

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

MANUAL OF PATENT EXAMINING PROCEDURE

Ninth Edition, Latest Revision June 2020

Executive Summary

June 2020 Publication of Revision 10.2019

The June 2020 publication of Revision 10.2019 includes the following changes:

Revisions to MPEP [Chapters 100, 200, 300, 400, 500, 600, 700, 800, 900, 1000, 1200, 1300, 1400, 1500, 1700, 1800, 1900, 2000, 2100, 2200, 2300, 2400, 2500, 2600, 2700, 2800](#), and [Chapter FPC](#) (Form Paragraph Book), and updates to the Foreword, Introduction, Subject Matter Index, Appendix II, Appendix L, Appendix R, Appendix AI, and Appendix T.

[Chapter 100](#) was revised to clarify requirements pertaining to foreign filing licenses and to include information previously in [MPEP § 706.03\(s\)](#) pertaining to improper filing without a foreign filing license.

[Chapter 200](#) was revised to correct an error in the reproduction of [35 U.S.C. 111](#) in [MPEP § 201.04](#) and to update the countries and regional offices listed in [MPEP § 213.01](#).

[Chapter 300](#) was amended to clarify policies and procedures regarding assignments; to state that a real party in interest will be listed in the assignee section of the patent but that this does not change who is the applicant; and to add recent case law regarding assignments and transfer of ownership.

[Chapter 400](#) was amended to update general requirements for powers of attorney, including appointment and revocation; add discussion of acting in a representative capacity; update correspondence practice; update guidelines on interviews with practitioners of record and not of record; provide guidance on assignee or obligated assignee filing of patent applications; and provide guidance on representations to the Office within [37 CFR 1.4\(d\)\(4\)](#) and [37 CFR 11.18](#).

[Chapter 500](#) was revised to incorporate the *Updated Legal Framework for Patent Electronic System*, 84 FR 56803 (October 23, 2019); to clarify signature requirements for correspondence filed via the Office electronic filing system; and to update procedures regarding hand-carried papers.

[Chapter 600](#) was modified to add a discussion of the web-based Application Data Sheet (ADS) and to clarify other procedures regarding a corrected ADS; to add examples of when a substitute statement under [35 U.S.C. 115\(d\)](#) may be made and a discussion of who may sign a substitute statement for juristic entities; to delete text regarding [37 CFR 1.79](#) due to its removal in *Eliminating Unnecessary Regulations*, 84 FR 51977 (October 1, 2019); and to clarify certain requirements and procedures regarding information disclosure statements.

[Chapter 700](#) was revised to replace the discussion of rejections based on prior art formerly in sections 706.02 *et seq.* with cross-references to other locations of the MPEP where the guidance now appears. Guidance on rejections not based on prior art was similarly relocated from sections 706.03 *et seq.* and replaced with

cross-references to the locations where it now appears. Guidance was revised to replace “same invention” with language requiring the claims to be either identical or patentably indistinct regarding when it is proper to make a first Office action final. Additional guidance on handling a supplemental reply was added, and guidance for conducting an interference search was updated to indicate the most efficient and effective manner based on the claimed subject matter in the broadest claim should be used.

[Chapter 800](#) was revised to add a new section [MPEP § 804.05](#) that discusses the impact of patent term extension on nonstatutory double patenting and to add recent case law and guidance regarding double patenting and terminal disclaimers.

[Chapter 900](#) was amended to replace references to the Patent File Wrapper (PFW) system with references to the Patent Transfer Inquiry (PTI) system and to include guidance to examiners concerning use of social media websites as part of a prior art search.

[Chapter 1000](#) was revised to resolve obsolete cross-references.

[Chapter 1200](#) was revised to clarify procedures for the handling of applications following the return of the application from the Patent Trial and Appeal Board (Board) or U.S. Court of Appeals for the Federal Circuit, and the policy and procedures for the handling of a new ground(s) of rejection in an examiner's answer.

[Chapter 1300](#) was updated to incorporate revised procedures and guidance for performing an interference search and a discussion of the Quick Path Information Disclosure Statement Pilot Program (QPIDS).

[Chapter 1400](#) was revised to update and clarify the policies and procedures regarding continuation and divisional reissue applications; to set forth the changes to the payment of maintenance fees in reissue utility patents and original utility patents as set forth in *Setting and Adjusting Patent Fees During Fiscal Year 2017*, 82 FR 52780 (November 14, 2017) (“Final Fee Rule”); to reflect recent case law and guidance regarding reissue applications, certificate of corrections, and terminal disclaimers; and to clarify that the reissue applicant must provide a priority/benefit claim in the reissue application because such claims do not carry over from the patent for which reissue is being sought.

[Chapter 1500](#) was modified to better distinguish pre-AIA from AIA guidance in various sections, to reinstate form paragraph 15.66.01, and to update cross-references in form paragraphs as a conforming change.

[Chapter 1700](#) was revised to include the patent expiration date as an issue that Office personal should not express an opinion on except to the extent necessary to carry out specific tasks; to reflect current Official Gazette information pertaining to the classification of patents; to clarify procedures regarding treatment of court and PTAB decisions affecting Office policy and practice; and to update information regarding the Global Patent Search Network and the Global Dossier Public Access.

[Chapter 1800](#) was revised to reflect recent changes, including revisions to the PCT Administrative Instructions and PCT Receiving Office Guidelines that became effective on January 1, 2019 and revisions to the PCT Rules that became effective on July 1, 2019.

[Chapter 1900](#) was revised to update and clarify the requirements of [37 CFR 1.291](#) in filing a protest; to delete discussion regarding public use proceedings; to clarify that a protest filed without indicating that service was made will not be entered; to remove procedures only related to paper processing of protests; to clarify that a World Intellectual Property Organization (WIPO) publication would not trigger the end of the

time period set in [37 CFR 1.291\(b\)](#) for submitting a protest in an application that entered the national stage in compliance with [35 U.S.C. 371](#); and to reorganize the text to reduce redundancy in the chapter.

[Chapter 2100](#) was amended to include the following notices: *October 2019 Patent Eligibility Guidance Update*, 84 FR 55941 (October 18, 2019); *Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112*, 84 FR 57 (January 7, 2019); and *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR 50 (January 7, 2019). The chapter was also modified to incorporate subject matter from former [MPEP §§ 706.02 et seq.](#) and [706.03 et seq.](#) and reorganized by moving subject matter from [MPEP §§ 2137.01](#) and [2137.02](#) into [MPEP § 2109](#) or [2137](#). The chapter was revised to include court or Board decisions regarding various topics such as prior art, obviousness, and definiteness.

[Chapter 2200](#) was revised to add new procedures regarding the filing of *ex parte* reexamination requests due to changes to [37 CFR 1.20\(c\)](#) as set forth in the Final Fee Rule; to reflect recent case law and guidance regarding *ex parte* reexamination; and to clarify that courts use a different claim interpretation standard than the Office during reexamination of unexpired patent claims.

[Chapter 2300](#) was updated to reflect current interference search procedures; to include guidance on rejections based on disclaimer, including guidance moved from former [MPEP § 706.03\(u\)](#); to add guidance regarding examiner action after termination of an interference or derivation proceedings; and to include a new section to provide guidance for handling applications after decision by the U.S. Court of Appeals for the Federal Circuit.

[Chapter 2400](#) was updated to reflect current seed deposit requirements; to provide further guidance regarding ASCII text file submissions, particularly submissions of text files 300MB or over; to provide clarification on when an incorporation-by-reference statement of the sequence listings is required; to update to include a reference to *Updated Legal Framework for Patent Electronic System*, 84 FR 56803 (October 23, 2019); to update guidance regarding submitting sequence listings on compact disc; updated guidance of transfer requests of previously filed sequence listings; and to update sequence listing form paragraphs.

[Chapter 2500](#) was revised to update the policies and procedures regarding the payment of maintenance fees in reissue utility patents and original utility patents as set forth in the Fee Final Rule.

[Chapter 2600](#) was amended in light of changes to [37 CFR 1.20\(c\)](#), as set forth in the Final Fee Rule, and to clarify that courts use a different claim interpretation standard than the Office during reexamination of unexpired patent claims.

[Chapter 2700](#) was revised to update patent term adjustment procedures regarding the filing of an information disclosure statement as explained in the *Interim Procedure for Requesting Recalculation of the Patent Term Adjustment With Respect to Information Disclosure Statements Accompanied by a Safe Harbor Statement*, 83 FR 55102 (November 2, 2018); to include a discussion of the amendment to [35 U.S.C. 156\(d\)\(1\)](#) for patent term extensions; to expand on the discussion of the requirements of [37 CFR 1.740\(a\)](#); to reflect recent case law and guidance regarding patent term adjustments and extensions; to clarify procedures regarding the Notice of Final Determination and other procedures for patent term extension; and to add new sections pertaining to when a terminal disclaimer is filed during patent term extension proceedings, filing a petition for stay in processing of patent term extension applications, and the processing of patent term extension applications when a reissue application is filed.

Nonsubstantive revisions were made to the introduction to correct an external link, [Chapter 2000](#) to update cross-references to MPEP sections for consistency with other changes made in this revision and to [Chapter 2800](#) to correct a typographical error in the citation to [35 U.S.C. 257\(f\)\(3\)](#) in the last sentence of the section.

Summary of Effective Dates

MPEP Chapters

Each section that has been revised in this revision (published June 2020) has a revision indicator of [R-10.2019], meaning that the section has been updated to include changes that became effective on or before October 2019.

MPEP Appendices

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

[Appendix R \(Patent Rules\)](#) includes the rules current as of October 31, 2019.

[Appendix L \(Patent Laws\)](#) includes the laws current as of October 31, 2019.

[Appendix AI \(Administrative Instructions under the PCT\)](#) as in force from July 1, 2019.

[Appendix T \(Patent Cooperation Treaty and Regulations under the Treaty\)](#) as in force from July 1, 2019.

Robert A. Clarke, Editor
Manual of Patent Examining Procedure

Summary of Changes to MPEP Chapters

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

CHAPTER 100:

103	—In subsection I, corrected "domestic priority" to read "domestic benefit." —In subsection III, updated the copy of form PTO/SB/68. —In subsection X, revised to provide a URL to Public PAIR.
140	—Added reproduction of 35 U.S.C. 182 . —In subsection I, revised title to clarify that the content thereof is directed to petitions filed under 37 CFR 5.12(b) . Added a sentence explaining that pursuant to 37 CFR 5.12(a) , the filing of an application on an invention made in the United States will be implicitly considered to include a petition for license under 35 U.S.C. 184 . Deleted word "expedited" before "petition" in the final paragraph of the subsection. —Added new subsection III to include information previously in MPEP § 706.03(s) pertaining to improper filing without a foreign filing license.

CHAPTER 200:

201.04	—Revised the Editor Notes and the reproduction of 35 U.S.C. 111 to correspond to the current, pre-PLT (AIA), and pre-AIA versions of 35 U.S.C. 111 found in Appendix L of the MPEP.
201.06	—Changed “the protection of 35 U.S.C. 121 ” to read “the protection of the third sentence of 35 U.S.C. 121 (see MPEP § 804.01)” to improve specificity.
201.06(c)	—Changed “MPEP § 602.01(c)(3)” to read “MPEP § 602.01(c)(3) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018” because MPEP § 602.01(c)(3) is not included in the current publication of the MPEP.
201.06(d)	—Changed “MPEP § 602.01(c)(3)” to read “MPEP § 602.01(c)(3) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018” because MPEP § 602.01(c)(3) is not included in the current publication of the MPEP.
211.01	—In subsection II, added cross-references to MPEP §§ 602.01(c) and 1412.04 .
213.01	—Updated the table to the version that became available on October 2, 2019. —In subsection IV, included the Gulf Cooperation Council (GCC) Patent Office in the list of foreign regional patent offices.
213.02	—In subsection II, added cross-references to MPEP §§ 602.01(c) and 1412.04 .

CHAPTER 300:

301	<p>—In subsection I, revised to clarify that for applications filed on or after September 16, 2012, the original applicant is presumed to be the owner of the application for an original patent.</p> <p>—In subsection II, added explanation that the U.S. Patent and Trademark Office cannot explain or interpret laws that govern assignments and related documents, nor act as a counselor for individuals. Assignments and other documents are contracts that are governed by the relevant state or jurisdictional law. Also added that 35 U.S.C. 261 requires transfer of ownership by an assignment to be in writing.</p> <p>—In subsections II and V, added citations to <i>Realvirt, LLC v. Lee</i>, 195 F.Supp.3d 847, 859 (E.D. Va. 2016).</p>
301.01	<p>—Added explanation that images of assignment documents recorded June 1998 and later are viewable on the Office website, and that assignment documents recorded before 1837 are not available. Added a URL to the National Archives website.</p>
302.04	<p>—Revised to clarify that the designation of a domestic representative will be entered into the record of the appropriate application or patent file, and that such designation should always be submitted to the Office as a paper separate from any assignment document, should be clearly labeled “Designation of Domestic Representative,” and must be signed in accordance with 37 CFR 1.33(b). Deleted indication that the designation of a domestic representative should be directed to the Office of Public Records.</p>
302.06	<p>—Revised to state if the request to record a document is submitted electronically, the fee is set forth in 37 CFR 1.21(h)(1), which is currently \$0; if the request to record a document is not submitted electronically (i.e., is submitted on paper or via facsimile), the applicable fee is set forth in 37 CFR 1.21(h)(2); and that customers should check the current fee schedule on the Office website before submitting documents for recordation. Added cross-references to MPEP §§ 302.08-302.10 for additional information regarding the acceptable ways to submit documents for recordation.</p>
302.07	<p>—Updated the copy of form PTO-1595.</p>
302.10	<p>—Replaced information pertaining to payment of the recordation fee by credit card with an indication that the fee set in 37 CFR 1.21(h)(1) for recording a document, if submitted electronically, is currently \$0. Added that customers should check the current fee schedule on the Office website before submitting documents for recordation, and cross-reference to MPEP § 509 for detailed information pertaining to the payment of fees.</p> <p>—Clarified that if a document submitted by the Electronic Patent Assignment System (EPAS) is determined not to be recordable, certain documents will be transmitted via fax back to the sender “if possible.”</p>
308	<p>—Revised to add that the real party in interest will be listed in the assignee section of the patent and to clarify that this does not change the applicant designated in the application or for any patent that is granted. Revised to state that any desired change to the designated applicant must be made in accordance with 37 CFR 1.46 no later than issue fee payment.</p>
310	<p>—Revised to add that providing information concerning government support on a provisional application cover sheet does not satisfy the requirement of 35 U.S.C. 202(c)(6), which requires that the a statement be included within the specification of such application and any patent issuing thereon specifying that the invention was made with Government support and that the Government has certain rights in the invention.</p>
317.03	<p>—Added citation to <i>Realvirt, LLC v. Lee</i>, 195 F.Supp.3d 847, 862-3 (E.D. Va. 2016).</p> <p>—Revised to add that in accordance with the subsequent purchaser provision in 35 U.S.C. 261, if an assignment is not timely recorded at the USPTO, the unrecorded assignment will not be superior to the rights acquired by a third party, i.e. a bona fide purchaser, for valuable consideration if that</p>

	third party did not have knowledge of the unrecorded assignment. Added a citation to <i>CMS Industries, Inc. v. L.P.S. International, Ltd.</i> , 643 F.2d 289 (5th Cir. 1981).
324	—In subsection II, added that 35 U.S.C. 261 requires transfer of ownership by an assignment to be in writing. Also added citation to <i>Realvirt, LLC v. Lee</i> , 195 F.Supp.3d 847, 859 (E.D. Va. 2016). —In subsection V, added that the Office recommends that when a person with a title that does not clearly set forth that person as an officer of the assignee is authorized to act on behalf of the assignee, the submission should clearly indicate that person's authority.
325	—In subsection II, added that 35 U.S.C. 261 requires transfer of ownership by an assignment to be in writing. Also added citation to <i>Realvirt, LLC v. Lee</i> , 195 F.Supp.3d 847, 859 (E.D. Va. 2016). —In subsection V, added that the Office recommends that when a person with a title that does not clearly set forth that person as an officer of the assignee is authorized to act on behalf of the assignee, the submission should clearly indicate that person's authority.

CHAPTER 400:

402.01	<p>—Revised to include reproduction of 37 CFR 11.10(a).</p> <p>—Revised to explain that only registered practitioners and individuals granted limited recognition are permitted to prosecute patent applications or represent others before the Office.</p>
402.02	—Revised to reflect that the associate power of attorney practice terminated on June 25, 2004, and is no longer accepted.
402.02(a)	<p>—In subsection I, revised to clarify that the applicant for patent is all parties identified as the applicant under 37 CFR 1.42(a). Further revised to clarify that where the applicant is all of the joint inventors under 37 CFR 1.45, one or more of the joint inventor-applicants may be appointed to represent on behalf of all of the joint inventor-applicants and that the power of attorney must be signed by parties identified as the applicant in order to be effective.</p> <p>—In subsection II, added that the copy of the power of attorney must comply with 37 CFR 1.32(b) in the continuing application in order to be accepted, meaning that it must be signed by the applicant for patent named in the continuing application.</p> <p>—In subsection III, added copies and discussion of power of attorney forms PTO/AIA/80, PTO/AIA/81, PTO/AIA/82, and PTO/AIA/81A.</p>
402.02(b)	—In subsection III, revised to indicate that form PTO/SB/81A may be used in a patent that issued from an application filed before September 16, 2012.
402.03	<p>—Revised to delete subsection title “I. Signature and Certificate.”</p> <p>—Revised to change “nonpractitioner” to “non-practitioner,” consistent with other sections in the MPEP.</p> <p>—Deleted subsection II. Content is moved to previously reserved MPEP § 402.04.</p>
402.04	—Revised to include prior content from MPEP § 402.03 , subsection II, regarding acting in a representative capacity. Updated cross-reference to MPEP § 408 to MPEP § 405 .
402.05	—Updated to reflect that all of the Office’s power of attorney forms include revocation language on them and will revoke any existing power of attorney.
402.05(a)	—Updated cross-reference to MPEP § 402.03 to MPEP § 402.04 .
402.02(b)	—Updated cross-reference to MPEP § 402.03 to MPEP § 402.04 .
402.06	<p>—Updated the URL for accessing the web-based e-petition for a Request for Withdrawal as Attorney or Agent.</p> <p>—Updated the copy of form PTO/AIA/83.</p>
402.07	<p>—In subsection I, added a parenthetical “(for a patent, including a patent in supplemental examination or reexamination proceeding)” in the first sentence.</p> <p>—In subsection II, added cross-reference to MPEP § 324, subsection V, for who can sign the Statement Under pre-AIA 37 CFR 3.73(b) (form PTO/SB/96 or equivalent). Updated the copy of form PTO/SB/90.</p>
402.10	—Revised to indicate that papers giving a power of attorney in an application will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition under 37 CFR 1.183 and fee under 37 CFR 1.17(f) demonstrating the extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) .
403	<p>—Revised to add that the attorney or agent is still responsible for responding to any notice or action from the Office and to add reference to 37 CFR 11.101, 11.103, and 11.804.</p> <p>—Replaced title of form paragraph 4.01 from “dual” to “double” correspondence. Changed the other reference to “dual” correspondence to “double” correspondence to be consistent with 37 CFR 1.33.</p>

