

Chapter 600 Parts, Form and Content of Application

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Rule 51 General requisites of an application. Applications for patents must be made to the Commissioner of Patents. A complete application comprises:

- (a) A petition or request for a patent, see rule 61.
- (b) A specification, including a claim or claims, see rules 71 to 77.
- (c) An oath, see rule 65.
- (d) Drawings, when necessary, see rules 81 to 88.
- (e) The prescribed filing fee. (See rule 21 for filing fees.)

[Old Rule 30]

The petition, specification, and oath must be in the English language and must be legibly written or printed in permanent ink. See Rule 52 and 608.01.

The parts of the application may be included in a single document, if the approved single signature form is used (Rule 58, 605.04 (a)).

Determination of completeness of an application is covered in 506.

The petition, specification and oath are secured together in a file wrapper bearing appropriate identifying data including the serial number and filing date (717).

NOTE

- Reissue patents, 1401.
- Design patents, Chapter 1500.
- Plant patents, Chapter 1600.

A model, exhibit or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (Rules 91-93, 608.03).

Rule 59 Papers of complete application not to be returned. The papers in a complete application will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost. See rule 87 for return of drawing.

[Old Rule 72, par. 1]

601 Petition

Rule 61 Petition. The petition must be addressed to the Commissioner of Patents and must state the name, residence, and post office address of the petitioner

and request the grant of a patent; designate by title the invention sought to be patented; contain a reference to the specification for a full disclosure of such invention; and must be signed by the applicant in person.

The power of attorney or authorization of agent may be incorporated in the petition.

In the single signature form, the statements above required for a separate petition do not all appear in the petition paragraph and are differently arranged. (See rule 58.)

[Old Rule 33]

Petitioner's or applicant's post office address is discussed in 605.03.

The petition need not be dated.

601.01 Amendment of Petition

Those portions of the petition other than the post office address (see 605.03) may be amended by the attorney. (Extract from Order No. 1994.)

601.02 Power of Attorney or Authorization of Agent

Usually a power of attorney or authorization of agent is incorporated in either the petition or single signature form. See 402 and 605.04 (a).

The attorney's or agent's full post office address should be given in every power of attorney or authority of agent. The prompt delivery of communications will thereby be facilitated. (Extract from Notice of Oct. 8, 1946).

602 Original Oath

Rule 65 Oath of applicant. (a) The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than one year prior to his application, or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country

or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

(b) If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the oath shall state the relationship of the affiant to the inventor and, upon information and belief, the facts which the inventor is required by this rule to make oath to.

(c) An additional oath may be required if the application has not been filed in the Patent Office within a reasonable time after the execution of the original oath.

(d) In the case of applications for patent for inventions to which section 3 of 61 Stat. 794; Public Law 380, August 6, 1947; 35 U. S. C., Supp., 101 note, applies, the oath should include a statement that the invention was not made before January 1, 1946, or was not made before January 1, 1946 in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. If not included in the oath, a separate affidavit will be required.

[Old Rule 46]

The single signature form mentioned in Rule 58 includes the oath.

An oath which refers to applicant as "the petitioner" need not contain applicant's name in the body thereof.

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

The oath usually bears an impressed seal of the administering official but such seal may not always be required. See Rule 66, and 604 to 604.01 (a).

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath is required. Rule 67, 603.

602.01 Oath Cannot Be Amended

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

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

Likewise, a consular certificate (604.04 (a)) or a consular fee stamp (604.05) can be added to correct a deficiency in the oath.

602.02 New Oath or Substitute for Original

In requiring a new oath, the Examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath, preferably by giving the serial number and the date of filing.

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

602.03 Defective Oath Must Not Be Waived by the Examiner

The fact that the courts would probably not invalidate a patent because of a defective oath does not relieve the Examiner of the duty of requiring the appropriate remedy for any such defect.

602.04 Foreign Oath

An oath executed in a foreign country must be properly authenticated, 604, Rule 66.

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

Extract from Rule 66. (b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribbioned or each sheet impressed with the seal, the case will be accepted for examination but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[Old Rule 47]

602.05 Oath Too Old at Time of Filing

The time elapsed between the date of execution of oath and the filing date of the application should be checked for compliance with Rule 65 (c). If an unreasonable time has elapsed, the Examiner should call for a new oath. What constitutes a reasonable time is a question of judgment to be determined by all the circumstances in the particular case. (Five weeks plus time of transmission in the mails was consid-

ered reasonable under the circumstances of *ex parte* Heinze, 1919 C. D. 67; 265 O. G. 145). Note 602.05 (a).

602.05 (a) Oath in Division and Continuation Cases

Where the date of filing the application is not the date that determines the statutory twelve months' period, as in divisional and continuation cases, it is immaterial, so far as concerns the acceptability of the oath, how long a time intervenes between the execution of the oath and the filing of the application.

When a divisional application is identical with the original application as filed, signing and execution of the oath in the divisional case may be omitted. (See Rule 147, 201.06).

603 Supplemental Oath

Rule 67 Supplemental oath for matter not originally claimed. (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath here required may be made on information and belief by an executor or administrator of a deceased person or a guardian, conservator, or representative of an insane person.

[Old Rule 48]

Rule 67 requires in the supplemental oath substantially all the data called for in Rule 65 for the original oath. As to the purpose to be served by the supplemental oath, the Examiner should bear in mind that it cannot be availed of to introduce new matter into an application. It applies only to matter originally shown or described but not embraced in the statement of invention or claims as originally presented.

603.01 Supplemental Oath Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 Fed. 158, many supplemental

oaths covering the claims in the case have been filed after the case is allowed. Such oaths may be filed as a matter of right and when received they will be placed in the file by the Issue Branch, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under Rule 312, since they make no change in the wording of the papers on file. (Order No. 2798.) See 714.16.

604 Administration or Execution of Oath

Extract From Rule 66 Officers authorized to administer oaths. (a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no oath or affirmation may be administered by any attorney or agent appearing in the case. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by a competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

[Old Rule 47]

NOTE:

Seals, 604.01.

When unnecessary, 604.01 (a).

In foreign case, 602.04 (a).

604.01 Seal

An oath under Rule 65 administered by a civilian official must be attested to by a competent seal, as required by Rule 66.

The seal must be a physical impression such as produced with a die upon the paper or upon a substance adherent to the paper. See also 602.04 (a) on foreign executed oath and seal.

604.01 (a) Seal, When Not Required

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in 604.03 (a), in which situations no seal is necessary.

604.02 Venue

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on oath, or from the listing at 604.03. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given as the caption of the oath, or in the body of the jurat. Otherwise, a new oath, or a certificate of the notary that the oath was taken within his jurisdiction, must be required. Ex parte Delavoye, 1906 C. D. 320; 124 O. G. 626; Ex parte Irwin, 1928 C. D. 13, 367 O. G. 701.

604.03 Notaries and Extent of Jurisdiction

The extent of the jurisdiction of the notaries in the various states is given below.

