Chapter 700 Examination of Applications

701 Statutory Authority for Examination

The authority for the examination of applications for patents is set forth in Sec. 4893 R. S.; 35 U. S. C. 36.

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. (R. S. Sec. 4893.)

The examination, made under the provisions of Sec. 4893 is to ascertain two things:

1. Is the applicant the first inventor of a patentable invention?

2. Has he taken the necessary steps to obtain a patent?

The main conditions precedent to the grant of a patent to an applicant inventor are set forth in Sec. 4886, R. S.; 35 U. S. C. 31:

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

The other Statutes, Rules of Practice and decisions of the Courts determine what "other due proceeding" must be had to obtain a patent.

702 Requisites of the Application

The Examiner should be careful to see that the application meets all the requisites set forth in Chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

702.01 Obviously Informal Cases

Whenever in the assignment of applications the Primary Examiner finds that a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 4888 R. S., 35 U. S. C. 33, or whenever immediately after assignment his attentiton is directed to such an application, he should call attention to Rule 71 and require in the first Office action, which should be taken immediately, that the application be revised to conform with the practice prevailing before this Office. A shortened statutory period may be set for compliance with this requirement, the duration of such shortened period, if set, being determined by the Primary Examiner in accordance with the complexity of the case, the revision of the specification necessary, and time necessary for communication with the applicant. These actions, in all cases, regardless of whether a shortened statutory period is set, should be submitted to the Supervisory Examiners for approval. (Notice of Jan. 23, 1947.)

A suitable form for this action is as follows:

A preliminary examination of this application discloses that it fails to comply with Sec. 4888 R. S. in that the invention is not presented with sufficient clarity to make possible an intelligent examination on the merits in a reasonable time.

In accordance with Rule 71, it is required that this application be revised to conform with the practice before this Office within the shortened statutory period hereinafter set to avoid any question of abandonment.

THE SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE _____.

For the procedure to be followed when the drawing is informal, see 608.02 (a) and 608.02 (b).

703 "General Information Concerning Patents" Sent Instead of "Rules of Practice"

The pamphlet "General Information Concerning Patents" may be sent to an applicant handling his own case when the Examiner deems it advisable. (Notice of January 15, 1924, Revised.)

704 Search

After reading the specification and claims, the Examiner searches the prior art. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution. See 904 through 904.02 and 717.05.

705 Patentability Reports

Where an application, properly assigned to one examining division, is found to contain one or more claims *per se* classifiable in one or more other divisions, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first division, the application may be referred to the other division or divisions concerned for a report as to the patentability of certain designated claims. This report will be known as a Patentability Report (P. R.) and will be signed by the Primary Examiner of the reporting division. Credit for an action will be given for each such report. (Extract from Notice of November 10, 1948.)

705.01 Instructions re Patentability Reports

705.01 to 705.01 (f) are quotations from the Notices of November 12, 1948, and April 12, 1951.

In the prosecution of an application under conditions authorized in the Notice of November 10, 1948, relating to Patentability Reports, the following procedure should be observed.

When an application comes up for any action and the Primary Examiners involved agree that a Patentability Report is necessary, the application will be forwarded to the proper division with a memorandum attached, for instance, For Patentability Report from Division _____ as to Claims_____.

705.01 (a) Nature of P. R., Its Use and Disposal

The Primary Examiner of the division from which the Patentability Report is requested, if he approves the request, will direct the preparation of the Patentability Report. This Patentability Report will made on Memo Form #64 and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. When an examiner to whom a case has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he should so state. The Patentability Report when signed by the Primary Examiner of the reporting division will be returned to the division to which the application is regularly assigned.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the examiner to whom the case is assigned to avoid duplication of work. If the Primary Examiner of a reporting division is of the opinion that a Patentability Report is not in order, he should so advise the Primary Examiner of the forwarding division.

Conflict of opinion as to classification or joinder may be referred to an Examiner of Classification for decision.

If the Primary Examiner of the Division having jurisdiction of the case agrees with the patentability Report, he should incorporate the substance thereof in his action, which action will be complete as to *all* claims. The Patentability Report in such a case will *not* be given a paper number but will be allowed to remain in the file until the case is finally disposed of by allowance or abandonment, at which time it should be removed.