	<p>—In subsection I, revised to emphasize that the customer number associated with the correspondence address is the Customer Number used to obtain access to the Patent Application Information Retrieval (PAIR) system and to update the URL. Revised to indicate that the Office will accept requests for changes to the Customer Number information through the Patent Electronic System. Added a cross-reference to MPEP § 502.05 for information pertaining to the Patent Electronic System. Updated description of forms for use with the Customer Number practice, in particular forms PTO/AIA/122, PTO/SB/122, PTO/AIA/123, and PTO/SB/123 and the URL to access the forms. Revised to provide additional clarification on managing Customer Number practice for law firms associated with practitioners or support staff. Revised to indicate that the customer number associated with the correspondence address is the Customer Number used to obtain access to the PAIR system.</p> <p>—In subsection II, revised to update discussion of patent applications filed without a correspondence address, to include discussion of the procedures when a patent application as filed has been accorded a filing date but is not complete, the applicant is notified and given a period of time within which to file the missing parts to complete the application and pay the applicable surcharge. Added a cross-reference to MPEP § 601.01 <i>et seq.</i> for discussion of the requirements for a complete application.</p>
403.01(b)	—Fictitious address of John Doe was changed.
403.02	—Revised to clarify power of attorney procedure within the Office when there are two patent practitioners in the same application.
405	<p>—Replaced cross-reference to MPEP § 402.03 to MPEP § 402.04.</p> <p>—Revised to clarify the alternative means by which practitioners acting in a representative capacity may be granted authority to conduct an interview.</p> <p>—Updated a copy of form PTO/SB/84.</p>
408	<p>—Replaced cross-reference to MPEP § 502.03 to MPEP § 713.</p> <p>—Revised to clarify that registered attorneys or agents not of record means that there is no power of attorney present in the file that appoints the patent practitioner(s). Further revised to state that Office employees are forbidden from holding either oral or written communication with an unregistered, suspended, or excluded attorney or agent regarding an application unless it is one in which said attorney or agent is the applicant.</p>
409.01(a)	—Rewritten to include subsections and discussions related to (I) termination of power of attorney – deceased inventor; (II) prosecution by assignee, obligated assignee, or sufficient proprietary interest party; (III) prosecution by legal representative, administrator, or executor; and (IV) prosecution by surviving joint inventor-applicants.
409.01(b)	<p>—In subsection III, revised to clarify that proof of authority of the legal representative of a deceased or incapacitated inventor is not required.</p> <p>—In subsection V, revised to delete reference to the Federal Republic of Germany.</p> <p>—In subsection VII, revised to clarify that when an application is being prosecuted by joint inventors without a joint inventor or patent practitioner having been granted a power of attorney, and a joint inventor dies after filing the application, the living joint inventor(s) must submit proof that the other joint inventor is dead.</p>
409.05	<p>—Revised to reflect that the reproduction of 37 CFR 1.46 is not the full recitation of the rule.</p> <p>—Revised to reflect that the reproduction of 37 CFR 1.64 is not the full recitation of the rule.</p> <p>—In subsection I, revised to clarify who may be considered the “sole” applicant and add a cross-reference to MPEP § 301.</p>
410	<p>—Revised to replace instances of “nonpractitioner(s)” with “non-practitioner(s),” consistent with rule 37 CFR 11.18(b).</p> <p>—Revised to correct the title of Director of the Office of Enrollment and Discipline.</p> <p>—Revised to clarify Office procedure regarding alleged violations of 37 CFR 11.18(b).</p>

CHAPTER 500:

501	<p>—Added reproduction of 37 CFR 2.190.</p> <p>—In subsection I.A, removed from the example of papers being required by the Office of Data Management that the papers must be hand-carried or faxed. Revised text to state that applicants are encouraged to transmit documents requiring immediate Office attention by EFS-Web.</p> <p>—In subsection I.B, removed the separate discussion of mailing Trademark-related correspondence under the Madrid protocol.</p> <p>In subsection III, revised to clarify that hand-carried papers may only be delivered to the Office’s Alexandria, Virginia, location and are not accepted at regional offices.</p>
502	—Revised in two locations to clarify that applications and application-related correspondence may be hand-delivered to the Customer Service Window in Alexandria, Virginia.
502.01	—In subsection I.B, moved discussion on filing correspondence subsequent to filing in an international application to the first “Note” in this subsection.
502.02	<p>—Revised to recite that pursuant to 37 CFR 1.4(d)(3), correspondence filed via the Office electronic filing system may be signed by a graphic representation of a handwritten signature, as provided for in 37 CFR 1.4(d)(1), or a graphic representation of an S-signature, as provided for in 37 CFR 1.4(d)(2). Further revised to state that a graphic representation of a handwritten signature may be created by using a stylus pen and/or touch-pad and that all correspondence, except for a notice of appeal pursuant to 37 CFR 41.31, filed in the Office must include a signature. Added references to 37 CFR 1.4, 1.33, and 11.18.</p> <p>—In subsection IV, revised to clarify that where it is necessary to ratify the signatures on multiple previously submitted documents, the ratification paper should include an itemized list of the documents and their filing dates.</p>
502.03	—In subsection II, revised to recite that a written authorization for communicating via the internet may be transmitted via EFS-Web, mail, or fax and that such authorization cannot be submitted via e-mail. Further revised to recite that in limited circumstances, the applicant may make an oral authorization for internet communication. Revised to recite that the Office strongly encourages the use of form PTO/SB/439, which may be filed through EFS-Web. Revised to remove procedures related to paper processing.
502.05	—Revised to incorporate the guidelines published in the <i>Updated Legal Framework for Patent Electronic System</i> , 84 FR 56803 (October 23, 2019).
503	<p>—In subsection I, updated to add new series codes for applications.</p> <p>—In subsection II, revised to add that applicants are encouraged to check their filing receipts for accuracy with particular attention to names, priority and benefit claims, and nonpublication requests.</p>
509	—In subsection II, updated the URL for the forms web page and updated the copy of form PTO-2038.
509.01	—In subsection I, revised text to state that authorized users for a deposit account must be listed in Financial Manager, that the Office will accept obvious variations of the listed name, and that if the last name of the payer does not match a name listed as an authorized payer, then the fee payment may be delayed or rejected. Reorganized text by moving the previous first two paragraphs to the end of the subsection.
509.02	<p>—In subsection V, updated the cross-reference from MPEP § 509.03, subsection VII, to MPEP § 509.03(b).</p> <p>—In subsection VI, in the first paragraph, added references to 37 CFR 1.27(a)(4)(i) and (ii). Deleted the previous second paragraph discussing Public Law 96-517.</p>
509.03	—Deleted subsections VI and VII-X and moved text to new sections MPEP § 509.03(a) and MPEP § 509.03(b) , respectively.
509.03(a)	—New section containing text formerly in subsection VI of MPEP § 509.03 .

509.03(b)	—New section containing text formerly in subsections VII-X of MPEP § 509.03 .
509.04(a)	—In subsection I.B, in the first paragraph, added text to define a “non-inventor applicant” and to state that any non-inventor applicant who is a natural person must also meet the application filing limit in 37 CFR 1.29(a)(2) . In the second paragraph, added a cross-reference to MPEP § 509.04(a) , subsection II. —In subsection II, added text to clarify that in order for 37 CFR 1.29(b) to apply, the assignment of all ownership rights or the existing obligation by contract or law to assign all ownership rights must have resulted from employment with a previous employer.
511	—In subsection III, changed "www.uspto.gov/patents-application-process/applying-online/legal-framework-efs-web-06april11" to "www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web".
512	—In subsection IV, in the first paragraph, revised text to state that all submissions under 37 CFR 1.8(b) and (c) should be forwarded to the Office of Petitions to be considered.

CHAPTER 600:

601.01(a)	—In subsection III, revised to clarify that in applications filed by reference under 37 CFR 1.57(a) , when responding to a notice requiring a copy of the specification and drawing, the applicant must include claims when submitting a copy of the specification from the previously filed application. Added text to describe that a petition under 37 CFR 1.182 may be filed to request that the modified specification and drawings be removed from the application filed by reference under 37 CFR 1.57(a) and be accorded a status as a new, separate application.
601.01(f)	—Revised to clarify that the filing requirements discussion in the fourth paragraph is directed to nonprovisional applications filed prior to December 18, 2013.
601.03(a)	—Updated the reproduced form(s) at the end of the section.
601.03(b)	—Updated the reproduced form(s) at the end of the section.
601.05	—Added a discussion of the web-based Application Data Sheet (ADS) in the last paragraph.
601.05(a)	—In subsection II, added a discussion of the web-based ADS; revised to clarify that a corrected ADS filed after a final rejection or allowance is not entered as a matter of right; revised to clarify that when no applicant is identified in the applicant information section of a properly signed ADS, a corrected ADS must identify a new applicant with underlining and does not need to show the deletion of the inventor-applicant(s) with strikethrough; revised to clarify that when filing a corrected ADS, all inventors must be listed in the Inventor Information section, even if the residence information is only being changed for one inventor; and added a new last paragraph that discusses the timing requirements of 37 CFR 1.55 and 37 CFR 1.78 as well as the requirements for deleting a benefit or priority claim on a corrected ADS.
602.01	—Revised the title for the section and updated cross-references to MPEP § 2109 for the definition and requirements of inventorship and MPEP §§ 602.09 and 2109.01 for information about joint inventorship. —In subsection I, corrected the title for 37 CFR 1.41 . —In subsection II, added a reproduction of pre-AIA 37 CFR 1.41 and text stating that actual inventorship will be taken from the first-filed executed oath or declaration, even if the information is different than initially presented at the time of filing the application, and that in a provisional application, inventorship is the inventor or joint inventors set by the cover sheet as prescribed by 37 CFR 1.51(c)(1) .
602.01(a)	—Corrected the reproduction(s) of 35 U.S.C. 115(f) .
602.01(b)	—Updated the form(s) reproduced at the end of the section.
602.01(c)	—In subsection I, added cross-references to MPEP § 602.01 for information specific to naming inventorship. Added that a correction of inventorship may be requested under 37 CFR 1.48 or may be obtained by filing a continuing application under 37 CFR 1.53 . Removed subsections A and B, except for the cross-references to MPEP §§ 601.01(a) and 601.01(b) . —In subsection II, added cross-reference to MPEP § 602.09 for additional information pertaining to correction of inventorship in applications that name joint inventors.
602.01(c)(1)	—Added subsection V – "Form to Request Correction or Change to Inventorship."
602.01(c)(2)	—Added cross-reference to MPEP § 602.01(c)(1) .
602.01(c)(3)	—Removed and reserved.
602.08(a)	—In subsection II, revised to correct a typographical error in the second paragraph.
602.09	—Relocated the Editor Note for 35 U.S.C. 116 to after the title. —Added text to explain that joint inventors do not have to separately "sign the application" but must apply jointly and make the required oath or declaration by signing the same. —Moved the discussion regarding the legal standard of inventorship to new MPEP § 2109.01 and reorganized remaining text.

604	—Added examples of when a substitute statement under 35 U.S.C. 115(d) may be made. Added a discussion of who may sign a substitute statement for juristic entities. Updated the reproduced form(s) at the end of the section.
605.01	—In subsection I, updated reproduction of 37 CFR 1.46 . Added clarification to the example of an assignee filing an application under 37 CFR 1.46 . —In subsection II, revised to clarify that identification of the real party in interest on the PTOL-85B form will not change the applicant of record in the application. —Added new subsection III – “Correction or Update of 37 CFR 1.46 Applicant.”
606	—Revised to update the list of words that are not considered a part of the title of invention and will be deleted by the Office.
608.01	—Changed "www.uspto.gov/patents-application-process/applying-online/legal-framework-efs-web-06april11" to "www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web".
608.01(a)	—Updated the reproduction of form paragraph 6.02.
608.01(e)	—Reserved. Text was deleted due to elimination of 37 CFR 1.79 in the final rule <i>Eliminating Unnecessary Regulations</i> , 84 FR 51977 (October 1, 2019).
608.01(f)	—Corrected a grammatical error in the first paragraph following the reproduction of 37 CFR 1.74 .
608.01(g)	—Added cross-references to MPEP §§ 2161 and 2162 . Revised to indicate that the specification must clearly convey enough information about the invention to show that applicant invented the subject matter claimed.
608.01(k)	—Revised to use gender-neutral wording.
608.01(l)	—Added that when subject matter is not shown in the drawing or described in the description, the words of the original claim must sufficiently describe the invention so that one of ordinary skill in the art would recognize that the inventor had possession of the full scope of the claimed invention. Further revised to state that if the claim does not provide its own description in this case, the claim should be rejected under 35 U.S.C. 112(a) as failing to be supported by an adequate written description.
608.01(m)	—Revised to state that generally the presence or absence of reference characters does not affect the scope of a claim. Revised to provide additional guidance for the treatment of duplicate claims. Added reproduction of form paragraphs 7.05.05 and 7.05.06.
608.01(n)	—In subsection II, divided section into subsection II “Initial Treatment of Dependent Claims” and subsection III “Test for Proper Dependency.” —In new subsection III, added discussion of the requirements of 35 U.S.C. 112(d) . Clarified example of proper dependent claim language. —Deleted previous subsection III directed to the “Infringement Test,” except for the last paragraph, which was relocated in new subsection III.
608.01(p)	—In subsection I.B, added a citation to and discussion of <i>Droplets, Inc. v. E*TRADE Bank</i> , 887 F.3d 1309, 126 USPQ2d 317 (Fed. Cir. 2018).
608.01(t)	—Revised to remove a reference to 37 CFR 1.79 , which was deleted in the final rule <i>Eliminating Unnecessary Regulations</i> , 84 FR 51977 (October 1, 2019). Also revised to remove cross-reference to MPEP § 608.01(e) .
608.01(v)	—Updated the reproduction of form paragraph 6.20.
608.02	—In subsection II, revised text to clarify that the examiner should describe the new matter that resulted in the drawing not being entered, and to suggest that form paragraph 6.37 may be used. —In subsection IV, updated the reproduction of form paragraph 6.23.01. —In subsection IX, revised to recite that graphic drawing symbols in design patent applications should be used judiciously, as the drawing symbol may interfere with a clear showing of the design. Further revised to state that because colored drawings may now be filed in a design application

	without the need for a petition, applicants may prefer to represent color using color drawings instead of graphic symbols.
608.02(b)	—Updated the reproduction of form paragraph 6.26.
608.02(h)	—Updated the reproduction of form paragraph 6.37.
608.04	—Added reproduction of 35 U.S.C. 132(a) . Added parenthetical examples of where new matter may be presented in an amendment.
608.04(a)	—Added content previously present in MPEP § 706.03(o) . Removed cross-reference to now reserved MPEP § 706.03(o) . Updated the reproduction of form paragraph 7.28. Revised to indicate that replacement drawings containing new matter should not be entered and the corrections necessary to obtain entry of the drawing(s) should be explained using form paragraph 6.37.
608.04(b)	—Replaced cross-reference to MPEP § 706.03(o) with cross-reference to MPEP § 608.04(a) .
608.05	—Changed "www.uspto.gov/patents-application-process/applying-online/legal-framework-efs-web-06april11" to "www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web".
608.05(c)	—Changed "www.uspto.gov/patents-application-process/applying-online/legal-framework-efs-web-06april11" to "www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web".
609	—Revised to clarify that an information disclosure statement (IDS) must include a signature in compliance with 37 CFR 1.33(b) . Further revised to indicate that an e-IDS submission in compliance with EFS-Web framework would satisfy the signature requirement. —Revised to add 37 CFR 1.33(b) to the requirements that IDSs must meet.
609.03	—Revised to state that when examining a PCT national stage application, the examiner will consider all U.S. patents, U.S. patent application publications, and U.S. pending applications cited in the international search report that are stored electronically in the USPTO's Image File Wrapper (IFW) system, and there is no requirement for applicant to provide a separate listing of references. Revised to state that such citation will not be printed on the face of the patent unless the citation listing lends itself to easy capture by the printing contractor.
609.04(a)	—In subsection I, replaced transmittal letter with cover sheet. Revised to indicate that the Office will accept a citation in an IDS where a U.S. patent application publication is identified using the inventor instead of the applicant. Added guidance pertaining to the citation of publications obtained from the internet. —In subsection II, added example for submitting content of a software program or video if it is reduced to writing. —In subsection III, revised to indicate that there is no requirement that a translation submitted with an information disclosure statement be verified. Revised to clarify that an English language equivalent application should be separately listed and identified as an English language equivalent in an information disclosure statement.
609.04(b)	—In subsection IV, added information concerning the Quick Path Information Disclosure Statement Program. —In subsection V, revised to state that compliance with the statement requirement of 37 CFR 1.97(e) does not substitute for compliance with 37 CFR 1.704(d) when attempting to avoid reduction of patent term adjustment. Further revised to clarify that an international application filed under the Patent Cooperation Treaty, which designates the U.S., is not a counterpart foreign application for purposes of making the statement set forth in 37 CFR 1.97(e) and that applicants should consider the applicability of making the statement in 37 CFR 1.97(e)(2) . Additionally revised to indicate that 37 CFR 1.97(e)(1) is construed to include any information in a foreign patent office communication, including the communication itself, such as an Office action or search report. Revised to indicate that while applicants are strongly encouraged to use the exact language of 37 CFR 1.97(e)(1) and/or 37 CFR 1.97(e)(2) , it is not required so long as the language used by applicant conveys the exact

	same meaning. Revised to indicate that the applicant may submit a single listing of references in an information disclosure statement along with two statements under 37 CFR 1.97(e) , so long as the applicant expressly designates which statement pertains to which citation(s). Further revised to clarify that if the information is being submitted in the time frame set forth in 37 CFR 1.97(d) and applicant includes two statements with either one or two lists on the same day, only one fee is required.
609.05(a)	—Revised to indicate that an “X” is an acceptable manner of indicating that a listing of references in an information disclosure statement has not been considered.
609.08	—Updated copies of the form(s) at the end of the section.

CHAPTER 700:

<i>Passim</i>	<p>—Revised the form paragraphs indicating extensions of time are available under 37 CFR 1.136(a) to indicate that no extension can carry the date for reply beyond the maximum period of six months set by statute (35 U.S.C. 133).</p> <p>—Removed or changed occurrences of “OACS” to “Official Correspondence.”</p> <p>—Changed occurrences of “disqualify” and “disqualified” to “except” and “excepted,” respectively, regarding the prior art exceptions specified in 35 U.S.C. 102(b) and (c).</p> <p>—Changed many occurrences of “which” to “that.”</p>
701	—Replaced cross-reference to MPEP § 706.03(a) with cross-references to MPEP §§ 2104–2109 and 2157 for discussions of inventions that are not considered to be patentable under 35 U.S.C. 101 .
704.12(c)	—Revised form paragraph 7.95.
704.14(a)	—Revised form paragraph 7.126.
706.02	—Revised to delete subsections I-VII. Information previously in subsections I, II, and V pertaining to the choice of best art, reliance on abstracts and foreign language documents, and the distinction between 35 U.S.C. 102 and 35 U.S.C. 103 has been moved to MPEP § 2120 . Information previously in subsection VI pertaining to determining the effective filing date of a claimed invention has been moved to MPEP § 2139.01 for applications subject to pre-AIA 35 U.S.C. 102 and MPEP § 2152.01 for applications subject to AIA 35 U.S.C. 102 . Information previously in subsection VII pertaining to the rejection of claims corresponding to patent claims has been moved to MPEP § 706.06 . Information previously in subsection III pertaining to admitted prior art already appears in MPEP § 2129 , and the information previously in subsection IV, which cross-references the reexamination chapters, was deleted as unnecessary.
706.02(a)	—Removed and reserved. Information pertaining to rejections under 35 U.S.C. 102(a)(1) or (a)(2) and pre-AIA 35 U.S.C. 102(a), (b), or (e) based on a printed publication or patent has been moved to MPEP § 2120.01 .
706.02(a)(1)	—Removed and reserved. Information pertaining to determining whether to apply 35 U.S.C. 102(a)(1) or (a)(2) has been moved to MPEP § 2152.05 .
706.02(a)(2)	—Removed and reserved. Information pertaining to whether to apply pre-AIA 35 U.S.C. 102(a), (b), or (e) has been moved to MPEP § 2139.02 .
706.02(b)	—Removed and reserved. Information pertaining to overcoming a 35 U.S.C. 102 rejection based on a printed publication or patent has been moved to MPEP § 2120.01 .
706.02(b)(1)	—Removed and reserved. Information pertaining to overcoming a 35 U.S.C. 102(a)(1) or (a)(2) rejection based on a printed publication or patent has been moved to MPEP § 2152.06 .
706.02(b)(2)	—Removed and reserved. Information pertaining to overcoming a rejection based on a printed publication or patent has been moved to MPEP § 2132.01 for rejections under pre-AIA 35 U.S.C. 102(a) , MPEP § 2133.02(a) for rejections under pre-AIA 35 U.S.C. 102(b) , and MPEP §§ 2136.05 -2136.05(b) for rejections under pre-AIA 35 U.S.C. 102(e) .
706.02(c)	—Removed and reserved. Information pertaining to rejections under 35 U.S.C. 102(a)(1) and pre-AIA 35 U.S.C. 102(a) or (b) based on knowledge by others or public use or sale has been moved to MPEP § 2120.02 .
706.02(c)(1)	—Removed and reserved. Information pertaining to rejections under 35 U.S.C. 102(a)(1) based on public use has been moved to MPEP § 2152.02(c) , and information pertaining to rejections under 35 U.S.C. 102(a)(1) based on sales or offers for sale has been moved to MPEP § 2152.02(d) .