STATEWIDE

| | |
|----------------------|----------------|
| Alaska | Nevada |
| Arkansas | New Hampshire |
| Canal Zone | New Jersey |
| Colorado | New Mexico |
| Connecticut | New York (c) |
| Delaware | North Carolina |
| District of Columbia | North Dakota |
| Florida | Oklahoma |
| Georgia | Oregon |
| Idaho | Pennsylvania |
| Illinois | Puerto Rico |
| Indiana | Rhode Island |
| Louisiana | South Carolina |
| Maine | South Dakota |
| Maryland | Utah |
| Massachusetts | Vermont |
| Michigan | Washington |
| Minnesota | Wisconsin |
| Montana | Wyoming |

COUNTY ONLY

| | |
|------------|---------------|
| Alabama | Mississippi |
| Arizona | Tennessee |
| California | Texas |
| Kansas | West Virginia |

VARIABLE JURISDICTION

(See explanatory paragraphs (a-f) below.)

| | |
|--------------|--------------|
| Hawaii | Nebraska (b) |
| Iowa (a) | Ohio (f) |
| Kentucky (a) | Virginia (d) |
| Missouri (a) | |

(a) In Iowa, Kentucky, and Missouri a notary, by filing a proper certificate in counties adjoining that for which he is appointed, may have authority to administer oaths in such counties also.

(b) In Nebraska a notary with a county commission can act only in that county; but he may have a general commission and may then act in any county on filing proper papers.

(c) In New York an attorney-at-law may be commissioned to act as a notary public but shall not employ the words "notary public" in connection with his official acts or duties.

(d) In Virginia, a notary may be appointed for one or more counties and cities, or for the commonwealth at large.

(e) In the Territory of Hawaii it is generally limited to the judicial circuit.

(f) In Ohio the law, as amended in 1941, gives notaries who are attorneys-at-law statewide jurisdiction and other notaries jurisdiction in the county of appointment. The extent of jurisdiction is stated on the seal or near the notary's signature.

The notary does not have to state when his commission expires but if he does so state, the oath should be inspected to determine whether or not the notary's commission had expired at the date of execution of the oath.

604.03 (a) Notarial Powers of Some Military Officers

Certain Naval Officers serving beyond the continental limits of the U. S. have notarial jurisdiction but have no seal. (Act of April 25, 1935; 34 U. S. C. 217 a.)

All Army officers on duty with the Judge Advocate General's Department, and all adjutants, assistant adjutants or personnel adjutants of any command, among other designated army officers, have notarial powers to administer oaths to be executed by persons subject to military law. (Act of Dec. 14, 1942; 10 U. S. C. 1586.)

During existence of war or declared national emergency and six months thereafter, any officer of the Navy, Marine Corps or Coast Guard designated by the Secretary of the Navy (or by the Secretary of the Treasury in the case of Coast Guard if under the jurisdiction of the Secretary of the Treasury) has notarial powers. No seal is required. (Act of April 9, 1943; 34 U. S. C. 217a-1.)

604.04 Consul

The authority of any officer, not a United States minister, chargé d'affairs, consul, or commercial agent, administering an oath to an applicant residing abroad must be proved by certificate of United States diplomatic or consular officer. Rule 66, 604.

604.04 (a) Consul-Omission of Certificate

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad, the Examiner should require a consular certificate for the original oath.

604.05 Consular Fee Stamp

Sec. 10, Act approved April 5, 1906; "whenever a consular officer is required or finds it necessary to perform any consular or notarial act he shall prepare and deliver to the party or parties at whose instance such act is performed a suitable and appropriate document as prescribed in the consular regulations and affix thereto and duly cancel an adhesive stamp in the denomination or denominations equivalent to the fee prescribed for such consular or notarial act, and no such act shall be legally valid within the jurisdiction of the Government of the United States unless such stamp or stamps is or are affixed and cancelled."

604.05 (a) Omission of Consular Fee Stamp

In all applications executed abroad before a consular officer, from which the required consular fee stamp has been omitted, the first action in the case will include the requirement that the necessary stamp be forwarded to the Patent Office to be affixed to the affidavit and canceled by the Head of the Application Branch. (Order No. 2032, Revised.)

604.05 (b) Embassies and Legations Stamp Not Required

Embassies and legations are not supplied with fee stamps, and are not required to attach any such stamps to papers executed by them. (Extract from Notice of Aug. 4, 1914.)

604.06 Oath by Attorney in Case, Invalid

The oath may not be executed before a notary who has power of attorney in the case. If such an oath is offered as one of the original papers, the application is not accepted as "complete," since an oath so executed is invalid and without legal effect. (Riegger v. Beierl, 1910 C. D. 12; 150 O. G. 826.) Rule 66, 604.

605 Applicant

Rule 41 Only inventor may apply for patent. Only the actual inventor may apply for a patent and the application papers must be signed and the necessary oath executed by the inventor, unless the inventor is dead or insane. See rule 147.

Extract from Rule 45. Joint inventors. (a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly.

For convertibility from a joint to sole application see 201.03.

Rule 46 Assigned inventions and patents. In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made by the inventor as indicated in rules 41 and 45, or by one of the persons mentioned in rules 42 and 43. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in rule 334. [Old Rule 26]

Rule 47 Applicant. Unless the contrary is indicated, the word "applicant" when used in these rules refers to the inventor (rule 41), joint inventors who have applied for a patent (rule 45), or to the person mentioned in rule 42 or 43 who has applied for a patent in place of the inventor.

NOTE

Disposition of application by inventor, 301.
Inventor dead or insane, 409.

Nationals of Germany or Japan may not apply for or obtain patents for any invention made, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. Public Law 380, Sec. 3, 602 O. G. 675-6.

605.01 Applicant's Citizenship

The statute (Sec. 4892, R. S.; 35 U. S. C. 35) requires an applicant to state his citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement; but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

605.02 Applicant's Residence

The rules of practice require that the applicant state his place of residence. In the case of an applicant who is in the U. S. Army or U. S. Navy, a statement to that effect is sufficient as to residence. For change of residence see 717.02 (b).

605.03 Applicant's Post Office Address

Applicant's post office address means under Rule 61 that address at which he customarily receives his mail.

The object of requiring applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instructions to send communications to applicant in care of the attorney is not sufficient. (Extract from Order No. 1994.)

If the post office address is entirely omitted it must be supplied by a letter over the applicant's own signature. Where, however, having given complete data as to his residence, the applicant identifies his post office address only by street and number, it is assumed and so accepted, that the city and state of his residence are the city and state of his post office address.

Any amendment of the post office address requires the signature of the applicant himself.

605.04 Applicant's Signature and Name

Rule 57 Signatures. The petition, the specification and claim, and the oath, must be signed by the applicant in person. Full names must be given, including the full first name without abbreviation, and the middle initial or name if any.

Rule 76 Signature to the specification. The specification and claim must be signed by the applicant in person. See rules 57 and 58.

[Old Rule 40]

If the oath, which is sworn to, and one of the other component parts of the application are properly signed by the applicant, his failure to sign the other parts will not of itself defeat acceptance as a complete application.

The signing and execution by the applicant of certain Divisional applications may be omitted. Rule 147, Section 201.06.

605.04 (a) Single Signature Form

Rule 58 Single signature form. The petition, oath, specification and claim, and power of attorney may be included in a single document and may be executed by a single signature of the applicant if an approved single signature form supplied by the Office or approved by the Office is used.

