUBSTITUTE DRAWINGS

If substitute drawings are timely filed, the examining group technical support staff should immediately send the new substitute drawings with the file wrapper to the Draftsperson for approval as to form.

If the application is allowed on the first action, the examiner should require formal drawings using form PTOL-37.

COMPARISON OF SUBSTITUTE DRAWINGS

In utility applications, the examination will normally be conducted using any informal drawings presented. The sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the informal drawings. IT IS APPLICANT'S RESPONSIBILITY TO SEE THAT NO NEW MATTER IS ADDED when submitting substitute drawings since they will not normally be reviewed by an examiner. Of course, if the examiner notices new matter in the substitute drawings, appropriate action to have the new matter deleted should be undertaken.

608.02(c) Drawing Print Kept in File Wrapper [R-1]

The drawing prints must always be kept on top of the papers on the right side of the file wrapper so as to be visible upon opening the wrapper and to permit them to be easily detached.

Applications may be sent to issue or to the Files Repository without the original drawing, if any, if the drawing cannot be located. For an application sent to issue with missing drawings, see MPEP § 608.02(z). For abandoned applications sent to the Files Repository, a notation should be made on the Contents portion of the file wrapper that the drawings were missing.

Upon initial processing, the original drawings are placed in the center portion of the application file wrapper *>on top of< the application papers by the *>Scanning< Division. The formal drawings should be retained in this position >for review by the Draftsperson<.

608.02(d) Complete Illustration in Drawings

37 CFR 1.83. Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

Any structural detail that is of sufficient importance to be described should be shown in the drawing. (*Ex parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911).)

Form Paragraph 6.36 should be used to require illustration.

¶ 6.36 Drawings Do Not Show Claimed Subject Matter

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Examiner Note:

In bracket 1, insert the features that must be shown.

See also MPEP § 608.02(a).

608.02(e) Examiner Determines Completeness of Drawings

The examiner should see to it that the figures are correctly described in the brief description of the several views of the drawing section of the specification, that the reference characters are properly applied, that no single reference character is used for two different parts or for a given part and a modification of such part, and that there are no superfluous illustrations.

608.02(f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. *Ex parte Badger*, 1901 C.D. 195, 97 O.G. 1596 (Comm'r Pat. 1901).

All modifications described must be illustrated, or the text canceled. (*Ex parte Peck*, 1901 C.D. 136, 96 O.G. 2409 (Comm'r Pat. 1901).) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

608.02(g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliott*, 1904 C.D. 103, 109 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, Form Paragraph 6.36.01 may be used.

¶ 6.36.01 Illustration of "Prior Art"

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

608.02(h) Additional, Duplicate, or Substitute Drawings [R-1]

When an amendment is filed stating that substitute or additional sheets of drawings are filed with the amendment and such drawings have not been transmitted to the examining group, the technical support staff in the examining group should attempt to locate the missing drawings. In the next communication of the examiner, the applicant is notified if the drawings have been received and whether or not the substitute or additional drawings have been entered in the application. If the substitute or additional drawings are not entered, the examiner should give the applicant a concise and complete explanation as to why the drawings were not entered.

Additional and substitute drawings, together with the file wrapper, are routed through the Draftsperson where any defects in execution will be noted. If there are none, they will be stamped, "Approved By Draftsman." When

such drawings are considered by the examiner, it should be kept in mind that the "Approved" stamp applies only to the size and quality of paper, lines rough and blurred, and other details of execution. **

The examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. The technical support staff will routinely enter all additional and substitute sheets on the file wrapper. ** If the examiner decides that the sheets should not be entered, **>the examiner should provide the applicant with the complete, explicit reasoning for the denial of entry.< The entries made by the technical support staff will be marked "(N.E.)." >The additional or substitute drawing sheets should be entered by the technical support staff after approval by both the draftsman and the examiner.<

Form Paragraph 6.37 may be used to acknowledge corrected or substituted drawings.

¶ 6.37 Acknowledgment of Corrected or Substitute Drawings

The corrected or substitute drawings were received on [1]. These drawings are [2].

Examiner Note:

1. In bracket 2, insert either --acceptable-- or --not acceptable--.
2. If not acceptable, an explanation must be provided.
3. If not acceptable because of informalities noted on PTO-948, use form paragraph 6.43.

Alternatively, PTOL-326 Office Action Summary includes a block for acknowledgment of corrected or substitute drawings.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

For return of drawing, see MPEP § 608.02(y).

608.02(i) Transfer of Drawings From Prior Applications

Transfer of drawings from a first pending application to another will be made only upon the granting of a petition filed under 37 CFR 1.182 which must set forth a hardship situation requiring such transfer of drawings.

608.02(m) Drawing Prints [R-1]

Preparation and distribution of drawing prints is discussed in MPEP § 508.

Prints are made of the drawings of an acceptable application. These prints are ** kept on top of the papers on the right side of the file wrapper *. See MPEP § 719.01(b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the **>application< number.

The print ** should not be >permanently< marked or in any way altered. The original drawing, of course, should not be marked up by the examiner. Where, as in an electrical wiring case, it is desirable to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows, or other indicia, an additional print for such use should be made ** by the examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in MPEP § 608.02(c).

INTERFERENCE PRINTS

A print is prepared of each drawing in all applications having a filing date. This interference print is in addition to the drawing print on white paper. **>The classification of the application should be placed on the interference print. All interference prints are then placed in the drawing cabinets.<

If an application has several sheets of drawings, the interference prints should be stapled together at their bottom edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the interference prints are removed from the drawing cabinets is determined by the Group Director.

The drawings filed by applicant remain in the file wrapper.

608.02(n) Duplicate Prints in Patentability Report Cases

In patentability report cases having drawings, the examiner to whom the case is assigned should normally obtain a duplicate set of the interference prints of the drawing for filing in the group to which the case is referred.

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

For patentability reports, see MPEP § 705 to § 705.01(f).

608.02(o) *>Notations< Entered on Drawing [R-1]

**>Drawing sheets received by the Mail Center are endorsed with the application number in the left-hand margin.< If the drawings are filed in the examining group, the

group date of receipt stamp should be applied to the back of the drawing near the top.

Approval by the **>Draftsperson< is indicated by a legend associated with the “O.G. Fig. Cl. . . . Sub. . . .” stamp on the front of each sheet.

608.02(p) Correction of Drawings

37 CFR 1.121. *Manner of making amendments*

(a) *Amendments in nonprovisional applications, other than reissue applications:* Amendments in nonprovisional applications, excluding reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(3) *Drawings.*

(i) Amendments to the original application drawings are not permitted. Any change to the application drawings must be by way of a substitute sheet of drawings for each sheet changed submitted in compliance with § 1.84.

