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15.

ALLOWANCE AND ISSUE

15-1.

When Case is Special

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action taken to require correction of formal matters. Such action should include a statement that prosecution on the merits is closed in accordance with the decision in *ex parte Quayle*, 1935 O.D. 11, 453 O.G. 213, and should conclude with the setting of a shortened statutory period for response. (Order 5267)

15-2.

Final Review and Preparation For Issue

15-2-1.

General Review of Disclosure

When an application is apparently ready for allowance, it should be reviewed by the Examiner to make certain that the whole case meets all formal requirements and particularly that the general statement of invention and the descriptive matter are confined to the invention to which the allowed claims are directed and that the language of the claims finds full support and elucidation in the specification. Neglect to give due attention to these matters may lead to confusion as to scope of the patent.

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the examiner should require the applicant to modify his general statement of invention and restrict his descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (Rules 10.1 and 11.2) Of course enough background should be included to make the invention clearly understandable.

The general statement of invention should be directed to the invention claimed, in contrast to mere generalities which would be equally applicable to numerous preceding patents. Stereotyped general statements that would fit one case as well as another should be required to be canceled as surplusage or replaced by statements that are directly in point.

There should be a verbal basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See Rule 10.4.

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or become abandoned and that fact inserted with appropriate data by examiner's amendment. If the file wrapper has a retention label (form PO-150) on it, the application specified on the label should be inspected to see that the case at hand properly complies with Rule 10.7.

The claims should be renumbered as required by Rule 17.6, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent.

The title should also be checked. It should be as specific as possible. If a satisfactory title is not supplied by the applicant, the examiner may change the title by Examiner's Amendment on or after allowance.

15-2-2. Specification to be Rewritten if
 Confused by Erasures and
 Amendments

The examiners are directed before passing applications to issue to carefully examine all papers and see that they are in such shape and condition as to avoid all possibility of error made by the printers. Whenever interlineations or erasures have been made in the specification or amendments which would lead to confusion and mistake, the examiners should require the entire specification to be rewritten before passing the case to issue. (Order 525)

15-2-3. Erasure of Notations Required

All marginal notes must be erased when the case is passed to issue. (Order 560)

15-2-4. Examiner's Amendment and Changes

On reviewing the disclosure preparatory to allowance, the Examiner may find that changes need to be made. Minor changes in the specification may be made by pen and ink and initialed. More important changes in the specification and claims, and changes in the drawing may be made

by Examiner's Amendment. See section 10 - 10. Other changes require an official action under the practice of ex parte Quayle, 1935 C.D. 11, 453 O.G. 213, as set forth in section 15 - 1.

15-2-5. Correction of Drawing

Where a case otherwise ready for issue requires correction of the drawing, the examiner should attach to the file a slip indicating that the case is ready for allowance.

15-2-6. Prior Foreign Applications

An applicant will not be required in any case to file a statement setting forth the date of any foreign patent granted him, or to others with his knowledge or consent between the date of execution of his specification and the date of the payment of the final fee. (Order 1239)

The examiners are directed on passing to issue any application in which an earlier foreign application, or applications, for the same invention has been filed, to enter (if entry has not been made) at the bottom of the face of the file wrapper the earliest date of filing in any foreign country and the name of such country; and in the event that more than one foreign application has been filed outside the twelve-months period, the filing date and name of country of each such application will also be thus entered. (Order 3233)

In the case of any foreign application filed more than 12 months prior to the U. S. filing date, the examiner should ascertain whether it has matured into a patent by a search of the records in the Scientific Library, noting on inside of left-hand flap of wrapper the date of such search. If no evidence that such foreign application has gone to patent is found, it is assumed that no foreign patent has issued and the case is sent to issue. Of course, no search is necessary in the case of a foreign application which qualifies for the right of priority under the provisions of Public Law 690. See 4-1-4.

15-2-7. Interference Search

Assuming that the case is found ready for issue, the examiner makes an "interference search." To do this, he inspects all the pending drawings (or all the digests of cases if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his division or elsewhere, in order

to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, he examines the corresponding file. The procedure in case the examiner concludes that an interference in fact exists is set forth in Section 13.

