

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

### Ninth Edition, Latest Revision January 2018

#### Executive Summary

##### *January 2018 Publication of Revision 08.2017*

The January 2018 publication of Revision 08.2017 includes the following changes:

Substantive revisions to MPEP [Chapters 200](#), [700](#), [800](#), [900](#), [1000](#), [1200](#), [1400](#), [1500](#), [1800](#), [2000](#), [2100](#), [2200](#), [2300](#), [2500](#), [2700](#), and [Chapter FPC](#) (Form Paragraph Book), and updates to the Table of Contents, Foreword, Introduction, Subject Matter Index, and all Appendices **except** Appendix I and Appendix P.

[Chapter 200](#) was revised to clarify when a petition and petition fee to accept an unintentionally delayed benefit or priority claim is necessary to correct an error in the benefit or priority claim; and to incorporate recent case law holding that a child application was entitled to the benefit of a parent application where the child application was filed on the same day that a patent issued on the parent application.

[Chapter 700](#) was revised to incorporate a memorandum regarding the recordation of search history data; to reflect recent case law regarding the requirements for a patent to be usable as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of a relied upon provisional application's filing date; to reflect recent case law and guidance relating to patent subject matter eligibility; to add a section directed to rejection of improper "Markush" claims in accordance with Office guidance published in 2011; to update information regarding petitions to make special based on age or health and the requirements for being granted accelerated examination status; to update the guidance on interview practice to be consistent with the forms and tools currently in use in the Office; to add information relating to the timing of applicant's submissions concerning the prior art exception under [35 U.S.C. 102\(b\)\(2\)\(C\)](#) or prior art exclusion under [pre-AIA 35 U.S.C. 103\(c\)](#); and to mention a fact situation where one particular uncorroborated inventor's declaration under [37 CFR 1.132](#) was recently found by the Federal Circuit to provide insufficient proof of inventorship.

[Chapter 800](#) was revised to limit the discussion of Markush claims to election of species requirements and update the text for consistency with Office guidelines published in 2011; and to rewrite the discussion of provisional nonstatutory double patenting (NDP) rejections for clarification and consolidation of existing Office policies.

[Chapter 900](#) was revised to add a discussion of Global Dossier Public Access and to provide additional information about the field of search where the proper classification corresponds to a disclosed, but unclaimed, embodiment.

[Chapter 1000](#) was revised to include the delegation of authority to the Central Reexamination Unit (CRU) Supervisory Patent Reexamination Specialists (SPRS) for three types of petitions and to include a new section addressing requests decided by the Associate Commissioner for Patent Information Management.

[Chapter 1200](#) was revised to add further information regarding the pre-appeal brief conference request program; to indicate that the Patent Appeals Center, rather than Board, reviews appeal briefs for compliance; to update guidance regarding the treatment of certain claims after a Board decision; and provide additional information pertaining to the dismissal of appeals.

[Chapter 1400](#) was revised to update and clarify the policies and procedures regarding recapture analysis, oath or declaration requirements, and restriction practice in reissue applications; to rewrite the discussion of disclaimers and provisional nonstatutory double patenting (NDP) rejections for clarification and consolidation of existing Office policies; to include changes made to [35 U.S.C. 119\(e\)](#) and [37 CFR 1.78](#) in the implementation of the Patent Law Treaties Implementation Act (PLTIA); to include changes made to [37 CFR 1.55](#) and [1.78](#) that were made in the final rule implementing the Hague Agreement Concerning International Registration of Industrial Designs ("Hague Agreement"); to incorporate a memorandum regarding the recordation of search history data; to further add procedures if the patent for which the reissue application was filed had been the basis of a PTAB trial; and to update procedures to include actions by the Central Reexamination Unit.

[Chapter 1500](#) was revised to update and clarify the discussion of the "ordinary observer" test in determining novelty; to update and clarify guidance pertaining to new matter in design patent applications, especially with regard to broken lines and drawing amendments; to provide guidance regarding compliance with the written description requirement for design applications; and to add a discussion of design patent term both before and after implementation of the Hague Agreement.

[Chapter 1800](#) was revised to add the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority (ISA) available to nationals and residents of the United States; to update information regarding the arrangement between the USPTO and the Israel Patent Office (ILPO); and to provide information about using WIPO's ePCT system for preparation of the PCT Request, explaining that a foreign filing license from the USPTO does not authorize the export of subject matter into ePCT for generating a PCT Request for filing with the RO/US.

[Chapter 2000](#) was updated to generally reflect duty of disclosure owed to the Office by individuals associated with filing and prosecution of any application; to add text explaining aspects of the duty to disclose in accordance with the America Invents Act (AIA); to add a new section to provide guidance on correction of errors in an application; to limit the applicability of certain MPEP sections to reissue applications filed before September 16, 2012; and to revise guidance pertaining to the duty of disclosure in reexamination (*ex parte* and *inter partes*) proceedings for consistency with the language of [37 CFR 1.555](#).

[Chapter 2100](#) was revised to reflect recent case law and guidance relating to patent subject matter eligibility; to add an overview of "Markush" claims and update the discussion of when a Markush grouping may be indefinite under [35 U.S.C. 112\(b\)](#); to reflect recent case law regarding the requirements for a patent to be usable as prior art under [pre-AIA 35 U.S.C. 102\(e\)](#) as of a relied upon provisional application's filing date; and to reflect recent case law pertaining to "reasonable diligence," the determination of obviousness, and written description.

[Chapter 2200](#) was revised to clarify information regarding [37 CFR 1.501](#) submissions, and to specify that proof of service is required by [37 CFR 1.501\(e\)](#); to include changes made to [37 CFR 1.55](#) and [1.78](#) that were made in the final rule implementing the Hague Agreement; and added text pertaining to treatment of claims after an appeal in a reexamination is decided.

[Chapter 2300](#) was revised to add a discussion of recent case law pertaining to written descriptive support for claims involved in an interference; to provide guidance on the limited applicability of [pre-AIA 35 U.S.C.](#)

[102\(g\)](#) to applications filed on or after March 16, 2013; and to provide an overview of derivation proceedings and their impact on examination with a cross-reference to the Board's Patent Trial Practice Guide for information pertaining to action at the Board during derivation proceedings.

[Chapter 2500](#) was revised to add information relating to the Patent Maintenance Storefront; and to explain when the maintenance fee paid with a petition under [37 CFR 1.378](#) will be refunded.

[Chapter 2700](#) was revised to update the reproduction of [35 U.S.C. 156\(d\)\(1\)](#) and add [35 U.S.C. 156\(i\)](#) to include changes made by Public Law 114-89, 129 Stat. 700 (November 25, 2015).

## Summary of Effective Dates

### *MPEP Chapters*

Each section that has been substantively revised in this revision (published January 2018) has a revision indicator of [R-08.2017] meaning that the section has been updated as of August 2017.

### *MPEP Appendices*

[App II \(List of Decisions Cited\)](#) includes the decisions cited in this Revision of the Manual.

[Appendix L \(Patent Laws\)](#) and [Appendix R \(Patent Rules\)](#) include the laws and rules current as of August 31, 2017.

[Appendix T](#) is as in force effective July 1, 2017.

[Appendix AI](#) is as in force effective July 1, 2017.

Robert A. Clarke, Editor  
Manual of Patent Examining Procedure

## **Summary of Changes to MPEP Chapters**

For the substantively revised chapters, particular attention is called to the changes in the following sections:

**CHAPTER 200:**

Title	—Revised title of chapter to "Types and Status of Application; Benefit and Priority Claims."
<i>Passim</i>	—In subsections with a "[R-08.2017]" revision indicator, revised text to be gender-neutral.
<a href="#">201.01</a>	—In subsection I, text discussing the changes made by the Patent Law Treaties Implementation Act (PLTIA) was changed to be in the past tense.
<a href="#">201.04</a>	—In subsections I and II, added links to Office form SB/16, Provisional Application for Patent Cover Sheet; deleted copy of form PTO/SB/16 from subsection III. —Revised subsection III to correct minor grammatical errors and to replace references to "priority" claims with "benefit" claims in the context of discussions of domestic benefit claims under <a href="#">35 U.S.C. 119(e)</a> , <a href="#">120</a> , <a href="#">121</a> , <a href="#">365(c)</a> , or <a href="#">386(c)</a> .
<a href="#">201.06</a>	—Revised to specify that it is no longer appropriate to include the U.S. Patent and Trademark Office classification of a divisional application and the status and assigned art unit of the parent application in the application data sheet.
<a href="#">201.06(c)</a>	—Revised to correct minor grammatical errors. Revised subsection V to add cross-references to <a href="#">MPEP §§ 602.01(c)</a> and <a href="#">602.01(c)(3)</a> for additional information pertaining to correction of inventorship.
<a href="#">201.06(d)</a>	—In subsection I, revised the discussion pertaining to the elimination of Continued Prosecution Application (CPA) practice as to utility and plant applicants to be in the past or present tense, as appropriate. Deleted the reference to File Wrapper Continuations (FWC).
<a href="#">201.07</a>	—Updated examiner note 3 in form paragraph 2.05.
<a href="#">201.08</a>	—Updated form paragraph 2.06.
<a href="#">202</a>	—Revised to correct references to "priority" claims and "benefit" claims in the context of discussions of <a href="#">35 U.S.C. 111(b)</a> and <a href="#">119(e)</a> . Corrected and updated cross-references to other MPEP sections and the reference to <a href="#">pre-AIA 37 CFR 1.63</a> ; also corrected minor grammatical errors.
<a href="#">203.08</a>	—Updated the website address for accessing PAIR; updated name of File Information Unit to Application Assistance Unit; and revised "domestic priority" to read "domestic benefit."
<a href="#">203.08(a)</a>	—Updated name of a business unit to the Office of Policy and International Affairs.
<a href="#">210</a>	—In the introduction, text discussing the changes made by the PLTIA was changed to be in the past tense. In subsection II, the description of <a href="#">37 CFR 1.55(e)</a> was clarified to explain that it relates to delayed claims for priority under <a href="#">35 U.S.C. 119(a) through (d) and (f)</a> , <a href="#">35 U.S.C. 365(a) or (b)</a> , and <a href="#">35 U.S.C. 386(a) or (b)</a> .
<a href="#">211.01(a)</a>	—Subsection I revised to clarify that if an application is claiming the benefit of a provisional application by claiming the benefit of an intermediate copending nonprovisional application, then in the later-filed application, the intermediate application must be clearly identified as claiming the benefit of the provisional application under <a href="#">35 U.S.C. 119(e)</a> . —Subsection I also revised to add text explaining that where a design patent application claims benefit under <a href="#">35 U.S.C. 120</a> to an intermediate nonprovisional utility patent application that directly claims the benefit of a provisional application, the design application cannot claim the benefit of the filing date of the provisional application. —Subsection II revised to add text indicating that if a petition under <a href="#">37 CFR 1.78</a> to restore the benefit of a provisional application is granted, a copy of the petition decision should be filed with any application that is entitled to claim benefit under <a href="#">35 U.S.C. 120</a> , <a href="#">121</a> , or <a href="#">365(c)</a> of the application for which benefit of the provisional application was restored; also corrected minor grammatical errors.

<a href="#">211.01(b)</a>	<p>—Revised to add discussion of the 2016 Federal Circuit decision in <i>Immersion Corp. v. HTC Corp.</i>, holding that a child application was entitled to the benefit of a parent application where the child application was filed on the same day that a patent issued on the parent application.</p> <p>—Deleted the citation to and discussion of <i>MOAEC, Inc. v. MusicIP Corp.</i>, 568 F. Supp. 2d 978 (W.D. Wis. 2008) and the district court decision <i>Immersion Corp. v. HTC Corp.</i>, Civil Action No. 12-259 RGA (D.Del. 2015).</p> <p>—Added cross-reference to <a href="#">MPEP § 711.03(c)</a> for a discussion of petitions to revive an abandoned application to provide copendency.</p>
<a href="#">211.02</a>	<p>—Revised subsection I to clarify that an ADS in compliance with <a href="#">37 CFR 1.76</a> (or for applications filed prior to September 16, 2012, an ADS in compliance with <a href="#">pre-AIA 37 CFR 1.76</a> or a reference in the first sentence(s) of the specification) is necessary to properly claim the benefit of a prior-filed application. Updated form paragraph 2.15 for consistency with changes to the text.</p> <p>—Further revised subsection I to explain that if the Office does not recognize an improper benefit claim as shown by its absence on the first filing receipt, then a petition under <a href="#">37 CFR 1.78</a> and the petition fee will be required to correct the claim if the correction is sought after expiration of the time period set in <a href="#">37 CFR 1.78</a>.</p> <p>—Revised subsection II to correct the reference to <a href="#">37 CFR 1.76</a> to <a href="#">pre-AIA 37 CFR 1.76</a> in the context of applications filed before September 16, 2012.</p> <p>—Revised subsection III to replace references to "priority" claims with "benefit" claims in the context of discussions of <a href="#">35 U.S.C. 119(e)</a>.</p>
<a href="#">211.02(a)</a>	<p>— Revised subsection I to change "plans to" to "may" in the context of the Office notifying applicants on or with the filing receipt that a benefit claim may not have been recognized because the benefit claim was improper.</p>
<a href="#">211.03</a>	<p>—Revised to clarify that the Office will not require a petition and the petition fee under <a href="#">37 CFR 1.17(m)</a> to correct a benefit claim if such claim was recognized by the Office as shown by its inclusion on the first filing receipt; and to clarify that the Office will require a petition under <a href="#">37 CFR 1.78</a> and the petition fee to correct the benefit claim if it was not recognized by the Office as shown by its absence on the first filing receipt and the correction is sought after expiration of the time period set in <a href="#">37 CFR 1.78</a>.</p> <p>—Also revised to clarify that an ADS in compliance with <a href="#">37 CFR 1.76</a> (or for applications filed prior to September 16, 2012, an ADS in compliance with <a href="#">pre-AIA 37 CFR 1.76</a> or a reference in the first sentence(s) of the specification) is necessary to properly claim the benefit of a prior-filed application.</p>
<a href="#">211.04</a>	<p>—Revised to add explanation that <a href="#">35 U.S.C. 119(e)(1)</a> no longer requires that the amendment containing the specific reference to the earlier filed provisional application be submitted during the pendency of the application. Therefore, applicant may simply file a petition under <a href="#">37 CFR 1.78</a> to accept an unintentionally delayed claim for the benefit of a prior-filed provisional application in the abandoned nonprovisional application, and may correct the benefit claim therein.</p>
<a href="#">211.05</a>	<p>—Revised subsection I to replace references to "priority" claims with "benefit" claims in the context of discussions of claiming the benefit of provisional applications under <a href="#">35 U.S.C. 119(e)</a>.</p> <p>—Added subsection II which cross-references <a href="#">MPEP § 2136.03</a> and <a href="#">MPEP § 2154.01(b)</a> for discussions of when an issued patent or patent application publication is available as a reference under <a href="#">35 U.S.C. 102</a> as of the filing date of a prior provisional or nonprovisional application.</p>
<a href="#">213</a>	<p>—Revised to use gender-neutral language.</p>
<a href="#">213.01</a>	<p>—In subsection I, updated the table of states with respect to which the right of priority under <a href="#">35 U.S.C. 119(a)-(d)</a> has been recognized based on their status as party to the PCT or Paris</p>

	Convention or as members of the WTO. Also updated the name of a business unit to the Office of Policy and International Affairs.
<a href="#">213.02</a>	—Revised to use to gender-neutral language.
<a href="#">213.03</a>	—Revised subsection III to add text indicating that a copy of the decision granting the petition under <a href="#">37 CFR 1.55(c)</a> should be filed with any application claiming the benefit of the subsequent application and the foreign application to ensure that the Office recognizes that the right of priority has been restored.
<a href="#">213.05</a>	—Deleted the phrase "or his or her attorney" as unnecessary and revised to use gender-neutral language.
<a href="#">213.06</a>	—Revised to use gender-neutral language.
<a href="#">214</a>	—Revised to use words for numbers (i.e., "12" to "twelve" and "6" to "six").
<a href="#">214.02</a>	—Added text explaining that a petition to accept an unintentionally delayed claim for foreign priority is necessary to correct any error in a foreign priority claim if the correction is sought after expiration of the time period set forth in <a href="#">37 CFR 1.55</a> .
<a href="#">214.03</a>	—Subsection V revised to clarify that a grantable petition to accept an unintentionally delayed claim for priority under <a href="#">37 CFR 1.55</a> must include the petition fee. —Revised examiner note 1 of form paragraph 2.27 to change "2.24" to "2.23."
<a href="#">214.04</a>	—Updated the WIPO tables pertaining to the presentation of application numbers, added a link to the WIPO website for a survey of current practices regarding the numbering of applications, and added a table of countries or organizations not appearing in the aforementioned WIPO tables that participate in the WIPO Digital Access Service.
<a href="#">215</a>	—Revised subsection II to add text explaining that a copy of the certified copy of a priority document will not satisfy the requirement in <a href="#">37 CFR 1.55(g)</a> . —Revised subsections IV and V and form paragraph 2.22 to clarify that a petition to accept an unintentionally delayed claim for priority is filed under <a href="#">37 CFR 1.55(e)</a> and must include the petition fee. Also deleted the note previously at the end of subsection IV as unnecessary because the remaining text in the subsection explains the appropriate action to take if a certified priority document is filed but no proper priority claim is made.
<a href="#">215.01</a>	—Revised to replace specifics regarding when the Office will initiate an electronic retrieval attempt with an indication that such an attempt will generally be made when the application is docketed to the examiner. —Deleted paragraph discussing applications that are not PDX eligible; added paragraph indicating that the USPTO will attempt retrieval of foreign applications to which priority is claimed in a U.S. design application where possible, and will automatically attempt retrieval of international applications under specified conditions.
<a href="#">215.03</a>	—Revised to clarify that petitions filed under <a href="#">37 CFR 1.55(e)</a> , <a href="#">(f)</a> , and <a href="#">(g)</a> must include the petition fee. Revised final paragraph to specify that the suggestion to add a notation is only applicable when priority papers are not submitted via a priority document exchange program.
<a href="#">216</a>	—Revised to use gender-neutral language.
<a href="#">216.01</a>	—Revised the introductory text, subsection I and subsection II to clarify that, <i>inter alia</i> , a claim to foreign priority benefits cannot be perfected via a certificate of correction where the correction sought would require further examination (e.g., where the foreign application has a pre-March 16, 2013 filing date in a patent that was examined under the first inventor to file (FITF) provisions of the AIA).