(ii) Where a change to the drawings is desired, a sketch in permanent ink showing proposed changes in red, to become part of the record, must be filed for approval by the examiner and should be in a separate paper.

For corrections which are deferrable, see MPEP § 608.02(b). For correction at allowance and issue, see MPEP § 608.02(w) and MPEP § 1302.05.

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description of the view if a canceled figure is reinstated.

608.02(q) Conditions Precedent to Amendment of Drawing [R-1]

*>Prior to allowance no< alterations will be permitted unless required by an examiner's letter in each case or proposed in writing by applicant or his or her attorney or agent. In either case, the alterations or corrections as indicated in the sketches filed with the request of the applicant or his or her attorney or agent must be given written approval by the examiner before the drawing is corrected.

CORRECTION OF INFORMALITIES (DRAFTSPERSON'S OBJECTIONS ON PTO-948)

Form Paragraph 6.40 (reproduced in MPEP § 608.02), the back page of PTO-948, and the back page of PTOL-37, the “Notice of Allowability,” provide detailed information on how to effect drawing changes.

In order to correct any informalities in the drawings, applicants *MUST* comply with the requirements set forth below. Failure to do so will result in *ABANDONMENT* of the application.

File new drawings with the changes incorporated therein. Applicant may delay filing of the new drawings until the application is allowed by the examiner. If delayed,

the new drawings *MUST* be filed within the period set for reply in the "NOTICE OF ALLOWABILITY" (PTOL-37). The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson which indicates the following in the upper right-hand corner:

Date of the Notice of Allowability
Issue Batch Number
Application Number

CORRECTIONS OTHER THAN INFORMALITIES NOTED BY THE DRAFTSPERSON ON THE PTO-948

All changes to the drawings, other than informalities noted by the Draftsperson, *MUST* be made in the same manner as above except that, normally, a sketch of the changes to be incorporated into the new drawings *MUST* be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

608.02(r) Separate Letter to Draftsperson

Any proposal by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter. Otherwise the case, unless in other respects ready for issue, cannot be corrected, and applicant must be so advised in the next action by the examiner.

For changes which may require sketches, see MPEP § 608.02(v).

608.02(t) Cancellation of Figures [R-1]

Cancellation of one or more figures which do not occupy entire sheets of the drawings is done by the technical support staff in the examining group who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancellation or the date that substitute sheets are filed should be written in red ink within the red line. Cancellation of an entire sheet of drawings is done by stamping the words "CANCEL per" **>on the back side of the drawing sheet<. Canceled drawing sheets should be placed >upside down< at the bottom of the papers on the right side of the file wrapper.

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, >the examiner should consult with< the Draftsperson ** as to whether the remaining figures should be transferred to other sheets already in the case or

shown in additional drawings. Cancellation of a figure may necessitate renumbering of the remaining figures.

608.02(v) Drawing Changes Which Require Sketches

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch must be filed showing such changes in red ink or with the changes otherwise highlighted. Ordinarily, broken lines may be changed to full without a sketch.

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

608.02(w) Drawing Changes Which May Be Made Without Applicant's Sketch [R-1]

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare a letter >to the applicant< indicating the change to be made and note in pencil on the drawing the addition or alteration to be made. >The marked-up copy of the drawing should be attached to the letter to the applicant.<

The correction must be made at applicant's expense.

As a guide to the examiner, the following corrections are illustrative of those that may be made by penciling in the change on the drawing without a sketch:

- (A) Adding two or three reference characters or exponents.
- (B) Changing one or two numerals or figure ordinals. *Garrett v. Cox*, 233 F.2d 343, 346, 110 USPQ 52, 54 (CCPA 1956).
- (C) Removing superfluous matter.
- (D) Adding or reversing directional arrows.
- (E) Changing Roman Numerals to Arabic Numerals to agree with specification.
- (F) Adding section lines or brackets, where easily executed.
- (G) Changing lead lines.
- (H) Correcting misspelled legends.

608.02(x) Disposition of Orders for Amendment of Drawing [R-1]

Where the correction of the drawing is approved by the examiner, the application and drawing are forwarded to the Publishing Division along with the Notice of Allowance.

CORRECTION NOT APPROVED

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not approved. **>The examiner should explicitly and clearly set forth all the reasons for not approving the corrections to the drawings in the next communication to the applicant.<

608.02(y) Return of Drawing [R-1]

If there is a formal drawing in the case, nonentered drawings (except those originally filed) that have been finally denied admission will be returned to the applicant only at applicant's request.

A request for return of nonentered drawings must be filed within a reasonable time; otherwise, the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, the examiner's letter stating that the drawing is being returned, and the drawing are taken to the **>manager of the Publishing Division< where the letter will be stamped and the drawing returned. The letter is mailed by the **>Publishing Division<.

Before drawings are returned, prints are made and put in the application file.

608.02(z) Allowable Applications Needing Drawing Corrections or Formal Drawings [R-1]

Allowable applications *>should< be turned in for counting and forwarding to the Publishing Division without the drawings having been corrected. When sending allowed applications to the Publishing Division which require drawing corrections, * yellow tag form PTO-1364 >must be attached to the center of the file. The yellow tag form PTO-1364 does not need to be filled out by the examiner<. The approved formal drawings requiring correction should be placed as the top papers in the center fold of the file wrapper. The drawing correction instructions >, for example a drawing sheet with corrections marked in pencil,< should be stapled to the right outside flap of the file wrapper over the area having the search information. Care should be taken to make certain that the corrections have been approved by the examiner. Such approval should be made by the examiner prior to counting the allowance of the application.

**

The yellow tag procedure should not normally be used in other situations where corrected drawings have been filed but have not been approved by the Draftsperson unless the

examiner is quite sure that the Draftsperson will approve the new drawings or in the situation where the application was examined utilizing an informal drawing and the request for formal drawings was not made until the Notice of Allowability was mailed. The yellow tag procedure should not be used in design applications where the drawings have not been approved by the Draftsperson because of shading problems which can arise. If the substitute drawings are not approved by the Draftsperson, the application should be promptly taken up for action by the examiner.

| | | |
|---|-----------------|--|
| To: DRAFTING DIVISION via PUBLISHING DIVISION | | |
| Return to: PUBLISHING DIVISION CPK-3, Room 915 | | |
| O.G. Fig. _____ | Serial No _____ | |
| Class _____ | Subclass _____ | |
| PTO-1364 (Rev. 2-955) | (OVER) | U.S. DEPARTMENT OF COMMERCE Patent & Trademark Office |

APPLICATIONS HAVING LOST DRAWINGS

A yellow tag is to be attached to the file wrapper and a "Drawing Missing" memo **>should< be stapled to the face of the file wrapper. The Notice of Allowability is verified and printed using PALM, and the Notice is mailed to the applicant.