[Old Rule 30A]

The single signature form (Rule 58) should be executed only when attached to a complete application as the last page thereof.

NOTE: Signature to response 714.01 (a) to (e).

605.04 (b) Full First Name Required

Rule 57 requires "full names". The full *first* name must appear somewhere in the papers as filed, and there must be consistency in the names and signatures. Otherwise, appropriate amendment is required.

All applications which disclose the full first and last names with middle initial or name, if any, of the

applicant at any place in the application papers will be received and considered as a sufficient compliance with Rules 57 and 76 of the Rules of Practice.

When the *full first name* of the applicant does not appear either in the signature or elsewhere in the papers the Examiner will, in the first official action, require an amendment over applicant's signature supplying the omission, and he will not pass the application to issue until the omission has been supplied unless a statement be filed over the applicant's own signature setting forth that his full first name is as signed or what is in fact his full first name.

No affidavit should be required.

The requirement should be made only when for the first name in the signature a mere initial appears or what can be only an abbreviation of a name. (Order No. 3140 Revised.)

In an application where the name is type written with a *middle name or initial*, but the signature is without such middle name or initial, action should be taken as follows:

In the first Office letter, call attention to the lack of uniformity and request information over the applicant's signature as to the correct form of his name, together with any necessary amendment.

If applicant, in reply, gives the name without the middle name or initial unaccompanied by any instructions to amend the typewritten name, the reply may be interpreted as a direction to cancel the middle name or initial from the preamble; though such amendment is not material, since the preamble is no longer printed in the patent. It is necessary however, that such surplus portion of the name, if it appears printed on the drawing, should be removed therefrom. This can be done by the Office draftsman.

If applicant gives the name with the middle name or initial, interpret the reply as a direction that the middle name or initial is to be used in the name on the printed patent. As the printer takes the name from the signature of the application, the addition of the middle name or initial must be indicated in red ink adjacent the signature.

If applicant fails to answer the request and the case is otherwise ready for issue, correct the name on the drawing by Examiner's amendment to correspond to the signatures, send copy to attorney, and pass the case to issue. This cannot be done if there are inconsistencies in the signatures.

There should be uniformity notwithstanding that lack of it is not sufficient to affect the validity of the patent.

When the name is corrected, the file should be sent to the Application Branch for correction of its records.

605.04 (c) Applicant Changes Name

In cases where an applicant's name has been changed after his application has been filed and the applicant desires that the patent when issued carry an endorsement as to the change in his name, it will be sufficient for the applicant to make a request in writing accompanied by an oath signed with both names and setting forth the procedure whereby the change of his name was effected. When such papers are received the application will be forwarded to the Assignment Branch and the oath pertaining to the change of name will be recorded in the assignment records. The Assignment Branch will then forward the application to the Application Branch for a change in their records. (Order No. 5106, Revised.)

No change is made on the face of the file by the Docket Clerk of the examining division, a suitable endorsement being made by the Assignment Branch. When ready for allowance, the case should be sent to the Drafting Branch for the addition of the new name to the drawing.

Where the change of name is merely by amendment, such as the addition of a full first name or a middle initial and no oath is required, the file is sent to the Application Branch for a change in their records and if the application is assigned it will be forwarded by the Application Branch to the Assignment Branch for a change in assignment record.

605.04 (d) Applicant Unable To Write

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

605.04 (e) May Use Title With Signature

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

605.04 (f) Signature on Joint Applications

In case of a joint application, the order of the names on the file wrapper is that in which they are signed to the specification or to the single signature form. It is not essential that the names appear in the same order in the signatures to the petition, specification, oath, and drawing.

605.04 (g) When Name Is Corrected, Send to Application Branch

When the name is corrected by amendment, the file should be sent to the Application Branch for correction of the name in its record. When the name is changed, see 605.04 (c).

605.04 (h) Unsigned Original Specification and Signed Duplicate

Whenever an application is filed in which the original specification is not signed by the applicant, a requirement should be made in the first action that the specification be signed by the applicant or that a properly signed duplicate specification be filed. An unsigned specification is not returned to the applicant, but the applicant may come in and sign such specification in the Patent Office. Otherwise, a properly signed permanent duplicate copy of the specification as originally filed is required. If the duplicate specification be filed with the first amendment, said amendment should be entered in the signed duplicate specification and the original or unsigned specification canceled; but if the first amendment be filed before the signed duplicate specification is filed, the amendment should be entered in the original specification, and the signed specification marked "Duplicate of Original Specification" and placed in the file, in which case a marginal notation should be made at the end of the unsigned specification to print the signature as found at the end of the duplicate specification. (Notice of Dec. 11, 1934, Revised.)

605.04 (i) Signature to Drawing

Rule 82 Signature to drawing. The drawing must either be signed by the applicant in person or have the name of the applicant placed thereon followed by the signature of the attorney or agent as such.

[Old Rule 50]

The drawing is not signed by both applicant and attorney. When the drawing is signed by the inventor in person the name of the attorney is not permitted to appear thereon.

The drawing may be signed by the applicant, attorney, or agent in person after the drawing has been filed. The signature need not be dated.

Prohibition against changing name of attorney on drawing is discussed at 608.02 (v).

For return of drawing to applicant for signature see 608.02 (z).

The name or signature of the inventor must be identified as such by an appropriate legend. Each sheet must be signed.

605.05 Administrator or Executor

For prosecution by administrator or executor see 409.01.

In an application filed by an administrator or executor, the specification should not be written in the first person. Instead of the usual "I have found," the wording should be "it was found."

605.05 (a) Signature of Executor or Administrator

The signature to the drawing must be in this form:

John A. Jones, deceased,
by Mary A. Jones, Administratrix.

The other signatures must either be in the above form or:

Mary A. Jones
Administratrix of Estate of
John A. Jones, deceased.

If the drawing is signed by the attorney, this form must be used:

John A. Jones, deceased,
by Mary A. Jones, Administratrix,
by William A. Smith, Atty.

If the specification bears the *signature* of the administrator or executor but omits the matter, "administrator of the Estate of John Jones, deceased," the matter can be added by amendment. The Examiner may make the amendment if the case is otherwise ready for issue.

If the application is by the heirs of a deceased inventor, see 409.01 and 409.01 (c).

606 Title of Invention

Rule 72 Title of the invention. The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification.

Despite the statement in the Rule, the Examiner should not require that the title be placed at this particular location.

A title is a requisite part of an application. (See Rule 61, section 601.)

606.01 Examiner May Require Change in Title

Where the title is not descriptive of the invention claimed, the Examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying,

searching, etc. If a satisfactory title is not supplied by the applicant, the Examiner may change the title by Examiner's Amendment on or after allowance. (Extract of Notice of July 1, 1946.)

If a change in title is the only change being made by the Examiner at the time of allowance a separate Examiner's Amendment need not be prepared. The change in title will be incorporated in the Notice of Allowance. This will be accomplished by adding the typewritten notation in capital letters "AS AMENDED BY EXAMINER" following the heading "Title of Invention or Improvement" and entering thereunder the title as changed by the examiner.

The Primary Examiner or the assistant examiner making the change must initial any Notice of Allowance containing a change in the title of invention.