**CHAPTER 700:**

<a href="#">704.14(b)</a>	—Changed "OACS 'Search Notes' page" to "'Search Notes' form."
<a href="#">705.01(a)</a>	—Changed "OACS 'Search Notes' page" to "'Search Notes' form" and added a cross-reference to <a href="#">MPEP § 719.05</a> .
<a href="#">706.02(f)(1)</a>	—In subsection I, items (B) and (C)(1), added cross-references to <a href="#">MPEP § 2136.03</a> , subsection III and revised to indicate that for benefit claims under <a href="#">35 U.S.C. 119(e)</a> , at least one claim of the reference patent must be supported by the disclosure of the relied upon provisional application in compliance with <a href="#">pre-AIA 35 U.S.C. 112</a> , first paragraph, in order for the patent to be usable as prior art under <a href="#">pre-AIA 35 U.S.C. 102(e)</a> as of a relied upon provisional application's filing date. —In subsection III, updated the flowcharts to include ".fti" at the end of the form paragraph numbers.
<a href="#">706.02(f)(2)</a>	—In subsection I, updated the examiner notes for form paragraphs 7.15.01.aia and 7.15.01.fti.
<a href="#">706.02(i)</a>	—Updated form paragraphs 7.12.fti, 7.12.01.fti, 7.15.01.aia, 7.15.01.fti, 7.15.02.aia, 7.15.02.fti, and 7.15.03.fti.
<a href="#">706.02(l)</a>	—Revised to remove a reference to "proper evidence."
<a href="#">706.02(l)(1)</a>	—Subsection I revised to remove a reference to "evidence."
<a href="#">706.02(l)(2)</a>	—Revised to remove references to "evidence."
<a href="#">706.02(l)(3)</a>	—Revised to remove references to "evidence."
<a href="#">706.02(m)</a>	—Updated form paragraphs 7.20.01.aia, 7.20.01.fti, 7.20.04.aia, and 7.20.04.fti .
<a href="#">706.03</a>	—Updated cross-references to the sections of <a href="#">MPEP Chapter 2100</a> that discuss rejections based on nonstatutory subject matter.
<a href="#">706.03(a)</a>	—Updated subsection II for consistency with changes relating to subject matter eligibility made in <a href="#">MPEP Chapter 2100</a> . —In subsection III, updated the references to the form paragraphs.
<a href="#">706.03(d)</a>	—Updated to reflect deletion of form paragraph 7.34.06.
<a href="#">706.03(k)</a>	—Revised to indicate a dependent claim that does not specify a further limitation of the subject matter claimed should be rejected under <a href="#">35 U.S.C. 112(d)</a> and it is not necessary to also object to the claims under <a href="#">37 CFR 1.75</a> as being substantial duplicates of one another. Form paragraphs 7.05.05 and 7.05.06 have each been updated to include an additional examiner note that reflects the revised text of this section.
<a href="#">706.03(y)</a>	—New section added to address the rejection of improper "Markush" claims according to the <i>Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications</i> , 76 Fed. Reg. 7162 (Feb. 9, 2011). —Subsection I provides an overview of Markush claims and cross-references to other MPEP sections particularly relevant to the examination of Markush claims. —Subsection II provides guidance regarding determining whether a Markush grouping is proper. —Subsection III provides guidance regarding making rejections based on improper Markush groupings. —Subsection IV provides examples illustrating proper and improper Markush groupings.
<a href="#">706.07(h)</a>	—Updated subsection XI to indicate the time period for filing a notice of appeal to the Federal Circuit or for commencing a civil action is sixty-three (63) days as provided in <a href="#">37 CFR 90.3</a> . Updated examiner note 1 in form paragraph 7.42.07.
<a href="#">707</a>	—Updated form paragraphs 7.100, 7.101, and 7.102 to include language stating different means for conducting interviews and encouraging the use of the USPTO Automated Interview Request (AIR) to schedule interviews.
<a href="#">707.05</a>	—Revised to include divisional applications among the applications in which parent applications should be reviewed for prior art. Added a cross-reference to <a href="#">MPEP § 609.02</a> .



<a href="#">707.05(e)</a>	—In subsection IV, added reference citation examples 17 (Twitter) and 18 (YouTube) and added "forums" to examples 11 and 12.
<a href="#">707.08</a>	—Updated form paragraphs 7.100, 7.101, and 7.102 to include language stating different means for conducting interviews and encouraging the use of the USPTO Automated Interview Request (AIR) to schedule interviews.
<a href="#">708.02</a>	<p>—Subsection I revised to indicate an application may be made special upon a petition by applicant accompanied by any evidence showing that the state of health of the <b><i>inventor or joint inventor</i></b> [emphasis added] is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course, such as a doctor's certificate or other medical certificate.</p> <p>—Subsection II updated to indicate an application may be made special upon filing a petition including any evidence showing that the <b><i>inventor or joint inventor</i></b> [emphasis added] is 65 years of age, or more, such as a statement by the inventor or joint inventor or a statement from a registered practitioner that he or she has evidence that the inventor or joint inventor is 65 years of age or older. Also updated to indicate the petition can be filed as a PDF-based ePetition or as a Web-based ePetition.</p>
<a href="#">708.02(a)</a>	<p>In subsection I, regarding requirements for being granted accelerated examination status:</p> <p>—Item (C) was updated to indicate that when the application, other papers, and fees are filed in paper instead of EFS-Web because of a system outage, the applicant should prominently indicate the paper filing is under the accelerated examination procedure to help ensure proper processing.</p> <p>—Item (D) was updated to indicate that while an inventor's oath or declaration is not required to obtain a filing date for applications filed under <a href="#">35 U.S.C. 111(a)</a>, it is a requirement under <a href="#">37 CFR 1.51</a> and must be present upon filing for entry in the accelerated examination program.</p> <p>—Item (H) was updated to require identification of the group/subgroup of the Cooperative Patent Classification for utility application and the class/subclass of the U.S. Patent Classification for design applications.</p> <p>—Item (I)(6) was revised to indicate that for an application subject to examination under AIA <a href="#">35 U.S.C. 102</a> and <a href="#">103</a>, the accelerated examination support document must identify any cited references that may be excepted as prior art under <a href="#">35 U.S.C. 102(b)(2)(C)</a> and for an application subject to examination under pre-AIA (first to invent) <a href="#">35 U.S.C. 102</a> and <a href="#">103</a>, the accelerated examination support document must identify any cited references that may be disqualified as prior art under <a href="#">pre-AIA 35 U.S.C. 103(c)</a> as amended by the Cooperative Research and Technology Enhancement (CREATE) Act (Pub. L. 108-453, 118 Stat. 3596 (2004)).</p> <p>—In subsection II, the time period to perfect the petition or accelerated examination support document was changed from one month to two months. Subsection II was also revised to indicate that extensions of time under the provisions of <a href="#">37 CFR 1.136(a)</a> will be permitted, but filing a petition for an extension of time will result in the application being taken out of the accelerated examination program.</p> <p>—In subsection III, final Office actions are no longer excluded from the Office actions providing a shortened statutory period of two (2) months.</p> <p>—In subsection VIII.B, the link to the forms on the USPTO's website was changed to <a href="http://www.uspto.gov/patent/forms/forms#patent">www.uspto.gov/patent/forms/forms#patent</a>.</p> <p>—In Subsection VIII.C, item (8) was revised to indicate the foreign priority claim (if applicable) must be identified in the application data sheet and item (12) was revised to indicate the application must include no petition that would delay the processing of the application. Item (12) was further revised to indicate that, for an application filed after September 16, 2012, the application must include no petition under <a href="#">37 CFR 1.46(b)(2)</a> to designate a person with sufficient proprietary interest as the applicant or a petition under <a href="#">37 CFR 1.78</a> to accept a delayed benefit claim.</p> <p>—In Subsection IX, form paragraphs 8.26.AE and 19.02.AE were updated.</p>
<a href="#">708.02(b)</a>	<p>—The link to the Prioritized Examination "Quick Start Guide" was changed to <a href="https://www.uspto.gov/sites/default/files/documents/track_one_quick_start_guide_11-24-2013.pdf">https://www.uspto.gov/sites/default/files/documents/track_one_quick_start_guide_11-24-2013.pdf</a>.</p> <p>—In subsection I.A.5, the link to the forms on the USPTO's website was updated to <a href="http://www.uspto.gov/patent/forms/forms#patent">www.uspto.gov/patent/forms/forms#patent</a>.</p>

<a href="#">709</a>	—Revised examiner note 2 of form paragraph 7.54 to reference <a href="#">MPEP § 1002.02(c)</a> instead of <a href="#">MPEP § 1003</a> .
<a href="#">710.06</a>	—Revised to include the procedure for applicant to request the resetting of a time period for reply when the delivery of an email notification informing the applicant of an Office communication is delivered a few days later than the mailroom/notification date.
<a href="#">711.03(c)</a>	—Corrected the spelling of "Schuyler." —Moved final two paragraphs of subsection I.A to follow the first paragraph, and thereafter added subsection I.A.1 heading, "Showing of Nonreceipt Required of a Practitioner." —Revised to add subsection I.A.2 directed to a <i>pro se</i> applicant's petition for withdrawal of a holding of abandonment when an Office action was not received by the <i>pro se</i> applicant.
<a href="#">713.01</a>	—Subsection IV revised to indicate that an interview, whether by video conference, over the telephone, or in person, should be arranged for in advance, and that use of the USPTO's Automated Interview Request (AIR) at <a href="http://www.uspto.gov/interviewpractice">www.uspto.gov/interviewpractice</a> is encouraged. —Updated form PTOL-413A.
<a href="#">713.04</a>	—Revised to provide updated guidance on interview practice, including indicating that: —— Examiners must complete an Interview Summary form for each interview where a matter of substance has been discussed during the interview; —— For an applicant-initiated interview, it is the responsibility of the applicant to make the substance of the interview of record in the application file, and it is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability; and —— For an examiner-initiated interview, it is the responsibility of the examiner to make the substance of the interview of record either on an Interview Summary form or, when the interview results in allowance of the application, by incorporating a complete record of the interview in an examiner's amendment. —New subsection heading "I. ITEMS REQUIRED IN A COMPLETE AND PROPER SUMMARY" added preceding the items needed for complete and proper recordation of the substance of an interview. —Subsection heading "EXAMINER TO CHECK FOR ACCURACY" numbered as subsection II and moved so it now precedes the paragraph before form paragraph 7.84.
<a href="#">713.05</a>	—Revised for consistency with <a href="#">MPEP § 405</a> and 1357 OG 254 (August 24, 2010). An interview concerning an application that has not been published under <a href="#">35 U.S.C. 122(b)</a> with an attorney or agent not of record who obtains authorization through use of the interview request form (PTOL-413A) will be conducted based on the information and files supplied by the attorney or agent in view of the confidentiality requirements of <a href="#">35 U.S.C. 122(a)</a> . —Further revised to indicate that the use of the provisions of <a href="#">37 CFR 1.34</a> by a third party or its representative to conduct an interview, or take other action not specifically permitted by the rules of practice in an application for patent, will be considered a violation of <a href="#">37 CFR 11.18</a> and may result in disciplinary action if done by a practitioner. Added a cross-reference to <a href="#">MPEP § 410</a> for a discussion of violations of <a href="#">37 CFR 11.18</a> .
<a href="#">713.09</a>	—Section title was changed to "Interviews Between Final Rejection and Notice of Appeal" and a cross-reference to <a href="#">MPEP § 1204.03</a> was added for interviews after a notice of appeal.
<a href="#">714</a>	—In subsection II.C, added "Cancelled" and "Previously Cancelled" to the list of acceptable status identifiers for consistency with <i>Acceptance of Certain Non-Compliant Amendments Under 37 CFR 1.121(c)</i> , 1296 OG 27 (July 5, 2005).
<a href="#">714.12</a>	—Revised to add text explaining that applicant's submissions concerning the prior art exception under <a href="#">35 U.S.C. 102(b)(2)(C)</a> or prior art exclusion under <a href="#">pre-AIA 35 U.S.C. 103(c)</a> are entitled to being considered even after a final rejection has been made, because if the exception or exclusion is established, the propriety of the rejection is obviated as a matter of law.

	<p>—Further revised to add text explaining that if a final rejection of certain claims is obviated by a timely reply based on a proper claim of entitlement to the prior art exception or exclusion, then the Office should acknowledge the reply by modifying the status of the claims as appropriate. An example is provided.</p> <p>—Added cross-reference to <a href="#">37 CFR 1.704(c)</a> and the discussion of comment 19 in <i>Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule</i>, 65 FR 56366, 79 (September 18, 2000) and to caution applicants that the failure to make a proper submission of entitlement to except or exclude prior art following the first Office action may be considered by the Office as conduct that is considered to be a failure to engage in reasonable efforts to conclude prosecution if such prior art is thereafter excepted under <a href="#">35 U.S.C. 102(b)(2)(C)</a> or excluded under <a href="#">pre-AIA 35 U.S.C. 103(c)</a>.</p>
<a href="#">714.13</a>	<p>— In subsection I, replaced references to form paragraph 7.40.02 with references to form paragraphs 7.40.02.fti and 7.40.02.aia; replaced references to form paragraph 7.42.03 with references to form paragraph 7.42.03.fti.</p> <p>—Subsection II revised to add text explaining that applicant's submissions concerning the prior art exception under <a href="#">35 U.S.C. 102(b)(2)(C)</a> or prior art exclusion under <a href="#">pre-AIA 35 U.S.C. 103(c)</a> are entitled to being considered even after a final rejection has been made, because if the exception or exclusion is established, the propriety of the rejection is obviated as a matter of law.</p> <p>—Subsection II further revised to add text explaining that if a final rejection of certain claims is obviated by a timely reply based on a proper claim of entitlement to the prior art exception or exclusion, then the Office should acknowledge the reply by modifying the status of the claims. An example is provided.</p>
<a href="#">714.16(d)</a>	<p>—Subsection I revised to update the procedures for examiners to use to indicate whether or not entry of an amendment under <a href="#">37 CFR 1.312</a> is recommended. The amendment is to be annotated with "OK to Enter" if the entire amendment is recommended for entry, with "Enter In Part" if only part of the amendment is recommended for entry, and with "Do Not Enter" if none of the amendment is recommended for entry.</p>
<a href="#">715.01</a>	<p>—Revised to replace "applicant" with "the inventor or at least one joint inventor" and to replace "applicant's" with "the inventor's or at least one joint inventor's."</p>
<a href="#">715.01(a)</a>	<p>—Section title and text of section updated because subsequent to September 16, 2012, applications may be filed by an assignee, someone to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.</p> <p>—Revised to include a discussion of <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i>, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017).</p>
<a href="#">715.01(b)</a>	<p>—Revised to include "(in the context of pre-AIA law)" following "derived."</p>
<a href="#">715.01(c)</a>	<p>—A number of occurrences of "applicant" were replaced with "inventor or at least one joint inventor."</p> <p>—Subsection I revised to include a discussion of <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i>, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017).</p> <p>—Subsection II revised to include a note explaining that "derivation" as discussed is in the context of pre-AIA law and that "derivation proceedings" as created in the AIA are discussed in <a href="#">MPEP § 2310 et seq.</a> Subsection II further revised to include cross-references to <a href="#">MPEP §§ 2132.01, 2136.05, and 2137.</a></p>
<a href="#">715.01(d)</a>	<p>—Revised to replace "applicant(s)" with "inventor or at least one joint inventor."</p>
<a href="#">715.02</a>	<p>—Revised to replace "his or her" with "the."</p>
<a href="#">715.03</a>	<p>—Revised to replace occurrences of "he or she," "him or her," and "his or her" with gender-neutral language (e.g., "applicant").</p>
<a href="#">715.07</a>	<p>—Subsection I revised to include a discussion of <i>In re NTP, Inc.</i>, 654 F.3d 1279, 99 USPQ2d 1481 (Fed. Cir. 2011) and <i>In re Steed</i>, 802 F.3d 1311, 116 USPQ2d 1760 (Fed. Cir. 2015).</p>

	<p>—Subsection II revised to change "if the applicant or patent owner does not desire to disclose his or her actual dates, he or she..." to "if disclosure of the actual dates is not desired, the declarant/affiant..." to make the text gender-neutral.</p> <p>—Subsection III revised to remove "the applicant or patent owner must also show," to add "must be shown" at the end of the first paragraph, to modify the text to be gender-neutral (i.e., by removing "his or her" and "he or she"), and to replace reference to form paragraph 7.59 with reference to form paragraph 7.59.fti and reference to form paragraph 7.63 with reference to form paragraph 7.63.fti.</p>
<a href="#">715.07(a)</a>	—Revised to replace "applicant or patent owner" with "the inventor or inventors", to include a discussion of <i>In re Steed</i> , 802 F.3d 1311, 116 USPQ2d 1760 (Fed. Cir. 2015), and to replace reference to form paragraph 7.62 with reference to form paragraph 7.62.fti.
<a href="#">715.07(b)</a>	—Revised to remove "of the applicant" following "testimony."
<a href="#">716.01(a)</a>	—Revised to correct the year <i>Sakraida v. Ag Pro</i> was decided by the Supreme Court.
<a href="#">716.01(c)</a>	—Subsections I and II each revised to replace "applicant" with "inventor or at least one joint inventor."
<a href="#">716.03(b)</a>	—Subsection II revised to include a discussion of <i>Merck &amp; Cie v. Gnosis S.P.A.</i> , 808 F.3d 829,117 USPQ2d 1393 (Fed Cir. 2015).
<a href="#">716.10</a>	<p>—Editor Note revised to indicate "derivation" or "derived" in this section is in the context of pre-AIA law and that "derivation proceedings" as created in the AIA are discussed in <a href="#">MPEP § 2310</a> <i>et seq.</i></p> <p>—Revised to replace "applicant" with "inventor or at least one joint inventor" and to shift the emphasis from who "filed" the application undergoing examination to the inventor(s) "named" in the application or the inventive entity of the application.</p> <p>—Revised to include a discussion of <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i>, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017) (fact situation that resulted in an uncorroborated declaration/affidavit of the inventor being found insufficient).</p> <p>—Revised to indicate that testimony or disclaimer by the other inventor named in the reference is usually not required but, if submitted, should be considered by the examiner.</p> <p>—Revised to change "naming another inventor" to "naming a different inventive entity."</p>
<a href="#">717.02(a)</a>	—Revised to remove references to "evidence" in the title and body of subsection I.B.
<a href="#">717.02(b)</a>	—Revised to remove references to "evidence" in the title of subsections III and IV and in the body of subsection III.
<a href="#">717.02(c)</a>	—Revised to remove references to "evidence" in the text preceding subsection I.
<a href="#">717.02(d)</a>	—Updated form paragraphs 7.20.01.aia and 7.20.04.aia.
<a href="#">719.05</a>	—Revised to incorporate an updated procedure for recording search history data described in a memo from the Assistant Deputy Commissioners for Patents Operations to the Patent Examining Corps on July 6, 2017.

**CHAPTER 800:**

<a href="#">803</a>	—Deleted "-type" after "Markush" for consistency with <a href="#">MPEP § 803.02</a> .
<a href="#">803.02</a>	<p>—Title of section revised to read "Election of Species Requirements – Markush Claims."</p> <p>—Text substantially rewritten to incorporate information from the <i>Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications</i>, 76 Fed. Reg. 7162 (Feb. 9, 2011) and to provide additional information specific to requirements for a provisional election of species and the examination of elected species.</p> <p>—Subsection I added to provide an overview of Markush claims and to cross-reference <a href="#">MPEP § 2117</a> for a general discussion of Markush claims, <a href="#">MPEP § 706.03(y)</a> for guidelines regarding the determination of whether a Markush grouping is improper, and <a href="#">MPEP § 2111.03</a> and <a href="#">MPEP § 2173.05(h)</a> for discussions of when a Markush grouping may be indefinite under <a href="#">35 U.S.C. 112(b)</a>.</p> <p>—Subsection II added to provide an overview of proper Markush groupings and to explain that if the examiner determines that one or more claims appear to include an improper Markush grouping the examiner should require the applicant to elect a species.</p> <p>—Subsection III.A provides an overview of election of species practice for Markush claims, and includes most of the information that appeared in this section prior to the revision. The prior references to the 1978 decisions in <i>In re Weber</i> and <i>In re Haas</i> have been deleted as unnecessary in view of the guidance provided regarding rejections of claims based on improper Markush groupings. The prior information has been substantively revised to add the word "proper" before "Markush group" when indicating that if the members are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group.</p> <p>—Subsection III.B added to provide additional guidance with regard to the provisional election of species, such as explaining the conditions under which such a requirement is proper, and indicating that a written provisional election of species requirement made prior to a first action of the merits should not include a rejection on the basis of an improper Markush grouping.</p> <p>—Subsection III.C added to discuss the initial examination of the elected species, including the treatment of Markush claims when the elected species is rejected over the prior art in subsection 1 and when the elected species is allowable over the prior art in subsection 2.</p> <p>—Subsection III.D includes information pertaining to the final rejection of Markush claims and the finality of election requirements.</p>
<a href="#">804</a>	<p>—Revised to remove references to "obviousness-type double patenting" and to replace them with "nonstatutory double patenting," as appropriate.</p> <p>—In subsection I.B, introductory text, revised the first sentence to clarify that double patenting issues may occur in two or more copending applications; revised the final sentence to indicate that a provisional double patenting rejection should continue to be made by the examiner until the rejection has been obviated or is no longer applicable except in limited situations.</p> <p>—In subsection I.B.1, text directed to provisional nonstatutory double patenting (NDP) rejections substantially rewritten for clarification and consolidation of existing Office policies. Revisions include the addition of an explanation of how a NDP rejection can be overcome by the filing of terminal disclaimers where there are three applications containing conflicting (i.e. patentably indistinct) claims; the addition of text to separately address the determination of the earliest effective filing date of conflicting claims (new subheading (a)); and clarification of the procedures to follow when a provisional NDP rejection is the only rejection remaining in an application (new subheadings (b)(i)-(b)(iv)).</p>
<a href="#">804.02</a>	—Added citation to <i>Boehringer Ingelheim Int'l v. Barr Laboratories</i> , 592 F.3d 1340, 93 USPQ2d 1417 (Fed. Cir. 2010), explaining that a terminal disclaimer filed after the expiration of a reference patent is not effective to obviate a nonstatutory double patenting rejection. Also added cross-reference to <a href="#">MPEP § 1490</a> , subsection VI.A.