The application is then forwarded to Licensing and Review or the Publishing Division, as appropriate, using the PALM transaction code after the application has been revised for issue.

UTILITY PATENT APPLICATIONS RECEIVING FORMAL DRAWINGS AFTER THE NOTICE OF ALLOWABILITY

Where substitute drawings are received in utility patent applications examined with informal drawings and the Notice of Allowability was mailed prior to the receipt of the substitute drawings, the **>technical support staff should forward the substitute drawings to the Publishing Division<. Submission to the examiner is not necessary unless an amendment accompanies the drawings which changes the specification, such as where the description of figures is added or canceled.

BORROWING FILES FROM **>PUBLISHING DIVISION<

Allowed files requiring drawing corrections are sent to ** the Publishing Division. At times, examiners have a need to borrow these applications. When borrowing

applications, examining corps personnel must submit a request to the Office of Patent Publications Customer Service Center.

37 CFR 1.312 AMENDMENTS

In handling 37 CFR 1.312 amendments, the examining corps should process drawings canceled in the normal manner. If there are corrections to the drawing, approval, if appropriate, is indicated by the examiner on form PTOL-271 in conjunction with Form Paragraph 6.48; the paragraph sets the appropriate period for effecting the approved drawing change.

¶ 6.48 Drawing Changes in 37 CFR 1.312 Amendment

Applicant is hereby given **ONE MONTH** from the >mailing< date of this letter or until the expiration of the period set in the "Notice of Allowance" (PTOL-85) or "Notice of Allowability" (PTOL-37 or PTO-37), whichever is longer, to file corrected drawings.

Examiner Note:

Use with the 37 CFR 1.312 amendment notice where there is a drawing correction proposal or request.

Formal drawings may be required in an allowed application by using Form Paragraph 6.25 in an Office action or by checking the appropriate box on form letter PTOL-37.

¶ 6.25 Formal Drawings Required, Application Allowed

The application having been allowed, formal drawings are required in response to this Office action.

Examiner Note:

Use this form paragraph only with the Notice of Allowability/Examiner's Amendment.

608.03 Models, Exhibits, Specimens

35 U.S.C. 114. Models, specimens.

The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

37 CFR 1.91. Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

- (1) Substantially conforms to the requirements of § 1.52 or § 1.84;
- (2) Is specifically required by the Office; or
- (3) Is filed with a petition under this section including:
 - (i) The petition fee as set forth in § 1.17(i); and
 - (ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

Models or exhibits are generally not admitted as part of an application or patent unless the requirements of 37 CFR 1.91 are satisfied.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

A physical exhibit, not to be part of the application, is generally not refused except when bulky or dangerous. Such exhibit, if left with the examiner, may be disposed of at the discretion of the Office.

37 CFR 1.93. Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients, or intermediates, for the purpose of inspection or experiment.

See MPEP Chapter 2400 regarding treatment of biotechnology deposits.

**

608.03(a) Handling of Models, Exhibits, and Specimens

All models and exhibits received in the Patent and Trademark Office should be taken to the examining group assigned the related application for examination. The receipt of all models and exhibits which are to be entered into the application file record must be properly recorded on the "Contents" portion of the application file wrapper.

A label indicating the application number, filing date, and attorney's name and address should be attached to the model or exhibit so that it is clearly identified and easily returned after prosecution of the application is closed, if return is requested and the model or exhibit is deemed not necessary for the examination of the application. See 37 CFR 1.94.

If the model or exhibit cannot be conveniently stored within the application file wrapper, it should not be accepted.

Models and exhibits may be presented for demonstration purposes during an interview. The models and exhibits should be taken away by applicant or his/her attorney or agent at the conclusion of the interview since models or exhibits are generally not permitted to be admitted as part of the application or patent unless the requirements of 37 CFR 1.91 are satisfied. See MPEP § 713.08. A full description of what was demonstrated or exhibited during the interview must be made of record. See 37 CFR 1.133. Any model or exhibit that is left with the examiner at the conclusion of the interview, which is not made part of the application or patent, may be disposed of at the discretion of the Office.

37 CFR 1.94. Return of models, exhibits or specimens.

Models, exhibits, or specimens in applications which have been abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

Upon request by applicant for the return of a model or exhibit, the model or exhibit will be returned to applicant at applicant's expense if (1) the examiner determines that it is not necessary to preserve the model or exhibit in the Office, and (2) the model or exhibit has not been earlier disposed of by the Office. A letter should be written to applicant by the examining group stating that the model or exhibit is being returned under separate cover, and the model or exhibit should be forwarded with a copy of the letter and an address label to the Mail Center for wrapping and return.

For disposition of exhibits which are part of the record, see MPEP § 715.07(d).

For plant specimens, see MPEP § 1607 and 37 CFR 1.166.

37 CFR 1.95. Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

608.04 New Matter*37 CFR 1.121. Manner of making amendments.*

(a) *Amendments in nonprovisional applications, other than reissue applications:* Amendments in nonprovisional applications, excluding reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(6) No amendment may introduce new matter into the disclosure of an application.

In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. See MPEP § 608.01(l).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected under 35 U.S.C. 112, first paragraph.

When new matter is introduced into the specification, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made to cancel the new matter. The subject matter which is considered to be new matter must be clearly identified by the examiner. If the new matter has been entered into the

claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed.

A "new matter" amendment of the drawing is ordinarily not entered; neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the examining group technical support staff. See MPEP § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable. See MPEP § 608.04(c).

For new matter in reissue application, see MPEP § 1411.02. For new matter in substitute specification, see MPEP § 608.01(q).

Note: No amendment is permitted in a provisional application after it receives a filing date.

608.04(a) Matter Not in Original Specification, Claims, or Drawings

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

For completeness of disclosure, see MPEP § 608.01(p). For trademarks and tradenames, see MPEP § 608.01(v).