706.02(c)(2)	—Removed and reserved. Information pertaining to whether to make a rejection under pre-AIA 35 U.S.C. 102(a) or (b) when the claimed invention was known, in public use, or on sale has been moved to MPEP § 2139.02 . For additional information relating to such rejections, see MPEP § 2132 for a discussion of rejections under pre-AIA 35 U.S.C. 102(a) and MPEP § 2133.03 <i>et seq.</i> for a discussion of case law treating the “public use” and “on sale” statutory bars of pre-AIA 35 U.S.C. 102(b) .
706.02(d)	—Removed and reserved. Information pertaining to rejections under pre-AIA 35 U.S.C. 102(c) has been moved to MPEP § 2134 .
706.02(e)	—Removed and reserved. Information pertaining to rejections under pre-AIA 35 U.S.C. 102(d) has been moved to MPEP § 2135 .
706.02(f)	—Removed and reserved. Information pertaining to rejections under pre-AIA 35 U.S.C. 102(e) has been moved to MPEP § 2136 .
706.02(f)(1)	—Removed and reserved. Examination guidelines for applying references under pre-AIA 35 U.S.C. 102(e) have been moved to MPEP § 2136 .
706.02(f)(2)	—Removed and reserved. Information pertaining to provisional rejections based on a copending U.S. application has been moved to MPEP § 2154.01(d) for rejections under AIA 35 U.S.C. 102(a)(2) and to MPEP § 2136.01 for rejections under pre-AIA 35 U.S.C. 102(e) .
706.02(g)	—Removed and reserved. Information pertaining to rejections under pre-AIA 35 U.S.C. 102(f) has been moved to MPEP § 2137 .
706.02(h)	—Removed and reserved. Information pertaining to rejections under pre-AIA 35 U.S.C. 102(g) has been moved to MPEP § 2138 .
706.02(i)	—Removed and reserved. Form paragraphs for use in rejections under AIA 35 U.S.C. 102 have been moved to MPEP § 2152.07 , and form paragraphs for use in rejections under pre-AIA 35 U.S.C. 102 have been moved to MPEP § 2139.03 .
706.02(j)	—Removed and reserved. Information pertaining to the contents of a 35 U.S.C. 103 rejection has been moved to MPEP § 2142 .
706.02(k)	—Removed and reserved. Information pertaining to provisional obviousness rejections using provisional prior art under pre-AIA 35 U.S.C. 102(e) has been moved to MPEP § 2146.03(a) , and information pertaining to the requirements to claim the benefit of a prior filed application under 35 U.S.C. 120 has been moved to MPEP § 2109 , subsection VI.
706.02(l)	—Removed and reserved. Information pertaining to the applicability of pre-AIA 35 U.S.C. 103(c) to obviousness rejections using prior art under only pre-AIA 35 U.S.C. 102(e), (f), or (g) has been moved to MPEP § 2146 .
706.02(l)(1)	—Removed and reserved. Information pertaining to prior art disqualification under pre-AIA 35 U.S.C. 103(c) has been moved to MPEP § 2146.01 .
706.02(l)(2)	—Removed and reserved. Information pertaining to establishing common ownership or joint research agreement under pre-AIA 35 U.S.C. 103(c) has been moved to MPEP § 2146.02 .
706.02(l)(3)	—Removed and reserved. Information pertaining to examination procedure with respect to pre-AIA 35 U.S.C. 103(c) has been moved to MPEP § 2146.03 .
706.02(m)	—Removed and reserved. Form paragraphs for making rejections under pre-AIA 35 U.S.C. 103(a) have been moved to MPEP § 2148 , and form paragraphs for making rejections under AIA 35 U.S.C. 103 have been moved to MPEP § 2158.01 . In addition, form paragraph 7.06.01 has been moved to MPEP § 2124.01 .
706.02(n)	—Removed and reserved. Information pertaining to biotechnology process applications and pre-AIA 35 U.S.C. 103(b) has been moved to MPEP § 2147 .
706.03	—Revised to update cross-references for consistency with the relocation of subject matter pertaining to rejections not based on prior art.

706.03(a)	—Removed and reserved. The overview of the requirements of 35 U.S.C. 101 has been moved to MPEP § 2104 . Form paragraphs for use in rejections based on lack of subject matter eligibility have been moved to MPEP § 2106.07(a)(1) , the form paragraph for use in rejecting a claim as being directed to a human organism has been moved to MPEP § 2105 , form paragraphs for use in rejections based on lack of utility have been moved to MPEP § 2107.02 , subsection IV, and form paragraphs for use in rejecting claims based on improper inventorship in applications subject to AIA 35 U.S.C. 102 have been moved to MPEP § 2157 .
706.03(b)	—Removed and reserved. Information pertaining to patents barred by the Atomic Energy Act has been moved to MPEP § 2104.01 .
706.03(c)	—Removed and reserved. Form paragraphs for use in rejections made under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112 , first paragraph, have been moved to MPEP § 2166 .
706.03(d)	—Removed and reserved. Form paragraphs for use in rejections made under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112 , second paragraph, have been moved to MPEP § 2175 .
706.03(e)	—Removed and reserved. Form paragraphs for use in rejections made under 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112 , sixth paragraph, have been moved to MPEP § 2187 .
706.03(k)	—Removed and reserved. Information pertaining to duplicate claims has been moved to MPEP § 608.01(m) .
706.03(m)	—Removed and reserved as unnecessary (former text merely cross-referenced other MPEP sections).
706.03(o)	—Removed and reserved. Information pertaining to objection to an amendment that adds new matter to the specification has been moved to MPEP § 608.04(a) .
706.03(s)	—Removed and reserved. Information pertaining to foreign filing without a foreign filing license has been moved to MPEP § 140 , subsection III.
706.03(u)	—Removed and reserved. Information pertaining to rejections based on disclaimer has been moved to MPEP § 2304.04(c) .
706.03(v)	—Removed and reserved. Effective September 16, 2012, former 37 CFR. 1.292 authorizing petitions seeking institution of public use proceedings was removed from title 37; in this revision, information regarding rejections after the institution of public use proceedings has been removed from the MPEP. See MPEP § 706.03(v) of the August 2012 revision of the MPEP, available at www.uspto.gov/web/offices/pac/mpep/old/mpep_E8R9.htm , for information regarding such rejections.
706.03(w)	—Removed and reserved. Information pertaining to rejections based on <i>res judicata</i> has been moved to MPEP § 2190 , subsection II.
706.03(x)	—Removed and reserved. Information previously in this section is covered in MPEP Chapter 1400 . See especially MPEP § 1412.03 for rejection of improperly broadened reissue claims, MPEP § 1444 for rejection of claims as being based on a defective reissue oath or declaration, and MPEP § 1442 for the special status of reissue applications.
706.03(y)	—Removed and reserved. Information pertaining to improper Markush groupings has been moved to MPEP § 2117 .
706.06	—Revised to add information previously in MPEP § 706.02 , subsection VII, pertaining to the rejection of claims corresponding to patent claims.
706.07(a)	—Changed the cross-reference to MPEP § 706.02(1)(3) to MPEP § 2146.03 . Amended the discussion of “disqualified” references under 35 U.S.C. 102(b)(2)(C) and 35 U.S.C. 102(c) to a discussion of subject matter “excepted” under 35 U.S.C. 102(b)(2)(C) and 35 U.S.C. 102(c) . —Revised form paragraphs 7.40.01, 7.40.02.aia, and 7.40.02.fti.

706.07(b)	—Revised “claims ... are drawn to the same invention” to “claims ... are either identical to or patentably indistinct from ...” in three places, including in form paragraph 7.42.09, regarding when it is proper to make a first Office action final in a new application or in a request for continued examination (RCE). Added the parenthetical information “(in other words, restriction under 37 CFR 1.145 would not have been proper if the new or amended claims had been entered in the earlier application)” to the paragraph explaining when a final rejection is proper in the first Office action in a new application, and similar language was added to form paragraph 7.42.09.
706.07(f)	—Revised form paragraph 13.02.02.
706.07(h)	<p>—Revised to indicate that for an effective request for continued examination (RCE) to be filed in a 35 U.S.C. 371 national stage application, all required inventor’s oaths or declarations (or substitute statements) must be submitted in the application prior to or with the RCE, notwithstanding 37 CFR 1.495(c)(3) permitting an inventor’s oath or declaration to be postponed until an application is otherwise in condition for allowance. In accordance with 37 CFR 1.114(e), an RCE cannot be filed in an international application that does not comply with 35 U.S.C. 371; 35 U.S.C. 371(c)(4) requires submission of the oath or declaration by the inventor(s) or a substitute statement.</p> <p>—In subsection IV, changed “lacks a submission under 37 CFR 1.114(b)” was changed to “lacks a submission under 37 CFR 1.114(c),” and “the lacking submission under 37 CFR 1.114(b)” was changed to “the submission that is required by 37 CFR 1.114.”</p> <p>—In subsection VI, revised form paragraph 7.42.08.</p> <p>—In subsection VII, changed the cross-reference to “MPEP § 706.03” to “MPEP §§ 608.04–608.04(c).”</p> <p>—In subsection VIII, revised form paragraph 7.42.09.</p> <p>—In subsection X.B, revised form paragraphs 7.42.11, 7.42.12, and 7.42.14.</p> <p>—In subsection XI.A, changed the cross-reference to MPEP § 706.03(w) to MPEP § 2190, subsection II. Revised form paragraph 7.42.07.</p> <p>—In subsection XI.B, revised form paragraph 7.42.16.</p> <p>—In subsection XIII, updated the copy of form PTO/SB/30.</p>
707	<p>—Revised to include a sentence indicating matters unrelated to examination of the application should not be included in the Office action; also revised to include a cross-reference to MPEP § 707.07(d).</p> <p>—Revised form paragraphs 7.101 and 7.102.</p>
707.05(a)	—Revised form paragraph 7.82.03.
707.05(e)	<p>—In subsection II, added a new paragraph indicating that when citing an international registration, both the International Registration Number (referenced by INID Code 11 in the publication) and the publication date should be included.</p> <p>—In subsection IV, added a new paragraph indicating that where an internet source does not provide an ability to download the information as an electronic document, screen shots should be captured of the information, and an explanation provided as to what can be found in the screen shots. Example 5 was revised to include an example of a published International Registration retrieved from the Global Design Database (www.wipo.int/designdb/en/index.jsp). Example 17 was revised to change “posted posted” to “posted.”</p>
707.07(d)	—For language used in rejecting claims, replaced the cross-references to MPEP §§ 706.02(i), (j), and (m) with cross-references to MPEP §§ 2106.07(a)(1), 2107.02, 2117, 2139.03, 2148, 2152.07, 2157, 2158.01, 2166, 2175, and 2187 .

	—Revised to include the sentence: “The impression that any part of an Office action fails to reflect the professional judgment of the examiner or other employee authorizing the action should not be created by the action.”
707.07(f)	—Revised form paragraphs 7.38 and 7.37.10.
707.07(d)	—Removed the cross-reference to MPEP § 706.03(a) .
707.08	—Revised form paragraphs 7.101 and 7.102.
708.01	—Revised to use gender-neutral wording. —Revised 37 CFR 1.102(e) to indicate that no more than 12,000 requests for prioritized examination will be accepted in any fiscal year in accordance with an interim rule <i>Increase of the Annual Limit on Accepted Requests for Track I Prioritized Examination</i> , 84 Fed. Reg. 45907 (September 3, 2019).
708.02	—Revised 37 CFR 1.102(e) to indicate that no more than 12,000 requests for prioritized examination will be accepted in any fiscal year in accordance with an interim rule <i>Increase of the Annual Limit on Accepted Requests for Track I Prioritized Examination</i> , 84 Fed. Reg. 45907 (September 3, 2019). —In subsection II, changed “as a PDF-based ePetition or as a Web-based ePetition” to “as a Web-based ePetition.”
708.02(a)	—In subsection I, item (E), corrected the reference to “37 CFR 41.37(c)(1)(vi)” to “ 37 CFR 41.37(c)(1)(iv) .” —In subsection I, item (I)(6)(i), changed the discussion of “disqualified” prior art under 35 U.S.C. 102(b)(2)(C) to a discussion of subject matter “excepted” as prior art under 35 U.S.C. 102(b)(2)(C) . —In subsection IX, revised form paragraphs 7.126.AE, 7.42.08.AE, 7.51.AE, 7.71.AE, 7.84.AE, 7.84.01.AE, 7.95.AE, 8.26.AE, and 19.02.AE.
708.02(b)	—Revised 37 CFR 1.102(e) and associated guidance to indicate that no more than 12,000 requests for prioritized examination will be accepted in any fiscal year in accordance with an interim rule <i>Increase of the Annual Limit on Accepted Requests for Track I Prioritized Examination</i> , 84 Fed. Reg. 45907 (September 3, 2019).
709	—Updated the copy of form PTO/SB/37.
710.02(e)	—Revised form paragraphs 7.98 and 7.98.01.
711.01	—Updated the copies of forms PTO/AIA/24, PTO/AIA/24A, and PTO/AIA/24B.
711.03(c)	—Removed three occurrences of “ 35 U.S.C. 41(a)(7) ” and changed two of them to “ 35 U.S.C. 27 .” The third occurrence, relating to the legislative history of 35 U.S.C. 41(a)(7) , has been revised to discuss the legislative history of “the unintentional delay revival provision.” —Updated the copies of forms PTO/SB/64, PTO/SB/64a, and PTO/SB/64PCT. —Removed two occurrences of “despite the exercise of due care or diligence on the part of the applicant.”
711.06	—In subsection III, removed a cross-reference to MPEP § 2136 .
711.06(a)	—Removed a cross-reference to MPEP § 2136 .
713.04	—In subsection II, revised form paragraph 7.84 to add “but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133).”
714	—In subsection II.C, revised item (E) to indicate claim listings that include the status identifiers in the table of acceptable alternative status identifiers will be accepted if the amendment otherwise complies with 37 CFR 1.121 . —In subsection II.F, revised item (G) to indicate an extendable time period of two months for reply to a non-compliant amendment filed in response to a <i>Quayle</i> action.

714.01(a)	<p>—Revised to indicate a two-month time period to ratify a previously-filed amendment in an application not under final rejection.</p> <p>—Revised form paragraph 7.84.01 to add "but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."</p>
714.01(e)	—Revised to cross-reference MPEP § 608.04 <i>et seq.</i> instead of MPEP § 706.03(o) regarding new matter.
714.03	—Revised form paragraph 7.95 to add "but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
714.03(a)	<p>—Revised to indicate that if a supplemental reply is approved for entry, the examiner must annotate the reply "OK TO ENTER," with initials, enter the annotated document into the electronic file wrapper, and notify the applicant in the subsequent Office action. Also revised to indicate that if a supplemental reply is not approved for entry, the examiner must annotate the reply "DO NOT ENTER," with initials, enter the annotated document into the electronic file wrapper, and notify the applicant in the next Office action.</p> <p>—Revised to include "and to explain the reason(s) for denying entry" in the discussion of when form paragraph 7.147 may be used.</p>
714.14	—Modified form paragraph 7.51 to include: "Extensions of time may be granted under 37 CFR 1.136 , but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
714.16	<p>—Revised to include a new paragraph indicating the listed examples of "amendments" must comply with the other applicable requirements.</p> <p>—In subsection II, revised to acknowledge an exception permitting amendment after the issue fee has been paid where the Office of Data Management has required an amendment. Further revised to include a cross-reference to MPEP § 714.16(d) for processing an amendment required by the Office of Data Management.</p>
714.16(d)	—Corrected form paragraph 7.87 by changing " 37 CFR 1.132 " to " 37 CFR 1.312 ."
714.19	—In item (J), changed the cross-references to " MPEP § 608.04 and § 706.03(o) " to " MPEP § 608.04 <i>et seq.</i> "
715	—Revised to remove cross-references to MPEP §§ 706.02(a) , 706.02(c) , and 706.02(f)(1) and to add a cross-reference to MPEP § 2120.02 .
715.01	—Revised to change the cross-references to " MPEP § 706.02(l)(1) through § 706.02(l)(3) " to " MPEP §§ 2146 through 2146.03 ."
715.01(a)	—Revised the discussion of <i>In re DeBaun</i> , 687 F.2d 459, 214 USPQ 933 (CCPA 1982) and <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i> , 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017).
715.01(b)	—Revised to change the cross-references to " MPEP § 706.02(l) and § 706.02(l)(1) " to " MPEP § 2146.01 - MPEP § 2146.02 ."
715.01(c)	—Revised the discussion of <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i> , 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017).
716.01(b)	—Revised to include a paragraph clarifying the nexus required between what is claimed and novel, and the objective indicia of nonobviousness (e.g., commercial success).
716.01(c)	—Revised to include a new subsection IV directed to the potential impact of strong market power or the existence of a "blocking patent" on the value of objective evidence of commercial success or long felt need and failure of others.

716.10	—Revised to include two occurrences of the parenthetical information “(declaration corroborated by attached drawing)” with respect to <i>In re DeBaun</i> , 687 F.2d 459, 214 USPQ 933 (CCPA 1982).
717.01	—Changed “may not be disqualified” to “does not meet the requirements for exception” with respect to a disclosure made more than one year before the effective filing date of the claimed invention. —In subsection I, replaced the discussion of how to “disqualify” a disclosure with a discussion of how to show a disclosure is eligible to be excepted under 35 U.S.C. 102(b)(1) or (2) .
717.01(b)(1)	—Corrected “UQPQ2d” to “USPQ2d” in the citation to <i>In re Kao</i> .
717.01(b)(2)	—Made minor grammatical changes.
717.02	—Changed the cross-reference to “ MPEP § 706.02(1) et seq. ” to “ MPEP §§ 2146 - 2146.03. ” —Revised to replace “can establish common ownership” with “can establish that disclosed subject matter and a claimed invention are deemed owned by the same person or subject to an obligation of assignment to the same person.” —Replaced a cross-reference to “ MPEP § 706.02(1)(1) ” with a cross-reference to “ MPEP § 2146. ”
717.02(a)	—Changed both cross-references to “ MPEP § 706.02(1) et seq. ” to “ MPEP §§ 2146 - 2146.03. ”
717.02(b)	—Changed the cross-reference to “ MPEP § 706.02(1) et seq. ” to “ MPEP §§ 2146 - 2146.03. ” —In subsection III, revised the sample statement for establishing common ownership of, or an obligation for assignment to, the same person(s) or organization(s) to change “reference(s)” to “the subject matter disclosed in the reference(s).”
717.02(c)	—Changed the cross-reference to “ MPEP § 706.02(1) et seq. ” to “ MPEP §§ 2146 - 2146.03. ”
717.02(d)	—Changed the cross-reference to “ MPEP § 706.02(1) et seq. ” to “ MPEP §§ 2146 - 2146.03. ” —Revised form paragraphs 7.20.01.aia, 7.20.04.aia, and 7.20.05.aia.
718	—Changed the cross-reference to MPEP §§ 706.02(1)-706.02(1)(3) to MPEP §§ 2146-2146.03.
719.05	—Changed two occurrences of “an electronic search” to “a limited electronic search.” —In subsection III, revised to indicate an interference search must be made by using the most efficient and effective manner based on the claimed subject matter in the broadest claim. Further revised to include a reminder that some applications, such as continuation-in-part applications, may contain claims entitled to different effective filing dates, and that each effective filing date should be considered when performing the interference search.
724.04(a)	—Revised item (E) to change “any portion or all” to “all.”