In connection with the subject of interference search, it is to be noted that, where the examiner at any time finds that two or more applications are claiming the same invention and he does not deem it expedient to institute interference proceedings at that time, he should make an appropriate record of the possible interference. No notations, however, should be made on the application file or drawing which give any hint to applicant of the date or identity of supposedly interfering applications.

If the search does not disclose any interfering application, the examiner should prepare the case for issue.

15-2-8.

Notations on File Wrapper

The Examiner fills out in ink the form at the bottom of the face of the file wrapper.

Examiners will ordinarily designate but one claim on each invention to be published in the Official Gazette in connection with each original or reissued patent. The BROADEST claim should be selected. When a plurality of devisible inventions are claimed in an application, additional claims to a maximum of five may be designated for publication.

The file wrapper bears on the left hand margin the legend: "Division of Application No. ----, Filed -----, 19--." This is to be filled in with the serial number and date of any prior application of which the one in question is a division, a continuation or a substitute, the word "Division" being replaced by Continuation, and the words "Division of" replaced by Substitute as may be required. If the prior application has issued as a patent, the patent number and date should also be supplied.

If the application under consideration contains any substantial matter in addition to that contained in the prior application no notation on the margin of the file wrapper is made; but in the case of a continuation-in-part the letters C-P are stamped on the face of the wrapper at the bottom thereof.

Fee-exempt applications are to be endorsed on the file jacket: (Granted under the act of March 3, 1883 as amended April 30, 1928).

Section 4 explains the types of applications here mentioned.

15-2-9.

Notations on Drawings

On the upper left hand margin of the sheet of drawing the examiner completes in ink the following data: "(O.G. Fig.----)," indicating the figure which he selects for illustration in the Official Gazette and "(class -- subclass --)" indicating the final official classification of the case. On the lower margin the examiner writes the allowance mark (*).

15-2-10.

Classification and Notations
on Issue Slips (Form No. 574)

In preparing a case for issue the examiner fills out a blue issue slip (Form 574), with the exception, of course, of the patent number, and pins it to the upper left hand corner of the drawing, being careful to insert the pin outside of the margin line. Where the case has no drawing, the blue slip is pinned inside the left-hand flap of the file wrapper.

In addition to noting on the blue slip the proper classification of the prospective patent, the examiner should make certain that all necessary cross-references are indicated. To insure that the field for cross-referencing has been fully covered, the examiner, where doubt exists, should consult other examiners having related art to determine the need of a cross-reference therein or include such doubtful cross-references, leaving it to the Classification Examiner to cancel them if deemed unnecessary.

Where a prospective patent is to be classified in a class in a division other than the one which is sending the application to issue, the examiner after filling in on the blue issue slip, the class and subclass number in which the patent is to appear will designate in red ink on the blue slip the division to which the patent is to be sent. For example, the blue issue slip in such cases will read:

Class 18 subclass 51 (Div. 15)

The division passing the case to issue will insert its own number as usual in the space provided in the lower left-hand corner. When the patent issues, the Classification

Division will, as a matter of routine, send the necessary notices to the divisions involved.

A case will not be sent to issue and assigned to a class in another division except where both examiners concur in the proposed classification or where there has been a ruling by the Classification Examiner. When the examiners concur, the examiner in charge of the class to which the patent will be sent will write below the third line of the blue slip "approved" together with his initials and Division number. Any ruling of the Classification Examiner should be attached to the inside of the file.

Principal examiners are directed to personally revise the classification made by the assistant of every application passed for issue. (Order 2357).

15-2-11. Dual Prosecution Cases

Where all the claims remaining in a Dual Prosecution case are allowable and classified in the division not having general jurisdiction, the case should be transferred.

See sections 10 - 4 - 10 and 10 - 4 - 15.