608.04(b) New Matter by Preliminary Amendment

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure in an application filed under 37 CFR 1.53(b) accompanied by a signed oath or declaration unless it is referred to in the oath or declaration filed therewith. Once an oath or declaration is submitted in an application filed under 37 CFR 1.53(b) identifying the papers which the inventor(s) has "reviewed and understands" as required by 37 CFR 1.63, the original disclosure of the application is defined and cannot be altered merely by filing of a subsequent oath or declaration referring to different papers. Where a 37 CFR 1.53(b) application is filed without a signed 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. See MPEP § 714.09. If the original executed oath or declaration filed on the filing date of the application fails to refer to the preliminary amendment which was included with the application papers on filing, the preliminary amendment will not be considered part of the original disclosure. Any request to treat the preliminary amendment as a part of the original disclosure is by way of petition under 37 CFR 1.182, requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an executed oath or declaration under 37 CFR 1.53(f). Any such petition must be timely filed and be accompanied by a newly executed oath or declaration (which identifies the application and refers to the preliminary amendment), the surcharge set forth in 37 CFR 1.16(e), and the \$130.00 petition fee.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under former 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

608.05 Deposit of Computer Program Listings

37 CFR 1.96. *Submission of computer program listings.*

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The

program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent.* If the computer program listing is contained on ten printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) Any listing submitted as part of the specification must be direct printouts (i.e., not copies) from the computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper, and the sheets should be submitted in a protective cover. Any amendments must be made by way of submission of a substitute sheet.

(c) *As an appendix which will not be printed.* If a computer program listing printout is eleven or more pages long, applicants must submit such listing in the form of microfiche, referred to in the specification (see § 1.77(a)(6)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" must be made at the beginning of the specification at the location indicated in § 1.77(a)(6). Any amendments thereto must be made by way of revised microfiche.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Except as modified or clarified in this paragraph (c)(2), computer-generated information submitted as a "microfiche appendix" to an application shall be in accordance with the standards set forth in 36 CFR Part 1230 (Micrographics).

(i) Film submitted shall be a first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(ii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iii) At least the left-most third (50 mm. x 12 mm.) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply an application number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(iv) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a test target.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1, resolution of the original microfilm shall be at least 120 lines per mm. (5.0 target).

(F) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche.

(v) Microfiche generated by Computer Output Microfilm.

(A) The first frame of each microfiche submitted should contain a resolution test frame.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(E) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

Special procedures for presentation of computer program listings in the form of microfiche in U.S. national patent applications are set forth in 37 CFR 1.96. Use of microfiche is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred pages in length. By filing and publishing such computer program listings on microfiche rather than on paper, substantial cost savings can result to the applicants, the public, and the Patent and Trademark Office.

BACKGROUND

A computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine-independent (object or source) programming language which will cause a computer to perform a desired task, such as solving a problem, regulating the flow of work in computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while the computer program listing may appear either directly or as a microfiche appendix to the specification and be incorporated into the specification by reference.

DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The provisions of 37 CFR 1.52 and 37 CFR 1.84 for submitting specifications and drawings on paper have been found suitable for most patent applications. However, when lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome.

The cost of printing long computer programs in patent documents is also very expensive to the Patent and Trademark Office.

In the past, all disclosures forming part of a patent application were presented on paper with the exception of microorganisms. Under 37 CFR 1.96, several different methods for submitting computer program listings, including the use of microfiche, are set forth.

A computer program listing contained on ten printout pages or less must be submitted either as drawings (in compliance with 37 CFR 1.84) or as part of the specification (in compliance with 37 CFR 1.52). A computer program listing contained on eleven printout pages or more must be submitted as microfiche (in compliance with 37 CFR 1.96(c)).

Form Paragraphs 6.02.02 through 6.02.04 may be used to notify the applicant of this requirement.

¶ 6.02.02 Microfiche Appendix Requirement (Computer Program Listing in Specification)

The description portion of this application contains a computer program listing consisting of more than ten (10) pages. In accordance with 37 CFR 1.96(c), a computer program listing printout of more than ten pages must be submitted as a "microfiche appendix" conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(a)(6)). Accordingly, applicant is required to cancel the computer program listing appearing in the specification on pages [1], file a "microfiche appendix" in compliance with 37 CFR 1.96(c) and insert an appropriate reference to the newly added "microfiche appendix" at the beginning of the specification.

Examiner Note:

1. This form paragraph must be used whenever an application filed on or after September 23, 1996 contains a computer program listing consisting of more than ten pages as part of the descriptive portion of the specification.
2. In bracket 1, insert the range of page numbers of the specification which include the computer program listing.

¶ 6.02.03 Computer Program Listing as Printout in Appendix (Not More Than Ten Pages)

This application contains an appendix consisting of a computer program listing of no more than ten (10) pages. In accordance with 37 CFR 1.96(b), a computer program listing contained on ten (10) pages or less, must be submitted either as drawings or as part of the specification. Accordingly, applicant is required to cancel the appendix and either incorporate such listing in a drawing in compliance with 37 CFR 1.84 (identifying each page as a separate figure), or insert the computer program listing in the descriptive portion of the specification. If the listing is submitted as part of the specification, it must appear after the detailed description of the invention but before the claims and must be in the form of direct printouts from a computer's printer with dark solid black letters not less than 0.21 cm. high, on white, unshaded and unlined paper. The sheets should be submitted in a protective cover. See 37 CFR 1.96(b)(2).

Examiner Note:

This form paragraph must be used whenever an application filed on or after September 23, 1996 contains a computer program listing consisting of a paper printout appendix of no more than ten pages.

¶ 6.02.04 *Computer Program Listing as Printout in Appendix (More Than Ten Pages)*

This application contains an appendix consisting of a computer program listing of more than ten (10) pages. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than ten (10) pages, must be submitted as a “microfiche appendix” conforming to the standards set forth in 37 CFR 1.96(c)(2) and must be appropriately referenced in the specification (see 37 CFR 1.77(a)(6)). Accordingly, applicant is required to cancel the computer program listing appearing in the current appendix to the specification, file a “microfiche appendix” in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added “microfiche appendix” at the beginning of the specification.

Examiner Note:

This form paragraph must be used whenever an application filed on or after September 23, 1996 contains a computer program listing consisting of a paper printout appendix of more than ten pages.

Copies of publicly available computer program listings are available from the Patent and Trademark Office on paper and on microfiche at the cost set forth in 37 CFR 1.19(a).

OTHER INFORMATION

The micrographic standards are set forth in 36 CFR Part 1230.

A microfiche filed with a patent application will be referred to as a “Microfiche Appendix,” and will be identified as such on the front page of the patent but will not be part of the printed patent. “Microfiche Appendix” denotes the total microfiche, whether only one or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less.