CHAPTER 800:

803.02	—Updated cross-references to MPEP Chapters 700 and 2100 consistent with revisions made to those chapters.
804	<p>—Revised to use gender-neutral wording.</p> <p>—Updated cross-reference in view of revisions to MPEP Chapters 700 and 2100.</p> <p>—In the paragraph starting with "The doctrine of double patenting seeks ...", deleted the note regarding <i>Gilead Sciences, Inc. v. Natco Pharma Ltd.</i>, 753 F.3d 1208, 110 USPQ2d 1551 (Fed. Cir. 2014) because the discussion of the decision has been moved to subsection I.</p> <p>—In the paragraph discussing <i>In re Van Ornum</i>, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982), changed the reference to 37 CFR 1.321(b) to 37 CFR 1.321(c) or (d).</p> <p>—In subsection I.B.1, changed the abbreviation for nonstatutory double patenting to NSDP. After the explanation that only objections or requirements as to form not necessary for further consideration of the claims may be held in abeyance until allowable subject matter is indicated, added the following sentence: "Replies with an omission should be treated as provided in MPEP § 714.03."</p> <p>In subsection I.B.1.(a), clarified text defining effective U.S. filing date for original applications and added text to define the effective U.S. filing date for reissue applications.</p> <p>—In subsection I, inserted a new paragraph D that discusses double patenting between two patents and the impact of the statutory patent term law regime to which each patent is subject. In particular, a citation to and discussion of <i>Gilead Sciences, Inc. v. Natco Pharma Ltd.</i>, 753 F.3d 1208, 110 USPQ2d 1551 (Fed. Cir. 2014) is included. Former paragraph D pertaining to reexamination proceedings is now labeled as paragraph E.</p> <p>—In subsection II.A, corrected the year to "1894" in the citation to <i>Miller v. Eagle Mfg. Co.</i>, 151 U.S. 186 (1894).</p> <p>—In subsection II.B.1, in the second paragraph, added "claim or claims of the" after "potentially conflicting" to emphasize that the claims are the basis for any nonstatutory double patenting rejection.</p> <p>—In subsection II.B.2.(a), added a citation to and discussion of <i>Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.</i>, 611 F.3d 1381, 95 USPQ2d 1797 (Fed. Cir. 2010).</p> <p>—Updated cross-references in form paragraph 8.33.</p>
804.01	—Added explanation that a patentee cannot retroactively recover the safe harbor protection of 35 U.S.C. 121 against nonstatutory double patenting by amending a patent that issued from a continuation-in-part application to only subject matter in the parent application and redesignating the CIP as a divisional of the parent application. Also added supporting citations to <i>In re Janssen Biotech, Inc.</i> , 880 F.3d 1315, 125 USPQ2d 1525 (Fed. Cir. 2018) and <i>G.D. Searle LLC v. Lupin Pharm., Inc.</i> , 790 F.3d 1349, 115 USPQ2d 1326 (Fed. Cir. 2015).
804.02	—In subsection II, added citation to a footnote in <i>Eli Lilly & Co. v. Barr Labs., Inc.</i> , 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001) that explains that "[a] patent owner cannot avoid double patenting by disclaiming the earlier patent." Corrected the year to "1894" in the citation to <i>Miller v. Eagle Mfg. Co.</i> , 151 U.S. 186 (1894).
804.03	<p>—Updated cross-references to MPEP Chapters 700 and 2100 consistent with revisions made to those chapters.</p> <p>—Updated form paragraph 7.15.02.fti examiner note 4 in view of <i>Amgen v. Sanofi</i>, 872 F.3d 1367 (Fed. Cir. 2017).</p> <p>—Updated cross-references in form paragraphs 7.21.01.fti and 7.21.02.fti. Deleted duplicative reproductions of form paragraphs 7.21.01.aia and 7.21.01.fti.</p> <p>—In subsection II.A, revised text to clarify that the excepted subject matter is disclosed in the commonly owned or joint research agreement reference.</p>

804.05	—Added a new section that discusses the impact of patent term extension on nonstatutory double patenting.
806.05(j)	—Revised the example text to clarify that the immediate product as claimed is useful to make something other than the final product as claimed and modified that the cross-reference to MPEP § 806.05(d) is for subcombinations disclosed as usable together.
821.03	—Revised form paragraph 8.26 to set a shortened statutory period of two months for reply and to add "but in no case can any extension carry the date for reply beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
821.04	—Updated cross-reference in view of revisions to MPEP Chapters 700 and 2100 .
822	—Updated cross-references in view of revisions to MPEP § 608.01(m) and MPEP Chapters 700 and 2100 .

CHAPTER 900:

901.04	—Replaced cross-reference to MPEP § 706.02(f)(1) with cross-reference to MPEP § 2136 .
901.05(d)	—Replaced cross-reference to MPEP § 706.02 with cross-reference to MPEP § 2120 .
902.03(b)	—Updated URL for the Classification home page intranet website.
903.02	—Updated URL for the Office of Patent Classification internet website. —Updated URL for the Classification home page intranet website.
903.07	—Revised to remove reference to the Office Action Correspondence System (OACS). —Updated URL for the Classification home page intranet website.
903.08(d)	—Subsection III revised to replace references to the Patent File Wrapper (PFW) system with references to the Patent Transfer Inquiry (PTI) system.
903.08(e)	—Revised to replace references to the Patent File Wrapper (PFW) system with references to the Patent Transfer Inquiry (PTI) system.
904	—Revised to remove reference to the Office Action Correspondence System (OACS).
904.02(c)	—Revised to include guidance to examiners concerning the use of social media websites as a part of an internet search.
905.03	—Changed " www.wipo.int/export/sites/www/classifications/ipc/en/guide/guide_ipc.pdf " to " www.wipo.int/classifications/ipc/en/ "

CHAPTER 1000:

1002.02(c)	—Revised item 3.e to delete a reference to 37 CFR 1.127 due to its elimination in the final rule <i>Eliminating Unnecessary Regulations</i> , 84 Fed. Reg. 51977 (October 1, 2019).
1004	—Revised item 20 to reference Revision 08.2017 for MPEP § 602.01(c)(3) because MPEP § 602.01(c)(3) is not being retained in the current revision.

CHAPTER 1200:

1203	<p>—Added that the Patent Appeal Center will forward the application to the Board after the jurisdiction has transferred to the Board and, where waiver of the appeal forwarding fee doesn't apply, the Patent Appeal Center has processed the appeal forwarding fee, even if the applicant has filed a reply brief.</p> <p>—In subsection I, replaced Patent Appeals Center with Patent Appeal Center.</p>
1204	<p>—In subsection I, revised to add that appeal fees, including notice of appeal, petition, and appeal forwarding fees, due under 37 CFR 41.20 cannot be paid using a general authorization to a deposit account under 37 CFR 1.25(b).</p> <p>—Added cross-reference to MPEP § 1204.01 for appeal fees due upon reinstatement of an appeal.</p>
1204.01	<p>—Revised to clarify that when prosecution is reopened after the filing of a notice of appeal and prior to a written decision by the Board, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37 in order to reinstate the appeal.</p> <p>—Revised to provide clarification and exemplary explanations as to when a new or additional appeal fee is required.</p>
1204.02	<p>—Revised to add that a pre-appeal brief request that is found not compliant cannot be corrected and resubmitted to cure the reason(s) for non-compliance because the corrected request would not meet the requirement that the notice of appeal and pre-appeal brief request be filed on the same date.</p>
1205.01	<p>—Updated form paragraph 12.209.</p>
1205.03	<p>—Replaced Patent Appeals Center with Patent Appeal Center.</p> <p>—Removed reference to OACS.</p>
1207.01	<p>—Replaced Patent Appeals Center with Patent Appeal Center.</p>
1207.02	<p>—Replaced Patent Appeals Center with Patent Appeal Center.</p> <p>—Replaced cross-reference to MPEP § 706.02 with cross-reference to MPEP § 2120.</p>
1207.03	<p>—Revised to clarify that an examiner's answer containing a new ground of rejection must be signed by a Technology Center Director or their designee.</p> <p>—In subsection III, removed first paragraph.</p>
1207.03(b)	<p>—Revised to add that a petition requesting designation as a new ground of rejection must be filed within two months from the entry of the examiner's answer and prior to the filing of a reply brief.</p> <p>—Added discussion of <i>In re Timothy D. Durance et al.</i>, 891 F.3d 991, 127 USPQ2d 1141 (Fed. Cir. 2018)</p>
1208.01	<p>—Revised to clarify when a waiver of the appeal forwarding fee may be applied.</p>
1209	<p>—Updated the URL for the Patent Trial and Appeal Board's oral hearing website.</p>
1210	<p>—In subsection I, revised to indicate that the time period under which jurisdiction passes from the Technology Center to Board is specified in 37 CFR 41.35(a).</p> <p>—In subsection II, renamed subsection "Abandonment of Appeal: Abandonment, Continued Examination or Refiling of Case on Appeal." Revised to add that a request for continued examination may be filed to avoid the rendering of a decision by the Board.</p>
1214.03	<p>—Revised to add that if a timely request for rehearing of the Board's decision is filed, the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action expires 63 days after a decision on a request for rehearing or reconsideration (37 CFR 90.3(b)(1)). An applicant may file an RCE during the 63 day period available to appeal after decision on the rehearing request.</p>

1214.06	<p>—Updated form paragraphs 12.291, 12.292, and 12.297.</p> <p>—In subsection I, revised to clarify that when the Board affirms a rejection of an independent claim, and there is a dependent claim that was objected to as being allowable prior to the appeal, the application is held abandoned, as there is no remaining time period for redrafting the dependent claim in independent form.</p> <p>—In subsection II, revised item (B) to indicate a two-month time limit with extensions of time available under 37 CFR 1.136(a).</p>
1215.01	<p>—Revised to clarify that when an appeal has been withdrawn and contains claims that are allowed except for their dependency on a rejected claim, the application is held abandoned, as there is no remaining time period for redrafting the dependent claim in independent form.</p>
1215.04	<p>—Updated form paragraph 12.209.</p> <p>—In subsection III, revised to provide guidance for handling of applications in which an appeal is dismissed for failure to pay the appeal forwarding fee.</p>
1216.01	<p>—In subsection I.A, revised to indicate that once an application in which all claims are rejected is returned to the examiner from the U.S. Court of Appeals for the Federal Circuit, a notice of abandonment should be mailed unless the mandate clearly indicates that further action by the USPTO is to be taken. Further revised to indicate that the application may not be revived on petition to the USPTO, as the USPTO has no jurisdiction and lacks the authority to consider a petition to revive, and that in accordance with <i>Morganroth v. Quigg</i>, 885 F.2d 843, 845, 12 USPQ2d 1125, 1126 (Fed. Cir. 1989), the subject application may not be revived by the USPTO on petition because the USPTO’s authority to revive applications does not extend to an alleged abandonment resulting from actions taken in proceedings outside the agency.</p> <p>—In subsection I.B, revised to provide guidance for the handling of cases returned from the Court of Appeals for the Federal Circuit that contain claims previously objected to as allowable except for their dependency on a rejected claim.</p>

CHAPTER 1300:

1302.04	—Revised examiner notes in form paragraphs 13.02.02 and 13.06 to add "In no case can any extension carry the date for reply to an Office action beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
1302.04(e)	—Added cross-reference to MPEP § 1216.01 .
1302.05	—Added cross-reference to MPEP § 608.02(z) .
1302.08	—Revised to incorporate the procedure for performing an interference search described in a memorandum from Deputy Commissioner for Patent Examination Policy to the Patent Examining Corps on May 31, 2007. Further revised to add guidance on performing interference searches when claims of an application are entitled to different effective filing dates.
1302.14	—In subsection I, last paragraph, replaced “the rule” with a reference to 37 CFR 1.104(e) . —In subsection II, revised to include pre-appeal brief conference in the list of scenarios when reasons for allowance should be included in the record. —In subsection IV, revised to correct a typographical error replacing reference to form paragraph 13.13.01 with form paragraph 13.03.01.
1305	—Revised to include 35 U.S.C. 154 as a statute under which the USPTO could take action once a patent has been granted.
1306	—Revised to include a reminder that payment of the issue fee and any required publication fee is not extendable. Removed as unnecessary language indicating that applicants are no longer required to pay any balance of the issue fee when there is a fee increase. Revised to indicate that the Fee Transmittal form should be submitted with payment of the issue fee, even when no additional fee is due.
1306.01	—Added cross-reference to MPEP § 1306.03 .
1306.03	—Added cross-reference to MPEP § 1308 .
1308	—In subsection I.B, added new paragraph discussing the Quick Path Information Disclosure Statement Pilot Program (QPIDS). —In subsection II.A, revised to update the status code associated with applications that have been withdrawn from issue and are awaiting action by the examiner.
1308.01	—Revised to add cross-reference to MPEP § 706.07 .
1309	—Updated to reflect changes in the appearance of the bond paper copy of an issued patent. —In subsection II, revised to clarify that the Office does not look to the assignment record to determine the name of the assignee to be printed on the front of the patent.
1309.02	—Revised to replace eDan with Docket Application Viewer (DAV).

CHAPTER 1400:

1402	<p>—In subsection I, added to the discussion of <i>Medrad, Inc. v. Tyco Healthcare Group LP</i>, 466 F.3d 1047, 80 USPQ2d 1526 (Fed. Cir. 2006) to clarify that the reissue error resulted in invalid claims.</p> <p>—In subsection II, deleted “divisional” from the first sentence.</p> <p>—In subsection IV, added a citation to and discussion of <i>G.D. Searle LLC v. Lupin Pharm., Inc.</i>, 790 F.3d 1349, 115 USPQ2d 1326 (Fed. Cir. 2015) and made minor grammatical changes.</p>
1405	—Clarified text regarding the procedures for deleting a benefit claim under 35 U.S.C. 120 in a reissue application filed on or after September 16, 2012, and made minor grammatical changes.
1410	—Revised text regarding compliance with 37 CFR 1.173(b) and 37 CFR 1.173(b)-(e) and (g) to more closely match similar text in MPEP § 1411 . Revised text to clarify that the reissue applicant must provide a priority/benefit claim in the reissue application because such claims do not carry over from the patent for which reissue is being sought, and that where appropriate the reissue applicant may also file an information disclosure statement. Added a new paragraph regarding compliance with sequence rules for reissue applications that disclose nucleotide and/or amino acid sequences.
1410.01	—In subsection I, corrected the reproduction of 37 CFR 1.172 and 37 CFR 1.175 and added a sentence to define what “filed under 37 CFR 1.46 by the assignee of the entire interest” means and added a citation to 37 CFR 1.175(f)(1) .
1410.02	—In subsection I, revised text regarding procedures when a copy of the assignee consent from the parent reissue application is filed in a continuation reissue application or in a divisional reissue application.
1411.02	—Replaced cross-reference to MPEP § 706.03(c) with cross-reference to MPEP § 2166 and replaced cross-reference to MPEP § 706.03(o) with cross-reference to MPEP § 608.04(a) .
1412.01	—Changed “reissued patent” to “reissue patent” in the discussion of <i>Antares Pharma Inc. v. Medac Pharma Inc. and Medac GMBH</i> , 771 F.3d 1354, 112 USPQ2d 1865 (Fed. Cir. 2014). In subsection I, made minor grammatical changes.
1412.02	<p>—Changed “reissued patent” to “reissue patent” in the discussion of <i>In re Mostafazadeh</i>, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011).</p> <p>—In subsection IV, replaced the cross-reference to MPEP § 706.02(n) with cross-reference to MPEP § 2147.</p>
1412.03	—In subsection IV, in the examiner notes accompanying form paragraphs 14.12 and 14.13, deleted the cross-references to MPEP § 706.03(x) .
1414	—In subsection II, in examiner note 1 of form paragraph 14.14, replaced the cross-reference to MPEP § 706.03(x) with a cross-reference to MPEP § 1444 , subsection II.
1415	—In subsection V, updated text to reflect that form PTO/SB/56 is not available on the USPTO website.
1415.01	—In subsection I, revised text to discuss the changes to the payment of maintenance fees in reissue utility patents and original utility patents as set forth in <i>Setting and Adjusting Patent Fees During Fiscal Year 2017</i> , 82 FR 52780 (November 14, 2017) (“Final Fee Rule”).
1416	—Changed “reissued patent” to “reissue patent” in the last paragraph.
1441.01	—In subsection I, revised text to clarify that a third-party submission directed to a reissue application that would otherwise be compliant with 37 CFR 1.290 will be entered into the record of the reissue application as a protest under 37 CFR 1.291 . Changed three occurrences of “preissuance” (including one in the subsection heading) to “pre-issuance.”
1442.05	—Deleted “his or her” prior to “assignee” to use gender-neutral wording.

1444	—In subsection II, in examiner note 1 of form paragraph 14.14, replaced the cross-reference to MPEP § 706.03(x) with a cross-reference to MPEP § 1444 , subsection II.
1450	—Revised text to make minor corrections, such as changing “continued” to “continue,” “reissued patent” to “reissue patent,” “containing” to “contains,” “occurred” to “will occur,” and “issued” to “issues.”
1451	<p>—In the preamble text prior to subsection I, revised and reorganized text to clarify the procedures to indicate that the application is a “continuation” or “divisional” of its parent reissue application and made minor corrections, such as changing “reissued patent” to “reissue patent.”</p> <p>—Examples 1-9 were indicated to be examples of acceptable identification for “the first sentence(s) of the specification” in the text preceding the examples. The text was also clarified to recommend that the first line of the specification contain the language set forth in the examples, even though the application data sheet contains the benefit claim(s).</p> <p>—In subsection I, added a new first paragraph to discuss how the Office of Patent Application Processing (OPAP) will treat a divisional reissue application filed with both a copy of the assignee consent and a copy of the oath or declaration from its parent reissue application. Deleted a parenthetical phrase in the fourth paragraph that referred to pre-AIA procedures and revised text discussing terminal disclaimers to account for terminal disclaimers filed under 37 CFR 1.321(c) and 37 CFR 1.321(d).</p> <p>—In subsection I.A, rewrote text to clarify that a copy of the assignee consent from a parent reissue application is only acceptable if the divisional reissue is correcting the same error for which consent was previously made.</p> <p>—In subsection I.B, added new subsection 1 to discuss the requirements for submitting a copy of the reissue oath or declaration from a parent reissue application. Added new subsection heading “2. Error Statement” and revised and reorganized existing text in the subsection that discusses the requirements for the error statement in an oath or declaration submitted in a continuing reissue application.</p> <p>—In subsection II, added a new first paragraph to discuss how OPAP will treat a continuation reissue application filed with both a copy of the assignee consent and a copy of the oath or declaration from its parent reissue application. Added two cross-references to subsection I and revised text discussing terminal disclaimers to account for terminal disclaimers filed under 37 CFR 1.321(c) and 37 CFR 1.321(d).</p> <p>—In subsection II.A, added the subsection heading and rewrote text to clarify that a copy of the assignee consent from a parent reissue application is only acceptable if the continuation reissue is correcting the same error for which consent was previously made.</p> <p>—In subsection II.B, added the subsection heading and rewrote text to state that OPAP will accept a copy of the oath or declaration in a continuation reissue and that applicant should explain why a copy of the oath or declaration is sufficient in reissue applications filed on or after September 16, 2012. Added new subsection 1 to discuss the requirements for submitting a copy of the reissue oath or declaration from a parent reissue application. Added new subsection indicator “2. Error Statement” and revised and reorganized text that provides examples to discuss the requirements for the error statement in an oath or declaration submitted in a continuation reissue application.</p>
1453	—In the preamble text before subsection I, deleted a redundant sentence relating to compliance with 37 CFR 1.173(b) . In subsection VI, changed “reissued patent” to “reissue patent” in item (A).
1470	—In the section heading, changed “of” to “to.”
1481.02	—In subsection I, corrected a typographical error in the reproduction of 35 U.S.C. 256(a) . —In subsection III, corrected “Form PTOL-360” to “Form PTOL-306.”
1481.03	—In subsection II.A, added “after patent grant” after “certificate of correction” for clarity. Added citations to and discussion of <i>In re Janssen Biotech, Inc.</i> , 880 F.3d 1315, 125 USPQ2d 1525

(Fed. Cir. 2018) and *G.D. Searle LLC v. Lupin Pharm., Inc.*, 790 F.3d 1349, 115 USPQ2d 1326 (Fed. Cir. 2015).