15-2-12. Reference to Assignment Division

Applications filed by an executor or an administrator or the guardian of an insane person, or in which an executor or administrator or guardian has intervened, or in which the death of the inventor has been suggested, and also all divisional, continuation, continuation-in-part, substitute and reissue applications must be referred to the Assignment Division before passing them to issue. (See Order 1838, Order 3411, and Section 5)

15-2-13. Listing of References

A list of references is made and appears in the issued patent. Foreign patents are listed by the actual name of the country, as for example, "France" rather than "French".

In order to avoid possible errors in the listing of references, the following procedure should always be followed:

Whenever a reference has been incorrectly cited in any official paper forming part of an application file, and such citation has been correctly given in an ensuing Office action, the Examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his initials on the margin of such paper, to-

gether with a notation of the paper number of the action in which the citation has been correctly given.

In any case, otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the Examiner is directed to correct the citation by way of an Examiner's Amendment.

Where an applicant in an amendatory paper refers to a reference which is subsequently relied on by the Examiner, such reference shall be cited by the Examiner in the usual manner. See section 10-9.

15-2-14. Signing

After revision by the clerk and correction of any discovered informalities, the application file is signed by the Primary Examiner.

15-3. Notice of Allowance

After the application file has been signed by the Primary Examiner the typist fills out the appropriate form of notice of allowance as described in the Clerk's Manual.

15-3-1. Amendment Received After Allowance

For discussion of amendments filed under Rule 34.2, see 10-16-17.

If the amendment contains claims copied from a patent, see 10-16-21.

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under Rule 34.2. Its entry is a matter of grace.

If, however, the amendment is filed in the Office but is not received by the examiner prior to the mailing out of the notice of allowance, it has the same standing in the case as though the notice had not been mailed. Where the case has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims (*ex parte* Quayle, 1935 CD 11; 453 O.G. 213), applicant is entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under Rule 34.2.

As above implied, the case will not be withdrawn

from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

15-3-2. Undelivered

In case a notice of allowance is returned, a new notice is sent, the file being obtained from the Issue and Gazette Branch, and the date of sending the notice changed to agree with the date of such remailing.

15-3-3. Not Withheld Due to Death of Inventor

The notice of allowance will not be withheld due to death of the inventor even though the executor or administrator has not intervened. See 6-3-3.

15-4. Withholding From Issue of Secret Cases

"Secret" cases are not sent to issue even when all of the claims have been allowed. They are prepared for issue in the same way as other cases but instead of mailing an ordinary notice of allowance a D-10 notice is sent.

In a "special handling" case and a Government-owned three-year case, the notice of allowance is sent out as in an ordinary case. If delay of the issue of the patent is desired in the interest of security or for other reasons, the agency may take appropriate action, such as recommending that the case be placed under secrecy order, or that Rule 14.3 be invoked. See section 2-1.

If the secrecy order in a case is withdrawn after the D-10 notice is mailed, the case should then be treated like an ordinary application in condition for allowance.

15-4-1. Amendment After D-10 Notice

The issuance of a D-10 Notice closes the prosecution. Any amendments received thereafter are treated like amendments filed after final rejection in an ordinary case. The applicant should be advised of their entry or non-entry, and in the latter case the reasons therefor.

15-5. Jurisdiction

After the notice of allowance is mailed, the case is sent to the Issue and Gazette Branch. It is then technically no longer under the jurisdiction of the primary examiner. However, the Examiner can make Examiner's amendments correcting obvious errors, as, when brought to the

attention of the examiner by the printer, and also to admit amendments under Rule 34.2 which are confined to matters of form in specification or claims, or, to the cancellation of a claim or claims. The examiner's action on other amendments under Rule 34.2 consists of a recommendation to the Commissioner.

To regain jurisdiction over the case, the examiner must write a letter to the Commissioner requesting it. See 15-8.

Once the patent has been granted, the Office has no control over it except for the issuance of a certificate of correction as provided in Rule 35.2. The applicant may, however, take steps to have the Office change the patent grant in several ways. See Section 16.

15-6.