The face of the file wrapper will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any cross-reference to related applications. 37 CFR 1.77 (a)(6). The patent front page and the *Official Gazette* entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix.

When an application containing microfiche is received in the Office of Initial Patent Examination (OIPE), a special envelope will be affixed to the right side of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course. A label which sticks up above the file wrapper will be placed at the center section of the face of the wrapper by OIPE. When the application file reaches the Micrographics Division, the Microfiche Appendix label will be placed on the face of the file wrapper. When the Publishing Division of the Office of Patent Publication receives the application file, the person placing the patent number on the face of the

file, upon seeing the Microfiche Appendix label, will give the file to the Supervisor who will call Micrographics Division and give the application number and patent number, and request copies of the microfiche. Micrographics Division personnel will then put the patent number on the microfiche(s), making certain each microfiche is the most recent, and numbering each correctly, e.g., 1 of 1, 1 of 2, etc. Upon completion, two copies will be produced and provided to Publishing Division — one for the grant head and one for the file wrapper.

At the time of assembly, the Microfiche Appendix will be placed inside the grant head behind the patent grant for eyeletting, ribboning, and mailing to the patentee/attorney. During the signing of the grant heads by the Attesting Officer, the patent will be checked to assure proper assembly prior to mailing.

609 Information Disclosure Statement [R-1]

37 CFR 1.97. Filing of information disclosure statement.

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, it must satisfy paragraph (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of either a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, and is accompanied by either:

- (1) A statement as specified in paragraph (e) of this section; or
- (2) The fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

- (1) A statement as specified in paragraph (e) of this section;
- (2) A petition requesting consideration of the information disclosure statement; and
- (3) The petition fee set forth in § 1.17(i).

(e) A statement under this section must state either:

- (1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or
- (2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known

to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a bona fide attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

(i) Information disclosure statements, filed before the grant of a patent, which do not comply with this section and § 1.98 will be placed in the file, but will not be considered by the Office.

37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of :

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed; and

(iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each foreign patent or published foreign patent application shall be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication shall be identified by author (if any), title, relevant pages of the publication, date and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. If a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement.

(d) A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT

Information Disclosure Statements are not permitted in provisional applications filed under 35 U.S.C. 111(b). Since no substantive examination is given in provisional

applications, a disclosure of information is unnecessary. Any such statement filed in a provisional application will be returned or destroyed at the option of the Office. In applications filed under 35 U.S.C. 111(a), applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. These individuals also may want the Office to consider information for a variety of other reasons; e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantively involved with the preparation or prosecution of a patent application.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 provides the procedure available to an applicant to submit information to the Office so that the information will be considered by the examiner assigned to the application. The requirements for the content of a statement have been simplified in the rules which became effective on March 16, 1992, to encourage individuals associated in a substantive way with the filing and prosecution of a patent application to submit information to the Office so the examiner can determine its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the rules are designed to encourage individuals to submit information to the Office promptly.

In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with 37 CFR 1.98 as to content must be filed in accordance with the procedural requirements of 37 CFR 1.97. The requirements as to content are discussed in A below. The requirements based on the time of filing the statement are discussed in B below. Examiner handling of information disclosure statements is discussed in C below.

The Office has set forth the minimum requirements for information to be considered in 37 CFR 1.97 and 37 CFR 1.98. Once the minimum requirements are met, the examiner has an obligation to consider the information. These rules provide certainty for the public by defining the requirements for submitting information to the Office so that the Office will consider information before a patent is granted. Information submitted to the Office that does not comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will not be considered by the Office but will be placed in the application file.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. 37 CFR 1.97(g). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56(b). 37 CFR 1.97(h). See MPEP § 2129 regarding admissions by applicant.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements. Use of form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B, "Information Disclosure Statement," is encouraged as a means to provide the required list of information. See C(2) below.

Information which has been considered by the Office in the parent application of a continued prosecution application (CPA) filed under 37 CFR 1.53(d) or a file wrapper continuing application (FWC) filed prior to December 1, 1997 under former 37 CFR 1.62 will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent. Likewise, the examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, (B) a divisional application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60, or (C) a continuation-in-part application (see MPEP § 201.06(b)) filed under 37 CFR 1.53(b), and a list of the information need not be submitted in the continuation, divisional, or continuation-in-part application unless applicant desires the information to be printed on the patent.

The examiner will consider the documents cited in the international search report in a PCT national stage application when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO-892 form.

In a national stage application, the following form paragraphs may be used where appropriate to notify applicant regarding references listed in the search report of the international application:

¶ 6.53 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Prior to Allowance

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR

1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Examiner Note:

1. This form paragraph may be used for PCT National Stage applications submitted under 35 USC 371 where the examiner has obtained copies of the cited references. For applications filed from US, JPO or EPO search authorities, the copies of the references should be supplied by those offices under the trilateral agreement. However, if receipt of such copies is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply copies for consideration. See MPEP § 1893.03(g).
2. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.
3. This form paragraph should only be used prior to allowance when a statutory period for reply is being set in the Office action.
4. If the application is being allowed, form paragraph 6.54 should be used with the Notice of Allowance instead of this form paragraph.

¶ 6.54 References Considered in 37 U.S.C. 371 Application Based Upon Search Report - Ready for Allowance

The references cited in the Search Report [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within ONE MONTH of the mailing date of this communication. NO EXTENSION OF TIME WILL BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) to comply with this requirement.

Examiner Note:

1. See the Examiner Note for form paragraph 6.53.

¶ 6.55 References Not Considered in 37 U.S.C. 371 Application Based Upon Search Report

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of each U.S. and foreign patent, each publication or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609 A(1) states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement requirements of 37 CFR 1.97(e). See MPEP § 609 C(1).

Examiner Note:

1. This form paragraph may be used in National Stage applications submitted under 35 U.S.C. 371 where the international searching authority was not the US, EPO or JPO.

A. Content

An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content in order to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of A(1), A(2), and A(3) below.

A(1) List of All Patents, Publications, or Other Information

Each information disclosure statement must include a list of all patents, publications, or other information submitted for consideration by the Office.

37 CFR 1.98(b) requires that each U.S. patent listed in an information disclosure statement be identified by patentee, patent number, and issue date. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

To comply with this requirement, the list may not be incorporated into the specification but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of either form PTO-1449, Information Disclosure Citation, or PTO/SB/08A and 08B, Information Disclosure Statement, is encouraged. See C(2) below.