[1485](#)

—In subsection I, updated the URL for the Official Gazette.

[1490](#)

—In subsection I, reorganized text and added citations to and discussion of *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, 853 F.3d 1370, 122 USPQ2d 1301 (Fed. Cir. 2017) and *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001).

—In subsection II, added a new paragraph discussing [37 CFR 1.321\(a\)](#) and the review of terminal disclaimers filed in patents that are not under reexamination.

—In subsection IV, corrected the citation to [37 CFR 1.321\(a\)](#) in item (A).

—In subsection V.A, added text discussing when an electronic TD (eTD) can be filed and updated the URL for the web page that contains more information on eTDs.

—In subsection V.B, added a new paragraph discussing the effect of approval of a terminal disclaimer by the paralegal or TQAS and indicating the examiner must determine whether the correct target application or patent is identified in the terminal disclaimer before withdrawing the nonstatutory double patenting rejection(s) based on the target application or patent.

—In subsection VI.A, replaced the cross-reference to [MPEP § 706.02\(1\)\(2\)](#) with a cross-reference to [MPEP § 2146.02](#). Added a quotation and citation to *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001), and a new paragraph indicating any terminal disclaimer submitted after the date of payment of the issue fee but prior to patent grant requires the filing of a certificate of correction requesting that the face of the patent be amended to state that the patent is subject to a terminal disclaimer.

—In subsection VI.B, changed “reissued patent” to “reissue patent” in the last sentence.

—In subsection VI.D, changed the abbreviation for nonstatutory double patenting to NSDP.

—In subsection VII, updated the URL for the forms web page in the reproduction of form paragraphs 14.37 and 14.38.

—In subsection VII.B, changed “reissued patent” to “reissue patent.”

—In subsection IX, updated the copies of the forms.

CHAPTER 1500:

1503.01	—Inserted “pre-AIA” in four locations.
1503.02	—Inserted “pre-AIA” in five locations.
1504	—Added form paragraph 15.66.01.
1504.03	—Updated the cross-references to former MPEP sections in form paragraphs 15.19.03.fti, 15.19.04.fti, 15.19.05.aia, and 15.19.06.fti; and corrected a typographical error in form paragraph 15.19.05.aia.
1504.04	—Revised to better distinguish pre-AIA practice under 35 U.S.C. 112 from the practice followed in applications filed on or after September 16, 2012. Updated form paragraphs 15.21, 15.22, and 15.22.02.
1504.06	—In subsection II, updated the URL for the forms web page in form paragraph 15.24.06.
1504.20	—Inserted “pre-AIA” in two locations.

CHAPTER 1700:

1701	<p>—Revised section title and text to include the expiration date of a specific patent among the list of issues that Office personnel should not express an opinion on except to the extent necessary to carry out specified tasks.</p> <p>—Added a paragraph discussing general information that Office employees may provide regarding patent term.</p>
1701.01	<p>—Revised the references to numbers of days to include both the word and number (e.g., “ten (10)”).</p>
1702	<p>—Revised to use gender-neutral wording.</p>
1703	<p>—Updated to reflect current Official Gazette information pertaining to the classification of patents.</p>
1705	<p>—Revised to use gender-neutral wording.</p>
1720	<p>—Revised to update MPEP cross-references as a conforming change.</p>
1721	<p>—Revised to clarify procedure regarding treatment of court and PTAB decisions affecting Office policy and practice.</p>
1730	<p>—Revised to use gender-neutral wording.</p> <p>—In subsection II.B.1, deleted former paragraph (f) directed to information about the Global Patent Search Network and replaced it with new paragraph (f) directed to information on Global Dossier Public Access.</p> <p>—In subsection II.B.2, updated URLs to USPTO web pages and the description of the Office of Finance Online page. Updated information regarding ordering patent documents online. Also added description of presentation patents.</p> <p>—In subsection III, updated the URL to page on the USPTO website.</p> <p>—In subsection VI.E, deleted former method for facsimile, email, and online document ordering and added information regarding the Certified Copy Center Storefront for ordering patent documents.</p>

CHAPTER 1800:

<i>Passim</i>	—Changed some occurrences of “that is” to “i.e.” —Changed some occurrences of “Nos.” to “numbers” or “numbered.”
1801	—In subsection V, revised to remove Uganda (UG) from the list of countries that have not adopted PCT Article 22(1) as amended effective April 1, 2002. —In subsection VI, revised to reflect changes to PCT Rule 69.1 that became effective on July 1, 2019.
1805	—Revised to more specifically set forth the situations when an international application filed with, or forwarded to, the International Bureau is not required to have a foreign filing license.
1809	—Revised to number the requirements for access to Private PAIR. In what is now number (3), changed “digital certificate” to “verified USPTO.gov account.”
1821	—In subsection III, revised “12 characters” to “25 characters” in three places for consistency with revisions to PCT Administrative Instructions Section 109 and the PCT Receiving Office Guidelines that became effective on January 1, 2019.
1828.01	—Revised to more specifically set forth the situations when an international application filed with, or forwarded to, the International Bureau is not required to have a foreign filing license. —“PCT Article 2(ix)” was corrected to read “PCT Article 2(xi).”
1832	—Revised to more specifically set forth the situations when an international application filed with, or forwarded to, the International Bureau is not required to have a foreign filing license.
1834.02	—“(PCT Rule 82 <i>quater</i>)” was changed to “See PCT Rule 82 quater .”
1840	—Revised to include Jordan among the countries for which the USPTO has agreed to conduct international searches and prepare international search reports and written opinions of the International Searching Authority.
1840.01	—Revised to reference the Official Gazette notices announcing the arrangement with the European Patent Office (EPO) as an International Searching Authority. —Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with the EPO as an ISA. —Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.
1840.02	—Revised to reference the Official Gazette notice that announced the arrangement with the Korean Intellectual Property Office (KIPO) as an International Searching Authority. —Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with the KIPO as an ISA. —Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.
1840.03	—Revised to reference the Official Gazette notices announcing the arrangement with the Australian Patent Office (IP Australia) as an International Searching Authority. —Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with IP Australia as an ISA. —Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.
1840.04	—Revised to reference the Official Gazette notice that announced the arrangement with the Federal Service for Intellectual Property (Rospatent) (Russian Federation) as an International Searching Authority.

	<p>—Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with Rospatent as an ISA.</p> <p>—Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.</p>
1840.05	<p>—Revised to reference the Official Gazette notices announcing the arrangement with the Israel Patent Office (ILPO) as an International Searching Authority.</p> <p>—Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with the ILPO as an ISA.</p> <p>—Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.</p>
1840.06	<p>—Revised to reference the Official Gazette notices announcing the arrangement with the Japan Patent Office (JPO) as an International Searching Authority.</p> <p>—Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with the JPO as an ISA.</p> <p>—Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.</p>
1840.07	<p>—Revised to reference the Official Gazette notice that announced the arrangement with the Intellectual Property Office of Singapore (IPOS) as an International Searching Authority.</p> <p>—Further revised to reference the PCT Information section of the Official Gazette for any limitations or restrictions with the IPOS as an ISA.</p> <p>—Further revised to reference Annex D of the PCT Applicant’s Guide for additional information, e.g., subject matter limitations, additional search fee, cited documents, etc.</p>
1842	<p>—Updated the PCT Timeline to a version showing 22 months (see PCT Rule 45 bis.1(a)) for the time period to request supplementary international search.</p> <p>—In subsection VII.A, revised to remove Uganda (UG) from the list of countries that have not adopted PCT Article 21(1) as amended effective April 1, 2002.</p>
1844.01	<p>—In subsection I.C, revised to be more consistent with the language found on form PCT/ISA/210.</p> <p>—In subsection III, revised to be more consistent with the language found on form PCT/ISA/210.</p> <p>—In subsection V, revised to change “patent classification” to “Cooperative Patent Classification (CPC).”</p> <p>—In subsection VII.A.7, revised to discuss new document category “D” introduced in Section 507 of the PCT Administrative Instructions on July 1, 2019.</p> <p>—In subsection VIII, revised to include the January 2019 version of form PCT/ISA/210.</p>
1845.01	<p>—In subsection I, revised to be more consistent with the language found on form PCT/ISA/237.</p> <p>—In subsection X, revised to include the January 2019 version of form PCT/ISA/237.</p>
1845.02	<p>—Revised to include the January 2019 version of form PCT/ISA/220.</p>
1848	<p>—Revised to clarify the furnishing of a sequence listing in response to an invitation under PCT Rule 13 ter.1(a) or (b) requires payment of a late furnishing fee within the time limit fixed in the invitation, or the search undertaken by the International Searching Authority may be limited.</p>
1856	<p>—Updated “prior to the expiration of 19 months” to “prior to the expiration of 22 months” in both PCT Rule 45 bis.1(a) and associated guidance to reflect a change that became effective on July 1, 2017.</p>
1857	<p>—In subsection I, updated “www.patentscope.wipo.int/search/en/sequences.jsf” to “https://patentscope.wipo.int/search/en/sequences.jsf.”</p>

1865	<p>—Revised to include Jordan among the countries for whose residents and nationals the USPTO will serve as International Preliminary Examining Authority if the USPTO was the ISA.</p> <p>—Revised to include the July 2019 version of the PCT Demand (form PCT/IPEA/401).</p>
1871	—Revised to reflect the changes to PCT Rule 69.1 that became effective on July 1, 2019.
1878	—In subsection I, revised to be more consistent with the language found on form PCT/IPEA/408.
1879	<p>—Revised to change “classification required by the IPEA/US” to “CPC classification required by the IPEA/US.” Further revised to change “OACS” to “Official Correspondence (OC).”</p> <p>—In subsection I, revised to be more consistent with the language found on form PCT/IPEA/409, including the removal of “or pages” from “claim nos. or pages” and clarifying what the examiner must indicate if the report has been based on a nucleotide and/or amino acid sequence disclosed and necessary to the claimed invention.</p> <p>—Revised to include the January 2019 version of form PCT/IPEA/409 with a notification of transmittal (form PCT/IPEA/416) showing a mailing date of July 10, 2019.</p>
1879.01	—Revised to reflect the changes to PCT Rule 69.1 that became effective on July 1, 2019.
1893	—Revised the list of types of U.S. national applications to include international design applications filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.
1893.01(a)(1)	—Changed “ www.uspto.gov/ebc/efs_help.html ” to “ www.uspto.gov/patents-application-process/file-online. ”
1893.01(a)(2)	—Changed “ www.uspto.gov/forms ” to “ www.uspto.gov/patent/patents-forms. ”
1893.01(a)(3)	—Changed “ www.uspto.gov/forms ” to “ www.uspto.gov/patent/patents-forms. ”
1893.01(a)(4)	—Revised to indicate claim listings that include alternative status identifiers as set forth in MPEP § 714 , subsection II.C, item (E) will be accepted if the amendment otherwise complies with 37 CFR 1.121 .
1893.01(c)	—Changed “ 37 CFR 1.495(c)(3) ” to “ 37 CFR 1.495(c)(2) .”
1893.02	<p>—Changed “www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.jsp” to “www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web.”</p> <p>—Changed “www.uspto.gov/forms” to “www.uspto.gov/patent/patents-forms.”</p>
1893.03(c)	<p>—Replaced the priority document cover sheet with a priority document cover sheet indicating filing outside the United States of America (application JP 2017-075548, filed in Japan on April 5, 2017, and received by the International Bureau on April 12, 2018).</p> <p>—In subsection III, updated the discussion of the requirements for benefit under 35 U.S.C. 120 and 35 U.S.C. 365(c) to remove “in the first sentence(s) of the specification.”</p>
1893.03(e)	—Changed “nos. or pages” to “numbers.”
1895.01	—Revised to remove an example of the first sentence of a continuation application meeting the requirements of 37 CFR 1.78(h) in a nonprovisional application resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012.

CHAPTER 1900:

1901	<p>—Updated the reproduction of 37 CFR 1.291 and 37 CFR 1.248 to correspond to current rule language.</p> <p>—Added text to clarify that it is Office policy that a protest cannot be filed in a provisional application.</p> <p>—Clarified text regarding 37 CFR 1.291(b) that a timely received protest will be entered if it complies with 37 CFR 1.291(c) and is accompanied by the statement under 37 CFR 1.290(b)(2) or complies with 37 CFR 1.291(c)(5).</p> <p>—Updated the discussion of the requirements of 37 CFR 1.291(c) to reflect the current rule text. To clarify current Office procedures, added a detailed discussion of the requirements of the information list, the legible copy of each item identified in the list, and an English translation of any non-English language item identified in the list.</p> <p>—Added a sentence to clarify that a protest that specifically identifies the application and is otherwise compliant will be considered if it is matched with the application in time to permit review by the examiner.</p>
1901.01	<p>—Added a sentence to clarify that, in accordance with 37 CFR 1.290(b)(2), a statement must accompany the protest that it is the first protest submitted by the real party in interest.</p> <p>—Added text to clarify that the requirements of 37 CFR 1.290(b)(2) do not apply to the first protest filed in an application and to address the situation where the protestor may not know if a protest has already been filed by another member of the public.</p>
1901.02	<p>—Updated text to discuss both pre-AIA patentability requirements as well as current patentability requirements.</p> <p>—Deleted discussion regarding public use proceedings (effective September 16, 2012, former 37 CFR. 1.292 authorizing petitions seeking institution of public use proceedings was removed from title 37).</p> <p>—Added indication that when submitting protected or secret material, a protestor should follow the procedures in MPEP § 724.</p>
1901.03	<p>—Updated the discussion of the requirements of 37 CFR 1.291(c) to reflect the current rule text.</p> <p>—Added text to clarify that in the event service of the protest is not possible, the protest should be accompanied by an explanation of why service could not be made.</p> <p>—Revised to update the information that the first page of the protest should include to assist in matching the protest with the application.</p> <p>—Updated text regarding the mailing address for a protest and added explanation that a protest must not be submitted electronically to the Office.</p> <p>—Added “by application number” after “directed” in the paragraph discussing the situation if the protestor is unable to identify the application by the application number. Updated text to remove the suggestion to annotate in a brightly colored ink and replaced with text that states that the protest should be “conspicuously” marked if the application is involved in litigation.</p> <p>—In the subsection heading and text, deleted “initial” before “protest.” Revised subsection for consistency with current Office policy that a protest not accompanied by a copy of each document relied on (except for U.S. patents and U.S. patent application publications) as required by 37 CFR 1.291 will not be entered. Added a new last paragraph that is revised text moved from MPEP § 1901.05, subsection II, to clarify that a protest filed without indicating that service was made will not be entered if not submitted in duplicate.</p>
1901.04	<p>—Revised section title to replace “Should” with “Can.” Updated the discussion of the requirements of 37 CFR 1.291(b) to reflect the current rule text.</p> <p>—Added text to clarify that a publication under the Patent Cooperation Treaty or under the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial</p>

	<p>Designs by World Intellectual Property Organization (WIPO) would not trigger the end of the time period set in 37 CFR 1.291(b) for submitting a protest in a national stage application or an international design application, respectively. Also corrected a spelling error and made other minor corrections.</p>
1901.05	<p>—Revised section title to “Acknowledgement of Protest” and limited text to when the Office will or will not acknowledge a protest when it is filed.</p> <p>—Information regarding when protests are referred to the examiner, previously set forth in subsection I, has been moved to MPEP § 1901 and updated for consistency with current Office policy.</p> <p>—Information regarding Office practice when the protest does not indicate service, previously set forth in subsection II, has been moved to MPEP § 1901.03 and updated for consistency with Office policy.</p> <p>—The heading of subsection III has been deleted; the text therein has been revised to clarify that the Office will acknowledge receipt of the protest and to remove that such acknowledgement is made “prior to the protest’s entry into the application file or return to the protestor, as appropriate.”</p> <p>—Former subsection IV is renumbered as subsection I and revised to add cross-references to MPEP §§ 1134 and 1901.06, subsection II, to update the name of the Patent Trial and Appeal Board, to revise the text referring to PAIR to more generally refer to the Office’s public application image file wrapper, and to update the cross-reference to 37 CFR 1.14(a)(1)(i) to correspond with current rule text.</p>
1901.06	<p>—Revised section title to “Office Treatment of Protest.”</p> <p>—Subsection I, directed to the initial review of protests, has been rewritten to explain that the Office reviews protests to determine if they are compliant with the relevant provisions of 37 CFR 1.291 before making a protest of record in an application; the revised text is consistent with text in MPEP § 1134.01, subsection VI.A. Subsection I also revised to clarify certain instructions to the examiner if a compliant protest is filed in a reissue application.</p> <p>—In subsection II, changed “primary examiner’s” to “Office’s” in the first sentence and deleted the last sentence in the paragraph discussing 37 CFR 1.291(f) for consistency with current rule text. Revised form paragraph 19.02 to set a shortened statutory period of two months for reply and to add “but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133).”</p> <p>—In subsection III, revised the subsection heading and text to make it clear that the examiner must not communicate with the protestor.</p> <p>—In subsection IV, revised the subsection heading and text to discuss examiner’s actions on an entered protest. Deleted text discussing procedures for noncompliant protests, which is now addressed in subsection I of this section.</p> <p>—In subsection V, revised the subsection heading.</p> <p>—In subsection V.A, revised to state that a protest submitted on or after the date the application is published will not be entered if it is not accompanied by the written consent of the applicant.</p> <p>—In subsection V.B, revised by deleting the first paragraph and modifying the second paragraph to be consistent with the current text of 37 CFR 1.291(b)(1).</p> <p>—Deleted former subsection VI pertaining to copies of documents; see MPEP § 1901.03 as revised for the current Office practice.</p> <p>—Renumbered former subsection VII to VI and revised to clarify that the examiner will not treat or discuss any arguments or issues relating to inequitable conduct of the applicant.</p> <p>—Renumbered former subsection VIII to VII.</p>
1901.07	<p>—Updated the name of the Patent Trial and Appeal Board.</p> <p>—Deleted the last paragraph discussing 37 CFR 1.291(f) because this topic is covered in MPEP § 1901.06, subsection II.</p>

1901.07(a)	—Updated the discussion of the requirements of 37 CFR 1.291(b) and (c) to reflect the current rule text.
1906	—Updated the name of the Patent Trial and Appeal Board.
1907	—Added a cross-reference to MPEP § 1134 .
1920	—Updated the discussion of the requirements of 37 CFR 1.501(a) to reflect the current rule text.