The Notice of Allowance containing a change of title will be authority for the clerk to make the change indicated.

However, if an Examiner's Amendment must be prepared for other reasons any change in title will be incorporated therein. (Notice of May 23, 1950.)

607 Filing Fee

While a filing fee, except as provided in the Act of March 3, 1883, as amended April 30, 1928, is a *sine qua non* part of the complete application for a patent, it seldom, if ever, presents any question requiring the attention of the Examiner. The requisite fee must be paid before the application is given a filing date, and hence before it is sent to the examining division, Rule 22. Fees are listed in Rule 21.

No additional filing fee is receivable after the filing date. If claims in excess of the number corresponding to the filing fee are presented before the first official action, see 714.10.

607.01 Fee Exempt

The Act of April 30, 1928, amending the Act of 1883, states the law governing the granting of patents without payment of fees, and is as follows:

35 U. S. C. 45. Patents; issue to Government officers for inventions used in public service. The Commissioner of Patents is authorized to grant, subject to existing law, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section 31 of this title, without the payment of any fee when the head of the department or independent bureau certifies such invention is used or liable to be used in the public interest: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in

the patent. (Mar. 3, 1883, ch. 143, 22 Stat. 625; Feb. 14, 1903, ch. 552, sec. 12, 32 Stat. 830; Apr. 30, 1928, ch. 460, 45 Stat. 467).

In revising "fee exempt" applications for issue, the specification should be checked to assure the presence of the substance of the following statement therein:

"The invention described herein may be manufactured and used by or for the Government for governmental purposes without the payment of any royalty thereon."

If the substance of such a statement does not appear in the specification, but is present elsewhere in the record, the same should be entered, by Examiner's Amendment, as the first paragraph of the specification.

If the substance of this statement is not present at any point in the record of the application, an action should be made requiring such statement, signed by the applicant, and an amendment directing insertion of same as the first paragraph of the specification. A shortened statutory period for response should be set and the application withheld from issue until such response has been made. (Notice of June 6, 1949.)

For notation to be put on file wrapper of "fee-exempt" application see 1302.08.

607.01 (a) Inventor Leaves Service of United States

An opinion of the Attorney General, dated January 14, 1936, rules that an application filed under the Act of 1883, as amended, which meets the requirements of this statute as to the status of the inventor at the time of filing, is sufficient warrant for the issuance of a patent to the inventor if the invention claimed therein is found patentable, whether or not he is in the service of the United States at the time the patent issues.

607.01 (b) Fee Exempt Changed to Fee Filed

Where an application is filed under the Act of March 3, 1883, as amended April 30, 1928, the regular filing fee can be subsequently paid and proper amendment made by the inventor, concurred in by the Head of the Department concerned, cancelling the offer of dedication, the fee being entered on the file and the original date of the application retained.

607.01 (c) Fee Filed Changed to Fee Exempt

An application for which a filing fee has been paid may issue under the Act of March 3, 1883, as amended April 30, 1928, if the applicant qualifies

under said Act, and files the required dedication by amendment signed by the inventor and certified by the Head of the Department. In such case the docket clerk of the division will forward the application to the Application Branch for appropriate amendment of the file wrapper and of the record in the Application Branch. (Notice of August 10, 1938, Revised.)

607.02 Returnability of Fees

All questions pertaining to the return of fees will be referred to the Financial Division. Examiners and Chiefs of other divisions will express no opinion to attorneys or applicants as to whether or not fees are returnable in particular cases. (Notice of Oct. 11, 1937.)

608 Disclosure

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which he seeks protection. All amendments or claims must find basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, all as filed complete. See Rule 118, 608.04.

608.01 Specification

Rule 71 Detailed description and specification of the invention. (a) The specification must include a written description of the invention or discovery and of the manner and process of making, constructing, compounding, and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.

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

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

[Old Rules 34, 35, 36]

Certain cross notes to other related applications may be made when appropriate, and others are required. Rule 78, 202.01.

Rule 52 Language, paper, writing, margins (a) The petition, specification, and oath must be in the English language. All papers which are to become a part of the permanent records of the Patent Office must be legibly written or printed in permanent ink.

(b) The specification and claims, and also papers subsequently filed, must be plainly written on but one side of the paper. A wide margin must be reserved on the left-hand side and on the top of each page and the lines must not be crowded too closely together. Legal paper, 8 to 8½ by 12½ to 13 inches, typewritten and double spaced with margins of one and one-half inches on the left-hand side and top is deemed preferable. Typewritten or printed papers suitable for use by the Office may be required if the papers originally filed are not correctly, legibly and clearly written.

(c) Any interlineation, erasure or cancellation or other alteration made before the application was signed and sworn to should be clearly referred to in a marginal note or footnote on the same sheet of paper, and

initialed or signed and dated by the applicant to indicate such fact. (See Rule 56.)

[Old Rules 30, 45]

In order that specifications may be expeditiously handled by the Office, page numbers should be placed at the center of the bottom of each page. (Notice of March 28, 1950.)

Typed, mimeographed, or multigraphed papers are acceptable. A good carbon copy is acceptable.

As stated in Rule 52 the specification as well as petition and oath must be in the English language.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications encumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

The specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 488 R. S. 35 U. S. C. 33, revision of the

application should immediately be required. See 702.01.

As the specification is never returned to applicant under any circumstance, he should retain a line for line copy thereof. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

608.01 (a) Parts of Specification

Rule 77 Arrangement of specification. The following order of arrangement should be observed in framing the specification:

(a) Title of the invention; or a preamble stating the name, citizenship and residence of the applicant and the title of the invention may be used.

(b) Brief summary of the invention.

(c) Brief description of the several views of the drawing, if there are drawings.

(d) Detailed description.

(e) Claim or claims.

(f) Signature.

[Old Rule 39]

The term specification as used herein includes the descriptive portion of the application and the claims. "Specification" is sometimes used to denote the descriptive portion without the claims.

NOTE

Design patent specification, 1503.01.

Plant patent specification, 1602.

Reissue patent specification, 1401.06.

608.01 (b) Preamble

The preamble of the specification is simply the introductory portion stating applicant's name, citizenship, residence, and the title of the invention.

608.01 (c) Preamble May Be Omitted

Since the preamble is not printed in the patent, its omission by applicant from the specification is permissible. The oath or single signature form supplies the data as to name, citizenship, etc., of which a specification preamble is composed.

608.01 (d) General Statement of Invention

Rule 73 Summary of the invention. A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Rule 79 Reservation clauses not permitted. A reservation for a future application of subject matter

disclosed but not claimed in a pending application will not be permitted in the pending application.

[Old Rule 44]

608.01 (e) General Statement of Invention-Coextensive With Claims

Since the purpose of the general statement of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention the statement should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the claims taken as a unit should be paraphrased in a few clear, concise sentences or paragraphs, according to the extent and nature of the invention. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly in point as applicable exclusively to the case in hand.

The general statement of invention should be coextensive with the claims. Note final review of application and preparation for issue, 1302.

608.01 (f) Brief Description of Drawings

Rule 74 Reference to drawings. When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

[Old Rule 38]

The Examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used.

608.01 (g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by Rule 71, 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to construct, prepare and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his own terminology, as long as it can be understood.