A(2) Legible Copies

In addition to the list, each information disclosure statement must also include a legible copy of:

- (A) Each U.S. and foreign patent;
- (B) Each publication or that portion which caused it to be listed; and
- (C) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included.

There are exceptions to this general rule that a copy must be provided. First, 37 CFR 1.98(d) states that a copy of any patent, publication, or other information listed in an information disclosure statement is not required to be provided

if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied on for an earlier filing date under 35 U.S.C. 120. The examiner will consider information cited or submitted to the Office and considered by the Office in a prior application relied on under 35 U.S.C. 120. This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See A(3) below.

Second, 37 CFR 1.98(c) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO-1449, or PTO/SB/08A and 08B, submitted, e.g., by crossing out the listing of the cumulative information.

37 CFR 1.98(c) further states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in 37 CFR 1.56(c), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

A(3) Concise Explanation of Relevance

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a translation of the information into English is submitted with the foreign language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims.

Applicants may, if they wish, provide a concise explanation of why English-language information is being submitted and how it is understood to be relevant. Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

B. Time for Filing

The procedure and requirements for submitting an information disclosure statement are linked to four stages in the processing of a patent application: (1) within 3 months of filing, or before first Office action, whichever is later; (2) after the period in (1), but before final Office action or a Notice of Allowance, whichever is earlier; (3) after the period in (2) but on or before the date the issue fee is paid; and (4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue. The procedures and requirements apply to applications filed under 35 U.S.C. 111(a) (utility), 161 (plants), 171 (designs), and 251 (reissue), as well as international applications entering the national stage under 35 U.S.C. 371.

The requirements based on the time when the information disclosure statement is filed are summarized as follows.

| <u>Time when IDS is filed</u> | <u>37 CFR 1.97 Requirements</u> |
|--|--|
| (1) Within 3 months of filing or before first Office action on the merits, whichever is later. | None (always considered). |
| (2) After (1) but before final action or notice of allowance. | 1.97(e) statement or 1.17(p) fee. |
| (3) After final action or notice of allowance and before payment of issue. | 1.97(e) statement, petition, and petition fee. |

B(1) Information Disclosure Statement Filed BEFORE First Action on the Merits or Within Three (3) Months of Actual Filing Date (37 CFR 1.97(b))

An information disclosure statement will be considered by the examiner if filed:

- (A) within 3 months of the filing date of a national application;
- (B) within 3 months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; or
- (C) before the mailing date of a first Office action on the merits,

whichever event occurs last. An information disclosure statement filed within this period requires neither a fee nor a statement under 37 CFR 1.97(e).

The term “national application” includes continuing applications (continuations, divisions, continuations-in-part) so 3 months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application.

All information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed within 3 months of the filing date, including the filing date of a CPA, will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is 3 months from the filing date, any information contained in a complete information disclosure statement filed within that 3-month window will be considered by the examiner. Since the preexamination processing of a CPA is performed by the examining group rather than by the Office of Initial Patent Examination (OIPE), it should be expected that a first Office action will normally issue in a CPA (continuation) well within 3 months from the filing date of the CPA request. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution. Therefore, applicants are encouraged to file any information disclosure statement in a CPA (especially continuation) as early as possible, preferably at the time of filing of the CPA request or before the first Office action.

Likewise, an information disclosure statement will be considered if it is filed later than 3 months after the filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement (37 CFR 1.142) or just a requirement for additional fees to have a claim considered (37 CFR 1.16(d)). Thus, if an application was filed on January 2 and the first Office action on the merits was not mailed until 6 months later on July 2, the examiner would be required to consider any proper information disclosure statement filed prior to July 2.

An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in proper compliance with the provisions for “Express Mail” delivery under 37 CFR 1.10. An Office action is mailed on the date indicated in the Office action.

B(2) Information Disclosure Statement Filed After B(1), but BEFORE Mailing of Final Action or Notice of Allowance (37 CFR 1.97(c))

An information disclosure statement will be considered by the examiner if filed after the period specified in B(1) above, but before (not on the same day as) the mailing date of either:

a final action under 37 CFR 1.113, e.g., final rejection,
** or

a notice of allowance under 37 CFR 1.311,

whichever occurs first, provided * the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e); or (2) the fee set forth in 37 CFR 1.17(p). If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement.

An *Ex parte Quayle* action is not a final action under 37 CFR 1.113 as referred to in 37 CFR 1.97. Therefore, an information disclosure statement filed after an *Ex parte Quayle* action, but before mailing of a notice of allowance, must comply with the provisions of 37 CFR 1.97(c) rather than those of 37 CFR 1.97(d). However, where an *Ex parte Quayle* action is issued after a final rejection which has not been withdrawn, any information disclosure statement filed after the *Ex parte Quayle* action must comply with the provisions of 37 CFR 1.97(d).

(A) If information submitted during the period set forth in 37 CFR 1.97(c) with a statement under 37 CFR 1.97(e) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office. The information submitted with a statement under 37 CFR 1.97(e) can be used in a new ground of rejection and the next Office action made final, however, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee, the examiner may use the information submitted, e.g., printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 706.07(a). If a new ground of rejection is introduced that is neither necessitated by an amendment to the claims nor based on the information submitted with the

fee set forth in 37 CFR 1.17(p), the Office action shall not be made final.

(B) A statement under 37 CFR 1.97(e) must state either

(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.

A statement under 37 CFR 1.97(e) can contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than 3 months prior to the filing date of the statement. Under this statement, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 CFR 1.10.

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application).

Communications from foreign patent offices in foreign applications sometimes include a list of the family of patents corresponding to a particular patent being cited in the communication. The family of patents may include a

United States patent or other patent in the English language. Some applicants submit information disclosure statements to the PTO which list and include copies of both the particular patent cited in the foreign patent office communication and the related United States or other English language patent from the family list. Since this is to be encouraged, the United States or other English language patent will be construed as being cited by the foreign patent office for purposes of a statement under 37 CFR 1.97(e)(1). The examiner should consider the United States or other English language patent if 37 CFR 1.97 and 37 CFR 1.98 are complied with.

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement.

The phrase "after making reasonable inquiry" makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being stated. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than 3 months, however, cannot make the statement under 37 CFR 1.97(e)(2) without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The statement can be based on present, good faith knowledge about when information became known without a search of files being made.

A statement under 37 CFR 1.97(e) need not be in the form of an oath or a declaration under 37 CFR 1.68. A statement under 37 CFR 1.97(e) by a registered practitioner or any other individual that the statement was filed within the 3-month period of either first citation by a foreign

patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a statement under 37 CFR 1.97(e) could read as follows:

I hereby state that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than 3 months prior to the filing of this statement.,

or

I hereby state that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than 3 months prior to the filing of this Information Disclosure Statement.