<a href="#">804.03</a>	—Updated form paragraphs 8.27.aia, 8.27.fti, 7.15.01.aia, 7.15.01.fti, 7.15.02.aia, and 7.15.02.fti.
<a href="#">817</a>	—Updated form paragraph 8.27.aia.
<a href="#">821.03</a>	—Updated form paragraph 8.26.
<a href="#">822</a>	—Updated form paragraph 8.29.



**CHAPTER 900:**

<a href="#">901.01</a>	—Revised to include references to corresponding AIA laws.
<a href="#">901.04</a>	—Added subsection heading I. "U.S. Patent Series". Revised to add references to <a href="#">MPEP § 2136</a> and <a href="#">§ 2154.01(b)</a> for guidance on determining the effective filing date of a reference in pre- and post- AIA applications, respectively. —Added new subsection II. "Certificates After the Issuance of a U.S. Patent" to describe reexamination certificates, certificates of correction, post-grant review certificates, <i>inter partes</i> review certificates, and derivation certificates. —Added subsection heading III prior to "Numbers for Identification of Bibliographic Data on the First Page of Patent and like Documents (INID Numbers)".
<a href="#">901.04(a)</a>	—Added kind codes "J", "K", and "O" to represent post-grant review, <i>inter partes</i> review, and derivation certificates, respectively.
<a href="#">901.05</a>	—Added cross reference to new <a href="#">MPEP § 901.08</a> in the introductory text. —Subsection II revised to distinguish between the determination of an effective date of a reference under pre-AIA and AIA <a href="#">35 U.S.C. 102</a> . Subsection II further revised to include reference to Global Dossier Public Access as a source of file histories for participating IP Offices.
<a href="#">901.05(c)</a>	—Revised to include reference to Global Dossier Public Access as a source of file histories for participating IP Offices.
<a href="#">901.05(d)</a>	Updated website address for the Scientific and Technical Information Center (STIC) for machine translations.
<a href="#">901.06(d)</a>	—Corrected grammatical error.
<a href="#">901.08</a>	—New section added to discuss Global Dossier Public Access.
<a href="#">902.03(a)</a>	—Updated web address for the Office of Patent Classification Home Page.
<a href="#">903.08(d)</a>	—In subsection IV, replaced "eDAN" with "IFW."
<a href="#">904</a>	—Revised for consistency with <a href="#">MPEP §§ 609.02</a> and <a href="#">2001.06(b)</a> to indicate that an examiner must review a parent application, including the prior art cited therein.
<a href="#">904.02(a)</a>	—Revised to indicate that a proper field of search normally includes the classification locations in which the claimed subject matter of an application would be properly classified at the time of the application's classification or grant of a patent, and to provide an exception where the proper classification corresponds to a disclosed, but unclaimed, embodiment.



**CHAPTER 1000:**

<a href="#">1002.02(c)</a>	—Revised item 3.g to indicate it relates to mailed correspondence delayed by the USPS or USPTO. —Added new item 20, corresponding to item 9 of the Ninth Edition, Revision 11-2013, published in March 2014. Former item 9 was inadvertently omitted in Revision 07-2015, published in November 2015.
<a href="#">1002.02(c)(4)</a>	—Revised the section title and the language of items 2 through 4 relating to petitions decided by Supervisory Patent Reexamination Specialists (SPRS).
<a href="#">1002.02(t)</a>	—New section added for requests decided by the Associate Commissioner for Patent Information Management.

**CHAPTER 1200:**

<a href="#">1201</a>	—Revised third paragraph to add language to clarify the difference between petitionable and appealable matters, including discussion of <i>In re Hengehold</i> , 440 F.2d 1395, 169 USPQ 473, 479 (CCPA 1971) and <i>Ex parte Frye</i> , 94 USPQ2d 1072 (BPAI 2010).
<a href="#">1202</a>	—Revised to add the year 2012 after to the second recitation of September 16.
<a href="#">1203</a>	—Introductory text revised to clarify that the Patent Examining Corps has jurisdiction over the application until the filing of a reply brief under <a href="#">37 CFR 41.41</a> or the expiration of the time period in which to file a reply brief, whichever is earlier. —Subsection I revised to clarify that a docketing notice is not sent by the Board until after the Board has received the application from the Patent Appeals Center. —Subsection II revised to make minor grammatical changes.
<a href="#">1204</a>	—Subsection II revised to indicate that an amendment filed under <a href="#">37 CFR 1.116</a> after a notice of appeal or appeal brief may be entered if it complies with all requirements of form set forth in previous Office actions. Further revised to clarify that a reply under <a href="#">37 CFR 1.111</a> in response to a second or subsequent non-final rejection filed before or on the same day of a notice of appeal will result in the notice of appeal being found defective if the Office did not consider the reply prior to the filing of the notice of appeal. Subsection IV revised to add cross reference to <a href="#">MPEP § 503</a> , subsection III.
<a href="#">1204.02</a>	—Added additional information regarding the pre-appeal brief conference request program, including new paragraphs describing the requirements for a request, the content of a decision on the status on the application after the review is complete, and applicant actions that will trigger termination of the review.
<a href="#">1204.04</a>	—Revised to indicate that the "Record" on appeal excludes documents which have not been indicated as being considered by the examiner.
<a href="#">1205.01</a>	—Replaced "Express Mail" with "Priority Mail Express." Revised to clarify that where a proper petition for extension of time to file an appeal brief is filed, the new due date is computed from the receipt date of the notice of appeal, as opposed to the original due date.
<a href="#">1205.02</a>	—Updated website URLs. Revised examples to refer to <a href="#">35 U.S.C. 102</a> , in effect as of March 16, 2013. Revised to clarify that an appeal brief is considered compliant with <a href="#">37 CFR 41.37(c)(1)</a> as long as it include items (i) to (v) in the order set forth therein and does not include prohibited material. Revised to remove the Board as a reviewer of an appeal brief for compliance.
<a href="#">1205.03</a>	—Revised to indicate that the Patent Appeals Center reviews appeal briefs for compliance. Also revised to refer to form paragraphs 12.249 - 12.279.01 instead of 12.150.01 - 12.156.01 for drafting an examiner's answer.
<a href="#">1206</a>	—Deleted reference to <a href="#">37 CFR 1.116</a> . Revised to include the qualification of "within the time period set forth in <a href="#">37 CFR 90.3</a> " to the discussion regarding admission of amendments filed on or after the filing of an appeal brief. Added a paragraph to discuss entry of amendments when considered to be filed before or after the expiration of the time period in <a href="#">37 CFR 90.3</a> .
<a href="#">1207.01</a>	—Revised to clarify that reasons for allowance may be appropriate when an application is allowed as the result of an appeal conference.
<a href="#">1207.02</a>	—Added guidance on treatment of claims when all rejections of independent or dependent claim(s) are withdrawn in the examiner's answer. Corrected business unit name of the Office of the Deputy Commissioner for Patent Examination Policy.
<a href="#">1207.03</a>	—In subsection III, added citation to and discussion of <i>In re Leithem</i> , 661 F.3d 1316, 100 USPQ2d 1155 (Fed. Cir. 2011) and <i>Rambus v. Rea</i> , 731 F.3d 1248, 108 USPQ2d 1400 (Fed. Cir. 2013). Also added cross reference to <a href="#">MPEP § 2144.03</a> .

<a href="#">1207.03(a)</a>	—In item (3) of subsection I, expanded the discussion of <i>In re Kumar</i> , 418 F.3d 1361, 76 USPQ2d 1048 (Fed. Cir. 2005).
<a href="#">1207.03(c)</a>	—Corrected typographical errors.
<a href="#">1211</a>	—Corrected typographical errors.
<a href="#">1212</a>	—Corrected typographical errors.
<a href="#">1214.01</a>	—Subsection II revised to clarify that an appellant's waiver to continue prosecution before the examiner under <a href="#">37 CFR 41.50(b)(2)</a> extends to the appellant's right to amend the claims under <a href="#">37 CFR 41.50(b)(1)</a> , however, the appellant may still invoke the limited right to rewrite dependent claims not subject to a new ground of rejection into independent form.
<a href="#">1214.04</a>	—Changed section title to "Examiner Reversed in Whole." —In the first paragraph, added the presence of withdrawn claims directed to a non-elected invention as a reason why an application, whose rejections were reversed by the Board, may not be in condition for immediate allowance. Revised to include references to the Central Reexamination Unit (CRU) and Central Reexamination Unit Director.
<a href="#">1214.06</a>	—Changed section title to "Examiner Sustained in Whole or in Part; Claims Require Action." —In the introductory text, updated <a href="#">37 CFR 1.197</a> to reflect current rule language. —Subsection I revised to clarify that a notice of abandonment or a notice of intent to issue a reexamination certificate should be prepared and mailed once the period for seeking review under <a href="#">37 CFR 90.3</a> has expired. Guidance added regarding applications with provisional double patenting rejections not reached by the Board. Revised guidance on treatment of claims found allowable but objected to because of their dependency from a rejected claim. Revised time period for replying to a requirement to rewrite dependent claims to two months and to indicate that extensions under <a href="#">37 CFR 1.136(a)</a> are available. Added cross reference to <a href="#">MPEP § 2278</a> for reexamination proceedings. —In subsection II, revised form paragraph 12.292 to set a two month time period. Added cross reference to <a href="#">MPEP § 2278</a> for reexamination proceedings. —In subsection III, added guidance for treatment of withdrawn claims directed to a non-elected invention following a Board decision. Added guidance for treatment of provisional double patenting rejections which were not reached by the Board in their decision. —Subsection IV revised to clarify that "evidence" refers to evidence as defined in <a href="#">37 CFR 41.33</a> .
<a href="#">1215.04</a>	—Added Subsection I heading "Dismissal Because No Brief was Filed" at the beginning of the section. Revised text in subsection I to add reference to <a href="#">MPEP § 1214.07</a> and to clarify that an amendment which clearly places the application in condition for allowance may be entered after the dismissal of an appeal for failure to file a brief without the filing of an RCE. Added a reference to <a href="#">MPEP § 1002.02(d)</a> . In example (D), deleted "or <i>ex parte</i> reexamination certificate" because procedures for <i>ex parte</i> reexamination proceedings are covered in <a href="#">MPEP § 2278</a> . —Added Subsection II heading "Dismissal Because Brief Was Held Non-compliant" following form paragraph 12.209. Revised text to clarify that the referenced petition is filed under <a href="#">37 CFR 1.182</a> . —Added new subsection III, "Dismissal Because Appeal Forwarding Fee Was Not Paid" and discussion of the same. —Added new subsection IV, titled "Dismissal as to Claims Subjected to New Grounds of Rejection in Examiner's Answer" and discussion of the same. —Added new subsection V, titled "Dismissal Following Remand From the Board" and discussion of the same.
<a href="#">1216.01</a>	—Deleted references to "Express Mail."

**CHAPTER 1400:**

<i>Passim</i>	<p>—Changed "Certificate of Correction" to "certificate of correction."</p> <p>—In subsections with a "[R-08.2017]" revision indicator, revised text, including form paragraphs, to be gender-neutral.</p>
<a href="#">1400.01</a>	—Added supplemental examination as the fifth way a patent may be corrected or amended and renumbered other items and added a cross reference to <a href="#">MPEP Chapter 2800</a> for supplemental examination. Updated the link to the Office Patent Trial Practice Guide.
<a href="#">1401</a>	—Changed "must" to "should" in the last paragraph and in the examiner note for form paragraph 14.01.
<a href="#">1402</a>	<p>—In subsection III, in the second paragraph, modified text to include changes made to <a href="#">37 CFR 1.55</a> that requires a petition under <a href="#">37 CFR 1.55(f)</a> or <a href="#">(g)</a> or a petition for an unintentionally delayed priority claim under <a href="#">37 CFR 1.55(e)</a>. Such changes were made in the final rule implementing the Hague Agreement Concerning International Registration of Industrial Designs ("Hague Agreement"), which was effective May 13, 2015. Added new third and fourth paragraphs on adding or perfecting a foreign priority claim in reissue or certification of correction.</p> <p>—In subsection IV, modified text to include changes made to <a href="#">35 U.S.C. 119(e)</a> and <a href="#">37 CFR 1.78</a> in the implementation of the Patent Law Treaties Implementation Act (PLTIA) and the changes to <a href="#">37 CFR 1.78</a> in the implementation of the Hague Agreement.</p> <p>—Added new subsection VI to address error in filing terminal disclaimers in reissue applications, including a citation to <i>In re Dinsmore</i>, 757 F.3d 1343, 111 USPQ2d 1229 (Fed. Cir. 2014).</p>
<a href="#">1403</a>	—Deleted the reference to <a href="#">MPEP § 1410.01</a> and inserted a new paragraph to note the discussion about diligence in <i>In re Rosuvastatin Calcium Patent Litigation</i> , 703 F.3d 511, 526, 105 USPQ2d 1437, 1447 (Fed. Cir. 2012).
<a href="#">1404</a>	—Deleted "Technology Center" at the end of the first paragraph and "and expedited handling" in the second paragraph. Added a reference to <a href="#">MPEP § 1901.07</a> for more information on protestor's participation.
<a href="#">1405</a>	<p>—In the second paragraph, clarified that maximum patent term is set at grant unless there is patent term adjustment or extension.</p> <p>—Under (A), deleted "new" in "supplemental ADS" and added a cross reference to <a href="#">MPEP § 601.05(b)</a>, subsection II, and a new sentence that if a benefit claim is stated in the specification, the specification should be amended to reflect the correction even if a supplemental or corrected application data sheet (ADS) is filed.</p>
<a href="#">1410</a>	<p>—In the paragraph beginning with "In either case...", added text to clarify that reissue application must be filed with claims as required by <a href="#">37 CFR 1.173(a)(1)</a>.</p> <p>—In the paragraph beginning with "Pursuant to <a href="#">37 CFR 1.173(a)(1)</a>...", added text to include certificates from a trial before the Patent Trial and Appeal Board (PTAB) as a paper reissue applicants must include in filing a reissue application and to explain amendments are made relative to patent as changed by any certificate.</p> <p>—In the paragraph beginning with "Where appropriate...", deleted the phrase "under <a href="#">37 CFR 1.46(a)</a> or if the oath or declaration does not identify the entire inventive entity" at the end of the paragraph.</p> <p>—In the paragraph beginning with "For expedited processing...", updated text regarding filing reissue application by the Office's electronic filing system and added a reference to <a href="#">MPEP § 502.05</a>.</p> <p>—Added a new paragraph to reference the guide for filing reissue application on or after September 16, 2012.</p> <p>—Updated form PTO/AIA/50.</p>

<a href="#">1410.01</a>	<p>—In subsection I, changed "supplemental statement" to "substitute statement" in lieu of the inventor's oath of declaration and added text following the reference to <a href="#">MPEP § 1414</a> to explain that this section includes additional information on the content of reissue oaths or declarations, such as when a copy of the oath or declaration from an earlier-filed reissue application will be accepted.</p> <p>—Added a new subsection "III. ADDING OR DELETING AN INVENTOR" before the last paragraph.</p>
<a href="#">1410.02</a>	<p>—In subsection I., in the paragraph beginning with "The reissue oath or declaration...", deleted text that a reissue application requires a specification, including claim(s) and any drawings because this requirement is covered in <a href="#">MPEP § 1410</a>. Added a reference to <a href="#">37 CFR 1.173(a)(1)</a> and <a href="#">1.173(b)(2)</a> following "reissue rules."</p> <p>—In subsection I., in the paragraph beginning with "The consent of assignee...", added text to clarify who can sign the consent for applications filed on or after September 16, 2012 and applications filed before September 16, 2012.</p> <p>—In subsection II, changed references to "<a href="#">37 CFR 3.73(b)</a>" to "<a href="#">37 CFR 3.73</a>" to reduce confusion as to which version of <a href="#">37 CFR 3.73</a> is being referenced.</p>
<a href="#">1411</a>	<p>—Revised text to clarify that when an "approved" terminal disclaimer was filed in the original application, a copy of that terminal disclaimer does not need to be filed in the reissue application by the reissue applicant.</p>
<a href="#">1411.02</a>	<p>—Added text and cross references regarding guidance on rejections under <a href="#">35 U.S.C. 112(a)</a> and new matter issues.</p>
<a href="#">1412.01</a>	<p>—In the first paragraph, added parenthetical after the citation to <i>In re Mead</i>.</p> <p>—Added text discussing <i>Antares Pharma Inc., v. Medac Pharma Inc. and Medac GMBH</i>, 771 F.3d 1354, 112 USPQ2d 1865 (Fed. Cir. 2014).</p> <p>—Added new item (C) and a statement that examiner should discuss any possible rejection under 35 U.S.C. 251 based on failure to meet the original patent requirement with their TQAS or SPRS.</p> <p>—In subsection I, revised language to change "divisional" to "continuing" and to add non-claimed, distinct subject matter as something that cannot be recovered by filing a reissue application (similar to non-elected inventions). Added a citation to <i>In re Weiler</i>, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986).</p> <p>—Added new subsection II to discuss overlooked aspects by moving modified text from <a href="#">MPEP § 1412.02</a>. Text was modified by, e.g., adding a definition of overlooked aspects and more discussion regarding <i>B.E. Meyers &amp; Co. v. United States</i>, 47 Fed. Cl. 200, 56 USPQ2d 1110 (Fed. Cl. 2000).</p>
<a href="#">1412.02</a>	<p>—In the last sentence of the first paragraph, changed "reissue patent" to "reissued patent." Added a new second paragraph to refer to the new overlooked aspects subsection in <a href="#">MPEP § 1412.01</a>.</p> <p>—Added a new definitions subsection as subsection I.</p> <p>—Subsection II includes the recapture analysis steps, which is modified as indicated. Added parenthetical notes to the three step quotation from <i>North American Container</i>.</p> <p>—In subsection II.A, revised the heading by changing "Was" to "Is."</p> <p>—In subsection II.B.1, in the paragraph beginning with "If an original patent...", changed "original application file (of the patent to be reissued)" to "original application (of the patent to be reissued and any related application(s))." Added text discussing <i>Mostafazadeh</i>, moved text discussing <i>Youman</i> and <i>Meyers</i> to <a href="#">MPEP § 1412.01</a>, subsection II, and added a reference to <a href="#">MPEP § 1412.01</a>, subsection II, for information on overlooked aspects.</p> <p>—In subsection II.B.2(A), in the first paragraph, deleted "assume that" and added "and no other amendments are made" in the example to eliminate the situation that there might be material narrowing. Removed the discussion of <i>Ex parte Yamaguchi</i>. Added "by the argument" after "anything" in the last sentence for clarification.</p>

—In subsection II.B.2(B), in the indented example, changed "reissued claims" to "reissue claims" and added a parenthetical note "(absent the addition of a materially narrowing limitation ...)" for clarification.