Public Law 690 Cases

In cases ready for issue or with all claims allowed and containing papers filed under Public Law 690 the examiner should ascertain whether a ruling on the right of priority has been made. If such a ruling has not been made, the examiner should write a letter to applicant stating whether or not the case is entitled to the priority date, using the forms of section 4-1-6. The letter should be submitted to the Supervisory Examiners for review. It may be mailed with the notice of allowance.

An application in condition for allowance, which has been previously given the benefit of the priority date and in which all claims still relate to the "same invention", may be passed to issue by the examiner without again referring it to the Supervisory Examiners.

If an application is in issue when papers filed under Public Law 690 are received, the examiner should, if the final fee has not been paid, borrow the file from the Issue and Gazette Branch and treat it in the same manner as a pending case, writing a letter and referring it to the Supervisory Examiners for approval. If the final fee has been paid the examiner should, if there is time, examine the papers promptly and write a letter in the same manner. Deferment of the issue of the patent may be requested if it is still possible. If the papers are received too late to take any of the above actions, they should be referred to the Supervisory Examiners.

15-7.

Change in Classification of Cases Which are in Issue

The classification of all applications which have been passed to issue, which would be changed by any change

made in the official classification by order of the Commissioner, should be corrected by the examiner having custody of such applications as soon as possible after promulgation of the order.

To effect the correction of the classification of applications that have been passed for issue but are awaiting payment of final fee, the examiner should correct the class and subclass numbers on the Issue slip and file wrapper.

15-8. Withdrawal From Issue

Rule 34.3 Withdrawal from issue. After the notice of allowance of an application is sent, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed. When the final fee has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue on account of any mistake or change of purpose of the applicant, his attorney or his agent, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. Express abandonment of the application (Rule 19.4) may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

If the applicant wishes to have the case withdrawn from issue he must petition the Commissioner. Withdrawal is permitted only for the reasons stated in the rule.

15-8-1. Rejection after Allowance

A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. (Order 3157).

If a reference is found for an allowed claim in an application that is in issue, the Primary Examiner in a letter addressed to the Commissioner requests that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the

reference, and, if need be, briefly state its application. Upon approval of this request by the Commissioner, the letter is taken to the Issue and Gazette Branch and the application is stamped "Withdrawn" over the allowance signature of the Primary Examiner. It is then returned to the Division from which it came; the clerk enters the withdrawal from issue on her register, and the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

If the examiner's proposed action is not approved, the letter requesting jurisdiction should not be placed in the file.

15-8-2.

Form of Letter

Where it becomes necessary to withdraw a case from issue for the purpose of rejecting claims, the following letter will serve as a form:

| | | |
|----------------------|---|-----------------------|
| Application of | : | (Date) |
| John Doe | : | |
| Ser. No. 85,963 | : | |
| Washing Machine | : | Withdrawal from Issue |
| Filed Feb. 14, 1935 | : | |
| Allowed Mar. 6, 1935 | : | |

Hon. Commissioner of Patents,

Sir:

It is requested that the above-entitled application be withdrawn from issue for the purpose of rejecting claims in view of the newly discovered reference, the patent No.-----
(Explain, if necessary)

Respectfully,

Examiner.

15-8-3.

For Interference Purposes

It may be necessary to withdraw a case from issue for the purpose of interference. See section 13.

15-9.

Issue of Patent

The cases of allowed cases (not patented cases) are

kept in the Issue and Gazette Branch, arranged in the order of dates of allowance. When the final fee is paid within the time allowed by law, the drawing is obtained by the Issue and Gazette Branch and the file is given a patent number and date. The file then goes to the Assignment Branch for examination as to assignments after which it is sent to the Government Printing Office for printing of the specification. A Bond paper copy of the drawing and specification is ribboned and sealed in the Issue and Gazette Branch and finally signed by the Commissioner or Law Examiner.

15-0-1.

Companion Case Queries

In those allowed cases in which another application is referred to and no statement has been made as to whether the other application is patented or abandoned, the Issue and Gazette Branch will send the case to the examining division with a Companion Case Query slip (form PO-140) and a retention label (form PO-150).