Necessary grammatical corrections, however, should be required by the Examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the "given part," with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide a basis for all terms used in the claims. See Rule 75 in 608.01 (i) and also 608.01 (o).

NOTE.—Completeness 608.01 (p).

608.01 (h) Mode of Operation of Invention

The best mode devised by the inventor of carrying out his invention must be set forth in the description. Current practice is to accept an operative example as sufficient to meet this requirement.

In chemical cases, complete data necessary for the preparation and use of at least one example of the invention should be presented.

NOTE.—Completeness 608.01 (p).

608.01 (i) Claims

Rule 75 Claim. (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the part, improvement, or combination which the applicant regards as his invention or discovery.

(b) More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

See rules 141 to 147 as to claiming different inventions in one application.

[Old Rule 37]

NOTE

Numbering of Claims, 608.01 (j).
Form of Claims, 608.01 (m).
Dependent claims, 608.01 (n).
Examination of claims, 706.
Claims in excess of fee, 714.10.

608.01 (j) Numbering of Claims

Rule 126 Numbering of claims. The original numbering of the claims must be preserved throughout the prosecution. When claims are cancelled, the remaining claims must not be renumbered. When claims are added by amendment or substituted for cancelled claims, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[Old Rule 73, par. 2]

608.01 (k) Statutory Requirement of Claims

Sec. 488 R. S. 35 U. S. C. 33 requires that the applicant shall particularly point out and distinctly claim the part, improvement, or combination which he regards as his invention or discovery. The portion of the application in which he does this forms the claim or claims. This is the most important part of the application, as it is the definition of that for which protection is granted.

608.01 (l) Original Claims

In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the specification is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and specification to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and specification. It is the drawing and specification that are defective; not the claim.

It is of course to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and specification.

608.01 (m) Form of Claims

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim" whether or not the words "I (or we) claim" are stated. The claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claim except for abbreviations.

See Rejections not based on Prior Art 706.03.

608.01 (n) Dependent Claims

A dependent claim is a claim which incorporates another claim by reference and further restricts the language of the claim incorporated. For example, claim 2, a dependent claim, could read as follows:

2. The product of claim 1 in which . . .

Rule 75 (c), permitting dependent claims, reads as follows:

When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

A dependent claim cannot in terms refer back to two or more preceding claims. For example, a claim reading as follows:

7. A machine as specified in claims 5 or 6 (or, 5 and 6) in which . . .

is not permitted. Such a claim disguises the true number of claims, since it is in reality two claims. It is also alternative.

However, a dependent claim may refer to a preceding claim, which in turn refers to another preceding claim, thus a series of dependent claims as follows:

2. The machine of claim 1 in which . . .

3. The machine of claim 2 in which . . .
etc.

is permitted.

There may be several series of dependent claims in a single application. All the claims in each series of dependent claims (i. e., those in addition to the base or independent claim) must either be in immediate consecutive order or as close thereto as is physically possible. In other words, it is permissible to have dependent claims which are dependent on the same dependent claim and are separated therefrom only by each other. (Notice of December 9, 1946, and Memorandum of July 16, 1951, revised.)

A dependent claim, which is otherwise allowable, should not be rejected merely because the

basic claim is rejected. See 707.07 (j).

When renumbering of the claims is necessary, in compliance with Rule 126, particular attention should be given to dependent claims to see that each dependent claim correctly identifies the claim upon which it is built.

608.01 (o) Basis for Claim, Terminology in Description

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import, and in mechanical cases it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, yet whenever by amendment of his claims, he departs therefrom, he should make appropriate amendment of his specification so as to have therein verbal basis for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. *Ex parte Kotler* 1901 C. D. 62; 95 O. G. 2634. See Rule 75, 608.01 (i).

608.01 (p) Completeness

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make, construct, compound and use the invention.

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such

details, including proportions and techniques where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Markush claims must ordinarily be provided with support in the disclosure of at least one specific example for each member of the Markush group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications. If the starting material is old but difficult to locate in the literature, the literature citation should be incorporated into the specification. This may be done by amendment. In the application as filed, preparation of a new chemical starting material may be described generally along with reference to a concurrently or previously filed application by the same inventor wherein the detailed preparation is given. If a concurrently or previously filed application of the same inventor adequately discloses the preparation of the starting material, amendments to include reference to such application by serial number and a general method of preparation are proper.

Reliance upon a copending application by a different inventor may not be made for the purpose of completing the disclosure.

All essential features of an invention must be fully disclosed in the application without depending upon a reference to a copending application for completing the disclosure.

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied upon to establish a constructive reduction to practice.

NOTE.—Trade-marks and trade names 608.01 (v).

608.01 (q) Substitute or Rewritten Specification

Rule 125 Substitute specification. If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the

entire specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the examiner.

[Old Rule 74]

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications cumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

A substitute specification that has not been required, and is not needed, is not entered. See 714.20.

New matter in amendment, see 608.04.

Application prepared for issue, see 1302.02.

608.01 (r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his invention, but he is not permitted to make derogatory remarks concerning the inventions of others, or to designate them by name unless to state that he desires to improve on the disclosure in a prior patent or in an application of common ownership or that he makes no claim to the disclosure in a certain application of common ownership.

608.01 (s) Restoration of Canceled Matter

Canceled text in the specification or a canceled claim can be restored only by filing a duplicate thereof. See Rule 124, 714.24.

608.01 (t) Use of Disclosure in Subsequent Application

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application. Rule 79, 608.01 (d).

While a specification cannot be transferred to another application, drawings may be transferred from a prior application to a latter case by the same inventor, note 608.02 (i) to 608.02 (l).

608.01 (u) Use of Formerly Filed Incomplete Application

Parts of an incomplete application may be used as part of a complete application if the missing parts are later supplied. See 506 and 506.01.

608.01 (v) Trade-Marks and Trade Names in Disclosure

The expressions "trade-mark" and "trade name" as used below have the following meanings:

Trade-mark; a proprietary word, letter, device or symbol, used in connection with merchandise and pointing distinctly to the origin or ownership of the article to which it is applied.

Trade name; a nonproprietary name by which an article is called among traders or workers in the art, and which is not indicative of the origin or ownership of the article to which it is applied.

The use of trade names in patent applications is permissible if:

(1) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(2) In this country, their meanings are well known and satisfactorily defined in the literature.

Condition (1) or (2) must be met at the time of filing of the complete application.

The relationship between a trade-mark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trade-mark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trade-marks which are liable to mean different things at the pleasure of manufacturers do not constitute such language.

However, if the product to which the trade-mark refers is otherwise set forth in such language that its identity is clear the Examiners are authorized to permit the use of the trade-mark if it is distinguished from common descriptive nouns, as by capitalization and/or quotation marks. If the trade-mark has a fixed and definite meaning it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event as also in those cases where the trade-mark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary.

Where the identification of a trade-mark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. (Notice of November 18, 1947, Revised.)

If proper identification of a trade-mark or trade name has been omitted from the specification but is deemed necessary therein under the

principles above set forth, the Examiner should object to the disclosure as insufficient, and reject, as based on an insufficient disclosure, any claims based on the disclosure of the product designated by the trade-mark or trade name. The original disclosure sometimes may be suitably amended to define the product to which the trade-mark or trade name is applied. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trade-marks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might endanger their validity as trade-marks. The Examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as T. M. (trade-mark)."