—In subsection II.B.2(C), clarified by adding a parenthetical that examiner's amendments approved by applicant are considered in a recapture analysis, and revised the description of Scenarios 1 and 2 to clarify that limitation C is or is not the surrendered subject matter. Added new scenario 3.

—In subsection II.C, revised the heading to be in present tense. In the first paragraph, changed "the third prong" to "this third step" and "should be barred as recapture" to "should be barred under the recapture doctrine" for clarification. Added a new second paragraph to discuss *In re Mostafazadeh*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011). Reorganized text to remove redundant text and for clarity by, e.g., relocating some of the text in the paragraphs beginning with "First" and "Second" to the "two possibilities" paragraphs, deleting some of the discussion of analysis performed in steps 1 and 2 and inserting references to steps 1 and 2 instead and explicitly stating what determination is made under step 3. Revised the first possible situation by adding numbered bullet, revising text regarding *Pannu* and clarifying that a surrender generating limitation is completely eliminated and not replaced. Revised the second possible situation by adding "2) If the SGL" to the beginning. Revised the paragraph beginning with "See *Youman*..." to insert "retained" before "portion of the modified limitation." Revised the last paragraph by changing "Even" to "In both situations 1 and 2, even...", adding "(e.g., same characteristic or concept)" after "surrendered subject matter" and changing "argued by applicant" to "amended or argued by applicant."

—In subsection III, added new subsection heading and relabeled existing subsections in accordance with format used in the MPEP. Deleted the definitions subsection because the terms are now defined in subsection I.

—In subsection III.A.2, reorganized the first paragraph to first state what the subsection discusses. Revised the third paragraph to add assumptions to the example and to add another example. Revised the last paragraph to clarify that the claimed invention was ABZC and that no patentability arguments were made based upon limitation Z in the original application.

—In subsection III.B, deleted the first sentence because the definition for patent claims is provided in subsection I and updated the reference from subsection V to VII due to relabeling in this revision.

—In subsection III.B.1, revised the subsection heading to clarify that the reissue claims entirely omits surrender generating limitations and are narrower in unrelated aspects. Added a new second paragraph to explain why there is recapture in this situation. Revised the third paragraph to clearly state that overlooked aspects are not applicable and that element C is a surrender generating limitation. Revised the fourth paragraph to clarify that the surrender generating limitation is entirely omitted and that there is no material narrowing of the reissue claims.

—In subsection III.B.2, revised the subsection heading to clarify that the reissue claims are narrower or equal in scope in an area related to surrendered subject matter and are broader in unrelated aspects. Revised the third paragraph to clarify that the parenthetical example concerns entirely omitting element C and adding a reference to example 4. Revised the fourth paragraph to clarify that narrowing a surrender generating limitation (element E) would not violate the recapture doctrine.

—In subsection III.B.3, revised the subsection heading to clarify that the reissue claims retain the surrender generation limitation(s) and are broader or narrower in unrelated aspects. Revised the last paragraph to clarify that neither element B nor element C could be "entirely" omitted and added a reference to example 4.

—In subsection III.B.4, revised the subsection heading to clarify that the reissue claims retain the surrender generation limitation(s) in broadened form. Added text relating to the explanation in *Mostafazadeh* that if the reissue claims are materially narrowed compared to the original claims, there is no impermissible recapture if full or substantial recapture is avoided.



	<p>—Renumbered former subsection II to IV as a conforming change.</p> <p>—Renumbered former subsection III to V as a conforming change.</p> <p>—Renumbered former subsection IV to VI as a conforming change. Revised form paragraph 14.17 to rewrite "A broadening aspect is present in the reissue which was not present in the application for patent" to "The reissue application contains claim(s) that are broader than the issued patent claims" and added a phrase to the end of the examiner note to clarify that the reissue claim is not materially narrowed to avoid recapture.</p> <p>—Renumbered former subsection V to VII as a conforming change. In items 2 and 4, added the phrase "which was determined to be not materially narrowing under step 3."</p> <p>—Renumbered former subsection VI to VIII as a conforming change. The flowchart was revised to add a new box in the lower right that states: "The reissue claim omits the key limitation, but has been materially narrowed with respect to the surrendered subject matter" and to revised the text in the box directly above the new text so that the last clause reads "the claim is still materially narrowed relative to the surrendered subject matter."</p>
<a href="#">1412.03</a>	<p>—In subsection I, corrected the citation for <i>Ex Parte Wikdahl</i> and deleted the last sentence pertaining to combination claims.</p> <p>—In subsection V.A, revised the first sentence to be two separate sentences in the first paragraph. Added "broadening" before "reissue application" in the first sentence of the second paragraph.</p>
<a href="#">1412.05</a>	<p>—In subsection I, deleted text regarding deletion of an inventor at the end of the second paragraph because the same text is in the third paragraph. In the paragraph beginning with "If an inventor is being added...", added "or to correct an error in the scope of the claims that results in the addition of one or more inventors". Added a second example and headers for the examples (e.g., "Example 1:" and "Example 2:").</p>
<a href="#">1414</a>	<p>—Added "MPEP" before references to <a href="#">§ 1414.02</a> and <a href="#">§ 1414.03</a>.</p> <p>—In subsection I., in the paragraph beginning with "Even though only one error...", changed "all of the reasons" to "each of the reasons" to mirror the previous sentence.</p> <p>—In subsection II, reorganized list item (D) into three numbered paragraphs, added a header for item (D), and changed the reference to forms paragraphs "14.01.01 through 14.01.03" to "14.01.01, 14.01.02, or 14.01.03" for clarity. Examiner Note 1 of form paragraph 14.01.06 updated to reference form paragraph 14.05.02.fti instead of 14.05.02.</p>
<a href="#">1414.01</a>	<p>—Updated reproduced <a href="#">37 CFR 1.175(f)(1)</a> to added reference to <a href="#">35 U.S.C. 386(c)</a> to reflect changes made from implementation of the PLTIA.</p> <p>—Added a new paragraph beginning with "Depending on the circumstances, the inventor's oath..." to describe different ways the inventor's oath or declaration can be made.</p> <p>—Added three new paragraphs starting with the paragraph beginning with "Unlike in non-reissue..." to clarify that the inventor's oath or declaration must be filed with the application and who can sign the inventor's oath or declaration or substitute statement in different situations.</p> <p>—Added a reference to and copy of form PTO/AIA/07 and updated copies of forms PTO/AIA/05 and PTO/AIA/06.</p>
<a href="#">1414.02</a>	<p>—In subsection I, updated the cross reference to <a href="#">MPEP § 2012</a> instead of <a href="#">MPEP § 2022.05</a> and added ".fti" to end of form paragraph 14.01.04 and the reference thereto.</p> <p>—In subsection II, added "pre-AIA" before "<a href="#">37 CFR 1.63(a) and (b)</a>" for clarification and updated copies of forms PTO/SB/51 and PTO/SB/52.</p>
<a href="#">1414.03</a>	<p>—In subsection I, corrected "replied" to "relied" in the last paragraph.</p> <p>—In subsection II, added "pre-AIA" before <a href="#">35 U.S.C. 251</a> and changed the phrase "was not identified..." to "was not covered..." in the first paragraph. In the first sentence of the paragraph beginning with "In the event..." corrected "applicant" to "application."</p> <p>—In subsection II.A, added "pre-AIA" before <a href="#">35 U.S.C. 251</a>.</p>



	—In subsection II.C, added "pre-AIA" before <a href="#">37 CFR 1.175</a> , text to clarify that the petition under <a href="#">37 CFR 1.183</a> requires the petition fee and a request to waive the requirement for the signature of the nonsigning inventor, and text to address the situation where the sole inventor refuses to sign or cannot be found to sign the oath/declaration in a broadening reissue application.
<a href="#">1415</a>	—In subsection V, updated the forms page website address.
<a href="#">1415.01</a>	—In the second paragraph, added phrase "prior to issuing any Office action and" before "during the process" for clarification. —In item (C), updated the website address for Public PAIR. —In the paragraph beginning with "If the window...", added reference to the Supervisory Patent Reexamination Specialist (SPRS).
<a href="#">1416</a>	—Added a reference to <a href="#">MPEP § 1460</a> at the end of the section.
<a href="#">1417</a>	—In subsection I, revised the last paragraph to update the procedures if the examiner notices a discrepancy between the PALM bib-data sheet and the information on the front page of the original patent. —In subsection II, modified text to include changes made to <a href="#">37 CFR 1.55</a> that requires a petition under <a href="#">37 CFR 1.55(f)</a> or <a href="#">(g)</a> or a petition for an unintentionally delayed priority claim under <a href="#">37 CFR 1.55(e)</a> . Such changes were made in the final rule implementing the Hague Agreement, which was effective May 13, 2015.
<a href="#">1418</a>	—Updated text of <a href="#">37 CFR 1.178(b)</a> to reflect current text by adding "or trials before the Patent Trial and Appeal Boards" after "interferences". —In form paragraph 14.11.01, changed "at" to "before" prior to "the Patent Trial and Appeal Board".
<a href="#">1430</a>	—In the second paragraph, updated the website address for Public PAIR.
<a href="#">1440</a>	—Added new subsection II to clarify the effective date for claims of a reissue application.
<a href="#">1441.01</a>	—In subsection I, pluralized "file content" in first paragraph. —In subsection II, deleted the paragraph regarding TC retaining jurisdiction and changed "before" to "prior" in the first sentence of the following paragraph. Added "further" before the second occurrence of "action."
<a href="#">1442</a>	—Added pending trials before the PTAB and defined pending trials.
<a href="#">1442.01</a>	—Added pending trials before the PTAB to the title and text. —Added a new paragraph that examiners can look up the status of a PTAB trial and that the PTAB (as delegated by the Director) may exercise exclusive jurisdiction. —In the last paragraph, changed the time period from 1 month to 2 months.
<a href="#">1442.02</a>	—Added pending trials before the PTAB to the title and text. —Revised text regarding suspension to state that the PTAB may suspend if there is a pending PTAB trial and that the Office has discretion to suspend based on the facts of the case. —In the paragraph beginning with "Where none of...", added SPRS as an alternative to TQAS.
<a href="#">1442.03</a>	—In the third paragraph, added SPRS as an alternative to TQAS; in the fourth paragraph, changed "P" to "PTAB."
<a href="#">1442.04</a>	—Updated reproduction of <a href="#">37 CFR 1.178</a> . —Added pending trials before the PTAB and interferences in the first paragraph of text. In the fourth paragraph, changed "litigation computer search by the Scientific and Technical Information Center (STIC)" to "search" because the litigation search can be performed outside of STIC. Also, deleted "OACS" before "'Search Notes'" (two occurrences) and changed "page" to "form" following "'Search Notes'" (two occurrences) to make conforming changes with the July 2017 Search Recordation Memo to the patent corps.
<a href="#">1443</a>	—In the first paragraph, added SPRS as an alternative to TQAS.

	<p>—In the second paragraph, added similar text from <a href="#">MPEP § 1410.02</a> regarding procedures when the reel and frame number of where the assignment document is recorded is given in a <a href="#">37 CFR 3.73</a> statement instead of an assignment document.</p> <p>—In the fourth paragraph, revised text to clarify that the ownership statement must be by the applicant and not contradicted by other documents of record.</p> <p>—In the last paragraph, corrected the decision year to "1993" in the citation to <i>In re Morgan</i>.</p>
<a href="#">1444</a>	<p>—In subsection I, added "MPEP" before <a href="#">§ 1414.02</a> and <a href="#">§ 1414.03</a>.</p> <p>—In subsection II, changed reference to form paragraph 14.01 to 14.01.06 to include all form paragraphs that address oaths or declarations.</p> <p>—In subsection III.B, corrected "replied" to "relied" and added "pre-AIA" before "<a href="#">35 U.S.C. 251</a>".</p> <p>—In subsection IV, replaced reference to form paragraph 14.05.02 with reference to form paragraph 14.05.02.fti.</p> <p>—In subsection V, deleted the date qualifications for the references to <a href="#">37 CFR 1.55</a> because such qualifications are no longer applicable after the implementation of the PLTIA.</p>
<a href="#">1448</a>	<p>—In subsection I, added SPRS as an alternative to TQAS in the first paragraph and replaced references to form paragraph 14.22 with references to form paragraph 14.22.fti.</p>
<a href="#">1449</a>	<p>—At the end of the first paragraph, added a sentence to define a contest case.</p> <p>—In the second paragraph, added SPRS as an alternative to TQAS.</p> <p>—In item (B), revised text to clarify that after the PTAB has finished their review, they will inform the examiner if the application may be acted upon.</p>
<a href="#">1449.01</a>	<p>—Added SPRS as an alternative to TQAS.</p> <p>—In subsection I, changed the reference to a Senior Legal Advisor in OPLA to a Legal Advisor in OPLA, changed "e-mail" to "email", and added a cross reference to <a href="#">MPEP § 2285</a> and <a href="#">§ 2686.03</a>.</p> <p>—In subsection I.A, revised text to include PTAB trial certificates by changing from "reexamination certificate" to "certificate" and adding PTAB trial, where appropriate, and a definition of a trial before the PTAB. In item (B)(1), changed the time period to two months to be consistent with the implementation of the PLTIA. In item (B)(5), clarified text by deleting "however" and inserting "if claims were canceled in a reexamination certificate" in its location and also added a new phrase regarding claims cancelled in a PTAB trial certificate. In item (B)(5)(a), added a parenthetical that "this includes any existing patent claims and any claims added in the reexamination proceeding or trial before the PTAB."</p> <p>—In the heading for subsection II, changed "AND" to "OR".</p> <p>—In subsection II, added a new paragraph concerning the situation where a PTAB trial certificate is to be issued while the reissue application is pending.</p>
<a href="#">1449.02</a>	<p>—Changed "applicable" to "applicable" in Editor Note.</p>
<a href="#">1449.03</a>	<p>—Changed "applicable" to "applicable" in Editor Note.</p> <p>—Added reference to <a href="#">MPEP § 2310</a>.</p>
<a href="#">1450</a>	<p>—Reorganized the section by adding three subsections, I to III.</p> <p>—In the paragraph prior to subsection I, revised text to clarify what items should be in an Office action containing a restriction requirement and that original patent claims will continue to be examined while non-elected claims to added inventions will be held in abeyance until such claims are filed in a divisional application.</p> <p>—In subsection I, revised the first paragraph to make it clear that a disclaimer of all the original patent claims must be filed before an Office action treating the original patent claims on the merits is issued. Modified text in the second paragraph to clarify that if all original patent claims are cancelled prior to the restriction and no new claims are directed to invention(s) covered by the original patent claims, the examiner may notify the applicant that a disclaimer is required. Revised text in the third paragraph to explain the procedures if the applicant does not file a disclaimer.</p>

	<p>—In subsection II, added text to clarify procedures when there are multiple reissue applications filed. The first paragraph was revised to explain applicant's options in responding to an Office action rejecting the original patent claims under <a href="#">35 U.S.C. 251</a> based on the fact that there is no error in the non-amended patent claims. The second paragraph was modified to state that if no divisional reissue application is filed for the non-elected claims, no reissue patent will issue because there is no error in the original patent claims to be corrected. The third paragraph was revised to clarify that if a divisional reissue application is timely filed, action on the first reissue application containing the original patent claims will be suspended once the first application is determined to be allowable. The fourth paragraph was modified to include text to explain that if the reissue applicant does not respond to a requirement for merger, the original patent claims may be lost if the divisional reissue application issues. The last paragraph was revised to clarify that if the divisional reissue application becomes abandoned, prosecution on the suspended first reissue application will be reopened and a rejection under <a href="#">35 U.S.C. 251</a> will "once again" be made.</p> <p>—In subsection III, in the last paragraph, deleted the parenthetical regarding adding species claims that require all the limitations of the issued generic claim and clarified in item (2) that the non-elected claims directed to the added species "that was not subject to restriction in the original prosecution" must be rejoined with the elected claims of the original patent.</p>
<a href="#">1451</a>	<p>—Added text to further explain the effects of filing a regular continuation or divisional application (e.g., a <i>Bauman</i> type continuation or divisional application) from a reissue application.</p> <p>—Revised text to allow for the application data sheet as an alternative to amending the specification to contain the benefit claim.</p> <p>—Changed "<a href="#">37 CFR 1.175</a>" to "<a href="#">37 CFR 1.173</a>" in item 3 in the listing of indicia for a continuing reissue application, and revised the text, in part, in item 6 to "a continuation of application number [the parent reissue application] and an application for reissue of the patent number [patent for which reissue is sought]".</p> <p>—Added text to refer to the reissue filing guide for identifying continuation or divisional reissue applications.</p> <p>—Added SPRS as an alternative to TQAS in the last paragraph prior to subsection I.</p> <p>—In subsection I, added SPRS as an alternative to the SPE and updated text to eliminate procedures that refer to paper files. Changed "obviousness-type" double patenting to "nonstatutory" double patenting. Added new subsections A and B and reorganized text so that subsection A only pertains to consent of the assignee and subsection B only pertains to the oath or declaration.</p> <p>—In subsection II, updated text to eliminate procedures that refer to paper files and changed "obviousness-type" double patenting to "nonstatutory" double patenting. In the paragraph prior to Example 1, added a parenthetical expression regarding supplemental declarations for applications filed prior to September 16, 2012 and remarks for application filed on or after September 16, 2012. Also, moved the revised sentence regarding waiver of the requirements in <a href="#">37 CFR 1.175</a> from further below in subsection II. Made the text pertaining to consideration of a nonstatutory double patenting rejection citing <i>In re Berg</i> into a separate paragraph.</p>
<a href="#">1452</a>	<p>—Revised the first two sentences to be one sentence by deleting "Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was". Added a new last sentence that applicants should refer to the merger decision for guidance.</p>
<a href="#">1453</a>	<p>—In subsection IV, added PTAB trial certificates to the parenthetical listing of post-issuance procedures.</p> <p>—In subsection V, added text that examiners may accept status identifiers even if the identifier used is not one listed in <a href="#">37 CFR 1.530(d)(2)</a> or <a href="#">1.121(c)</a> (three occurrences). In subsections C and D, added text that although use of the status identifier "new" is not required, its use is recommended. In "(D) Amendment of New Claims," added an example of an amendment.</p>