CHAPTER 2000:

2004	—Replaced cross-reference to MPEP §§ 706.02(1)-706.02(1)(2) with cross-reference to MPEP §§ 2146-2146.02 .
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CHAPTER 2100:

<i>Passim</i>	<p>—Changed “unobvious” to “nonobvious” (except when used in a quote) to be more consistent with 35 U.S.C. 103.</p> <p>—Changed “disqualify” or “disqualified” to “except” or “excepted,” respectively, when discussing the prior art exceptions in 35 U.S.C. 102(b) and (c).</p>
2103	<p>—In subsection I, revised heading to "DETERMINE WHAT INVENTION IS SOUGHT TO BE PATENTED." Added text to state that the bases for rejections not based on prior art should be fully explained and to add cross-references for guidance regarding reissue applications, reexaminations, and supplemental examination proceedings.</p> <p>—In subsection I.A, added text to incorporate guidance from <i>2019 Revised Patent Subject Matter Eligibility Guidance</i>, 84 FR 50 (January 7, 2019) and <i>October 2019 Patent Eligibility Guidance Update</i>, 84 FR 55942 (October 18, 2019).</p> <p>—In subsection III.A, in the first paragraph, added "(have utility)" after "useful" and, in the last sentence, added "only" prior to "issues" to clarify that examiners should consider all issues regarding patentability and not solely focus on patent eligibility issues.</p> <p>—In subsection IV.A, rewrote the second sentence to clarify that when there is evidence, e.g., admissions, that shows what the inventor or a joint inventor regards as the invention is different from what is claimed, then the application is deficient under the first requirement of 35 U.S.C. 112(b).</p> <p>—In subsection IV.B, made several minor editorial changes, including providing a full citation to <i>Fonar Corp. v. General Elec. Co.</i></p> <p>—In subsection VI, made several minor editorial changes.</p>
2104	<p>—Changed the title to "Requirements of 35 U.S.C. 101."</p> <p>—Revised to incorporate subject matter from MPEP § 706.03(a).</p> <p>—Divided content into a preamble and four subsections: “I. Double Patenting”; “II. Naming of Inventor”; “III. Subject Matter Eligibility”; and “IV. Utility.”</p>
2104.01	<p>—New subsection incorporating content from MPEP § 706.03(b).</p>
2105	<p>—In subsection I, revised to correct the citation to <i>J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.</i></p> <p>—In subsection II, revised to update the citation to <i>Association for Molecular Pathology v. Myriad Genetics, Inc.</i></p> <p>—In subsection III, added the reproduction of form paragraph 7.04.03.</p>
2106	<p>—Revised to incorporate guidance from <i>2019 Revised Patent Subject Matter Eligibility Guidance</i>, 84 FR 50 (January 7, 2019) and <i>October 2019 Patent Eligibility Guidance Update</i>, 84 FR 55942 (October 18, 2019).</p>
2106.03	<p>—Made minor editorial changes.</p> <p>—In subsection I, corrected the citation to <i>Samsung Electronics Co. v. Apple Inc.</i></p> <p>— In subsection II, removed or updated the cross-references to MPEP § 706.03(a).</p>
2106.04-2106.06	<p>—Revised to incorporate guidance from <i>2019 Revised Patent Subject Matter Eligibility Guidance</i>, 84 FR 50 (January 7, 2019) and <i>October 2019 Patent Eligibility Guidance Update</i>, 84 FR 55942 (October 18, 2019).</p>
2106.07-2106.07(a)	<p>—Revised to incorporate guidance from <i>2019 Revised Patent Subject Matter Eligibility Guidance</i>, 84 FR 50 (January 7, 2019) and <i>October 2019 Patent Eligibility Guidance Update</i>, 84 FR 55942 (October 18, 2019).</p>
2106.07(a)(1)	<p>—New subsection "Form Paragraphs for Use in Lack of Subject Matter Eligibility Rejection."</p>

2106.07(b)	—Revised to incorporate guidance from <i>2019 Revised Patent Subject Matter Eligibility Guidance</i> , 84 FR 50 (January 7, 2019) and <i>October 2019 Patent Eligibility Guidance Update</i> , 84 FR 55942 (October 18, 2019).
2107.01	—Updated cross-references as a conforming change.
2107.02	—In subsection IV, added form paragraphs 7.04.01 and 7.05.02 through 7.05.04.
2109	—A new section that incorporates subject matter from MPEP § 2137.01 . Subsection V incorporates subject matter from MPEP § 2137.02 . Subsection VI incorporates subject matter from MPEP § 706.02(k) , subsection III.
2109.01	—New section that incorporates subject matter from MPEP § 2137.02 .
2111	—Revised to clarify that the USPTO uses a different claim interpretation standard than courts during the examination of patent applications.
2111.01	—In subsection I, added “(BRI)” in the first sentence to define that abbreviation used later in the section. —In subsections IV and V, made minor grammatical corrections.
2111.02	—In subsections I and II, added “as drafted without importing ‘extraneous’ limitations from the specification” in the description of <i>Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.</i> , 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989). —In subsection II, added the citation to and discussion of <i>Nantkwest, Inc. v. Lee</i> , 686 Fed. App’x. 864, 867 (Fed. Cir. 2017) and modified the second paragraph to clarify that a recited purpose or intended use limitation in a claim may or may not be limiting.
2111.04	—In subsection I, corrected the volume in the citation of <i>Griffin v. Bertina</i> . —In subsection II, removed “(precedential)” after the citation of <i>Ex parte Schulhauser</i> .
2111.05	—Added to the discussion of <i>In re DiStefano</i> and added a citation to <i>In re Gulack</i> , 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). —In subsection I, changed title to “Determining whether a functional relationship exists between printed matter and associated substrate.” —In subsection I.B, added to the discussion of <i>Gulack</i> and corrected a typographical error. —In subsection II, changed title to “Functional relationship between printed matter and associated substrate must be new and unobvious.”
2112	—In subsection III, changed “35 U.S.C. 102/103” to “35 U.S.C. 102 and 103” and deleted the phrase “expressed as a 102/103 rejection” from the first sentence. —In subsections IV and V, deleted “tending” from the title of the subsections.
2112.02	—In subsection I, changed “35 U.S.C. 102/103” to “35 U.S.C. 102 and 103,” deleted “ <i>prima facie</i> case” prior to “rejections,” and made other minor grammatical corrections.
2113	—In subsection I, added a citation to and discussion of <i>In re Nordt Dev. Co.</i> , 881 F.3d 1371, 125 USPQ2d 1817 (Fed. Cir. 2018). —In subsection II, changed the title to read “ONCE A PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS FOUND AND A PRIOR ART REJECTION IS MADE, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN UNOBVIOUS DIFFERENCE” and made corrections to the citation of <i>In re Marosi</i> . —In subsection III, changed the title to read “A REJECTION BASED ALTERNATIVELY ON 35 U.S.C. 102 OR 103 FOR PRODUCT-BY-PROCESS CLAIMS HAS BEEN APPROVED BY THE COURTS.”
2117	—Revised to create subsections I – “Markush Claim”; subsection II – “Determine Whether Markush Grouping Is Proper”; Subsection III – “Rejection Based on Improper Markush Grouping”; and Subsection IV- “Markush Grouping Examples.” New subsections II-IV incorporate subject matter from previous MPEP § 706.03(y) .

	Subsection I contains the previous subject matter of MPEP § 2117 but revised to delete cross-references to MPEP § 706.03(y) .
2120	—New section that incorporates subject matter from previous MPEP § 706.02 .
2120.01	—New section that incorporates subject matter from previous MPEP § 706.02(a) .
2120.02	—New section that incorporates subject matter from previous MPEP § 706.02(c) .
2121.01	—In the introduction, changed “date of invention” to “effective filing date of the claimed invention for applications or patents subject to the first inventor to file provisions of the AIA or the time the invention was made for applications or patents subject to pre-AIA law.” —In subsection I, revised text to clarify that a reference may anticipate the claimed invention even if the reference does not teach how to make the article disclosed or how to use the method disclosed.
2121.03	—Added a cross-reference to MPEP § 2152.02(d) .
2121.04	—Added a citation to and description of <i>In re Bager</i> , 47 F.2d 951, 8 USPQ 484 (CCPA 1931).
2124	—Changed the title to “Exception to the Rule That the Reference Must Be Prior Art.” —Added “showing the state of the art existing after the effective filing date of the application” after “later factual reference.” Corrected the pinpoint citation of <i>In re Koller</i> and added a citation to and discussion of <i>Amgen Inc. v. Sanofi</i> , 872 F.3d 1367, 124 USPQ2d 1354 (Fed. Cir. 2017).
2124.01	—In subsection II, added form paragraph 7.06.01.
2125	—In subsection II, added pinpoint pages to the citation of <i>In re Wright</i> and added “[the reference’s]” after “Bauer’s” to make it clear that Bauer is a reference in the discussion of the court decision.
2127	—In subsection II.A, added “or application publication” in the title and the body of the text and deleted “issues into a patent since this is the date the application” to make the text equally applicable to U.S. patent application publications as to U.S. patents. —In subsection IV, updated cross-references as a conforming change.
2128	—Added an Editor Note. —In subsection I, added citations to and explanations of <i>Voter Verified, Inc. v. Premier Election Solutions</i> , 698 F.3d 1374, 104 USPQ2d 1553 (Fed. Cir. 2012) and <i>Medtronic, Inc. v. Barry</i> , 891 F.3d 1368, 127 USPQ2d 1208 (Fed. Cir. 2018). Added a new last paragraph to explain the manner in which an applicant may challenge the public availability and/or accessibility date of a prior art document in an examination of a patent application or during a reexamination proceeding. —In subsection II.A, changed “such as” to “obtained from” in the last sentence. —In subsection II.B, added cross-reference to Subsection I. —Added new subsection II.E regarding the use of the Wayback Machine as a source of prior art. —Added new subsection II.F regarding the use of social media as a source of prior art. —In subsection III, added a citation of and quotation from <i>Jazz Pharm., Inc. v. Amneal Pharm., LLC</i> , 895 F.3d 1347 (Fed. Cir. 2018) and made minor editorial changes.
2128.01	—Added introductory text, including a citation to <i>Constant v. Advanced Micro-Devices, Inc.</i> , 848 F.2d 1560, 7 USPQ2d 1057, 1062 (Fed. Cir. 1988). —In subsection I, changed the title to “A THESIS PLACED IN A UNIVERSITY LIBRARY OR A DOCUMENT PLACED IN AN ONLINE DATABASE MAY BE PRIOR ART IF SUFFICIENTLY ACCESSIBLE TO THE PUBLIC.” Revised the discussion of <i>In re Cronyn</i> . Deleted text discussing the dissent in <i>In re Cronyn</i> and

	<p>the citation to and discussion of <i>In re Tenney</i> and <i>Deep Welding, Inc. v. Sciaky Bros.</i> Added citations to and discussions of <i>Voter Verified, Inc. v. Premier Election Sols., Inc.</i>, 698 F.3d 1374, 104 USPQ2d 1553 (Fed. Cir. 2012) and <i>Acceleration Bay, LLC v. Activision Blizzard Inc.</i>, 908 F.3d 765, USPQ2d 1507 (Fed. Cir. 2018).</p> <p>—In subsection IV, changed the title to “PUBLICLY DISPLAYED REFERENCES CAN CONSTITUTE A ‘PRINTED PUBLICATION’ EVEN IF THE REFERENCES ARE NOT DISSEMINATED BY COPIES OR INDEXED IN A LIBRARY OR DATABASE.” Deleted the citation and explanation of <i>Diomed, Inc. v. Angiodynamics</i>. Added citations to and discussions of <i>Medtronic Inc. v. Barry</i>, 891 F.3d 1368, 127 USPQ 1208 (Fed. Cir. 2018); <i>Jazz Pharm., Inc. v. Amneal Pharm., LLC</i>, 895 F.3d 1347, 127 USPQ2d 1485 (Fed. Cir. 2018); and <i>GoPro, Inc. v. Contour IP Holding LLC</i>, 908 F.3d 690, 128 USPQ2d 1447 (Fed. Cir. 2018).</p>
2128.02	—In subsection I, added citation to and explanation of <i>In re Lister</i> , 583 F.3d 1307, 92 USPQ2d 1225 (Fed. Cir. 2009).
2129	—In subsection I, revised to incorporate subject matter from previous MPEP § 706.02 , subsection III.
2132	—In subsection II, revised to incorporate subject matter from MPEP § 706.02(c)(2) regarding the meaning of “in this country” as used in pre-AIA 35 U.S.C. 102(a) . —In subsection III, changed “Than” to “From” in the subtitle.
2132.01	—Changed the title to “Overcoming a Pre-AIA 35 U.S.C. 102(a) Rejection Based on a Printed Publication or Patent.” —Revised to incorporate subject matter from previous MPEP § 706.02(b) . —Revised to clarify that showing that a reference’s disclosure was derived from inventor’s or at least one joint inventor’s own work must be shown in an affidavit or declaration under 37 CFR 1.132 . —Revised to clarify that in order to overcome a rejection under pre-AIA 35 U.S.C. 102(a) , a claim to priority under 35 U.S.C. 119(a)-(d) or a benefit claim under 35 U.S.C. 119(e) must be perfected. —In subsection I, changed the title to “Showing Reference’s Disclosure Was Derived From Inventor’s or At Least One Joint Inventor’s Own Work.” In the discussion of <i>In re Katz</i> and <i>Ex parte Kroger</i> , revised text to refer to “joint” inventors. —Previous subsection II incorporated into subsection I with minor editorial changes. Subsection III renumbered Subsection II.
2133	—In subsection II, updated cross-reference to MPEP § 2139.01 as a conforming change.
2133.01	—Added text to clarify that the effective filing date of a claimed invention is determined on a claim-by-claim basis. Added to the discussion of determining the effective filing date for a claim in a CIP, including adding citations to and discussion of <i>Santarus, Inc. v. Par Pharmaceutical, Inc.</i> , 694 F.3d 1344, 104 USPQ2d 1641 (Fed. Cir. 2012) and <i>Studiengesellschaft Kohle, m.b.H. v. Shell Oil Co.</i> , 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997).
2133.02(a)	—New subsection that incorporates subject matter from previous MPEP § 706.02(b)(2) .
2133.03	—Revised to incorporate subject matter from previous MPEP § 706.02(c)(2) .
2133.03(b)	—Changed “U.S. application” to “claimed invention” in the first sentence.
2133.03(c)	—Changed “U.S. application” to “claimed invention” in the second sentence.
2133.03(d)	—Revised to clarify the meaning of “in this country” under pre-AIA 35 U.S.C. 102(b) .
2133.03(e)	—Added text to clarify that experimentation must be the primary purpose for a sale to be a permitted activity that does not create a bar under pre-AIA 35 U.S.C. 102(b) .

2133.03(e)(7)	—Deleted the citations to <i>Bourne v. Jones</i> and <i>Watson v. Allen</i> and inserted citation to and explanation of <i>In re Hamilton</i> , 882 F.2d 1576, 111 USPQ2d 1890 (Fed. Cir. 1989).
2134	—Revised to incorporate subject matter from previous MPEP § 706.02(d) .
2135	—Revised to incorporate subject matter from previous MPEP § 706.02(e) . —In subsection I, changed “effective filing date of the United States application” to “effective filing date of the claimed invention in the United States” in item (A).
2135.01	—In subsection III.A, added text to clarify that German Gebrauchsmuster petty patent had a term of six years at the time of the court decision being discussed and made other minor corrections.
2136	—Revised to incorporate subject matter from previous MPEP §§ 706.02(f) and 706.02(f)(1) .
2136.01	—Revised to incorporate pre-AIA law subject matter from previous MPEP § 706.02(f)(2) .
2136.02	—Revised to update cross-references as a conforming change.
2136.03	—In subsection I, revised for clarity the sentence discussing that the U.S. filing date of <i>Habicht</i> was later than the German priority date of the application under rejection and updated the cross-reference to MPEP § 2120.01 as a conforming change. —In subsection II, updated text regarding proper benefit claims to a provisional application, which require proper support for the subject matter as required by 35 U.S.C. 119(e) and that at least one claim of the international application is supported by the written description of the relied upon provisional application in compliance with pre-AIA 35 U.S.C. 112 , first paragraph or 35 U.S.C. 112(a) . —In subsection III, updated text regarding proper benefit claims to a provisional application, which require proper support for the subject matter as required by 35 U.S.C. 119(e) and that at least one claim of the patent, patent application, or international application is supported by the written description of the relied upon provisional application in compliance with pre-AIA 35 U.S.C. 112 , first paragraph or 35 U.S.C. 112(a) and added a citation to <i>Amgen Inc. v. Sanofi</i> , 872 F.3d 1367 (Fed. Cir. 2017). Updated cross-references as a conforming change. —In subsections IV and V, updated cross-references as a conforming change.
2136.04	—Updated cross-references as a conforming change.
2136.05	—Revised to incorporate subject matter regarding overcoming a rejection under pre-AIA 35 U.S.C. 102(e) from previous MPEP § 706.02(b)(2) .
2136.05(a)	—A new section that incorporates subject matter regarding antedating a pre-AIA 35 U.S.C. 102(e) reference from MPEP § 2136 and previous MPEP § 706.02(b)(2) .
2136.05(b)	—New section that incorporates subject matter regarding showing that the reference is describing an inventor’s or at least one joint inventor’s own work from MPEP § 2136 and previous MPEP § 706.02(b)(2) .
2137	—Revised to incorporate subject matter from previous MPEP § 706.02(g) .
2137.01	—Reserved. Subject matter moved to MPEP § 2109 .
2137.02	—Reserved. Subject matter moved to MPEP §§ 2109 and 2137 .
2138	—Revised to incorporate subject matter from previous MPEP § 706.02(h) .
2138.03	—In subsection II, clarified that the court identified that a total of three months was possibly excusable in the explanation of <i>Shindelar v. Holdeman</i> . —In subsection III, clarified the first sentence to state that even if there is an inference of suppression or concealment due to time(s) of inactivity, the senior party may still

	prevail if that party shows renewed activity on the invention just prior to the junior party's entry into the field.
2138.04	<p>—In subsection I, added a citation to and discussion of <i>In re VerHoef</i>, 888 F.3d 1362, 126 F.2d 1561 (Fed. Cir. 2018).</p> <p>—Deleted subsection II. Subject matter was moved to MPEP § 2109.</p> <p>—Moved subject matter in former subsection III into subsection II and renumbered former subsection IV to III.</p> <p>—In subsection II, added cross-references to MPEP §§ 2106.04(b) and 2106.04(c) and added “in unpredictable technologies” to clarify that in such technologies, conception and reduction to practice occurring simultaneously is rare.</p>
2138.05	—In subsection V, clarified text regarding activity by a non-inventor not inuring to the benefit of the inventor in the discussion of <i>Genentech</i> .
2138.06	<p>—In subsection I, deleted “THE INVENTION” from the end of the title and clarified that priority was denied because of failure to supply the certified copy during pendency of the application that was filed within the twelve-month period prescribed by 35 U.S.C. 119 in the explanation of <i>Justus v. Appanzeller</i>.</p> <p>—In subsection II, clarified that less than one month of inactivity during the critical period showed a lack of diligence in the explanation of <i>Fitzgerald v. Arbib</i> and revised the explanation of <i>Kendall v. Searles</i> to state “Evidence of diligence must be specific as to dates and facts.”</p>
2139	—New section that provides an overview of the types of applications subject to rejections under pre-AIA 35 U.S.C. 102(a) .
2139.01	—New section that incorporated subject matter regarding pre-AIA law from previous MPEP § 706.02 , subsection VI.
2139.02	<p>—New section that incorporated subject matter from previous MPEP § 706.02(a)(2).</p> <p>—In subsection II, deleted the sentence regarding the reservation under PCT Article 64(3).</p>
2139.03	—New section that incorporated subject matter regarding pre-AIA form paragraphs from previous MPEP § 706.02(i) .
2141	<p>—In the introductory text, deleted “recent” prior to “decision” in describing <i>KSR</i> and deleted the second sentence in the block quote from <i>Arendi v. Apple</i>.</p> <p>—In subsection II, changed “the Graham factors” to “these factual inquiries” in the first sentence of the paragraph starting with “The question of obviousness ...”</p> <p>—In subsection II.A, in the first sentence, changed “what the applicant has invented” to “what has been invented.”</p> <p>—In subsection II.A.2, corrected the pinpoint page and changed “[applicant]” to “appellant” in the citation to and explanation of <i>In re Lintner</i>.</p> <p>—In subsection III, changed “such a rejection should be made” to “such a rejection is appropriate.”</p> <p>—In subsection IV, in the first sentence, added “in view of the relevant evidence of record at that time” after “concluded.”</p>
2141.01	<p>—In subsection III, in the first sentence, added “pre-AIA 35 U.S.C. 103(a)” before “requirement” for clarification.</p> <p>—In subsection IV, updated cross-references as a conforming change.</p>
2141.01(a)	<p>—In subsection I, deleted “A recent decision from the U.S. Court of Appeals for the Federal Circuit” prior to “<i>In re Klein</i>.”</p> <p>—In subsections III and IV, in the first sentence, changed “See, for example” to “Examples of analogous art in the ... arts include:”</p>