608.02 Drawing

Rule 81 Drawings required. The applicant for patent is required by statute to furnish a drawing of his invention whenever the nature of the case admits of it; this drawing must be filed with the application. Illustrations facilitating an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views) may also be furnished in the same manner as drawings, and may be required by the Office when considered necessary or desirable.

[Old Rule 49]

Rule 86 Draftsman to make drawings. Applicants are advised to employ competent draftsmen to make their drawings.

The Office may furnish the drawings at the applicant's expense as promptly as its draftsmen can make them, for applicants who can not otherwise conveniently procure them. (See rule 21.)

[Old Rule 55]

NOTE

Standards for drawings, Rule 84.
Design patent drawings, Rule 152, 1503.02.
Plant patent drawings, Rule 165.
Reissue application drawings, 608.02 (k).
Signature to drawing, 605.04 (i).

The back of each sheet of drawing must bear the stamp of the draftsman before the application is allowed.

The Patent Copy Sales Branch, Reproduction Section 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 in the Abandoned Files Unit.

See: Correction of drawings, 608.02 (g); Prints, preparation and distribution, 508, 608.02 (m). Prints, Return of drawing, 608.02 (z).

608.02 (a) New Drawing—When Required

The Chief Draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the Examiner is the judge as to the sufficiency of the showing. The drawings, upon receipt of an application, are sent from the Application Branch to be inspected by the Chief Draftsman. If satisfactory, he stamps on the back of each sheet "Approved, Draftsman, U. S. Patent Office" together with the date.

If the drawings are informal, but may be admitted for examination purposes the Draftsman writes in lead pencil in the margin of the drawing "Inf. A. F. E." (admit for examination) together with his criticism and if the drawings can be corrected he adds the words "can be corrected." On all informal drawings that cannot be freed from objection he notes the words "New drawings required." The drawings are then returned to the Application Branch.

If the drawing is endorsed "Inf. A. F. E." it is accepted as satisfying the requirement of Rule 51.

The Examiners are directed to advise the applicants in the first Office action of the conditions which render the drawing informal, and when indicated, that such drawings can be corrected so as to be acceptable, but will not, in any case, require new drawings because of their execution unless the necessity therefor shall have been indicated by the Chief of the Drafting Branch. (Extract from Order No. 1764). See 707.07 (c).

The Examiner may require additional drawings for the purpose of illustrating the disclosure.

When a necessary additional illustration is small and may be added to the drawings on file, an additional sheet of drawing should not be required, but the Examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings (Extract from Order No. 1862).

For the handling of additional, duplicate, or substitute drawings, see 608.02 (h).

608.02 (b) Informal Drawings

Rule 85 Informal drawings. The requirements of Rule 84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto may be

admitted for purpose of examination, but in such case the drawing must be corrected or a new one furnished, as required. The necessary corrections will be made by the Office upon applicant's request and at his expense. (See Rule 21.)

[Old Rule 54]

If the drawing is such that the prosecution of the application can be properly carried on without the corrections being made, the Examiner should inform the applicant that the corrections need not be made until patentable subject matter is found in the application. Even where appeal is taken, if no claim has been allowed, correction of the drawing will not be insisted on.

608.02 (c) Drawing or Print Always Kept in Examining Division

The photographic copies of the drawings must always be kept on top of the papers on the right of the file wrapper so as to be visible upon opening the wrapper and easily detached.

Whenever the original drawing is taken from the examining division, the photographic copy must be taken from the application file and placed in the cabinet of drawings in lieu of the original drawing. When the original drawing is returned to the examining division and placed in the cabinet, the photographic copy must be replaced in the file.

When sending for the original drawing upon payment of the final fee, the Issue and Gazette Branch, after stamping the patent date upon the photographic copy, will send the latter to the Examining Division, and such photographic copy must be placed in the cabinet in lieu of the original drawing.

This procedure is to make certain that either the original drawing or the protographic copy (print) is always available for interference searches.

Each examining division will, each week, select the photographic copies bearing the date of that week's issue and return them to the Issue and Gazette Branch by Wednesday morning of that week in order that the latter may replace them in the proper application (now patent) files.

If there is no copy of the drawing in the file, a dummy must be placed in the cabinet of drawings in lieu of the original drawing whenever the latter is removed from the examining division.

No application should be sent to issue or to abandoned files unless the original drawing is checked up and found in the division. (Order No. 3104, Revised.)

608.02 (d) Complete Illustration in Drawings

Rule 83 Content of drawing. The drawing must show every feature of the invention specified in the claims. When the invention consists of an improvement

on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

[Old Rule 50]

608.02 (e) Examiner Determines Completeness of Drawings

The Examiner should see to it that the figures are correctly described in the brief description of the specification and that the reference characters are properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. Every feature covered by the claims must be illustrated, but there should be no superfluous illustrations.

608.02 (f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. (Ex parte Badger, 1901 C. D. 195; 97 O. G. 1596.)

All modifications described must be illustrated, or the text canceled. (Ex parte Peck, 1901 C. D. 136; 96 O. G. 2409.) Likewise, any structural detail that is of sufficient importance to be described should be shown in the drawing. (Ex parte Good, 1911 C. D. 43; 164 O. G. 739.) This requirement does not apply to a mere reference to well-known and conventional parts.

NOTE.—Correction of drawing, 608.02 (q).

608.02 (g) Illustration of Prior Art

Generally where an applicant shows prior art in one or more figures of the drawings, such figures and the description thereof should be canceled. Ex parte Elliott 1904 C. D. 103, 109 O. G. 1337.

608.02 (h) Additional, Duplicate or Substitute Drawings

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed and such drawings have not been transmitted to the examining division, the docket clerk in the examining division should call the Application Branch before entering the amendment to ascertain if the drawing was not received. In the next communication of the Examiner the applicant is notified if the drawings have not been received. (Notice of March 24, 1919 Revised.)

To avoid accumulation of canceled sheets of drawings, the Examiners will not admit an additional or substitute drawing, unless the necessities of the case so require. If the Examiner considers an additional or substitute sheet of drawing necessary it must be submitted to the Chief Draftsman before entering it in the case.

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

For return of drawing, see 608.02 (z).

608.02 (i) Transfer of Drawings From Prior Applications

Rule 88 Use of old drawings. If the drawings of a new application are to be identical with the drawings of a previous application of the applicant on file in the Office, or with part of such drawings, the old drawings or any sheets thereof may be used if the prior application is, or is about to be, abandoned, or if the sheets to be used are cancelled in the prior application. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

Formal transfer of drawings from one application to another is made only by the Application Branch. The name of the attorney on the drawing being transferred is not changed, 608.02 (v).

When an application becomes a patent, any canceled sheet of drawing then in the case is sent to the abandoned files. Such canceled sheet is available for applicant's use in another application directed to its subject matter.

608.02 (j) Transfer of Canceled Sheets of Drawings to Divisional Application

In the case of a divisional application, if the drawing and descriptive matter pertaining thereto have been canceled from the parent case, the canceled sheet or sheets of drawing may be withdrawn and used as the original drawing of the divisional case.