	<p>—In subsection VI, revised text to include PTAB trial certificates by changing from "reexamination certificate" to "certificate" and adding PTAB trial, where appropriate.</p>
<a href="#">1455</a>	<p>—In subsection VIII, in item (A), changed "facsimile transmission" to "electronic filing". Also, changed "replied" to "relied" in the third paragraph and added "and" between the MPEP references in the fourth paragraph.</p> <p>—In subsection IX, added "or Supervisory Patent Reexamination Specialist (SPRS)" after "(TQAS)" and changed the reference to the Paralegal Specialist to SPRS.</p>
<a href="#">1456</a>	<p>—Revised the first sentence to clarify that all reissue applications assigned to the technology centers are monitored and revised by TQASs and added a new second paragraph to state that all reissue applications assigned to the CRU are monitored and reviewed by SPRSs.</p>
<a href="#">1457</a>	<p>—In subsection I, in the third paragraph, deleted the phrase regarding the processing of fees and the assigning of an application number because these steps may be done prior to the TC director's decision on the expedited examination request and revised text to state that the design reissue application file is referred to OPLA.</p> <p>—In subsection V, added a sentence that a utility cannot be converted to a design via reissue for clarification. Deleted the last sentence regarding 14 year patent term and inserted a reference to subsection IV above regarding patent term.</p>
<a href="#">1460</a>	<p>—Added a new last paragraph to explain effect of abandonment of the reissue application, including effect if there was a restriction made and the merger requirement was not met.</p>
<a href="#">1470</a>	<p>—Updated the website address and deleted "(A)."</p>
<a href="#">1480</a>	<p>—Updated text of <a href="#">37 CFR 1.322(a)(3)</a> to reflect current text by adding "or trial before the Patent Trial and Appeal Board" after "interference" and adding "or <a href="#">§ 42.20</a>" after "<a href="#">§ 41.121(a)(3)</a>".</p> <p>—Corrected the spelling of "Management" in the address for the Certificates of Correction Branch.</p>
<a href="#">1481.02</a>	<p>—Added two new paragraphs before subsection I to state procedures for correction of a typographical error in the inventor's name and correction due to changes in the inventor's name.</p> <p>—Updated the text of <a href="#">35 U.S.C. 256</a> to reflect current text by adding paragraph labels. In subsection I, updated the reproduction of <a href="#">37 CFR 1.324</a> and related text. In item (1), corrected "in inventor" to "an inventor."</p> <p>—In subsection III, added text regarding new form PTOL-360. In form paragraphs 10.13 and 10.14, corrected the name for "Certificates of Correction Branch." In examiner note 1 of form paragraph 10.18, changed "10.16" to "10.16.fti."</p>
<a href="#">1481.03</a>	<p>—In subsection II, modified text to include changes made to <a href="#">37 CFR 1.78</a> that requires a petition for an unintentionally delayed priority claim under <a href="#">37 CFR 1.78(e)</a>. Such changes were made in the final rule implementing the Hague Agreement, which was effective May 13, 2015. Updated the text for the reproduction of <a href="#">37 CFR 1.78</a> from the implementation of the PLTIA and Hague Agreement. Deleted text regarding changes in <a href="#">35 U.S.C. 119(e)</a> in the AIPA and added text regarding changes in <a href="#">35 U.S.C. 119(e)</a> in the PLTIA. Revised text when a certificate of correction can correct a benefit claim under <a href="#">35 U.S.C. 120</a>, <a href="#">121</a>, <a href="#">365(c)</a>, or <a href="#">386(c)</a> to be consistent with changes made by the PLTIA and Hague Agreement. Deleted subsections B and C.</p>
<a href="#">1485</a>	<p>—Corrected the name for "Certificates of Correction Branch." In the paragraph beginning with "If the patent...", added a reference to a trial before the PTAB, <a href="#">37 CFR 1.323</a>, <a href="#">37 CFR 42.20</a> or <a href="#">42.22</a> and <a href="#">MPEP §§ 1481</a> and <a href="#">1481.02</a> and changed "the party making..." to "the patentee making...."</p> <p>—In subsection I, changed "Web site" to "website", updated the website address for Official Gazette notices, and corrected the spelling of "after" in the third paragraph.</p>
<a href="#">1490</a>	<p>—Added text of <a href="#">AIA 37 CFR 1.321</a> and moved text of <a href="#">pre-AIA 37 CFR 1.321(b)</a> from subsection I. Added a brief discussion of the changes to <a href="#">35 U.S.C. 253</a> by the AIA and the two types of disclaimers, which was a discussion in former subsection II.</p>

- Reorganized the section by, e.g., moving text from former subsections II and III to I and II, respectively, and former subsection I to III.
- Subsection I was revised to contain information on statutory disclaimers and contains revised text from former subsection II.
- Subsection II was revised to contain information on terminal disclaimers and contains revised text from former subsection III.
- Subsection III was revised to contain information on signing and supporting a disclaimer and contains revised text from former subsection I. This subsection was reorganized to contain further subsections for disclaimers filed in a patent or reexamination proceeding and terminal disclaimers filed in a patent application.
- Subsection IV was revised to clarify processing for terminal disclaimers and statutory disclaimers in the Certificates of Correction Branch and to correct the name for "Certificates of Correction Branch." For example, item (D) was revised to explicitly apply to both statutory and terminal disclaimer data (when the terminal disclaimer is filed in a patent) and item (E) was newly added.
- Subsection V was revised to explicitly include processing of terminal disclaimers in reexamination proceedings and to reorganize existing text into further subsections A and B.
- Subsection VI.A was revised to include reference to forms PTO/SB/25a & 26a, to consistently refer to the "reference" patent, and to state that a terminal disclaimer filed under [37 CFR 1.321\(c\) or \(d\)](#) must be filed before the expiration of the reference patent to be effective, citing *Boehringer Ingelheim Int'l v. Barr Laboratories*, 592 F3d 1340, 93 USPQ2d 1417 (Fed. Cir. 2010) for support.
- In subsection VI.B, revised text to limit the discussion to terminal disclaimers and added text regarding the effect of terminal disclaimers in reexamination proceedings. Reorganized text by moving text regarding reissue applications after the inserted text regarding reexamination proceedings. Revised text to clarify procedures regarding the internal review form.
- In subsection VI.C, added "terminal" and changed "target" to "reference" in the heading and body of text.
- In subsection VI.D, revised text to clarify when nonstatutory double patenting rejections must be applied and maintained in the situation where there are two or more copending applications filed by the same inventive entity, different inventive entities having a common inventor, a common applicant, and/or a common assignee or that claim an invention resulting from activities undertaken within the scope of a joint research agreement. Revised text to include claims under [35 U.S.C. 365\(c\)](#) and [386\(c\)](#) and changed "obviousness-type double patenting" or "ODP" to "nonstatutory double patenting" or "NDP." Added subheadings 1 and 2(a)-(d) to reorganized text to address specific situations clearly. Replaced reference to form paragraph 14.27.04 with reference to form paragraph 14.27.04.fti.
- In subsection VII, revised form paragraphs 14.27.04 to 14.27.08, 14.37, and 14.38 to change "obviousness-type double patenting" or "ODP" to "nonstatutory double patenting" or "NDP," "prior" application or patent to "reference" application or patent. Revised form paragraphs 14.27.04, 14.27.04.1, and 14.27.06 to add a sentence at the end that a copy of the forms may be found in [MPEP § 1490](#). Form paragraph 14.27.06 revised to reference forms PTO/SB/25a and PTO/SB/26a and in Note 2, to reference form paragraph 14.27.07.1 instead of 14.27.04.1. In Note 2 of form paragraph 14.27.07.fti, added a date qualification for use of form paragraph 14.27.04.fti and added reference to form paragraph 14.27.04.1 for applications filed on or after September 16, 2012. In form paragraph 14.27.08, changed "any patent granted on the pending reference application" to "the instant patent" in the last sentence of subsection I, and added "run with the instant patent and" in the last sentence of subsection II.
- In subsection VIII, revised the first sentence by adding "if a terminal disclaimer is filed" and the second sentence by deleting "it is unlikely that" and adding "not" before "be nullified."
- In subsection VIII.A, added text to explain when a terminal disclaimer can be withdrawn in a reexamination proceeding.

—In subsection VIII.B, added "or Reexamination Certificate" in subheading. Added a citation to and explanation of *In re Dinsmore*, 757 F.3d 1343, 111 USPQ2d 1229 (Fed. Cir. 2014). Revised the last paragraph to state that after issuance of a patent a request to replace or remove a previously recorded terminal disclaimer will not be addressed on the merits.

—In subsection IX, updated the forms.



**CHAPTER 1500:**

<a href="#">1503</a>	—Corrected minor typographical error.
<a href="#">1503.01</a>	—In subsection I, added paragraph indicating that when the article named in the title does not correspond to the article named in the claim as required by <a href="#">37 CFR 1.153</a> , the examiner should object to the inconsistency and require correction. —In subsection III, added cross-reference to <a href="#">MPEP Chapter 2900</a> for international design applications.
<a href="#">1503.02</a>	—In subsection IV, deleted "prohibited" before "new matter" and corrected cross-reference to <a href="#">MPEP § 1504.04</a> , subsection I.B. —Subsection V revised to delete references to "formal" or "informal" drawings because the Office no longer considers drawings as formal or informal; drawings are either acceptable or not acceptable. Form paragraph 15.05.041 revised for the same reason. Revised to correct cross-references to <a href="#">MPEP § 1503.01</a> , subsection II.
<a href="#">1504</a>	—Revised to change reference to "Official" action to "Office" action. Further revised to delete references to "formal" or "informal" drawings because the Office no longer considers drawings as formal or informal; drawings are either acceptable or not acceptable.
<a href="#">1504.01(c)</a>	—Revised subsection IV to make minor non-substantive change for clarity.
<a href="#">1504.02</a>	—Revised to update and clarify the discussion of the "ordinary observer" test in determining novelty. Added citations to <i>Apple Inc. v. Samsung Elecs. Co.</i> , 786 F.3d 983, 114 USPQ2d 1953 (Fed. Cir. 2015); <i>Ethicon Endo-Surgery, Inc. v. Covidien, Inc.</i> , 796 F.3d 1312, 115 USPQ2d 1880 (Fed. Cir. 2015); and <i>Sport Dimension, Inc. v. Coleman Co. Inc.</i> , 820 F.3d 1316, 118 USPQ2d 1607 (Fed. Cir. 2016). —Revised table to change "Czech Republic" to "Czechia", consistent with the revision of WIPO Standard ST.3, effective November 1, 2016.
<a href="#">1504.03</a>	—Revised to make minor non-substantive changes for clarity. Revised to replace references to "obviousness-type" or "obviousness" double patenting with "nonstatutory" double patenting in form paragraphs 15.19.02.aia; 15.19.02.fti; 15.19.04.fti; and 15.19.06.fti. Form paragraph 15.19.05.aia revised to change "Because the upon the reference" to "Because the reference."
<a href="#">1504.04</a>	—Subsection I.A revised to indicate that the title of the design identifies the article in which the design is embodied by the name generally known and used by the public and may contribute to defining the scope of the claim. Form paragraph 15.20.02 revised. —Subsection I.B rewritten and split into two subsections, subsection I.B entitled "New Matter" and subsection I.C entitled "Written Description." —Subsection I.B revised to update and clarify guidance pertaining to new matter in design patent applications. In particular, further guidance is provided regarding when broken lines and drawing amendments introduce new matter. —Subsection I.B revised to add cross-reference and recitation of form paragraph 15.51.01. —Subsection I.C added to 1) provide guidance regarding compliance with the written description requirement for design applications; 2) address specific situations in design applications where compliance with written description issues arise; and 3) provide guidance on clarity of the record. Form paragraphs 15.51.01, 15.51, and 15.65 revised.
<a href="#">1504.05</a>	—Revised to replace "obviousness-type" double patenting with "nonstatutory" double patenting and to make minor non-substantive changes for clarity.
<a href="#">1504.06</a>	—Revised to replace "obviousness-type" double patenting with "nonstatutory" double patenting and to make minor non-substantive changes for clarity.
<a href="#">1504.10</a>	—Revised to indicate that where a design patent application claims benefit under <a href="#">35 U.S.C. 120</a> to an intermediate nonprovisional utility patent application that directly claims priority to a foreign application, the intermediate nonprovisional utility application must have been filed



	<p>within 6 months of the filing date of the foreign priority application in order for the design patent application to obtain the benefit of the earlier foreign filing date.</p> <p>—Revised to clarify that design applications may not claim the benefit of a provisional application under <a href="#">35 U.S.C. 119(e)</a>.</p>
<a href="#">1504.20</a>	<p>—Revised to indicate that where a design patent application claims benefit under <a href="#">35 U.S.C. 120</a> to an intermediate nonprovisional utility patent application that directly claims the benefit of a provisional application, the design patent application cannot claim the benefit of the filing date of the provisional application.</p> <p>—Revised form paragraph 15.74.01 by deleting the last sentence.</p>
<a href="#">1504.30</a>	<p>—Revised to make minor non-substantive changes for clarity.</p>
<a href="#">1505</a>	<p>—Title revised and section rewritten to update <a href="#">35 U.S.C. 173</a> and add a discussion of design patent term both before and after implementation of the Hague Agreement.</p>

**CHAPTER 1800:**

<i>Passim</i>	—Business unit name change: Office of PCT Legal Administration (OPCTLA) changed to International Patent Legal Administration (IPLA).
<a href="#">1801</a>	—Subsection III updated to add the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority (ISA) available to nationals and residents of the United States.
<a href="#">1810</a>	—Edited 37 CFR 1.431(b)(1) and 37 CFR 1.431(c)(1)(ii) to reflect changes published at 58 FR 4344 (January 14, 1993) and 68 FR 59887 (October 20, 2003), respectively.
<a href="#">1812</a>	—Revised to remove a reference to the PCT-SAFE website and to include a cross-reference to <a href="#">MPEP § 1821</a> for information about using a zip file created using WIPO's ePCT system.
<a href="#">1820</a>	—Revised to indicate that pursuant to <a href="#">37 CFR 1.34</a> , a patent practitioner acting in a representative capacity must set forth his or her registration number on submitted papers. —Revised to indicate that pursuant to <a href="#">37 CFR 1.4(d)(2)(ii)</a> , a patent practitioner using an S-signature must supply his or her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature.
<a href="#">1821</a>	—Revised to include information about using WIPO's ePCT system for preparation of the PCT Request, including a recommendation that users contact the Bureau of Industry and Security (BIS), the Directorate of Defense Trade Controls (DDTC), or the National Nuclear Security Administration (NNSA) for appropriate clearance. A foreign filing license from the USPTO does not authorize the export of subject matter into ePCT for generating a PCT Request for filing with the RO/US.
<a href="#">1825</a>	—Revised to include a cross-reference to <a href="#">Administrative Instructions Section 311</a> and indicate that where one or more sheets are added, each sheet shall be identified by the number of the preceding sheet followed by a slant and then by another Arabic numeral such that the additional sheets are numbered consecutively, starting always with number one for the first sheet added after an unchanged sheet (e.g., 10/1, 15/1, 15/2, 15/3, etc.).
<a href="#">1826</a>	—"Gist" changed to "Summary."
<a href="#">1828.01</a>	—Revised to include a discussion of <a href="#">PCT Rule 26 bis.3(h- bis)</a> , which became effective on July 1, 2016 and applies to any international application whose international filing date is on or after July 1, 2016.
<a href="#">1834</a>	—Revised to replace "date of deposit with the United States Postal Service as shown on the 'date-in'" with "'date accepted' indicated" because the United States Postal Service mailing label now has a "date accepted" field instead of a "date-in" field.
<a href="#">1834.02</a>	—Section title and subsection II revised to include a discussion of excuse of delay when there is a general unavailability of electronic communications services.
<a href="#">1840</a>	—Subsection III updated to include the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority (ISA) available to applicants who are nationals or residents of the United States.
<a href="#">1840.02</a>	—Updated link to Korean Intellectual Property Office (KIPO) website.
<a href="#">1840.05</a>	—Revised to reflect a revised arrangement between the USPTO and the Israel Patent Office (ILPO) that became effective on April 10, 2016. The ILPO removed a former restriction and will now act as an ISA for applications having one or more claims directed to the field of business methods. Additionally, the ILPO has increased the maximum number of applications it will accept from 75 per fiscal quarter to 100 per fiscal quarter.
<a href="#">1840.07</a>	—New section added to discuss the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority for applicants who are U.S. nationals or residents.

<a href="#">1842</a>	—Subsection V updated to reflect a change to <a href="#">PCT Rule 45 bis</a> . For international applications in which the 19-month time limit for filing a supplementary search request had not expired as of July 1, 2017, the time limit is 22 months instead of 19 months.
<a href="#">1850</a>	—Revised subsection V to add JPO and IPOS to the list of International Searching Authorities to which additional search fees are payable directly. —In subsection IX, form paragraph 18.05, "process of use" was changed to "a process of use" for consistency with 37 CFR 1.475(b)(2).
<a href="#">1857</a>	—Revised to include new subsection II discussing information omitted from international publication or from public access because: (i) the information does not obviously serve the purpose of informing the public about the international application; (ii) publication of the information would clearly prejudice the personal or economic interests of any person; and (iii) there is no prevailing public interest to have access to that information. The receiving Office, the International Searching Authority, the Authority specified for supplemental search or the International Preliminary Examining Authority shall not provide access to any information in respect of which it has been notified by the International Bureau that the information has been omitted from publication or from public access.
<a href="#">1860</a>	—In subsection I, added IPOS to the list of International Searching Authorities for which the United States International Preliminary Examining Authority will treat any written opinion as the first written opinion of the International Preliminary Examining Authority.
<a href="#">1865</a>	—Revised to indicate U.S. residents and nationals may choose to have the international preliminary examination done by the IPOS if the IPOS served as the ISA.
<a href="#">1893.01(a)(4)</a>	—New section added discussing claim amendments filed with the U.S. Designated or Elected (i.e., national stage) Office.
<a href="#">1893.03(a)</a>	—Updated name of "Office of PCT Legal Administration" to "International Patent Legal Administration."
<a href="#">1893.03(b)</a>	—Revised to indicate that a request to change the applicant under <a href="#">37 CFR 1.46(c)(2)</a> must include an ADS specifying the corrected applicant and a statement under <a href="#">37 CFR 3.73</a> . Also revised to indicate the <a href="#">37 CFR 3.73</a> statement must be furnished before or concurrently with the ADS specifying the corrected applicant.
<a href="#">1893.03(d)</a>	—In form paragraph 18.18, "process of use" was changed to "a process of use" for consistency with 37 CFR 1.475(b)(2).
<a href="#">1893.03(e)</a>	—Updated name of "Office of PCT Legal Administration" to "International Patent Legal Administration."
<a href="#">1895.01</a>	—Updated name of "Office of PCT Legal Administration" to "International Patent Legal Administration."