An information disclosure statement may include two lists and two statements, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than 3 months prior to filing the statement and some was not, but was not known more than 3 months prior to filing the statement.

A copy of the foreign search report need not be submitted with the statement under 37 CFR 1.97(e), but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information was known to any individual designated in 37 CFR 1.56(c) is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date certain for determining if a statement under 37 CFR 1.97(e) can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith, but questions about the adequacy of any statement received in writing by the Office should be directed to the Office of the Assistant Commissioner for Patents.

B(3) Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee (37 CFR 1.97(d))

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of either a final action under 37 CFR 1.113 or a notice of allowance under 37 CFR 1.311, whichever occurs first, but

before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in 37 CFR 1.97(e) (see the discussion in B(2) above);
- (B) a petition requesting consideration of the information disclosure statement; and
- (C) the petition fee set forth in 37 CFR 1.17(i).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. The petition should be directed to the Group Director of the examining group handling the application. The petition need do nothing more than request consideration of the information being submitted. Payment of the petition fee (37 CFR 1.17(i)) and submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

Form paragraph 6.52 may be used to inform the applicant that the information disclosure statement is being considered.

¶ 6.52 Information Disclosure Statement, Petition Granted

The information disclosure statement (IDS) submitted on [1] was filed after the mailing date of the [2] on [3]. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the petition is granted and the information disclosure statement is being considered by the examiner.

Examiner Note:

1. This form paragraph may be used in an Office action only when signed by a Supervisory Patent Examiner.
2. In bracket 2, insert either --final Office action-- or --Notice of Allowance--, as appropriate.

The requirements of 37 CFR 1.97 provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within 3 months after an individual designated in 37 CFR 1.56(c) becomes aware of the information or within 3 months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid. If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), a continuing application could be filed to have the information considered by the examiner. The parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance, for example, or by the filing of a continued prosecution application under 37 CFR 1.53(d). All information disclosure statements filed in the prior application that

comply with the content requirements of 37 CFR 1.98 but have not been considered in the prior application will be considered by the examiner in a continued prosecution application filed under 37 CFR 1.53(d). No specific request that the previously submitted information disclosure statement be considered in the continued prosecution application is required. However, for file wrapper continuing (FWC) applications filed prior to December 1, 1997 under former 37 CFR 1.62, in order to ensure consideration of information complying with the content requirements of 37 CFR 1.98 previously submitted in a parent application which has not been considered in the parent application, applicant must either specifically request that the previously submitted information be considered in the FWC or resubmit the information complying with 37 CFR 1.97 and 37 CFR 1.98 in the FWC. For continuing applications filed under 37 CFR 1.53(b), in order to ensure consideration of information previously submitted in a parent application which has not been considered in the parent application, applicant must resubmit the information complying with 37 CFR 1.97 and 37 CFR 1.98 in the continuing application. It would not be proper to make final a first Office action in the continuing application if the information submitted is used in a new ground of rejection.

B(4) Information Disclosure Statement Filed After Payment of Issue Fee

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See C below. The application may be withdrawn from issue at this point, however, pursuant to 37 CFR 1.313(b)(5) so that the information can be considered in a continuing application. In this situation, a continued prosecution application >(CPA)< under 37 CFR 1.53(d) could be filed even though the issue fee had already been paid. >See MPEP § 1308. Applicants are encouraged to file the petition under 37 CFR 1.313(b)(5) with a CPA under 37 CFR 1.53(d) by facsimile to the Office of Petitions (see MPEP § 1730 for the facsimile number). The petition need not be accompanied by the information disclosure statement if the size of the statement makes its submission by facsimile impracticable, but the petition should indicate that an information disclosure statement will be filed in the CPA if it does not accompany the petition under 37 CFR 1.313(b)(5).<

All information disclosure statements filed in the prior application that comply with the content requirements of 37 CFR 1.98 but have not been considered in the prior application will be considered by the examiner in a contin-

ued prosecution application filed under 37 CFR 1.53(d). No specific request that the previously submitted information disclosure statement be considered in the continued prosecution application is required. However, for file wrapper continuing (FWC) applications filed prior to December 1, 1997 under former 37 CFR 1.62, in order to ensure consideration of information complying with the content requirements of 37 CFR 1.98 previously submitted in a parent application which has not been considered in the parent application, applicant must either specifically request that the previously submitted information be considered in the FWC or resubmit the information complying with 37 CFR 1.97 and 37 CFR 1.98 in the FWC. For continuing applications filed under 37 CFR 1.53(b), in order to ensure consideration of information previously submitted in a parent application which has not been considered in the parent application, applicant must resubmit the information complying with 37 CFR 1.97 and 37 CFR 1.98 in the continuing application. Alternatively, for example, a petition pursuant to 37 CFR 1.313(b)(3) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under 37 CFR 1.313(b)(3). Form paragraph 13.09 may be used.

¶ 13.09 Information Disclosure Statement, Issue Fee Paid

Applicant's information disclosure statement of [1] was filed after the issue fee was paid. Information disclosure statements filed after payment of the issue fee will not be considered, but will be placed in the file. However, the application may be withdrawn from issue in order to file a continuing application under 37 CFR 1.53(b) or 1.53(d) upon the grant of a petition filed under the provisions of 37 CFR 1.313(b)(5). Alternatively, the other provisions of 37 CFR 1.313 may apply, e.g., a petition to withdraw the application from issue under the provisions of 37 CFR 1.313(b)(3) may be filed together with an unequivocal statement by the applicant that one or more claims are unpatentable over the information contained in the statement. The information disclosure statement would then be considered upon withdrawal of the application from issue under 37 CFR 1.313(b)(3).

Examiner Note:

1. For information disclosure (Prior Art) statements submitted after the issue fee has been paid, use this paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the filing date of the IDS.

If an application has been withdrawn from issue under one of the provisions of 37 CFR 1.313(b)(1)-(4), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under 37 CFR 1.313(b) should be directed to the Office of Petitions in the Office of the Deputy Assistant Commissioner for Patent Policy and Projects. >See MPEP § 1308.<

B(5) Extensions of Time (37 CFR 1.97(f))

No extensions of time for filing an information disclosure statement are permitted under 37 CFR 1.136(a) or (b). If a *bona fide* attempt is made to comply with the content requirements of 37 CFR 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

C. Examiner Handling of Information Disclosure Statements

Information disclosure statements will be reviewed for compliance with the requirements of 37 CFR 1.97 and 37 CFR 1.98 as discussed in A and B above. Applicant will be notified of compliance and noncompliance with the rules as discussed below.