608.02 (k) Transfer of Drawings to Reissue

Extract from Rule 174. The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue appli-

cation is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

In a reissue application, the prints of the original or patented drawing may be used for examination purposes, and the formal transfer of the original drawing to the reissue application made when the reissue application is ready for issue, *provided* no change whatever, even so much as the priming of a reference character, or correction of an obvious error, is made in the drawing. If there is to be any change whatsoever in the drawing, a new drawing for the reissue must be filed.

If there is more than one sheet of original drawing, a required change on any sheet will preclude the use of the entire set of the original drawings which must be kept intact and in the condition existing at the time of issue of the original patent. See 1401.05.

Transfer of the drawing is made by the Application Branch, notation thereof being entered on the file wrapper of the original application.

608.02 (1) Transfer of Drawings to Continuation or Substitute

Where a continuation is filed, prints are accepted in lieu of formal drawings to establish a filing date, the original drawings being transferred *after* abandonment of the parent case either by operation of law or by properly executed letter of abandonment. When a substitute application is filed, the drawing of the abandoned application may be used as the original drawing in the substitute application.

PRINTS IN LIEU OF DRAWINGS TO BE TRANSFERRED

Prints submitted in lieu of drawings are dated on the back by the Register, Correspondence and Mail Branch of the Administrative Services Division. These prints are mounted upon Bristol board by the Application Branch and the back of the board upon which the prints are mounted bears a date stamped by the Application Branch to correspond with the then covered date of the Mail Branch.

608.02 (m) Prints

Preparation and distribution of prints is discussed in 508.

Photographic prints are made of the drawings of an acceptable application. Prints of the drawings as filed are entered in the application, given a paper number and kept on top of

the papers on the right side of the file wrapper, see 717.01 (b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the date of their receipt in the office and given their appropriate paper number.

The print being thus an official paper in the record should not be marked or in any way altered. Where, as in an electrical wiring case, it is desirable, to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows or other indicia, an additional print for such use should be ordered by the Examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in 608.02 (e).

608.02 (n) Duplicate Prints in Patentability Report Cases

In Patentability Report cases having drawings, the Examiner to whom the case is assigned will obtain a duplicate set of prints of the drawing for filing in the division to which the case is referred.

When a case that has had Patentability Report prosecution is passed for issue or becomes abandoned, notification of this fact will at once be given by the division having jurisdiction of the case to each division that submitted a P. R. The Examiner of each such reporting division will note the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting division, they may be destroyed. (Extract of Notice of November 10, 1948.)

608.02 (o) Data on Prints

The photoprint in an application contains, besides a print of the drawing, the following information:

On the front of the print:

Serial number of the application. Stamp by the Application Branch "Print of drawing as originally filed." or "This is an additional sheet of drawing and must be submitted to the Chief Draftsman before entering the case." (This latter is stamped on the additional drawing and reproduced therewith.)

Paper number, usually #2.

Marginal notation of informalities by the Draftsman on the margin of the original drawing, or

"O. K." if there are no Draftsman notations. Class and subclass of the application.

On the back of the print:

Stamp of the Application Branch and date of receipt of the print from the photoprinting establishment. Sometimes a stamp of the Examining Division receipt date.

Additional prints prepared for the Examiner or the Board of Appeals bear on the front such information as is on the drawing as of the copying date, namely:

Serial number of the application. Sometimes the reproduced stamping "This is an additional sheet of drawing and must be submitted to the Chief Draftsman before entering in the case."

Marginal stamp "O. G. figure, Class and Sub-Class" reproduced from the stamp on the drawing.

On the back, additional prints bear a stamp stating "Photographs for Examiner" and the date the additional prints were made.

After the final fee has been paid the patent date is stamped on the print, 608.02 (c).

608.02 (p) Dates Entered on Drawing

Dates are entered by the Office upon the back of each sheet of drawing.

The earliest date is that of the Mail Branch, regardless of whether or not the drawing was submitted by mail.

If and when the drawing is approved by the Draftsman, and before the case is passed to issue, each uncanceled sheet of drawing must bear a date of the Draftsman.

The Examining Division receipt date is applied by the clerk of the Examining Division.

Dates when photoprints are made for the Examiner are stamped as "Photographs for Examiner."

Dates of correction of the drawing are stamped and noted by the Draftsman upon the back of each corrected sheet.

608.02 (q) Correction of Drawings

Rule 123 Amendments to the drawing. (a) No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the Office. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn from the Office except for signature.

(b) Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

[Old Rule 72, par. 2]

NOTE.—Correction is deferrable, see 608.02 (b), correction at allowance and issue, see 608.02 (x) and 1302.05.

608.02 (r) Conditions Precedent to Amendment of Drawing

Correction and alterations in the disclosure of the drawings of a pending application may be made only

under the supervision of, or by the Chief Draftsman.

No alterations as above indicated will be permitted unless required by an Examiner's letter in each case, or proposed in writing by applicant or his attorney. In either case the alterations or corrections as indicated in the sketches filed after the requirement by the Examiner, or with the request of the applicant or his attorney will receive the written approval of the Examiner before the case is sent to the Chief Draftsman. (Extract from Order No. 1958.)

NOTE.—Disposition of Orders for Amendment of Drawing, 608.02 (y).

608.02 (s) Separate Letter to Draftsman

Any request by the applicant for amendment of the drawing to cure defects must be embodied in a separate letter for the Chief Draftsman. Otherwise the case, unless in other respects ready for issue, will not be forwarded by the Examiner to the Drafting Branch, and applicant will be so advised in the next action by the Examiner. (Extract from Order No. 4009.)

NOTE.—Changes which may require sketches, 608.02 (w).

608.02 (t) Estimating Cost of Correcting Drawings

Files and drawings sent from the Examining Division to the Draftsman for estimating the cost of correcting the drawing or of making new drawings will be retained by the Draftsman only long enough to estimate the cost of the work.

If the Examiner approves of a proposed correction of a drawing for which an estimate is requested he will note his approval on the order for the estimate, attach the order to the outside of the file and have the Docket Clerk of the Division forward the file and drawing to the Draftsman. The Draftsman will note the estimate on the order and also on the drawing. If the application is not up for action the Draftsman sends the estimate to the Applicant. If the application is up for action the Draftsman does not send an estimate, but the Examiner should include the estimate in the next action.

After stating the estimate the following paragraph should be added in the Examiner's letter:

When corrections are made, prints of the corrected sheets should be ordered, cost 20 cents each, to ascertain whether the changes made are correct. (Notice of July 13, 1906, Revised.)

When giving an estimate in a case where no allowable subject matter has been found the Examiner should inform the applicant that no correction will be made until a claim is found to be allowable. If specifically requested by the applicant, the draw-

ing will be corrected whether or not a claim is allowable. (Extract from Notice of February 1, 1932.)

If an application is ready for allowance except for a correction required by the Official Draftsman, such as in a case where the lines are rough and blurred, the Examiner will obtain an estimate of the cost of this work from the Draftsman even though applicant has not requested such an estimate. Including the estimate in the final requirement for correction of the drawing may avoid prolonging the prosecution.