**CHAPTER 2000:**

<a href="#">2000.01</a>	<p>—Updated to generally reflect duty of disclosure owed to the Office by individuals associated with filing and prosecution of any application.</p> <p>—Added text explaining aspects of the duty to disclose in accordance with the America Invents Act (AIA).</p> <p>—Added text explaining the split in how materiality may be considered in the courts and under current Office guidance.</p>
<a href="#">2001</a>	— Revised to update <a href="#">37 CFR 1.56</a> defining the duty to disclose information to the Office.
<a href="#">2001.01</a>	—Revised to update <a href="#">37 CFR 1.56(c)</a> and the discussion regarding the individuals who have a duty of disclosure before the Office.
<a href="#">2001.03</a>	Updated the name of the Patent Trial and Appeal Board.
<a href="#">2001.04</a>	<p>—Deleted text discussing the 1992 amendment to <a href="#">37 CFR 1.56</a>.</p> <p>—Updated the discussion of individuals' duty of candor and good faith when interacting with the Office. Revised to include litigation statements among the information that may be considered material to patentability. Revised to include discussion of <a href="#">37 CFR 1.555</a>, which provides for the duty of disclosure in reexamination proceedings where a substantial new question of patentability arises. Revised to include cross-references to materiality discussions in the context of supplemental examination and <i>ex parte</i> reexamination.</p>
<a href="#">2001.05</a>	—Revised to delete references to a theoretical possibility.
<a href="#">2001.06</a>	—Revised to include post-grant proceedings among the sources by which an individual may become aware of material information under <a href="#">37 CFR 1.56</a> .
<a href="#">2001.06(b)</a>	<p>—Revised to indicate that in some circumstances individuals covered by <a href="#">37 CFR 1.56</a> may need to provide the identification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee in order to comply with their duty of disclosure.</p> <p>—Revised to include citation to <i>Regeneron Pharm., Inc. v. Merus B.V.</i>, 144 F. Supp. 3d 530 (S.D.N.Y. 2015) and to clarify an example of other applications material to patentability that must be brought to the attention of examiners.</p> <p>—Revised to add cross-reference to example J in <a href="#">MPEP § 719.05</a>, subsection II.A, regarding review and treatment of prior art cited in a related application.</p>
<a href="#">2001.06(c)</a>	—Revised section title to "Information From Related Litigation and/or Trial Proceeding" and revised text to include discussion of trial proceedings, which may yield information considered material to pending related patent applications.
<a href="#">2001.06(d)</a>	—Revised to delete reference to 37 CFR 1.607(c) and replace with <a href="#">37 CFR 41.202(a)</a> and to make minor grammatical changes.
<a href="#">2002.02</a>	—Revised to correct text of <a href="#">37 CFR 1.4(b)</a> to remove instances of "trademark registration file".
<a href="#">2003</a>	—Revised to add <a href="#">37 CFR 1.97</a> and a discussion of the timing of filing an information disclosure statement.
<a href="#">2003.01</a>	<p>—Title of subsection I revised to "By Citations of Prior Art and Written Statements Under 37 CFR 1.501". Subsection I revised to clarify the discussion of filings under <a href="#">37 CFR 1.501</a>.</p> <p>—Title of subsection II revised to "By <i>Ex Parte</i> Reexamination". Subsection II revised to delete information regarding <i>inter partes</i> reexamination.</p> <p>—Added new subsection III entitled "By Supplemental Examination" which discusses consideration of prior art submitted in a patent owner request for supplemental examination and cross-references <a href="#">MPEP Chapter 2800</a>.</p>
<a href="#">2004</a>	—Updated to provide best practices for avoiding duty of disclosure problems. Revised to include <i>Apotex v. UCB, Inc.</i> , 763 F.3d 1354, 112 USPQ2d 1081 (Fed. Cir. 2014); <i>Intellect</i>

	<i>Wireless v. HTC Corp.</i> , 732 F. 3d 1339, 108 USPQ2d 1563 (Fed. Cir. 2013); and <i>TransWeb v. 3M</i> , 812 F.3d 1295, 117 USPQ2d 1617 (Fed. Cir. 2016).
<a href="#">2005</a>	—Revised to update cross-reference regarding requirements for information to <a href="#">MPEP §§ 704.10 - 714 et seq.</a> and to include citation of <i>Hyatt v. USPTO</i> , 797 F.3d 1374, 116 USPQ2d 1331 (Fed. Cir. 2015).
<a href="#">2010</a>	—Revised to limit discussion of determination of inequitable conduct and to delete references to <i>In re Harito</i> , 847 F.2d 801, 6 USPQ2d 1930 (Fed. Cir. 1988) and <i>FMC Corp. v. Manitowoc Co.</i> , 835 F.2d 1411, 5 USPQ2d 1112 (Fed. Cir. 1987). —Revised to state that the examiner does not investigate and reject original or reissue applications under <a href="#">37 CFR 1.56</a> and that generally the examiner will not comment upon duty of disclosure issues which are brought to the attention of the Office. Further revised to delete discussion of lack of deceptive intent in reissue applications. —Revised to state that issues of fraud and/or inequitable conduct in an interference proceeding before the Board may be considered if there is a showing of good cause.
<a href="#">2011</a>	—Added new section to provide guidance on correction of errors in an application.
<a href="#">2012</a>	—Added Editor Note explaining that this section is only applicable to reissue applications filed before September 16, 2012. —Added and updated content previously in MPEP § 2022.05 and added cross-reference to <a href="#">MPEP § 1414.02</a> . —Replaced final paragraph with a cross-reference to <a href="#">MPEP § 1448</a> for information pertaining to the examination of a reissue application when there is an admission or judicial determination of fraud, inequitable conduct or violation of the duty of disclosure.
<a href="#">2012.01</a>	—Added Editor Note explaining that this section is only applicable to reissue applications filed before September 16, 2012.
<a href="#">2013</a>	—Revised to indicate that protests filed under <a href="#">37 CFR 1.291</a> with information indicating the presence of fraud, inequitable conduct, or violation of the duty of disclosure will be entered in the application file generally without comment on the inequitable conduct issues raised.
<a href="#">2014</a>	—Added text of <a href="#">37 CFR 1.555(a) and (c)</a> . —Revised guidance pertaining to the duty of disclosure in reexamination ( <i>ex parte</i> and <i>inter partes</i> ) proceedings for consistency with the language of <a href="#">37 CFR 1.555</a> . —Added guidance pertaining to the duty of disclosure in supplemental examination.
<a href="#">2016</a>	—Revised to add a citation to <i>Therasense Inc. v. Becton Dickinson and Co.</i> , 649 F.3d 1276, 99 USPQ2d 1065 (Fed. Cir. 2011).
<a href="#">2022.05</a>	—Section reserved. Previous content moved to <a href="#">MPEP § 2012</a> and updated.

**CHAPTER 2100:**

<a href="#">2103</a>	<p>—Replaced "USPTO personnel" with "examiners" and removed references to <a href="#">pre-AIA 35 U.S.C. 112</a>, throughout.</p> <p>—In Subsection I.C, revised the text to clarify that claims are given their broadest reasonable interpretation in view of the specification and terms are given their plain meaning as understood by one having ordinary skill in the art. Added cross-reference to discussion of plain meaning in <a href="#">MPEP § 2111.01</a>. Added statements of purpose or intended use in the preamble, contingent limitations, printed matter and terms with associated functional language to the listing of types of claim language that may raise a question as to its limiting effect. Added cross-reference to discussions concerning claim interpretation in <a href="#">MPEP §§ 2111.02 – 2111.05</a>. Deleted citation of <i>Kemco Sales, Inc. v. Control Papers Company, Inc.</i> Added citation to <i>In re Aoyama</i>, 656 F.3d 1293, 99 USPQ2d 1936 (Fed. Cir. 2011).</p> <p>—In subsection II, replaced discussion of the examiner search with a reference to <a href="#">MPEP §§ 904 - 904.03</a>.</p> <p>—In subsection IV.A, replaced "'means' limitation" with "limitation that invokes <a href="#">35 U.S.C. 112(f)</a>".</p> <p>—In subsection V, added cross reference to <a href="#">MPEP §§ 2150 - 2159</a> for discussion on post-AIA application of prior art. Added clarification that the test for obviousness under <a href="#">35 U.S.C. 103</a> is whether the invention would have been obvious to one of ordinary skill in the art.</p> <p>—In subsection III.A, substantially revised to limit the discussion to an overview of the basic requirements of <a href="#">35 U.S.C. 101</a>. Moved portions of previous text to <a href="#">MPEP § 2106 et seq.</a></p>
<a href="#">2104</a>	<p>—Revised to add a cross reference to <a href="#">MPEP § 2106</a>. Further revised for consistency with current Office guidance on <a href="#">35 U.S.C. 101</a>.</p>
<a href="#">2105</a>	<p>—Revised title to read "Patent Eligible Subject Matter - Living Subject Matter".</p> <p>—Subsection I revised to include background information concerning the patent eligibility of living subject matter.</p> <p>—Revised title of subsection II, to read "Living Subject Matter May be Patent Eligible".</p> <p>—In subsection II.A, revised discussion of <i>Diamond v. Chakrabarty</i>, 447 U.S. 303, 206 USPQ 193 (1980) for consistency with current <a href="#">35 U.S.C. 101</a> guidelines. Clarified discussion of <i>Ex parte Allen</i>, 2 USPQ2d 1425 (Bd. Pat. App. &amp; Inter. 1987) by adding "non-naturally occurring" prior to "polyploid Pacific coast oyster." Removed discussion of the Plant Patent Act of 1930.</p> <p>—In subsection II.B, revised discussion of <i>Chakrabarty</i> and added a citation to <i>Association for Molecular Pathology v. Myriad Genetics, Inc.</i>, 569 U.S. ___, 133 S. Ct. 2107, 106 USPQ2d 1972 (2013). Removed discussion of <i>Seed Co. v. Kalo Inoculant</i>, 333 U.S. 127, 76 USPQ 280 (1948). Added cross references to <a href="#">MPEP §§ 2106.04</a>, <a href="#">2106.04(b)</a> and <a href="#">2106.04(c)</a>.</p>
<a href="#">2106</a>	<p>—Rewritten to reflect current Office guidance on subject matter eligibility.</p>
<a href="#">2106.03</a>	<p>—New section discussing the four categories of statutory subject matter under <a href="#">35 U.S.C. 101</a>. Contains text from the 07.2015 revision of MPEP § 2106, subsection I.</p>
<a href="#">2106.04</a>	<p>—New section directed to determining whether a claim is directed to a judicial exception, under <a href="#">35 U.S.C. 101</a>. Contains text from the 07.2015 revision of MPEP § 2106, subsection II.</p>
<a href="#">2106.04(a)</a>	<p>—New section including guidance on abstract ideas under <a href="#">35 U.S.C. 101</a>.</p>
<a href="#">2106.04(a)(1)</a>	<p>—New section directed to examples of claims that are not directed to abstract ideas.</p>
<a href="#">2106.04(a)(2)</a>	<p>—New section directed to examples of concepts the courts have identified as abstract ideas.</p>



<a href="#">2106.04(b)</a>	—New section including guidance on laws of nature, natural phenomena, and products of nature under <a href="#">35 U.S.C. 101</a> . Contains text from the 07.2015 revision of MPEP § 2106, subsection I.
<a href="#">2106.04(c)</a>	—New section discussing the "markedly different characteristic" analysis of the current Office guidance under <a href="#">35 U.S.C. 101</a> .
<a href="#">2106.05</a>	—New section discussing determining if a claim amounts to "significantly more" than an abstract idea, law of nature or natural phenomena under <a href="#">35 U.S.C. 101</a> .
<a href="#">2106.05(a)</a>	—New section discussing improvements to the functioning of a computer or to another technology or technical field, as it relates to subject matter eligibility.
<a href="#">2106.05(b)</a>	—New section discussing determining if a claimed invention applies a "particular machine" as it relates to subject matter eligibility.
<a href="#">2106.05(c)</a>	—New section discussing determining if a claimed invention applies a "particular transformation" as it relates to subject matter eligibility.
<a href="#">2106.05(d)</a>	—New section discussing determining whether a claim recites "significantly more" or whether the additional element(s) are well-understood, routine, and conventional activity, as it relates to subject matter eligibility.
<a href="#">2106.05(e)</a>	—New section discussing "other meaningful limitations" as it relates to subject matter eligibility.
<a href="#">2106.05(f)</a>	—New section discussing patent claims which include only instructions to "apply" a judicial exception, as it related to subject matter eligibility.
<a href="#">2106.05(g)</a>	—New section discussing insignificant extra-solution activities, as it related to subject matter eligibility.
<a href="#">2106.05(h)</a>	—New section discussing field of use and technological environment as it relates to subject matter eligibility.
<a href="#">2106.06</a>	—New section discussing current guidance on the "Streamlined Analysis" of claims under the Office's subject matter eligibility guidelines.
<a href="#">2106.06(a)</a>	—New section discussing when eligibility is self-evident under <a href="#">35 U.S.C. 101</a> .
<a href="#">2106.06(b)</a>	—New section discussing when a claimed invention is a clear improvement to a technology or to computer functionality and when application of the full eligibility analysis may not be required.
<a href="#">2106.07</a>	—New section discussing guidance to examiners on formulating and supporting rejections for lack of subject matter eligibility.
<a href="#">2106.07(a)</a>	—New section relating to formulating a rejection for lack of subject matter eligibility including exemplary explanations.
<a href="#">2106.07(b)</a>	—New section discussing guidance on evaluating an applicant's response to a rejection based on lack of subject matter eligibility.
<a href="#">2106.07(c)</a>	—New section discussing guidance on clarifying the record, as it relates to subject matter eligibility.
<a href="#">2111.01</a>	—In subsection IV.B, added the USPQ reporter citation to the reference to <i>SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.</i>
<a href="#">2111.03</a>	—Added subsection headings "I. COMPRISING", "II. CONSISTING OF", and "III. CONSISTING ESSENTIALLY OF" and numbered the pre-existing heading as "IV." —In subsection II, added a citation to and discussion of <i>Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.</i> , 831 F.3d 1350, 119 USPQ2d 1773 (Fed. Cir. 2016) and <i>Abbott Laboratories v. Baxter Pharmaceutical Products Inc.</i> , 334 F.3d 1274, 67 USPQ2d 1191 (Fed. Cir. 2003).
<a href="#">2111.04</a>	—Revised section heading to include contingent clauses.

	<p>—Added subsection heading "I. 'ADAPTED TO,' ADAPTED FOR,' 'WHEREIN,' AND 'WHEREBY'".</p> <p>—Added new subsection II to discuss the broadest reasonable interpretation of contingent limitations.</p>
<a href="#">2111.05</a>	<p>—Revised the first paragraph to add a citation to and discussion of <i>In re DiStefano</i>, 808 F.3d 845, 117 USPQ2d 1267 (Fed. Cir. 2015).</p> <p>—In subsection I.B, expanded discussion of <i>In re Bryan</i> and updated the citation to reference the Fed. App'x reporter.</p> <p>—In subsection III, added "to" after "directed" in the first sentence of the second paragraph.</p>
<a href="#">2113</a>	—In subsection I, added a citation to <i>Purdue Pharma v. Epic Pharma</i> , 811 F.3d 1345, 117 USPQ2d 1733 (Fed. Cir. 2016).
<a href="#">2117</a>	—New section added to provide an overview of Markush claims, which are claims that recite a closed list of alternatively usable members. Includes cross-references to <a href="#">MPEP § 706.03(y)</a> for guidelines regarding the determination of whether a Markush grouping is improper; <a href="#">MPEP § 2111.03</a> and <a href="#">MPEP § 2173.05(h)</a> for discussions of when a Markush grouping may be indefinite under <a href="#">35 U.S.C. 112(b)</a> ; and <a href="#">MPEP § 803.02</a> for information pertaining to the election, search, and examination of Markush claims.
<a href="#">2121</a>	—In subsection I, added a citation to and quote from <i>In re Antor Media Corp.</i> , 689 F.3d 1282, 103 USPQ2d 1555 (Fed. Cir. 2012). Added a citation to and explanation of <i>In re Morsa</i> , 713 F.3d 104, 106 USPQ2d 1327 (Fed. Cir. 2013). Added a cross reference to <a href="#">MPEP § 716.07</a> .
<a href="#">2121.02</a>	—In subsection II, corrected the year to "1973" in the citation to <i>In re Wiggins</i> .
<a href="#">2122</a>	—Corrected the volume number to 81 USPQ2d in the citation to <i>Impax Labs. Inc. v. Aventis Pharm. Inc.</i>
<a href="#">2126</a>	—In subsection II, corrected the page number to 1785 in the citation to <i>In re Kathawala</i> .
<a href="#">2128</a>	—In subsection II.A, added the parenthetical explanation "(e.g., discussion groups, forums, digital videos, and social media posts)" following "Internet publication" in the first sentence. Added a citation to and explanation of <i>Suffolk Tech v. AOL and Google</i> , 752 F.3d 1358, 110 USPQ2d 2034 (Fed. Cir. 2014).
<a href="#">2131</a>	—Revised the first paragraph to clarify that to reject a claim as anticipated, the reference's disclosure must teach every element required by the claim under its broadest reasonable interpretation and to add a cross reference to <a href="#">MPEP § 2114</a> , subsections II and IV.
<a href="#">2131.02</a>	—In subsection III, added citation to and discussion of <i>Kennametal, Inc. v. Ingersoll Cutting Tool Co.</i> , 780 F.3d 1376, 114 USPQ2d 1250 (Fed. Cir. 2015); also corrected case name of <i>Osram Sylvania Inc. v. American Induction Tech. Inc.</i>
<a href="#">2131.03</a>	—In subsection II, deleted "APPROACHING" from the subsection heading.
<a href="#">2132.01</a>	—Revised to change "applicant's" to "inventor's or at least one joint inventor's" (and similar changes) because effective September 16, 2012, the term "inventor(s)" is no longer synonymous with "applicant." <a href="#">37 CFR 1.42</a> defines an "applicant" as the inventor or all of the joint inventors, or the person applying for the patent (e.g., assignee) for patent applications filed on or after September 16, 2012.
<a href="#">2133.03(a)</a>	—In subsection II.C, added the Federal reporter citation for <i>Lockwood v. American Airlines, Inc.</i>
<a href="#">2133.03(b)</a>	—In subsections I and I.D, added a citation to and explanation of <i>Medicines Co. v. Hospira, Inc.</i> , 827 F.3d 1363 119 USPQ2d 1329 (Fed. Cir. 2016) ( <i>en banc</i> ).
<a href="#">2133.03(e)(1)</a>	—In subsection II, added the Federal reporter citation for <i>Amphenol Corp. v. Gen'l Time Corp.</i> and corrected the citation to <i>Akron Brass Co. v. Elkhart Brass Mfg., Inc.</i>
<a href="#">2133.03(e)(7)</a>	—Corrected the year to 1958 in the citation for <i>Watson v. Allen</i> .

<a href="#">2136.02</a>	—In subsection II, added citation to and explanation of <i>In re Klesper</i> , 397 F.2d 882, 158 USPQ 256 (CCPA 1968) and a cross reference to <a href="#">MPEP § 901.02</a> . Added a new paragraph regarding where a U.S. patent claims benefit to a provisional application and a cross reference to <a href="#">MPEP § 2136.03</a> , subsection III.
<a href="#">2136.03</a>	—In subsection II.A, deleted "priority to" before "an earlier-filed U.S. provisional application." —In subsection III, changed "PRIORITY FROM" to "BENEFIT OF" in the subsection heading. Added citation to and explanation of <i>Dynamic Drinkware, LLC, v. National Graphics, Inc.</i> , 800 F.3d 1375, 116 USPQ2d 1045 (Fed. Cir. 2015). —In subsection IV, revised the subsection heading to "BENEFIT OF NONPROVISIONAL APPLICATION UNDER 35 U.S.C. 120". Changed "Child" to "Continuing Application" in the heading starting with "Filing Date of..." In the first sentence added a parenthetical explanation following "prior nonprovisional application."
<a href="#">2136.04</a>	—In subsection II, added the Supreme Court reporter in the citation to <i>Milburn v. Davis-Bournonville</i> .
<a href="#">2136.05</a>	—Revised to change "applicant's" to "inventor's or at least one joint inventor's" (and similar changes) because effective September 16, 2012, the term "inventor(s)" is no longer synonymous with "applicant." <a href="#">37 CFR 1.42</a> defines an "applicant" as the inventor or all of the joint inventors, or the person applying for the patent (e.g., assignee) for patent applications filed on or after September 16, 2012. —In subsection I, corrected the page number in the Federal reporter in the citation to <i>In re Bartfeld</i> .
<a href="#">2137</a>	— Revised to change "applicant's" to "inventor's or at least one joint inventor's" (and similar changes) because effective September 16, 2012, the term "inventor(s)" is no longer synonymous with "applicant." <a href="#">37 CFR 1.42</a> defines an "applicant" as the inventor or all of the joint inventors, or the person applying for the patent (e.g., assignee) for patent applications filed on or after September 16, 2012.
<a href="#">2138</a>	—Corrected the year in the citation to <i>In re Zletz</i> .
<a href="#">2138.01</a>	—In subsection I, made clarifying changes in light of the AIA statutory changes by, e.g., adding "in certain applications" after "first to file system", "in some instances" after "to obtain a patent" and rewriting the description of the inventorship requirements in the last paragraph.
<a href="#">2138.04</a>	—Corrected the year in the citation for <i>Townsend v. Smith</i> . —In subsection III, corrected the citation to <i>Amgen, Inc. v. Chugai Pharmaceutical Co.</i>
<a href="#">2138.05</a>	—In subsection VI, corrected the citation to <i>Meitzner v. Corte</i> by adding "(CCPA 1976)." —In subsection VII, corrected the volume number for the Federal reporter in the citation to <i>Rey-Bellet v. Engelhardt</i> .
<a href="#">2138.06</a>	—In subsection II, added a new first paragraph that adds a quotation from <i>Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.</i> , 841 F.3d 1004, 120 USPQ2d 1605 (Fed. Cir. 2016). Added a new last paragraph that discusses and further quotes from <i>Perfect Surgical Techniques, Inc.</i> —In subsection IV, corrected the volume number in the Federal reporter in the citation to <i>Bey v. Kollonitsch</i> and added a quotation from <i>Perfect Surgical Techniques, Inc.</i>
<a href="#">2141</a>	—Added a citation to and quotation from <i>Arendi v. Apple</i> , 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016). —In subsection V, corrected the volume number for the Federal reporter in the citation for <i>In re Eli Lilly &amp; Co.</i>
<a href="#">2141.01(a)</a>	—In subsection I, corrected "USPQ2" to "USPQ2d" in the citation to <i>In re Clay</i> .