If the Primary Examiner does not agree with the Patentability Report or any portion thereof, he may consult with the Primary Examiner responsible for the report. If agreement as to the resulting action cannot be reached, the Primary Examiner having jurisdiction of the case need not rely on the Patentability Report but may make his own action on the referred claims, in which case the Patentability Report should be removed from the file.

When an appeal is taken from the rejection of claims, all of which are examinable in the division preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the case to said division should be made for the purpose of appeal only. The receiving division will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said division with its classification determined by the controlling claims remaining in the case. (Extract from Notice of April 12, 1951.)

705.01 (b) Sequence of Examination

In the event that the Primary Examiners concerned in a P. R. case cannot agree as to the order of examination by their divisions, the Primary Ex-

aminer having jurisdiction of the case will direct that a complete search be made of the art relevant to his claims prior to referring the case to another division for report. The division to which the case is referred will be advised of the results of this search.

If the Primary Examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

705.01 (c) Counting and Recording P. R.'s

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding division. When the P. R. is completed and the application is ready for return to the forwarding division, the reporting division will simultaneously count the P. R. as a receipt and action by transfer and so enter it on the current Weekly Work Report.

The number of actions by Patentability Report will be recorded on the Weekly Work Report in the columns headed "PR's".

The file of an application in which a Patentability Report has been made will be distinguished by noting in pencil in the upper left-hand corner of the file directly below "Div. _____" the following: "P. R. Div. _____."

The date status of the application in the reporting division will be determined on the basis of the dates in the division of original jurisdiction.

705.01 (d) Duplicate Prints of Drawings

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.

705.01 (e) Limitation as to Use

The above outlined Patentability Report practice is not obligatory and should be resorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ in scope only, prosecution by Patentability Report is never proper.

Exemplary situations where Patentability Reports are ordinarily not proper are as follows:

(1) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(2) Where the claims are related as a product and a process which involves merely the fact that a product having certain characteristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(3) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination *per se*. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.

705.01 (f) Interviews With Applicants

In case of an interview on an application in which a Patentability Report has been adopted, the Primary Examiner of the division having jurisdiction of the case may call on the Primary Examiner of the reporting division for assistance at the interview when it concerns the claims treated by the reporting divisions. (Notice of November 12, 1948.) (See 713 to 713.10 regarding interviews in general.)

706 Rejection of Claims

Rule 106 Rejection of claims. If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

In rejecting claims for want of novelty or for want of invention, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not obvious, must be clearly explained and each rejected claim specified.

[Old Rule 66, par. 1]

Rule 112 Re-examination and reconsideration. After response by applicant (rule 111) the application

will be re-examined and reconsidered, and the applicant will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant may respond to such Office action, in the same manner provided in rule 111, with or without amendment, but any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made, and the application will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

706.01 Contrasted With Objection

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the Examiner's letter. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Appeals, while an objection, if persisted in, may be reviewed only by way of petition to the Commissioner.

An example of a matter of form as to which objection is made is improper dependency of a claim. See 608.01 (n).

706.02 Rejection on Prior Art

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed matter is not "new" and patentable or does not involve invention. The reference relied upon is identified and the claim is accordingly rejected either because it is *fully met* therein or *completely anticipated*, or if there is a difference between the requirements of the claim and the showing of this prior art, as *unpatentable* thereover.

In the event that there is no invention involved in combining several elements of two or more prior structures, the rejection is made on the combination of the several references. See 707.07 (d) for language to be used in rejecting claims.

A U. S. patent is a valid reference against an application even though the patent date is after the filing date of an application provided that the filing date of the patent is prior to the filing date of the application. The fact that the second applicant had no way of knowing about the prior application that is now a patent does not matter. It is proper to use such a patent as a basic or an auxiliary reference and such patents may be used as both basic and auxiliary references. The doctrine of the Milburn Co. *v.* Davis-Bournonville Co. decision, 1926 C. D. 303; 344 O. G. 817, has been thus construed in In re Youker (C. C. P. A.), 1935 C. D. 658; 461 O. G. 10, and in Minn. Mining & Mfg. Co. *v.* Coe (C. A. D. C.) 1938 C. D. 100; 497 O. G. 766.