608.02 (u) Cancellation of Figures

In the cancellation of figures on drawings which is done by the Docket Clerk of the Division, the figure or figures and their ordinals to be canceled will be surrounded by a line in red ink and the word "canceled" with proper date of the paper directing cancellation will be written in red ink within each line. No portion of the figure itself, however, will be crossed by the red lines. When the entire drawing is to be canceled, a red line will be drawn entirely around the same (but immediately within the marginal line), the authority for cancellation and the word "canceled" written with red ink with proper date of cancellation placed within the said surrounding red line. But no lines shall be drawn in any case across the figures themselves. (Order No. 55, Revised.)

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the Chief Draftsman should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. (Extract from Order No. 1862.)

608.02 (v) Changing Name of Attorney on Drawing Forbidden

Erasing the name of a first attorney or writing upon the drawing the name of an attorney subsequently appointed so as to make it appear that the latter name was present when the drawing was originally filed is prohibited.

This prohibition applies also where a drawing is transferred from one case to another having a different attorney. (Order No. 480, Revised.)

608.02 (w) Drawing Changes Which May Require Sketches

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch showing such changes must be filed. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used by the draftsman for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints. (Extract from Order No. 4009.)

If requested by the applicant, a pencil sketch that is otherwise acceptable is inked in by the Office Draftsman at the expense of the applicant.

Blueprints with the changes to be made sketched thereon may be used. If a blueprint is submitted with the changes made in pencil, the Draftsman will ink in the changes and charge the applicant for the work of inking the pencil. Blueprints are not returned.

608.02 (x) Drawing Changes Which May Be Made by Examiner's Amendment Without a Sketch

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the Examiner will prepare an Examiner's Amendment indicating the change made and note in pencil on the drawing the addition or alteration to be made and send the drawing by the file clerk to the Draftsman for the required correction.

As a guide to the Examiner the following corrections are illustrative of those that may thus be made:

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals (Quality of paper being a factor).
3. Removing superfluous matter, e. g., Figure and ordinal where all but one figure have been canceled.
4. Adding or reversing directional arrows.
5. Changing Roman Numerals to Arabic Numerals to agree with specification.
6. Adding section lines, or brackets, where easily executed.
7. Making simple changes in Inventor's name (not his signature).
8. Changing lead lines.
9. Correcting misspelled legends. (Extract from Order No. 4009.)

608.02 (y) Disposition of Orders for Amendment of Drawing

Where the ordered correction of the drawing in a case up for action by the Examiner will NOT put the case in condition for issue, if the correction is approved, the Examiner forwards to the draftsman the case with drawing and order for correction indicating such corrections as are approved. The order for correction is attached to the outside of the file wrapper.

Where the correction is not approved, for example, because the proposed changes are erroneous, or

involve new matter or (although otherwise proper) do not include *all* necessary corrections, the case and request for correction of drawing are not sent to the draftsman.

Where the correction of a drawing is ordered and the correction when made will put the case in condition for allowance, the Examiner writes "Approved", with the date of approval, and initials the notation on the order for correction, attaches the order for correction and a "Special this case is ready for allowance" tag to the outside of the file wrapper and sends the file, drawing, letter for correction of drawing, and special tag to the draftsman by the file clerk. The tag is signed by the Primary Examiner, or, in his absence by the assistant chief. These cases must be so marked if the draftsman is expected to make the correction "special." (Extract from Notice of February 1, 1932, revised.)

608.02 (z) Return of Drawing

Rule 87 Return of drawings. The drawing of an accepted application will not be returned to the applicant except for signature.

A photographic print is made of the drawing of an accepted application.

If there is an accepted drawing in the case, other drawings (except those originally filed) that have been finally denied admission will be returned to the applicant.

The Examiner states in his letter that the drawing is being returned under separate cover, giving the reason therefor; e. g., unentered because of new matter, paper poor, or returned at applicant's request.

Such a request must be filed within a reasonable time; otherwise the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, letter and drawing are taken to the Drafting Branch where the letter will be stamped and the drawing returned. The letter stating that the drawing is returned is mailed by the Examining Division.

Drawings will not be returned until prints have been made and put in the application file. (Extracts from Orders 1783 and 4009.)

608.03 Models, Exhibits, Specimens

Rule 91 Models not generally required as part of application or patent. Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete,

and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

[Old Rules 56, 57, 58]

Rule 92 Model or exhibit may be required. A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

[Old Rule 59]

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the Examiner, but he may choose his own way of so doing.

A physical exhibit, not to be part of the case, is generally not refused except when bulky or dangerous.

Rule 93 Specimens. When the invention is a composition of matter, the applicant may be required to furnish specimens of the composition, and of its ingredients or intermediates, sufficient in quantity for the purpose of experiment.

[Old Rule 62]

608.03 (a) Handling of Models, Exhibits and Specimens

All models received in this Office, whether forming part of an application, or filed upon request from the Examiner, must be received from the Model and Receiving Room and not from the applicant or his agent. It is necessary that all models should be taken to the Model Room for proper recording in order that they may be located under subsequent inquiry and for final disposition. The Examiners should, therefore, refuse to accept models from inventors or attorneys. Models properly received and entered upon the books of the Model Clerk will be delivered by a representative of the Property Clerk's Office (Notice of Nov. 26, 1921).

When a model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper of the application.

Rule 94 Return of models, exhibits or specimens. Models, exhibits, or specimens in applications which have become abandoned, and also in other application on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

[Old Rules 60, 61]

When a model is to be returned a letter should be written to applicant by the Examining Division stating that it is being returned under separate cover and the model room should be properly notified to return the model.

Note.—Disposition of exhibits which are part of the record, 715.07 (d).

Models, exhibits and specimens may be presented to the Office for purposes of interview and taken away by the attorney at the end of the interview. See 713.08.

NOTE.—Plant specimens, 1603.02, Rule 166.

Rule 95 Copies of exhibits. Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

[Old Rule 60]

608.04 New Matter

Rule 118 Amendment of disclosure. In original applications, all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

[Old Rule 70]

In establishing a disclosure applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. Note 608.01 (1).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected.

A "new matter" amendment of the drawing is not entered.

The Examiner's holding of new matter may be petitionable or appealable, 608.04 (c).

NOTE.—New matter in reissue application, 1401.07. New matter in substitute specification, 714.20.

608.04 (a) Matter Not in Original Specification, Claims or Drawings

Matter not in the original specification, claims or drawings is usually new matter. Characteristics inherent in the disclosure such as chemical or physical properties, or mode of operation, may be amplified if such inherency was initially present in the case as filed. New uses or additional limitations not imposed by the initial disclosure may be new matter. For rejection of claim involving new matter see 706.03 (o).

NOTE.—Completeness of disclosure, 608.01 (p); Trade-marks and trade names, 608.01 (v).

608.04 (b) New Matter by Preliminary Amendment

As an applicant has the right to amend before action on his case provided the number of claims is kept within the limit imposed by his filing fee, an amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure. Its test as to involving new matter is the same as though filed on a subsequent date. *Ex parte Leishman*, 137 Ms. 366, Pat. No. 1,581,937, and *Ex parte Adams*, Pat. No. 1,789,921.

608.04 (c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the Examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. Rules 181 and 191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.