<a href="#">2141.02</a>	<p>—In the first paragraph, added a cross reference to <a href="#">MPEP § 2143.03</a> for examples of types of claim language that may raise a question as to its limiting effect.</p> <p>—In subsection V, corrected citation to <i>In re Rijckaert</i>.</p> <p>—In subsection VI, added a citation to and quotation from <i>Allied Erecting v. Genesis Attachments</i>, 825 F.3d 1373, 119 USPQ2d 1132 (Fed. Cir. 2016).</p>
<a href="#">2143</a>	<p>—In subsection I.D, added a new example 3 pertaining to <i>In re Urbanski</i>, 809 F.3d 1237, 117 USPQ2d 1499 (Fed. Cir. 2016).</p> <p>—In subsection I.E, in example 9, added a citation to and explanation of <i>Arendi v. Apple</i>, 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016).</p>
<a href="#">2143.01</a>	<p>—In subsection I, added a citation to <i>In re Urbanski</i>, 809 F.3d 1237, 117 USPQ2d 1499 (Fed. Cir. 2016).</p> <p>—In subsection V, added a citation to and explanation of <i>Urbanski</i> and a citation to and explanation of <i>Allied Erecting v. Genesis Attachments</i>, 825 F.3d 1373, 119 USPQ2d 1132 (Fed. Cir. 2016).</p> <p>—In subsection VI, revised to clarify the parenthetical discussion of <i>In re Ratti</i>.</p>
<a href="#">2143.03</a>	<p>—After the first paragraph, added text discussing proper claim construction and the determination of whether particular language is a limitation in a claim.</p>
<a href="#">2144.03</a>	<p>—In subsection A, added a citation to and explanation of <i>Arendi v. Apple</i>, 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016).</p>
<a href="#">2144.04</a>	<p>—In subsection VII, added a citation to and explanation of <i>Purdue Pharma v. Epic Pharma</i>, 811 F.3d 1345, 117 USPQ2d 1733 (Fed. Cir. 2016).</p>
<a href="#">2144.05</a>	<p>—In subsection I, added the USPQ citation for <i>Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.</i></p> <p>—In subsection II.B, corrected "personal" to "person" in the last sentence.</p> <p>—In subsection III.A, revised "change" to "range" in the subsection heading and in the first sentence. Added USPQ citation for <i>In re Scherl</i>.</p>
<a href="#">2144.09</a>	<p>—In subsections I, III, and VII, corrected the year to 1990 in the citation to <i>In re Dillon</i>.</p>
<a href="#">2151</a>	<p>—In the last paragraph, added <a href="#">35 U.S.C. 119</a> and <a href="#">386</a> to "<a href="#">35 U.S.C. 120</a>, <a href="#">121</a>, or <a href="#">365</a>" for an earlier application that ever contained a claimed invention having an effective filing date that is on or after March 16, 2013.</p>
<a href="#">2152.01</a>	<p>—In the second paragraph, added <a href="#">35 U.S.C. 119</a> and <a href="#">386</a> to "<a href="#">35 U.S.C. 120</a>, <a href="#">121</a>, or <a href="#">365</a>".</p>
<a href="#">2152.02</a>	<p>—Corrected cross-references to MPEP subsections discussing each type of prior art document and activity that might preclude patentability under AIA <a href="#">35 U.S.C. 102(a)(1)</a>.</p>
<a href="#">2154.02(b)</a>	<p>—In the paragraph beginning with "In addition, if subject matter...", corrected the reference from <a href="#">35 U.S.C. 102(b)(1)(B)</a> to <a href="#">35 U.S.C. 102(b)(2)(B)</a>.</p>
<a href="#">2158</a>	<p>—Updated the website address for the KSR training materials.</p>
<a href="#">2161.01</a>	<p>—Added "Computer Implemented Inventions" to the section heading.</p> <p>—In subsection I, in the first paragraph, added "at the time of filing" at the end of the second and third sentences, changed "and show" to "in a way that shows" in the third sentence, and moved "as of the filing date of the application relied on" to after "later claimed" in the fourth sentence. Added a new fourth paragraph with revised text discussing <i>LizardTech, Inc. v. Earth Resource Mapping, Inc.</i>, which uses similar language in <a href="#">MPEP § 2163</a>, subsection II.A.3(a)(ii). In the fifth paragraph, revised text to more closely align the text with the August 2015 training slides for rejections under <a href="#">35 U.S.C. 112(a)</a>. In the sixth paragraph, deleted the text and citation to <i>Fonar Corp. v. General Elec. Co.</i> and inserted new text at the end to state what the critical inquiry is. In the following paragraph, revised text stating it is not enough that one skilled in the art could write a program to achieve the claimed function; added a citation to and explanation of <i>Vasudevan Software, Inc. v. MicroStrategy, Inc.</i>, 782</p>

	<p>F.3d 671, 114 USPQ2d 1349 (Fed. Cir. 2015); deleted the phrase "including how to program the disclosed computer to perform the claimed function"; and changed the reference to <a href="#">MPEP § 2161.01</a> to <a href="#">MPEP § 2162</a>.</p> <p>— In subsection II, in the second paragraph, moved the phrase "at the time the application was filed" to the end of the second sentence.</p> <p>— In subsection III, in the third paragraph, modified text regarding functional claim language to make it clear that that functional language at issue does not invoke <a href="#">35 U.S.C. 112(f)</a> and clarify text regarding potential enablement concerns prior to the citation to <i>In re Swinehart</i>.</p>
<p><a href="#">2162</a></p>	<p>—Revised to clarify that to comply with the written description requirement, a patent application must disclose sufficient information to demonstrate that the inventor had possession of the invention at the time of filing.</p>
<p><a href="#">2163</a></p>	<p>—Throughout the section, minor editorial changes have been made to improve readability.</p> <p>—In the introductory text of subsection I, revised the first paragraph to indicate that an objective of the written description requirement is to convey to the public what the applicant claims as the invention; revised the second paragraph to delete references to viewpoints in early court opinions that were rejected and to clarify that while a satisfactory description may be found in the originally-filed claims or any other portion of the originally- filed specification, that does not mean that all originally-filed claims have adequate written support.</p> <p>—In subsection I.A, clarified the example discussing written descriptive support for a claim directed to "A gene comprising SEQ ID NO:1." Also clarified that an invention described solely in terms of a method of making and/or its function may lack written descriptive support where there is no described or art-recognized correlation between the disclosed function and the structure(s) responsible for the function and clarified the associated example.</p> <p>—In subsection I.B, clarified parenthetical text discussing <i>In re Smith</i>. Added more recent article indicating that sequencing errors are a common problem in molecular biology. Revised text to indicate that where an application as filed references a deposit of sequenced material, an amendment to correct the sequence may be permissible where the amendment conforms the sequence information to the compound described in the specification and covered by the claims. Added citation to, and discussion of, <i>Cubist Pharm., Inc. v. Hospira, Inc.</i>, 805 F.3d 1112, 117 USPQ2d 1054 (Fed. Cir. 2015).</p> <p>—Revised subsection II.A to specify that to make a <i>prima facie</i> case, it is necessary to identify the claim limitations that are not adequately supported, and explain why the claim is not fully supported by the disclosure. Further revised to clarify discussion of <i>Hyatt V. Dudas</i> and <i>Stored Value Solutions, Inc. v. Card Activation Techs.</i> and to correct a typographical error in the citation to <i>AbbVie Deutschland GmbH &amp; Co., KG v. Janssen Biotech, Inc.</i></p> <p>—Subsection II.A.2 revised to clarify that disclosure of an element may be critical where those of ordinary skill in the art would require it to understand that applicant was in possession of the invention.</p> <p>—In subsection II.A.3(a), clarified the description of the <i>Lockwood, Eli Lilly, Tronzo v. Biomet</i>, and <i>AbbVie</i> Federal Circuit decisions.</p> <p>—In subsection II.A.3(b), added a citation to and explanation of <i>Yeda Research and Development Co. v. Abbott GMBH &amp; Co.</i>, 837 F.3d 1341, 120 USPQ2d 1299 (Fed. Cir. 2016).</p>
<p><a href="#">2163.07</a></p>	<p>—In subsection I, corrected the spelling of "Schering" and "Amgen" in the citation to and explanation of <i>Schering Corp. v. Amgen, Inc.</i>, 222 F.3d 1347, 55 USPQ2d 1650 (Fed. Cir. 2000).</p> <p>— In subsection II, corrected "Odd" to "Oda" in the citation to <i>In re Oda</i>, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971) and corrected the citation to <i>Ex parte Bondiou</i>.</p>



<a href="#">2163.07(a)</a>	—Added a citation to and explanation of <i>Yeda Research and Development Co. v. Abbott GMBH &amp; Co.</i> , 837 F.3d 1341, 120 USPQ2d 1299 (Fed. Cir. 2016).
<a href="#">2164.01(c)</a>	—Corrected the citation to <i>In re Brana</i> .
<a href="#">2164.04</a>	—In the fourth paragraph, added a citation to and explanation of <i>In re Wands</i> , 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988).
<a href="#">2164.05</a>	—Revised to clarify that evidence submitted to the FDA may be submitted to the Office as evidence of enablement, but is not required. Further revised to clarify that the evidence provided to overcome an enablement rejection need not be absolute, but applicant must present argument and/or evidence that the disclosure would have enabled one of ordinary skill in the art to make and use the claimed invention at the time of filing.
<a href="#">2164.05(a)</a>	—Revised to clarify that information published for the first time after the filing date generally cannot be used to show what was known at the time of filing, and that if a publication demonstrates that those of ordinary skill in the art would find that a particular invention was not enabled years after the filing date, the publication would be evidence that the claimed invention was not possible at the time of filing.
<a href="#">2164.05(b)</a>	—Corrected citation to <i>Ex parte Zechnall</i> .
<a href="#">2164.06(a)</a>	—In subsection I, added the Federal reporter citation for <i>MagSil Corp. v. Hitachi Global Storage Technologies</i> and the USPQ reporter citation for <i>Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.</i> —In subsection II, clarified text discussing <i>In re Argoudelis</i> . Corrected citation to <i>Ex parte Jackson</i> .
<a href="#">2164.06(b)</a>	—Revised discussion of all cited cases (except <i>In re Bundy</i> ) for improved readability.
<a href="#">2164.06(c)</a>	—In subsection II, revised to indicate that, in the context of applications involving computer programs, it is appropriate to challenge the sufficiency of disclosures that fail to include the programmed steps, algorithms or procedures that the computer performs necessary to produce the claimed function. —In subsection III, in the last paragraph, corrected "personal" to "person." —In subsection IV, updated to discuss citation to patent application publications.
<a href="#">2165</a>	—In subsection I, corrected the page number in the federal reporter citation to <i>Union Carbide Corp. v. Borg-Warner</i> .
<a href="#">2165.04</a>	—In subsection I, added "499 F.Supp 924" to the citation for <i>Honeywell v. Diamond</i> .
<a href="#">2173.01</a>	—In subsection I, added the USPQ reporter citation for <i>In re Yamamoto</i> . Deleted the sentence "Absent claim language ... the broader definition" from the quote from <i>In re Bigio</i> . Added two new paragraphs at the end to discuss that applicant must point out that a term was given a special definition and may not added a special definition or disavowal after the filing date of the application. In subsection II, added the USPQ reporter citation for <i>In re Donaldson Co.</i>
<a href="#">2173.02</a>	—In subsection I, added the USPQ reporter citation for <i>In re Zletz</i> , <i>In re Buszard</i> , and <i>In re Yamamoto</i> . —In subsection II, corrected the citation for <i>In re Larson</i> .
<a href="#">2173.03</a>	—Added the USPQ reporter citation for <i>In re Moore</i> .
<a href="#">2173.05(b)</a>	—In subsection IV, added the USPQ reporter citation for <i>In re Musgrave and DDR Holdings, LLC v. Hotels.com, L.P.</i>
<a href="#">2173.05(e)</a>	—Added the USPQ reporter citation for <i>In re Packard</i> and corrected the citation for <i>In re Larson</i> .
<a href="#">2173.05(g)</a>	—Added the USPQ reporter citation for <i>K-2 Corp. v. Salomon S.A.</i> , <i>Phillips v. AWH Corp.</i> and <i>In re Schreiber</i> .



<a href="#">2173.05(h)</a>	<p>—Subsection I rewritten for consistency with the discussion regarding Markush groups in the <i>Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications "Supplementary Guidelines"</i>, 76 Fed. Reg. 7162, 7166 (Feb. 9, 2011).</p> <p>—Added paragraph explaining that if a Markush grouping requires a material selected from an open list of alternatives (e.g., selected from the group "comprising" or "consisting essentially of" the recited alternatives), the claim should generally be rejected under 35 U.S.C. 112(b) as indefinite because it is unclear what other alternatives are intended to be encompassed by the claim. Added citation to <i>Abbott Laboratories v. Baxter Pharmaceutical Products Inc.</i>, 334 F.3d 1274, 67 USPQ2d 1191 (Fed. Cir. 2003) for suggested language when a Markush group is intended to encompass combinations or mixtures of the alternatives. Moved discussion of the test for the propriety of a Markush grouping to new <a href="#">MPEP § 706.03(y)</a>, and revised that discussion for consistency with the Supplementary Guidelines.</p> <p>—Added citation to and discussion of <i>Eli Lilly &amp; Co. v. Teva Parenteral Meds.</i>, 845 F.3d 1357, 121 USPQ2d 1277 (Fed. Cir. 2017) with regard to double inclusion of alternatives.</p> <p>—Deleted paragraph pertaining to subgenus claims as unnecessary because it is longstanding Office practice that Markush claims are not rejected merely because there are genus claims that encompass the Markush claims.</p> <p>—Information previously in Subsection II pertaining to "or" terminology moved to subsection I because any list of alternatives from which a selection is to be made is considered a Markush group, including those that use "or" terminology.</p> <p>—Subsection III redesignated as subsection II and "or <a href="#">pre-AIA 35 U.S.C. 112</a>, second paragraph," deleted in the last sentence.</p>
<a href="#">2173.05(i)</a>	<p>—Added a citation to and explanation for <i>Inphi Corporation v. Netlist, Inc.</i>, 805 F.3d 1350, 116 USPQ2d 2006 (Fed. Cir. 2015).</p>
<a href="#">2173.05(p)</a>	<p>—In subsection I, added a citation to <i>Purdue Pharma v. Epic Pharma</i>, 811 F.3d 1345, 117 USPQ2d 1733 (Fed. Cir. 2016).</p>
<a href="#">2181</a>	<p>—In subsection I, added the USPQ reporter citation for <i>Greenberg v. Ethicon Endo-Surgery and Caterpillar Inc. v. Detroit Diesel Corp.</i></p> <p>—In subsection II.B, in the second to last paragraph, corrected "<a href="#">35 U.S.C. 112(f)</a>" to "<a href="#">35 U.S.C. 112(b)</a>".</p> <p>—In subsection III, added the USPQ reporter citation for <i>Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.</i></p> <p>—In subsection V, revised the first paragraph by moving the citation to and explanation of <i>In re Hyatt</i> to later in the subsection and removing the reference to <i>Donaldson</i>. Added text to discuss the difference between claims that recite multiple functional limitations and claims that recite a single element in means-plus-function terms and how multiple functional limitations occur in computer-implemented inventions, including an example.</p>
<a href="#">2182</a>	<p>—Added citation to and explanation of <i>In re Spada</i>, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990) and a cross reference to <a href="#">MPEP § 2114</a>, subsection I.</p>
<a href="#">2183</a>	<p>—Corrected the citation to <i>Warner-Jenkinson Co. v. Hilton Davis Chemical Co.</i></p>
<a href="#">2185</a>	<p>—In item (B), deleted the phrase "including how to program the disclosed computer to perform the claimed function" and inserted references to <a href="#">MPEP § 2161.01</a> and <a href="#">MPEP § 2181</a>, subsection IV, in its place.</p> <p>—In item (C), deleted the citations to <i>Biomedino, LLC v. Waters Technology Corp.</i>, 490 F.3d 946, 83 USPQ2d 1118 (Fed. Cir. 2007) and <i>In re Dossel</i>, 115 F.3d 942, 42 USPQ2d 1881 (Fed. Cir. 1997). Added citations to <i>Noah Systems v. Intuit</i>, 675 F.3d 1302, 102 USPQ2d 1410 (Fed. Cir. 2012); <i>In re Aoyama</i>, 656 F.3d 1293, 99 USPQ2d 1936 (Fed. Cir.</p>

2011); and *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 86 USPQ2d 1609 (Fed. Cir. 2008).