C(1) Noncomplying Statements

Pursuant to 37 CFR 1.97(i), submitted information, filed before the grant of a patent, which does not comply with 37 CFR 1.97 and 37 CFR 1.98 will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with 37 CFR 1.501.

If an information disclosure statement does not comply with the requirements based on the time of filing the statement as discussed in B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), the statement will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use Form Paragraph 6.49 which is reproduced below to inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed statement, but the date that the new statement or correction is filed will be the date of the statement for purposes of determining compliance with the requirements based on the time of filing the statement (37 CFR 1.97).

The examiner should write “not considered” on an information disclosure statement where none of the information listed complies with the requirements, e.g., no copies of listed items submitted. If none of the information listed on a PTO-1449 or PTO/SB/08A and 08B form is considered, a diagonal line should also be drawn in pencil across the form and the form placed on the right side of the application file to instruct the printer not to list the information on the face of the patent if the application goes to issue. The paper containing the disclosure statement or list will be placed in the record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.09. If the improper citation appears as part of another paper, e.g., an amendment, which may be properly

entered and considered, the portion of the paper which is proper for consideration will be considered.

¶ 6.49 Information Disclosure Statement Not Considered

The information disclosure statement filed [1] fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Examiner Note:

See MPEP § 609 for situations where the use of this form paragraph would be appropriate.

¶ 6.49.01 Information Disclosure Statement Not Considered, After First Action, Before Final or Allowance, No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.02 Information Disclosure Statement Not Considered, After First Action, Before Final or Allowance, No Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.03 Information Disclosure Statement Not Considered, After Final or Allowance, Issue Fee Not Paid No Statement

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.04 Information Disclosure Statement Not Considered, After Final or Allowance, Issue Fee Not Paid No Petition Requesting Consideration

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks a petition requesting consideration of the information disclosure statement. It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.05 Information Disclosure Statement Not Considered, After Final or Allowance, Issue Fee Not Paid No Petition Fee

The information disclosure statement filed [1] fails to comply with 37 CFR 1.97(d) because it lacks the petition fee set forth in 37 CFR 1.17(i). It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.06 Information Disclosure Statement Not Considered, References Listed in Specification

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

¶ 6.49.07 *Information Disclosure Statement Not Considered, No Copy of References*

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.08 *Information Disclosure Statement Not Considered, No List of References*

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

¶ 6.49.09 *Information Disclosure Statement Not Considered, No Explanation of Relevance*

The information disclosure statement filed [1] fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

If an information disclosure statement complies with the requirements based on the time of filing the statement as discussed in B above, including the requirements for fees and/or statement under 37 CFR 1.97(e), but part of the content requirements as discussed in A above has been inadvertently omitted, the examiner may set a 1-month time period to correct the omission. Form paragraph 6.51 may be used for this purpose.

¶ 6.51 *Time for Completing Information Disclosure Statement*

The information disclosure statement filed on [1] does not fully comply with the requirements of 37 CFR 1.98 because: [2]. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above-mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b)**. Failure to timely comply with this notice will result in the above-mentioned information disclosure statement being placed in the application file with the non-complying information **not** being considered. See 37 CFR 1.97(i).

Examiner Note:

This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in 37 CFR 1.97, have not been complied with.

If a statement fails to comply with requirements as discussed in this section for an item of information, that item of information in the statement will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements will be considered by the examiner.

If information is listed in the specification rather than in a separate paper, or if the other content requirements as discussed in A above are not complied with, the information need not be considered by the examiner, in which case the examiner should notify applicant in the next Office action that the information has not been considered. It should be noted, however, that no copy of a U.S. patent application is required to be submitted. See A(2) above. Where a U.S. patent application is properly cited on a separate list, the examiner should obtain access to that file within the Office.

C (2) Complying Statements

The information contained in information disclosure statements which comply with both the content requirements as discussed in A above and the requirements based on the time of filing the statement as discussed in B above will be considered by the examiner.

Applicants, patent owners, reexamination requesters, protestors, and others are encouraged to use form PTO-1449, "Information Disclosure Citation," or PTO/SB/08A and 08B "Information Disclosure Statement," when preparing an information disclosure statement. A copy of each form is reproduced in this section to indicate how the form should be completed. The form will enable persons to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that information has been considered. Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 or PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form. If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write "all considered" and his or her initials to indicate that all citations have been considered. If any of the citations are considered, a copy of the submitted list, form PTO-1449, or PTO/SB/08A and 08B, as reviewed by the examiner, will be returned to the applicant with the next communication. Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto. The original copy of the list, form PTO-1449, or PTO/SB/08A and 08B will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication as to which references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to

indicate the attachment of form PTO-1449 or PTO/SB/08A and 08B .

Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (A(3) above) and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent.

Since information is required to be submitted in a separate paper listing the citations rather than in the specification, there is no need to mark "All checked" or "Checked" in the margin of a specification containing citations.

If a statement fails to comply with requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the rules and this section will be considered by the examiner and will be appropriately initialed.

C(3) Documents Submitted As Part of Applicant's Reply to Office Action

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (e.g., PTO-892, PTO-1449, or PTO/SB/08A and 08B) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in reply to the first Office action and also lists those patents on a PTO-1449 or PTO/SB/08A and 08B along with two journal articles, but does not file a statement under 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p), it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO-1449 or PTO/SB/08A and 08B and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

D. Information Printed on Patent

A citation listed on form PTO-1449 or PTO/SB/08A and 08B and considered by the examiner in accordance with this section will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO-1449 or PTO/SB/08A and 08B, and considered by the examiner in accordance with this section will be printed on the patent if the list is on a separate sheet which is clearly identified as an information disclosure statement and the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, the information is uniform in format for each listed item, and the list includes a column for the examiner's initials to indicate that the information was considered.

>If the applicant does not provide classification information for a citation, or if the examiner lines through incorrect classification data, the citation will be printed on the face of the patent without the classification information.< If a U.S. patent application number is listed on a PTO-1449 or PTO/SB/08A and 08B form or its equivalent and the examiner considers the information and initials the form, the application number will be printed on the patent. Applicants may wish to list U.S. patent application numbers on other than a form PTO-1449 or PTO/SB/08A and 08B format to avoid the application numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner in accordance with this section, the patented file will reflect that fact as noted in C(2) above.

MANUAL OF PATENT EXAMINING PROCEDURE