Upon receiving such a case the Examiner will promptly check the current status of the application referred to and report the same on the query slip in accordance with the instructions thereon. If the application referred to is patented or abandoned, he will indicate this fact in the specification of the allowed case by appropriate Examiner's amendment. The retention label will be used in the manner indicated on the query slip.

If the pending application is referred to in more than one allowed application, it is not necessary to use more than one retention label. Instead the Examiner will merely add the necessary data to the label already on the pending application.

Query slips are used at the time the application is being prepared for printing so that the data in the specification of the patent will be as complete as possible.

15-0-2.

"Printer Waiting" Cases

After printing of the specification the proof is read by employees of the Government Printing Office. Where apparent error is found, the file with the proof is transmitted to the Examiner, attention being called on an attached "printer waiting" slip to the supposed errors.

All printer waiting cases must receive immediate attention and be returned to the Issue and Gazette Branch as soon as possible (preferably within three hours). If the Examiner concurs in the criticisms, the errors should, if possible, be corrected in ink and initialed, or be corrected by Examiner's amendment.

If the required correction cannot be cured by ex-aminer's amendment, the application may have to be withdrawn from issue. This may sometimes be avoided if the attorney or his representative is in Washington. In such a case, he should be called in immediately, and the error corrected by amendment under Rule 4.3.

If the Examiner finds the specification correct as it stands, he endorses the slip to that effect.

Chemical and similar formulae are also sent to the Examiner with "printer's lines" slips for checking.

After correction or checking, the application file and proof are returned to the Issue and Gazette Branch.

15-9-3. Examiner's Notations on Patents

It is directed that when the Examiner's copies of patents are sent to their respective divisions to be filed, the Primary Examiners require the assistants who examined the applications to mark in ink on the face of the drawings, or the specification, where there are no drawings, such features as may be deemed advantageous in aiding understanding of the patent in future searches. (Order 2320)

15-9-4. Protest against Issue

It is directed that when a protest is filed against the issuance of a patent the same shall, after being considered by the Examiner, be forwarded to the Executive Officer to be placed in his files and shall not be entered in the file of the application to which it refers. (Order 1005)

15-9-5. Patented Files

In the examination of an application it is sometimes necessary to insert the application papers of some previously issued patent. This is always true in the case of a relative application.

Patented files may be obtained in the Patent Law by filling out a slip (Form 60), found there, and leaving it in the file with the clerk in charge. The patented files are drawn from the shelves and distributed, the slip being retained by the clerk in charge. The patented files should be promptly returned to the Examiner for filing as soon as it is possible to keep longer than thirty days without remark by the clerk in charge the file is needed for the purpose of reference or interference, this information should be given to the clerk in charge upon obtaining the file, as soon as possible. If the files have been disposed of, the Patent Law should be consulted for their location.

When an interference is declared between a patent and an application and the interference is forwarded to the Examiner of Interferences, the clerk in charge of the Record Room should be informed in order that the charge may be changed and the location of the file known at all times.

Patent Copy Sales Branch has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the "Abandoned Files and Drawings."

Inquiries as to the status of applications in the examining divisions should in every case be answered promptly. If the inquiry is directed to an application awaiting action on the part of the Office a prediction should be made of the probable date a case may be reached for action. This prediction of a date is not to be considered as binding upon the Examiner in making his next action.

The privilege of an answer to a status letter is accorded to applicants and attorneys who wish to inquire about individual cases. Any instances of wholesale status inquiries by attorneys should be reported to the Supervisory Examiners.

The Examiner's answer may be typewritten on the letter of inquiry and will be signed by the Primary Examiner. The original inquiry should be returned to the correspondent with the reply.

Specimen Reply

Patent Office, July 1, 1948

The above application is awaiting action on the part of your attorney in response to Office letter of June 1, 1948. Unless proper action is taken on or before December 1, 1948, the application will become abandoned.

Examiner