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—Corrected the citation to *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*

**CHAPTER 2200:**

<i>Passim</i>	<p>—In subsections with a "[R-08.2017]" revision indicator, revised text, including form paragraphs, to be gender-neutral.</p> <p>—Changed "Certificate of Correction" to "certificate of correction."</p>
<a href="#">2202</a>	—Corrected the reproduction of <a href="#">37 CFR 1.502</a> to be consistent with current language in the regulation by changing "terminated" to "concluded by the issuance and publication of a reexamination certificate."
<a href="#">2206</a>	<p>—Revised section title to include "Submission and" prior to "Handling". Added a new first paragraph stating what mechanism (mail, hand-delivery, or electronic filing) can be used to file a submission under <a href="#">37 CFR 1.501</a> and under what circumstances. For example, the new paragraph explains why submissions under <a href="#">37 CFR 1.501</a> cannot be electronically filed as a follow-on paper because such submissions need to be reviewed for compliance before being entered into the patent file.</p> <p>—In subsection I.A.1, added "and proof of service on the patent owner" in the parenthetical listing and deleted "immediately" before "entered."</p> <p>—In subsection I.A.2, revised text to clarify that a <a href="#">37 CFR 1.501</a> submission must include a proof of service to be proper, and that a proper <a href="#">37 CFR 1.501</a> submission is not entered into the patent file after an order for reexamination was been granted and the reexamination proceeding is pending. Deleted text that permitted alternative procedures if a proof of service is not included with the <a href="#">37 CFR 1.501</a> submission because proof of service is required by <a href="#">37 CFR 1.501(e)</a>.</p> <p>—In subsection II.A, at the end of the first paragraph, added text to explain that if the <a href="#">37 CFR 1.501</a> submission is filed via the electronic filing system, the third party submitter or the patent owner may request to be notified if the submission is improper.</p> <p>—In subsections II.A.1, 2, and 3, deleted the phrase "or satisfactory showing that none of the modes of service set forth in <a href="#">37 CFR 1.248(a)</a> are practicable," because proof of service is required by <a href="#">37 CFR 1.501(e)</a>.</p>
<a href="#">2208</a>	—In the last paragraph, deleted the phrase "or satisfactory showing that none of the modes of service set forth in <a href="#">37 CFR 1.248(a)</a> are practicable" because proof of service is required by <a href="#">37 CFR 1.501(e)</a> .
<a href="#">2210</a>	—Added a new paragraph stating what mechanism (mail, hand-delivery, or electronic filing) can be used to file a request for reexamination and under what circumstances. For example, the new paragraph explains that reexamination requests must be electronically filed as a "new" proceeding and not as a follow-on paper.
<a href="#">2214</a>	—Updated form PTO/SB/57.
<a href="#">2224</a>	—In the second sentence of the paragraph beginning with "Effective July 9, 2007...", added "proper" before "reexamination" and added a cross-reference to <a href="#">MPEP § 2267</a> . These changes were made to clarify that only proper "follow-on" papers are permitted to be electronically filed in a reexamination proceeding.
<a href="#">2227</a>	—In subsection A.2, changed the title of form PTOL-2079 to "Notice of Termination of Preprocessing of <i>Ex Parte</i> Reexamination Request" to reflect its current title.
<a href="#">2242</a>	—In subsections I and II, revised text about issues involving 35 U.S.C. 325(d) to state that examiner must bring such issues to the attention of the appropriate SPRS or the Director of the CRU and that public inquiries about such issues should be referred to OPLA.
<a href="#">2248</a>	—In the paragraph beginning with " <a href="#">37 CFR 1.515(c)</a> applies...", modified text by changing "denying of" to "refusing" and added a new second sentence to clarify that a petition under <a href="#">37 CFR 1.515(c)</a> may be filed to challenge any refusal to reexamine a requested claim or a claim based on a requested basis.

<a href="#">2249</a>	—Deleted "by telephone" and two occurrences of "telephone" because Office personnel may use other means of communication (e.g., email) if proper authorization is of record.
<a href="#">2250</a>	—In subsection II, added "PTAB trial certificate" to the listing of changes made by post-patent proceedings. —In subsection IV, added text that examiners may accept status identifiers even if the identifier used is not one listed in <a href="#">37 CFR 1.530(d)(2)</a> or <a href="#">1.121(c)</a> (three occurrences). In "(E) Amendment of New Claims," added an example of an amendment. In subsection V, item (E), added new text regarding amendments in a pending reexamination proceeding when a PTAB trial certificate has issued. Relabeled former item (E) as a new item (F).
<a href="#">2258</a>	—In subsection III, changed "the claims" to "a claim" so the quoted language corresponds to the current text of <a href="#">35 U.S.C. 305</a> . In subsection III.C, revised form paragraph 22.11 by changing "any claim" to "each and every claim."
<a href="#">2258.01</a>	—In item (B), deleted the first occurrence of the paragraph beginning with "The following guidelines ... with the Portola Packaging decision." The second occurrence of the same paragraph was unchanged.
<a href="#">2258.02</a>	—In subsection I, modified text to include changes made to <a href="#">37 CFR 1.55</a> that requires a petition under <a href="#">37 CFR 1.55(f)</a> or <a href="#">(g)</a> or a petition for an unintentionally delayed priority claim under <a href="#">37 CFR 1.55(e)</a> . Such changes were made in the final rule implementing the Hague Agreement, which was effective May 13, 2015. In item (c) in subsection I.B.1 and 2, changed "an exception in <a href="#">37 CFR 1.55(h), (i), or (j)</a> applies" to "the exception in <a href="#">37 CFR 1.55(h)</a> is applicable" because the exceptions in <a href="#">37 CFR 1.55(i) and (j)</a> would not be applicable in a reexamination proceeding. —In subsection II, modified text to include changes made to <a href="#">37 CFR 1.78</a> that requires a petition for an unintentionally delayed priority claim under <a href="#">37 CFR 1.78(e)</a> . Such changes were made in the final rule implementing the Hague Agreement, which was effective May 13, 2015.
<a href="#">2262</a>	—In the paragraph starting with "Current procedures permits...", changed "telephone" to "contact" because Office personnel may use other means of communication (e.g., email) if proper authorization is of record.
<a href="#">2266.01</a>	—In the paragraph starting with "In the very unusual situation...", revised text to state that notification should first be made by telephone, or by email if authorized and contact could not be made by telephone. Also, the last sentence was revised to state "If the examiner is not successful in contacting the patent owner" instead of "When notification by telephone is not possible." These changes were made because Office personnel may use other means of communication (e.g., email) if proper authorization is of record.
<a href="#">2266.03</a>	—In the paragraph starting with "Any paper for which proof...", deleted "by telephone" because Office personnel may use other means of communication (e.g., email) if proper authorization is of record.
<a href="#">2275</a>	—Added two occurrences of "[sic]" in <a href="#">37 CFR 41.39</a> because the words "of this" are repeated twice in the official version of <a href="#">37 CFR 41.39(b)(1) and (2)</a> . Updated text of <a href="#">37 CFR 41.39(b)(2)</a> to correspond to current rule language. —In the last paragraph, revised text to clarify that after receipt of a compliant reply brief or expiration of the time to file a reply brief, jurisdiction over the appeal passes to the Patent Trial and Appeal Board (Board). The Board may remand the appeal to the examiner to furnish a substitute examiner's answer or the Director may remand the appeal under <a href="#">37 CFR 41.35(c)</a> . Except for these situations, a substitute examiner's answer is not permitted.
<a href="#">2278</a>	—After the first paragraph, added text from <a href="#">MPEP § 1214.06</a> pertaining to treatment of claims after an appeal is decided. The text from <a href="#">MPEP § 1214.06</a> was revised to account for differences in procedures in treating claims in reexamination versus in application prosecution. For example, Examples 3 and 4 in subsection II result in the allowance of dependent claim 2 in a reexamination

	proceeding but in a pending application under examination, dependent claim 2 would be cancelled or require an amendment to make the claim independent.
<a href="#">2280</a>	—In the second to last paragraph, corrected the reference to " <a href="#">37 CFR 1.52(b)</a> " to " <a href="#">37 CFR 1.56(b)</a> " (two occurrences).
<a href="#">2287</a>	—In subsection I, in the paragraph beginning with "The examiner should inspect...", changed " <a href="#">37 CFR 3.73(b)</a> " to " <a href="#">37 CFR 3.73</a> " and added a sentence that if communication could not be made by telephone, the examiner could use email (if authorized) to contact the patent owner. —In subsection II, in the second paragraph, added a sentence that if communication could not be made by telephone, the examiner could use email (if authorized) to contact the patent owner. In the second to last paragraph, changed "reached by telephone" to "contacted" because Office personnel may use other means of communication (e.g., email) if proper authorization is of record.
<a href="#">2288</a>	—In the penultimate paragraph, added a cross reference to <a href="#">MPEP § 1449.01</a> , subsection I.A.

**CHAPTER 2300:**

<i>Passim</i>	<p>—Revised to add "pre-AIA" to references to <a href="#">35 U.S.C. 102(a)</a>, <a href="#">35 U.S.C. 102(e)</a>, <a href="#">35 U.S.C. 102 (g)(1)</a>, <a href="#">35 U.S.C. 104</a>, and <a href="#">35 U.S.C. 154(b)(1)</a>.</p> <p>—Revised to add "pre-AIA" to references <a href="#">35 U.S.C. 135(a)</a> and <a href="#">35 U.S.C. 135(b)</a> as appropriate.</p> <p>—Revised to replace references to "<a href="#">35 U.S.C. 112</a>, first paragraph" with "<a href="#">35 U.S.C. 112(a)</a>" and "<a href="#">35 U.S.C. 112</a>, second paragraph" with "<a href="#">35 U.S.C. 112(b)</a>."</p> <p>—Revised to replace "Interference Practice Specialist" and "IPS" with "Technology Center Practice Specialist" and "TCPS," respectively.</p> <p>—Revised "Board of Patent Appeals and Interferences" to read "Board."</p> <p>—Corrected minor grammatical and typographical errors.</p>
<a href="#">Title and Preliminary Text</a>	<p>—Revised title of chapter to "Interference and Derivation Proceedings."</p> <p>—Added definition of "Board" as used throughout the chapter as the Patent Trial and Appeal Board and its predecessor organizations, the Board of Patent Appeals and Interferences and the separate Board of Appeals and Board of Interferences.</p>
<a href="#">2301</a>	<p>—Revised title of section to "Interference Introduction."</p> <p>—Added a cross-reference to <a href="#">MPEP § 2310 et seq.</a> for discussion of derivation proceedings.</p>
<a href="#">2301.02</a>	—Revised to update <a href="#">37 CFR 41.2</a> , <a href="#">41.200</a> , and <a href="#">37 CFR 41.201</a> .
<a href="#">2301.03</a>	—Revised to include discussion of <i>Tas v. Beachy</i> , 626 Fed. App'x 999, 1001 (Fed. Cir. 2015) (nonprecedential) and <i>Agilent Techs., Inc. v. Affymetrix, Inc.</i> , 567 F.3d 1366, 91 USPQ2d 1161 (Fed. Cir. 2009). Revised to indicate that claims must be construed in light of the application in which it appears for purpose of evaluating whether there is interfering subject matter, unlike when evaluating whether copied claims comply with the written description requirement where the originating disclosure is consulted. Deleted reference to <a href="#">37 CFR 41.200(b)</a> .
<a href="#">2301.04</a>	—New section added to provide guidance on limited applicability of <a href="#">pre-AIA 35 U.S.C. 102(g)</a> to applications filed on or after March 16, 2013.
<a href="#">2302</a>	<p>—Revised to make minor revisions to discussion regarding the Interference Practice Specialist.</p> <p>Revised to add a heading which clarifies that the interference general practices are for those applications subject to <a href="#">pre-AIA 35 U.S.C. 102(g)</a>.</p>
<a href="#">2303</a>	—Revised to include reference to <a href="#">pre-AIA 35 U.S.C. 291</a> in example 1. Revised to indicate that patent term adjustments may be available for patents whose issuance has been delayed for an interference.
<a href="#">2303.01</a>	—Revised to provide additional clarifying information to the examples.
<a href="#">2303.02</a>	—Revised to indicate that any administrative trial ordinarily must be resolved before an interference is suggested. Revised example 2 to clarify that the disclaimer is statutory.
<a href="#">2304.01</a>	—Section reserved.
<a href="#">2304.01(a)</a>	—Revised to reflect current CPC search parlance.
<a href="#">2304.01(b)</a>	—Revised title of subsection III to read "Patent Cooperation Treaty Application Files."
<a href="#">2304.01(d)</a>	—Revised to indicate that interfering claims of applications with either the same assignee or the same inventive entity are "patentably indistinct claims" within the meaning of <a href="#">37 CFR 1.78(f)</a> and that the examiner may require consolidation of such claims into a single application that provides support for the claims.
<a href="#">2304.02(b)</a>	—Added "pre-AIA" before reference to <a href="#">35 U.S.C. 102 (g)(1)</a> .



<a href="#">2304.02(c)</a>	<p>—Revised introductory text to add <i>Tas v. Beachy</i>, 626 Fed. App'x 999 (Fed. Cir. 2015) (nonprecedential) and <i>Hyatt v. Boone</i>, 146 F.3d 1348, 47 USPQ2d 1128 (Fed. Cir. 1998) to the discussion of seeking the benefit of an earlier-filed application.</p> <p>—Revised subsection II to include recitation of <a href="#">pre-AIA 35 U.S.C. 135(b)</a>. Revised to update and clarify discussion of compliance with <a href="#">pre-AIA 35 U.S.C. 135(b)</a> as it pertains to patents in paragraph (b)(1) and published applications in paragraph (b)(2). With regard to patents, updated to indicate that when the requisite relationship between post- and pre-critical date claims is otherwise established, the condition of <a href="#">pre-AIA 35 U.S.C. 135(b)(1)</a> is met and there is no requirement of diligent prosecution. Added citation to <i>In re Commonwealth Scientific</i>, 632 Fed. App'x 1024 (Fed. Cir. 2015) (nonprecedential). With regard to published applications, updated to indicate that in a subsequently filed application relative to an application published under <a href="#">35 U.S.C. 122(b)</a>, if applicant does not appear to have a claim that is for "substantially the same subject matter" prior to one-year after publication, in accordance with <a href="#">pre-AIA 35 U.S.C. 135(b)(2)</a>, an interference will not be declared. Added citation to <i>Loughlin v. Ling</i>, 684 F.3d 1289, 103 USPQ2d 1413 (2012).</p>
<a href="#">2304.02(d)</a>	<p>—Revised to include an excerpt of <a href="#">37 CFR 41.201</a> Definitions.</p> <p>—Revised to indicate that the written description requirement does not demand, as a matter of law, actual examples or an actual reduction to practice, so long as the application or priority application sufficiently described the subject matter to a person skilled in the art. Added citation to <i>Tas v. Beachy</i>, 626 Fed. App'x 999 (Fed. Cir. 2015) (nonprecedential).</p> <p>—Revised to indicate that when an applicant copies a claim from another application or patent, the applicant's claims are construed in view of the originating specification when the other party challenges the sufficiency of written description support. Added citation to <i>Agilent Techs., Inc. v. Affymetrix, Inc.</i>, 567 F.3d 1366, 91 USPQ2d 1161 (Fed. Cir. 2009).</p>
<a href="#">2304.03</a>	<p>—Revised to update <a href="#">37 CFR 41.202</a> and to remove references to <a href="#">37 CFR 1.99</a> (removed and reserved in 77 FR 42150, July 17, 2012, effective Sept. 16, 2012).</p>
<a href="#">2304.04(a)</a>	<p>—Revised to delete reference to "Patent Appeals and Interferences."</p>
<a href="#">2304.04(b)</a>	<p>—Revised Example 3 to delete references to "applicant" and replace them with "application" or "inventor" as appropriate for consistency with changes prompted by the America Invents Act (AIA).</p>
<a href="#">2305 -2309</a>	<p>—No substantive revisions made to these sections. Revised only to add "pre-AIA" as necessary before "35 U.S.C.," correct minor grammatical or typographical errors, and/or change "of Board of Patent Appeals and Interferences (Board)" to "Board."</p>
<a href="#">2310</a>	<p>—New section added to provide overview of derivation proceedings.</p>
<a href="#">2310.01</a>	<p>—New section added to provide statutory basis for derivation proceedings.</p>
<a href="#">2310.02</a>	<p>—New section added to provide text of <a href="#">37 CFR 42.2</a> Definitions, related to trial proceedings (including derivation proceedings) at the Board.</p>
<a href="#">2311</a>	<p>—New section added to provide guidance on consulting with a Technology Center Practice Specialist when an application becomes involved in a derivation proceeding. An example of the notice added to the respondent's application is also provided.</p>
<a href="#">2312</a>	<p>—New section added to explain that the Board may assume jurisdiction of an application in which a petition for derivation is filed before the application is otherwise allowable.</p>
<a href="#">2313</a>	<p>—New section added to provide an overview on status of applications once a derivation proceeding is instituted. Includes text of <a href="#">37 CFR 42.3(a)</a>.</p>

<a href="#">2314</a>	—New section added to indicate that action at the Board during derivation proceedings is beyond the scope of the chapter and directs interested persons to the Board's Patent Trial Practice Guide.
<a href="#">2315</a>	—New section added to provide guidance regarding action on an application after a derivation proceeding has been terminated and jurisdiction returned to the examiner.

**CHAPTER 2500:**

<a href="#">2504</a>	—Added discussion of patent term and patent term adjustment.
<a href="#">2510</a>	—Updated website addresses. —Subsection I revised to indicate that receipts for electronic payments through the Patent Maintenance Storefront are available upon processing and to include discussion of the receipt content. —Subsection III revised to clarify that payment of a maintenance fee sent by facsimile must be faxed to the number indicated on the Maintenance Fee Transmittal Form (SB/45).
<a href="#">2520</a>	—Revised to remove reference to the USPTO Office of Finance and to update the URL for the USPTO Fee Information website.
<a href="#">2522</a>	—Removed references to sending cash by mail to pay a maintenance fee.
<a href="#">2532</a>	—Corrected grammatical error.
<a href="#">2540</a>	—Corrected citation of <i>Rydeen v. Quigg</i> .
<a href="#">2550</a>	—In subsection I, added guidance regarding changing the entity status of a patent at the time of payment of the maintenance fee. —In subsection II, replaced "a non-small entity" with "the undiscounted" fee. —In subsection III, added reference to the Patent Maintenance Fees Storefront.
<a href="#">2570</a>	—Revised to update how to obtain maintenance fee status information from the USPTO maintenance fees website.
<a href="#">2590</a>	—Revised to indicate that pursuant to <a href="#">37 CFR 1.31</a> , as revised effective September 16, 2012, a juristic entity must be represented by a patent practitioner and therefore, unless otherwise specified, all papers submitted on behalf of the juristic entity on or after September 16, 2012 must be signed by a patent practitioner. —Revised to indicate that a decision on petition under <a href="#">37 CFR 1.378</a> may provide that no further reconsideration or review of the matter will be undertaken by the Director of the Office. Further revised to indicate that the maintenance fee paid with a petition under <a href="#">37 CFR 1.378</a> will be refunded when the petition is denied if the decision indicates that no further reconsideration or review will be undertaken, or upon request after the expiration of the time for filing a petition for reconsideration, if none is filed.
<a href="#">2595</a>	—Updated forms.

**CHAPTER 2700**

<a href="#">2720</a>	—Added "date" after "filing" in <a href="#">37 CFR 1.701(d)(1)</a> to make text consistent with current regulatory text.
<a href="#">2733</a>	—Changed "date in" to "date accepted" because the United States Postal Service mailing label now has a "date accepted" field instead of a "date-in" field.
<a href="#">2752</a>	—Updated the reproduction of <a href="#">35 U.S.C. 156(d)(1)</a> and added <a href="#">35 U.S.C. 156(i)</a> to include changes made by the Improving Regulatory Transparency for New Medical Therapies Act, Public Law 114-89, 129 Stat. 700 (November 25, 2015).
<a href="#">2755.02</a>	—Changed "paragraphs" to "paragraph," "regulating" to "regulatory," and "day" to "date" in <a href="#">35 U.S.C. 156(d)(5)</a> to make the text consistent with current statutory text.
<a href="#">2758</a>	—Changed "(e)(i)" to "(e)(1)" in <a href="#">35 U.S.C. 156(c)(4)</a> to make the text consistent with current statutory text. —Changed "environment" to "environmental" in <a href="#">35 U.S.C. 156(g)(6)(B)(ii)</a> to make the text consistent with current statutory text. —Changed "date of enactment" to "date of the enactment" in <a href="#">35 U.S.C. 156(g)(6)(C)</a> to make the text consistent with current statutory text.
<a href="#">2761</a>	—Changed "(e)(i)" to "(e)(1)" in <a href="#">35 U.S.C. 156(c)(4)</a> .

## CHAPTER FPC:

[Chapter FPC](#) provides a consolidated listing of the form paragraphs found in the numbered chapters of the MPEP. The FPC sections within Chapter FPC are organized by form paragraph number, and do not necessarily correspond to the chapters of the MPEP in which the form paragraphs appear. The Subject Matter Index may be consulted to locate the MPEP section(s) wherein a given form paragraph is reproduced. A description of changes to the form paragraphs has been provided within the summary of changes organized by MPEP section number above.