<p>2141.02</p>	<p>—In subsection I, inserted “disagreed and” before “held” in the discussion of <i>In re Hirao</i>. —In subsection III, changed “applicants” to “the inventor” in the discussion of <i>In re Wiseman</i>. —In subsection IV, changed “they” to “the inventor” in the first sentence. —In subsection V, corrected “contractor” to “contractor.”</p>
<p>2141.03</p>	<p>—In subsection I, added a citation to and description of <i>Thomas & Betts Corp. v. Litton Sys., Inc.</i>, 720 F.2d 1572, 220 USPQ 1 (Fed. Cir. 1983).</p>
<p>2142</p>	<p>—Added a new first paragraph that includes a citation to and quotation from <i>ACCO Brands Corp. v. Fellowes, Inc.</i>, 813 F.3d 1361, 117 USPQ2d 1951 (Fed. Cir. 2016). Deleted the last sentence “The initial evaluation of prima facie obviousness ...” in the former first paragraph, now second paragraph. —Revised to incorporate subject matter from previous MPEP § 706.02(j) and eliminated the cross-reference to MPEP § 706.02(j).</p>
<p>2143</p>	<p>—In the introduction, added a citation to and explanation of <i>In re Van Os</i>, 844 F.3d 1359, 121 USPQ2d 1209 (Fed. Cir. 2017). —In subsection I, in the first sentence, changed “Exemplary” to “Example of.” —In subsection I.B, in example 2, added “joint” in the phrase “authored by two of the three joint inventors.” —In subsection I.F., in example 4, corrected the page in the citation to <i>Ex parte Catan</i>.</p>
<p>2143.01</p>	<p>—In the introductory text, added a citation to and quotation from <i>Zup v. Nash Mfg.</i>, 896 F.3d 1365, 127 USPQ2d 1423 (Fed. Cir. 2018) and a cross-reference to MPEP § 2144.05.</p>
<p>2143.02</p>	<p>—In the introductory text, corrected the page in the citation to <i>KSR</i>. —In subsection I, added a new second paragraph that includes citations to <i>Acorda Therapeutics, Inc. v. Roxane Lab., Inc.</i>, 903 F.3d 1310, 128 USPQ2d 1001 (Fed. Cir. 2018); <i>PharmaStem Therapeutics, Inc. v. ViaCell, Inc.</i>, 491 F.3d 1342 (Fed. Cir. 2007); and <i>Pfizer, Inc. v. Apotex, Inc.</i>, 480 F.3d 1348 (Fed. Cir. 2007).</p>
<p>2143.03</p>	<p>—In the introductory text, added “However, this conclusion of the <i>Fine</i> court may not apply if the claim is not properly dependent” and a cross-reference to MPEP § 608.01(n). —In subsection I, revised text to clarify that examiners should make indefinite rejections and prior art rejections, when appropriate, to avoid piecemeal prosecution and should construe indefinite claims on a reasonable interpretation basis. Updated the cross-reference as a conforming change.</p>
<p>2144.01</p>	<p>—Corrected a typographical error in the compound portion in the explanation of <i>In re Lamberti</i>.</p>
<p>2144.03</p>	<p>—In subsection A, added a sentence that it is preferable, when reasonably possible, to cite a prior art reference rather than using official notice and added a citation to and quotation from <i>In re Van Os</i>, 844 F.3d 1359, 121 USPQ2d 1209 (Fed. Cir. 2017). —In subsection C, in the title changed “Challenges” to “Traverses.”</p>
<p>2144.04</p>	<p>—In subsection II.B, changed “Indicia” to “Indicium” in the title and the text of the subsection. —In subsection VI.C, deleted the citation to and explanation of <i>Ex parte Chicago Rawhide Mfg. Co.</i></p>
<p>2144.05</p>	<p>—In subsection I, deleted the quote in the explanation of <i>Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.</i> and added a citation to and discussion of <i>In re Brandt</i>, 886 F.3d 1171, 126 USPQ2d 1079 (Fed. Cir. 2018). —In subsection II.B, changed the title to “There Must Be an Articulated Rationale Supporting the Rejection.” Added a new first paragraph that includes citations to <i>In</i></p>

	<p><i>re Stepan</i>, 868 F.3d 1342, 123 USPQ2d 1838 (Fed. Cir. 2017); <i>In re Van Os</i>, 844 F.3d 1359, 121 USPQ2d 1209 (Fed. Cir. 2017); and <i>Arendi S.A.R.L. v. Apple Inc.</i>, 832 F.3d 1355, 119 USPQ2d 1822 (Fed. Cir. 2016). Added a new first sentence to the second paragraph.</p> <p>—In subsection III.A, added a citation to and quotation from <i>E.I. DuPont de Nemours & Company v. Synvina C.V.</i>, 904 F.3d 996, 128 USPQ2d 1193 (Fed. Cir. 2018).</p> <p>—In subsection III.B, added citations to <i>U.S. v. Adams</i>, 383 U.S. 39 (1966); <i>Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i>, 567 F.3d 1314, 90 USPQ2d 1865 (Fed. Cir. 2009); <i>Allergan, Inc. v. Sandoz Inc.</i>, 796 F.3d 1293, 115 USPQ2d 2012 (Fed. Cir. 2015); and <i>In re Brandt</i>, 886 F.3d 1171, 126 USPQ2d 1079 (Fed. Cir. 2018).</p> <p>—Added new subsections III.C and III.D regarding showing obviousness of a claimed parameter.</p>
2144.08	<p>—In subsection II.A, deleted the first sentence stating a proper obviousness analysis involves a three-step process and deleted “First,” at the start of the second sentence.</p> <p>—In subsection II.A.1, changed “As an initial matter” to “After construing the claims” and “should” to “must also” in the first sentence.</p> <p>—In subsection II.A.3, added “and a discussion of the level of ordinary skill will not be needed” and cross-references to MPEP §§ 2141 and 2141.03.</p> <p>—In subsection II.A.4, deleted “three” before “Graham factors.”</p>
2144.09	<p>—In subsection II, added citation to and explanation of <i>Aventis Pharma Deutschland v. Lupin Ltd.</i>, 499 F.3d 1293, 84 USPQ2d 1197 (Fed. Cir. 2007).</p> <p>—In subsection III, revised the discussion of <i>In re Mayne</i> and deleted the cross-reference to MPEP § 2144.08 for a more detailed discussion of the facts in the <i>Mayne</i> and <i>Merck</i> cases.</p> <p>—In subsection VII, deleted “Superior or” before “Unexpected” in the title and added pinpoint pages and added the designation “(en banc)” to <i>In re Dillon</i>.</p>
2145	<p>—Added the designation “(en banc)” to <i>In re Dillon</i>. Added “together with the knowledge of a person skilled in the art” prior to “be enabling” before the citation to <i>In re Hoeksema</i>. Revised the citation to <i>In re Hoeksema</i>. Moved the citation to <i>In re Alton</i> to after the first sentence of the same paragraph.</p> <p>—In subsection IV, added discussion of and citation to <i>In re Mouttet</i>, 686 F.3d 1322, 103 USPQ2d 1219 (Fed. Cir. 2012).</p> <p>—In subsection VII, added pinpoint pages to the citation to <i>In re Farrenkopf</i>.</p>
2146	<p>—Revised to incorporate subject matter from previous MPEP § 706.02(1).</p> <p>—Editor Note changed to state that this section is not applicable to applications subject to examination under the first inventor to file provisions of the AIA.</p> <p>—In subsection II, deleted the sentence “Therefore, in these applications, information learned from or transmitted to persons outside the organization is not disqualified as prior art.”</p>
2146.01	—New section that incorporates subject matter from previous MPEP § 706.02(1)(1) .
2146.02	—New section that incorporates subject matter from previous MPEP § 706.02(1)(2) .
2146.03	—New section that incorporates subject matter from previous MPEP § 706.02(1)(3) .
2146.03(a)	—New section that incorporates subject matter from previous MPEP § 706.02(k) , subsection II.
2147	—New section that incorporates subject matter from previous MPEP § 706.02(n) .
2148	—New section that incorporates pre-AIA form paragraphs from previous MPEP § 706.02(m) .
2151	—Deleted reference to form paragraphs 7.04.101.aia and 7.04.102.aia and replaced with a cross-reference to MPEP § 2157 .

2152.01	—Revised to incorporate subject matter regarding AIA law from previous MPEP § 706.02 , subsection VI.
2152.02(c)	—Revised to incorporate subject matter pertaining to public use from previous MPEP § 706.02(c)(1) .
2152.02(d)	—Revised to incorporate subject matter pertaining to on sale from previous MPEP § 706.02(c)(1) . —Added a citation to and discussion of <i>Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.</i> , 139 S.Ct. 628 (2019).
2152.02(e)	—Added a citation to <i>Jazz Pharm., Inc. v. Amneal Pharm., LLC</i> , 895 F.3d 1347,127 USPQ2d 1485 (Fed. Cir. 2018).
2152.05	—New section that incorporates subject matter from previous MPEP § 706.02(a)(1) .
2152.06	—New section that incorporates subject matter from previous MPEP § 706.02(b)(1) .
2152.07	—New section that incorporates AIA form paragraphs from previous MPEP § 706.02(i) .
2153.02	—At the end of the third paragraph, added “In other words, the exception in AIA 35 U.S.C. 102(b)(1)(B) does not necessarily remove the entire disclosure in the intervening reference from being prior art.”
2154.01(b)	—Updated cross-references as a conforming change.
2154.01(d)	—A new section that incorporates AIA law subject matter from previous MPEP § 706.02(f)(2) .
2154.02(b)	—At the end of the third paragraph, added “In other words, the exceptions in AIA 35 U.S.C. 102(b)(2)(B) do not necessarily remove the entire disclosure in the intervening reference from being prior art.”
2154.02(c)	—Revised to clarify that if the publication date (in addition to the issue date) of a U.S. patent document is before the effective filing date of the claimed invention, it may be prior art under AIA 35 U.S.C. 102(a)(1) , regardless of common ownership or the existence of an obligation to assign. —Updated cross-references as a conforming change.
2155.01	—Added citation to and discussion of <i>EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.</i> , 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017).
2156	—Updated a cross-reference as a conforming change.
2157	—Revised to incorporate form paragraphs for rejections under 35 U.S.C. 101 and AIA 35 U.S.C. 115 from previous MPEP § 706.03(a) . Updated cross-references as a conforming change.
2158	—Updated a cross-reference as a conforming change.
2158.01	—New section that incorporates AIA form paragraphs from previous MPEP § 706.02(m) .
2161.01	—This section was revised in light of the notice <i>Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112</i> , 85 FR 57 (January 7, 2019) by making the following changes: —In the introductory text, added a new second paragraph stating that even if claim language is not construed under 35 U.S.C. 112(f) , the computer-implemented functional claim language must still be evaluated under 35 U.S.C. 112(a) . —In subsection I, added citations to and explanations of <i>Reiffin v. Microsoft Corp.</i> , 214 F.3d 1342 (Fed. Cir. 2000); <i>Hynix Semiconductor Inc. v. Rambus Inc.</i> , 645 F.3d 1336 (Fed. Cir. 2011); and <i>Rivera v. Int’l Trade Comm’n</i> , 857 F.3d 1315 (Fed. Cir. 2017), and expanded on the discussion of <i>LizardTech Inc. v. Earth Resource Mapping Inc.</i> , 424 F.3d 1336 (Fed. Cir. 2005). Deleted the citation to <i>Vas-Cath, Inc. v. Mahurkar</i> , 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Added a citation to and explanation

	<p>of the definition of an algorithm in Microsoft Computer Dictionary (5th ed., 2002) and <i>Finisar Corp. v. DirecTV Grp., Inc.</i>, 523 F.3d 1323, 1340 (Fed. Cir. 2008). Added a cross-reference to MPEP § 2181, subsection II.B.2(a).</p> <p>—In subsection III, added a new second paragraph that states that all questions of enablement are evaluated against the claimed subject matter. Adding two new paragraphs that include citations to and explanations of <i>Trs. of Bos. Univ. v. Everlight Elecs. Co., LTD.</i>, 896 F.3d 1357 (Fed. Cir. 2018); <i>AK Steel Corp. v. Sollac & Ugine</i>, 344 F.3d 1234 (Fed. Cir. 2003); and <i>Sitrick v. Dreamworks, LLC</i>, 516 F.3d 993 (Fed. Cir. 2008). Added a cross-reference to MPEP § 2181, subsection IV.</p>
2163	<p>—In subsection I, in the second paragraph, changed "adequate written support" to "support in the written description and/or the drawings" in the last sentence.</p> <p>—In subsection II.A.3(a), deleted the parenthetical explanation at the end of the paragraph discussing <i>Enzo Biochem</i>. Revised the discussion regarding biomolecules, including adding text that states a claimed invention itself must be adequately described, adding a citation to and explanation of <i>Amgen Inc. v. Sanofi</i>, 872 F.3d 1367, 1378, 124 USPQ2d 1354, 1361 (Fed. Cir. 2017), and revising the explanation of <i>Centocor Ortho Biotech, Inc. v. Abbott Labs</i>.</p>
2163.03	—In subsection VI, added a cross-reference to MPEP § 2181 .
2164.06	—Corrected the page number in the citation to <i>In re Angstadt</i> .
2164.06(b)	—Changed the heading to read "Examples of Enablement Issues - Biological and Chemical Cases."
2164.06(c)	—Added a cross-reference to MPEP § 2181 , subsection II.B.2(a).
2164.08	—Corrected the citation to <i>Amgen Inc. v. Chugai Pharm. Co.</i> , 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991) to add "Inc."
2166	—A new section that incorporates the subject matter from previous MPEP § 706.03(c) .
2172	—In subsection I, added a citation to <i>In re Zahn</i> , 617 F.2d 261, 204 USPQ 988 (CCPA 1980).
2172.01	—Added a new first paragraph to describe the guidance provided in this section. In the second paragraph, added to the possible grounds of rejection that should be considered when a claim omits essential subject matter, including citations to <i>Gentry Gallery, Inc. v. Berkline Corp.</i> , 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998); <i>In re Venezia</i> , 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and <i>In re Collier</i> , 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). Added a new third paragraph that cross-references other relevant sections of the MPEP. In the fourth paragraph, deleted the citation to <i>In re Collier</i> . Added a new fifth paragraph that discusses rejections under 35 U.S.C. 112(b) , including citations to <i>Ex parte Robertson</i> , Appeal 2016-001938, op. at 4 (PTAB 2017); <i>Ex parte Mehta</i> , Appeal No. 2000-0160, op. at 5-6 (Bd. Pat. App. & Inter. 2002); and <i>In re Goffe</i> , 542 F.2d 564, 191 USPQ 429 (CCPA 1976).
2173	—Revised text to clarify that the statutory requirement under 35 U.S.C. 112(b) focuses on what the inventor or a joint inventor regards as the invention.
2173.01	—Revised text to clarify that the statutory requirement under 35 U.S.C. 112(b) focuses on what the inventor or a joint inventor regards as the invention.
2173.02	—In subsection I, added a citation to <i>Ex parte McAward</i> , Appeal 2015-006416 (PTAB Aug. 25, 2017).
2173.04	—Revised text to clarify that the statutory requirement under 35 U.S.C. 112(b) focuses on what the inventor or a joint inventor regards as the invention.
2173.05(h)	—Updated cross-references as a conforming change.
2173.05(o)	—Revised <i>Ex parte White</i> citation from 759 O.G. 783 to 127 USPQ 261.

2173.05(p)	—Added a new last paragraph that includes a citation to <i>Mastermine Software, Inc. v. Microsoft Corp.</i> , 874 F.3d 1307, 124 USPQ2d 1618 (Fed. Cir. 2017).
2173.05(q)	—Revised the second paragraph to state that “use” claims that do not purport to claim a process, machine, manufacture, or composition of matter fail to comply with 35 U.S.C. 101 and added a citation to <i>In re Moreton</i> , 288 F.2d 708, 709, 129 USPQ 227, 228 (CCPA 1961). —In subsection I, changed the title to “A ‘USE’ CLAIM MAY BE REJECTED UNDER 35 U.S.C. 101 AND/OR 112.” Revised the text to state that it is appropriate to reject a claim that recites a use but fails to recite steps under 35 U.S.C. 101 and 112(b) if the facts support both rejections and to include references to form paragraphs 7.05.01 and 7.34.01.
2173.05(r)	—Updated cross-references as a conforming change.
2173.05(s)	—Revised to state that the presence or absence of reference characters generally does not affect the scope of the claim.
2175	—New section that incorporates the form paragraphs from previous MPEP § 706.03(d) .
2181	—This section was substantially revised in light of the notice <i>Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. 112</i> , 85 FR 57 (January 7, 2019).
2185	—Revised text to clarify that the statutory requirement under 35 U.S.C. 112(b) focuses on what the inventor or a joint inventor regards as the invention. —Revised to limit the list of 35 U.S.C. 112 rejections to be considered to items (A)-(C) and to add text in the following paragraph that states that examiners must consider compliance with all requirements of patentability, including 35 U.S.C. 101 , 102 , and 103 .
2187	—New section that incorporates the form paragraphs from previous MPEP § 706.03(e) .
2190	—Revised title to “Prosecution Laches and Res Judicata.” —Added new subsection heading “I. Prosecution Laches” prior to existing text. —Added new subsection II to incorporate subject matter pertaining to <i>res judicata</i> from previous MPEP § 706.03(w) . The text from previous MPEP § 706.03(w) was revised by deleting the former first paragraph and the first sentence of the following paragraph; adding "or federal court proceeding" after "administrative trial" in the first paragraph and a new second paragraph; and clarifying that when a <i>res judicata</i> rejection is made, any prior art rejection should be made on the basis of the same prior art used in the <i>res judicata</i> rejection in the third paragraph. The text was further revised by deleting the citations to <i>In re Freeman</i> and <i>In re Szwarc</i> and expanding the parenthetical discussion of cases in which <i>res judicata</i> rejections were reversed.

CHAPTER 2200:

2204	—In the first paragraph, added “appropriate” before “fee” because 37 CFR 1.20(c) was amended by <i>Setting and Adjusting Patent Fees During Fiscal Year 2017</i> , 82 FR 52780 (November 14, 2017) (“Final Fee Rule”), which created two filing fees for <i>ex parte</i> reexamination.
2206	—In the first paragraph, deleted reference to “PKI certificate” and replaced with reference to “the Office’s electronic filing agreement (e.g., the Patent Electronic System Agreement)” to reflect the Office’s new authentication method for EFS-Web and Private PAIR. Deleted the last sentence that cross-referenced guidance that is no longer posted on the USPTO website.
2209	—In the second paragraph, revised text regarding the filing fee to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule.
2210	—In the first and last paragraphs following 37 CFR 1.510 , revised the text regarding the filing fee to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule.
2214	—Inserted subsection heading “I. REQUIREMENTS UNDER 37 CFR 1.510.” This subsection contains the existing text of the section but was revised with respect to the filing fee to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule. —Added new subsection “II. REQUESTS FILED ON OR AFTER JANUARY 16, 2018” to discuss the different filing options resulting from the amendment to 37 CFR 1.20(c) in the Final Fee Rule. —Inserted subsection heading “III. TRANSMITTAL FORM FOR FILING A REQUEST.” This subsection contains the existing text regarding form PTO/SB/57. Updated the copy of form PTO/SB/57.
2215	—The reproduction of 37 CFR 1.20(c) was updated to reflect the amendment made by the Final Fee Rule. —The section was reorganized into five subsections and revised to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule. —Subsection I was added to explain the filing fees for <i>ex parte</i> reexamination requests filed on or after January 16, 2018, the effective date of the Final Fee Rule. —Subsection II was added to clarify that former 37 CFR 1.20(c)(1), in effect prior to January 16, 2018, applies to <i>ex parte</i> reexamination requests filed prior to January 16, 2018. —Subsection III contains previous published text regarding entity status but was revised to reflect the changes to 37 CFR 1.20(c) by the Final Fee Rule. —Subsection IV contains previous published text regarding incomplete requests but was revised to reflect the changes to 37 CFR 1.20(c) by the Final Fee Rule. —Subsection V contains previous published text regarding refunds but was revised to change “37 CFR 1.26(c)” to “ 37 CFR 1.26(c)(1) ” and to reflect the changes to 37 CFR 1.20(c) by the Final Fee Rule.
2222	—Revised to use gender-neutral wording. Deleted “and the patent is in storage” in the paragraph starting with “Where no request . . . ” to remove text pertaining to discontinued paper processing. —Updated the copies of the forms PTO/AIA/81B and PTO/SB/81C.
2223	—Updated the copy of the form PTO/AIA/83.
2224	—Updated the URL for the Legal Framework for EFS-Web.
2233	—In subsection I, in the first paragraph, added a reference to 37 CFR 1.20(c)(2) to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule.
2236	—In the first paragraph, added “classification” after “original.” —In subsection I, in item (B)(2), revised text to clarify procedures if reexamination has not been ordered yet. —In subsection II, clarified text regarding procedures if the reexamination proceeding is assigned to an original examiner.

2239	<p>—Revised to use gender-neutral wording.</p> <p>—In the sixth paragraph after 37 CFR 1.520, added a reference to 37 CFR 1.20(c)(1) or (c)(2) to reflect the amendment to 37 CFR 1.20(c) by the Final Fee Rule.</p>
2242	<p>—In subsection III.A, revised text to clarify that federal courts do not hold patent “valid” but instead hold that “a patent has not been proven invalid.”</p> <p>—In subsection III.C, added “because such claims no longer exist in the patent” after “unenforceable” to clarify why a substantial new question of patentability is not present.</p>
2258	<p>—In subsection I.A, changed “Note also” to “See also” and deleted the last sentence in the description of <i>In re Hiniker Co.</i></p> <p>—In subsection I.D, added a citation to and description of <i>In re Janssen Biotech, Inc.</i>, 880 F.3d 1315, 125 USPQ2d 1525 (Fed. Cir. 2018).</p> <p>—In subsection IV.A, in the second paragraph, changed “of their prior adjudication” to “the claims were held invalid” for clarification.</p> <p>—In subsection IV.I, added “under 35 U.S.C. 252” after “surrender” for clarification.</p>
2259	<p>—In the second paragraph, added a citation to and description of <i>In re Arunachalam</i>, 709 Fed. Appx. 699 (Fed. Cir. 2017).</p> <p>—In the third paragraph, added a new first sentence to clarify that claims finally held “not invalid” by a federal court, after all appeals, may be subject to reexamination.</p> <p>—In the last paragraph, added “of claims finally held as ‘not invalid’ by a federal court” after “reexamination” for clarification.</p>
2266	<p>—In the second to last paragraph, inserted “if prior to a final rejection” after “37 CFR 1.550(c)” for clarification.</p>
2267	<p>—In subsection III, in the first row of the table, changed “less” to “fewer.”</p>
2271.01	<p>—Revised to use gender-neutral wording.</p> <p>—In subsection II, deleted the last sentence as unnecessary because managers have the authority to reassign reexamination proceedings, as appropriate, for multiple reasons.</p> <p>—In subsection III, revised the text to clarify the goals of the panel conference, e.g., to provide assistance to the examiner in charge.</p>
2274	<p>—In subsection VII, deleted the reference to “OACS” because this examiner correspondence tool has been retired.</p>
2279	<p>—Added “of Patents & Trademarks” in the citation to <i>Boeing Co. v. Comm’r of Patents & Trademarks</i>, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988).</p>
2284	<p>—In subsection I, deleted the cross-reference to form paragraph 23.16 because that form paragraph has been deleted.</p>
2286	<p>—In subsection II, revised text to clarify that courts use a different claim interpretation standard than the Office during reexamination of unexpired patent claims and that courts find that claims are “not proven invalid” instead of finding claims “valid.” Also, added the USPQ citations for <i>In re Swanson</i> and <i>Abbott Labs. v. Syntron Bioresearch, Inc.</i></p> <p>—In subsection IV, revised text to clarify that courts find that claims are “not proven to be invalid” or “not invalid” instead of finding claims “valid.” Also, clarified text by stating that courts and the Office use different standards for claim construction and different standards of proof.</p>

CHAPTER 2300:

2304.01(a)	—Updated to reflect current interference search procedure across technologies.
2304.02	—Form paragraph 23.06.06 revised to add "but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
2304.04(b)	—Form paragraph 23.04 revised to add "but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute (35 U.S.C. 133)."
2304.04(c)	—New section added directed to rejections based on disclaimer. Includes information moved from former MPEP § 706.03(u) .
2308	—Revised to add examiner guidance regarding examiner action after termination of an interference or derivation proceeding.
2308.04	—New section added to provide guidance for handling applications after decisions by the U.S. Court of Appeals for the Federal Circuit.

CHAPTER 2400:

2403.02	—Updated to reflect current seed deposit requirements in accordance with <i>Changes to Requirements for Seed Deposits at American Type Culture Collection and Advanced Notice of Change to Manual of Patent Examining Procedure</i> , 1460 OG 263 (March 26, 2019).
2422	—Corrected the reproduction of 37 CFR 1.821(a) .
2422.01	—In subsection III, deleted the phrase "the purpose of" before "assessing" as unnecessary.
2422.03	—Revised to move the following language from section I to the introductory paragraph: “If the sequence listing is submitted on paper, the sequence listing is a separate part of the disclosure that must begin on a new page within the specification. A plurality of sequences may, if feasible, be presented on a single page; the separate presentation of both nucleotide and amino acid sequences on the same page is also permitted.” Added a new second paragraph regarding the sequence listing being submitted in ASCII text format in an international application. —Revised to add subsection headings: "I. ASCII Text File Submitted via EFS-Web" and "II. ASCII Text File on Compact Disc." —In new subsection II, added subheadings directed to "A. Text Files Up to 300 MB" and "B. Text Files 300 MB or Over" and reorganized text accordingly. —In new subsection II.B, added text to explain that a “submission” under 37 CFR 1.21(o) is the uncompressed (file as processed) file size, and not the compressed version, and that transfer requests having a text file of 300 MB or greater filed on or after January 16, 2018, are subject to the mega-sequence listing fee set forth in 37 CFR 1.21(o) . See 82 FR 52780 (November 14, 2017).
2422.03(a)	—Updated the website for the EFS-Web Legal Framework. —In subsection I, included a cross-reference to 37 CFR 1.825 and clarified as to when an incorporation-by-reference statement of the sequence listings is required. —In subsection III, revised to clarify when a sequence listing submission is subject to the fee set forth in 37 CFR 1.21(o) . Updated to indicate that if the sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split for submission on multiple physical media using software designed to divide a file into multiple files for subsequent concatenation. Corrected the citation of Priority Mail Express®. —In subsection IV.A, revised in accordance with <i>Updated Legal Framework for Patent Electronic System</i> , 84 FR 56803 (October 23, 2019). —In subsection IV.B, revised to correct citation of Priority Mail Express®. Updated to indicate that if the sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split for submission on multiple physical media using software designed to divide a file into multiple files for subsequent concatenation. Further updated to discuss international and national stage submissions of 300 MB or over in accordance with 37 CFR 1.21(o) .
2422.05	—Updated to indicate that instead of submitting a transfer request of a previously filed CRF, the Office strongly recommends that applicant submit a sequence listing in ASCII text format in the new application, which will serve both as the sequence listing part of the disclosure as well as the CRF. —In subsection I, revised to clarify the requirements of a transfer request and when a sequence listing submission is subject to the fee set forth in 37 CFR 1.21(o) . —In subsection II, revised to clarify the preferred reply to a defective transfer request notice.
2423	—Corrected the reproduction of 37 CFR 1.822(b) .
2427	—Revised to include reproductions of the form paragraphs pertaining to sequence listing.
2429	—Revised to state that applicants are encouraged to draft their specifications such that sequence data that is not essential material is not required to be included in a sequence listing. 37 CFR

[1.21\(o\)](#) provides that the submission of very lengthy sequence listings (mega-sequence listings) of 300 MB or more are subject to additional fees. Mega-sequence listings, in particular, often include sequences that are available in the prior art, are not essential material, and could have been described instead, for example, by name and a publication or accession reference.

[2435](#)

—Corrected web address for the USPTO sequence homepage.

CHAPTER 2500:

2504	<p>—Updated the reproduction of 37 CFR 1.362 to correspond to current rule language as amended by <i>Setting and Adjusting Patent Fees During Fiscal Year 2017</i>, 82 FR 52780 (November 14, 2017) (“Final Fee Rule”).</p> <p>—Revised text in the first paragraph following the reproduction of 37 CFR 1.362 for consistency with the changes in the Final Fee Rule.</p> <p>— Added a new subsection I to discuss the changes to the Final Fee Rule regarding maintenance fee payments in reissue utility patents and original utility patents for which a reissue application is pending.</p>
2506	<p>—In the fourth paragraph, changed “a reissue patent” to “all reissued patents.” In the last paragraph, clarified the text explaining the weekend rule by changing “at midnight on Saturday” to “after midnight on Saturday (e.g., on Sunday)” and adding “the day following” prior to “the anniversary date.”</p>
2522	<p>—In the fourth paragraph, changed “Commissioner” to “Director.”</p>
2550	<p>—In subsection I, revised the sentence regarding accessing Private PAIR to state, “[I]n order to change entity status via Private PAIR, you must: (1) be a registered patent attorney/agent, an independent inventor, or a person granted limited recognition, (2) have a USPTO.gov account, (3) have a customer number, and (4) have two-step authentication.”</p>
2580	<p>—In the third paragraph, added “of” after “purposes.”</p>
2590	<p>—In subsection I, revised to reflect that the EFS-Web version of the SB/66 form was retired on February 1, 2018, and to suggest that applicants use form PTO/SB/66 to file the petition to accept an unintentionally delayed payment of a maintenance fee on an expired patent.</p>
2595	<p>—Updated the copies of all the forms.</p>

CHAPTER 2600:

2622	—Updated copies of forms PTO/AIA/81B and PTO/SB/81C.
2623	—Updated the copy of form PTO/SB/83.
2624	—Updated URL for the web page for the Legal Framework for EFS-Web.
2658	—In subsection IV.E, changed “Foreign and Domestic Priority” in the subheading to “Foreign Priority or Domestic Benefit” to be consistent with statutory language of 35 U.S.C. 119 and 35 U.S.C. 120 .
2666.01	—Updated the reproduction of 37 CFR 1.530(a) and (1)(1) to correspond to current rule language.
2666.04	—Updated the reproduction of 37 CFR 1.20 to correspond to current rule language.
2667	—In subsection II.A.1, changed “less” to “fewer” to fix a grammatical issue.
2668	—Updated the reproduction of 37 CFR 1.137 .
2674	—Deleted the reference to “OACS” because this examiner correspondence tool has been retired.
2682	—Updated the title in the reproduction of 37 CFR 1.981 to correspond to current rule language.
2686.04	—In subsection II, in the first bullet under item (A), revised text to clarify that courts use a different claim interpretation standard than the Office during reexamination of unexpired patent claims.

CHAPTER 2700:

Chapter Title	—Added “Adjustments” to reflect that the chapter discusses patent term adjustments.
2701	—In subsection IV, changed “Domestic priority” to “Domestic benefit” to be consistent with statutory language of 35 U.S.C. 119(e) .
2731	—Added a citation to and discussion of <i>Actelion Pharm. v. Matal</i> , 881 F.3d 1339, 125 USPQ2d 1585 (Fed. Cir. 2018). —Added a citation to and discussion of <i>Pfizer Inc. v. Lee</i> , 811 F.3d 466, 117 USPQ 1781, 1786 (Fed. Cir. 2016). —Changed “one month” to “two months” for the shortened statutory period for reply to a written restriction requirement. —Added citations to and discussion of <i>Mayo v. Iancu</i> , 309 F. Supp. 3d 425 (E.D. Va. 2018) and <i>Ariad Pharm. Inc. v. Matal</i> , 283 F. Supp. 3d 503 (E.D. Va. 2018). —Corrected a spelling mistake for “derivation” proceeding.
2732	—Revised to use gender-neutral wording. —Added a citation to and discussion of <i>Intra-Cellular Therapies, Inc. v. Matal</i> , 2018 WL 852368, 1:17-CV-00776 (E.D. Va. 2018). —Revised the discussion of 37 CFR 1.704(d) to discuss the safe harbor statement and added a discussion of and copy of form PTO/SB/133 that can be filed with an information disclosure statement as explained in the <i>Interim Procedure for Requesting Recalculation of the Patent Term Adjustment With Respect to Information Disclosure Statements Accompanied by a Safe Harbor Statement</i> , 83 FR 55102 (November 2, 2018).
2734	—Revised to use gender-neutral wording. —In subsection I, corrected the page citation in the federal reporter for <i>Novartis AG v. Lee</i> , 740 F.3d 593, 109 USPQ2d 1385 (Fed. Cir. 2014). —Added new subsection IV that explains the interim procedure for requesting patent term adjustment recalculation as discussed in the Federal Register Notice <i>Interim Procedure for Requesting Recalculation of the Patent Term Adjustment With Respect to Information Disclosure Statements Accompanied by a Safe Harbor Statement</i> , 83 FR 55102 (November 2, 2018). Added a copy of new form PTO/SB/134.
2750	—In the first sentence, added “premarket” before “regulatory review.” —In the first paragraph, added a new sentence at the end that discusses a safe harbor provided for in 35 U.S.C. 271(e)(1) . —In the third paragraph, corrected a minor grammatical error. —Added text regarding the amendment to 35 U.S.C. 156(d)(1) . —In the last paragraph, added “former” before 35 U.S.C. 155 and 155A for clarification.
2751	—In subsection I, added a cross-reference to a new MPEP § 804.05 that discusses the impact of patent term extension on double patenting analysis. —In subsection II, deleted the phrase “either alone ... marketing or use” in item A for clarification. Also, added a citation to and discussion of <i>Angiotech Pharms. Inc. v. Lee</i> , 191 F. Supp. 3d 509 (E.D. Va. 2016). Added a cross-reference to 35 U.S.C. 156(a)(5)(A) and revised text to improve clarity. —In subsection V, added a citation to and discussion of <i>Avanir Pharm. v. Kappos</i> , No. 1:12cv69 (E.D. Va. March 21, 2012) and revised text to improve clarity.
2752	—Revised the discussion regarding 35 U.S.C. 156(d)(1) to use “registered practitioner” in place of “patent attorney or agent” and added a sentence about how an application for patent term extension filed by a registered practitioner not of record is treated.
2753	—In the paragraph discussing 37 CFR 1.740(a)(2) , made minor changes for clarity and added another U.S. patent as an example.

	<p>—Added to the discussion of 37 CFR 1.740(a)(3), including a listing pertaining to the date of approval for a drug product.</p> <p>—Added a new paragraph that discusses the amendment to 35 U.S.C. 156(d)(1).</p> <p>—Added two new sentences at the end of the paragraph discussing the expiration date of the patent for which extension is sought to recommend showing how the expiration date was calculated and to provide an example.</p> <p>—In the paragraph discussing the showing required by 37 CFR 1.740(a)(9), revised the first sentence for clarity and added a new example at the end of the paragraph.</p> <p>—Added two new paragraphs discussing the requirements of 37 CFR 1.740(a)(13) and (14).</p> <p>—In the penultimate paragraph, revised text to use “registered practitioner” in place of patent attorney or agent.</p> <p>—In the last paragraph, added a parenthetical “(for a total of three copies)” at the end of the first sentence and added a new last sentence regarding when copies of the application will be viewable in Public PAIR.</p>
2754.01	<p>—Deleted citation to and description of <i>Unimed, Inc. v. Quigg</i>, 888 F.2d 826 (Fed. Cir. 1989).</p> <p>—Added a discussion of the covered date in regards to 35 U.S.C. 156(d)(1).</p>
2754.02	—Added a sentence that discusses when the interim extension lapses under 35 U.S.C. 156(d)(5) and a citation to 35 U.S.C. 156(d)(5) in the following sentence.
2754.03	—Removed and reserved. Subject matter is discussed in MPEP § 2755.01 .
2755.01	<p>—In the second paragraph, added a new sentence at the end of the paragraph that states best practice for the applicant for term extension.</p> <p>—Added a new paragraph that discusses when extensions of multiple patents have been sought at the end of the section.</p>
2755.02	—Added a new sentence that discusses when the interim extension lapses under 35 U.S.C. 156(d)(5) at the end of the section.
2756	<p>—In the second paragraph, revised text for clarification (e.g., added “Plant” before “Health” and “United States” before “Department of Agriculture”).</p> <p>—In subsection II, added a citation to 35 U.S.C. 156(d)(1) after the “sixty-day statutory period.”</p>
2757	—In the second paragraph, added a sentence regarding the Federal Register Notice also setting a date.
2758	<p>—Deleted the sentence that recently mailed Notices of Final Determination are posted in the FOIA section of the USPTO website.</p> <p>—Revised the paragraph discussing a determination of ineligibility for clarification and to expressly state that the only remaining remedy is to pursue court action under 5 U.S.C. 704.</p> <p>—In the paragraph before subsection I, added “notice of” prior to “final determination.”</p>
2759	<p>—Revised the first paragraph to clarify procedures regarding the Notice of Final Determination.</p> <p>—Deleted text pertaining to a sample Official Gazette Notice and Notices of Final Determination being posted in the FOIA section of the USPTO website.</p>
2761	<p>—In the first paragraph, added “single” prior to “regulatory review period” in the first sentence.</p> <p>—In the second paragraph, revised text to clarify what is meant by voluntarily withdrawing other applications for extension and to explicitly state that this withdrawal is different than the situation covered in MPEP § 2764.</p> <p>—Added three new paragraphs at the end of the section to further discuss the situations when there are multiple applications for patent term extensions.</p>
2762	—Revised to use “registered practitioner” in place of “patent attorney or agent.”

2762.01	—New section pertaining to when a terminal disclaimer is filed during patent term extension proceedings.
2764	—Added a new last sentence to explicitly state that this withdrawal is different than the situation covered in MPEP § 2761 .
2765	—New section discussing petition for stay in processing of patent term extension applications.
2766	—New section regarding processing of patent term extension applications when a reissue application has been filed.

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.