For the proper way to cite a patent granted after the filing of an application, see 707.05 (e) and the sample letter in 707.03.

706.02 (a) Establishing "Well Known" Prior Art

Things believed to be known to those skilled in the art are often asserted by the Examiner to be "well known" or "matters of common knowledge". If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm, 1942 C. D. 589; 543 O. G. 440. If the applicant traverses such an assertion the Examiner should, if possible, cite a reference in support of his position.

Failure of the applicant to seasonably challenge such assertions establishes them as admitted prior art. See In re Gunther, 1942 C. D. 332; 538 O. G. 744; In re Chevenard, 1944 C. D. 141; 560 O. G. 196. This applies also to assertions of the Board. In re Selmi, 1946 C. D. 525; 591 O. G. 160; In re Fischer, 1942 C. D. 295; 538 O. G. 503.

706.03 Rejections Not Based on Prior Art

Although they constitute a relatively small percentage of all rejections made, there are a number of rejections which may be appropriate despite the fact that no pertinent prior art is discovered in the search. The Examiner's function is not to scrutinize each claim with the idea of rejecting it on some far-fetched technical ground. Nevertheless, claims which, for example, are drawn to nonstatutory subject matter, or present new matter, should be recognized as such and rejected. Such rejections are explained in 706.03 (a) to 706.03 (y). If the italicized language in these sections is incorporated in the rejection, there will be less chance of a misunderstanding as to the grounds of rejection.

706.03 (a) Nonstatutory Subject Matter

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by R. S. 4886; 35 U. S. C. 31 (701), which permits patents to be granted only for "any new and useful art, machine,

manufacture, or composition of matter, or any new useful improvements thereof, or---------- any distinct and new variety of plant other than a tuber-propagated plant."

This subject matter is further limited by the Atomic Energy Act explained in 706.03 (b). Judicial decisions, have determined the limits of the classes set forth in R. S. 4886. Examples of subject matter not patentable under the Statute follow:

PRINTED MATTER

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as *not being within the statutory classes.*

NATURALLY OCCURRING ARTICLE

Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture." A shrimp with the head and digestive tract removed is an example. Ex parte Grayson, 51 USPQ 413.

METHOD OF DOING BUSINESS

Though seemingly within the category of an "art" or method, the law is settled that a method of doing business can be rejected as not being within the statutory classes. Hotel Security Checking Co. v. Lorraine Co., 160 Fed. 467.

SCIENTIFIC PRINCIPLE

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. O'Reilly v. Morse, 15 Howard 62.

706.03 (b) Barred by Atomic Energy Act

A limitation on what can be patented is imposed by the Atomic Energy Act, Public Law 585, 590 O. G. 195. Sec. 11 (a) of the Act contains the following provisions:

(1) No patent shall hereafter be granted for any invention or discovery which is useful solely in the production of fissionable material or in the utilization of fissionable material or atomic energy for a military weapon. Any patent granted for any such inventions or discovery is hereby revoked, and just compensation shall be made therefor.

Section 5 (a) (1) defines "Fissionable material" as follows:

As used in this act, the term "fissionable material" means plutonium, uranium, enriched in the isotope 235, any other material which the Commission determines to be capable of releasing substantial quantities of energy through nuclear chain reaction of the material, or any material artificially enriched by any of the foregoing; but does not include source materials, as defined in Section 5 (b) (1).

Section 11 (d) provides in part as follows:

The Commissioner of Patents shall notify the Commission of all applications for patents heretofore or hereafter filed which in his opinion disclose such inventions or discoveries and shall provide the Commission access to all such applications.

Extract from Rule 14 (c) Applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Atomic Energy Commission and the Commission will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by sec. 11 (d) of the Atomic Energy Act of 1946, 60 Stat. 768, 42 U. S. C. 1811.

All applications relating to atomic energy should be submitted to Division 70 for consideration (Memorandum of February 1, 1949, 107).

706.03 (c) Functional

Claims which are rejected as *functional* are so broad in scope that it is considered to be against public policy to allow them, even though they do not read upon any prior art. A so-called "single means" claim, such as:

In a device of the class described, means for transferring clothes-carrying rods from one position and depositing them on a suitable support.

covers every possible means for accomplishing the desired result. Ex parte Bullock, 1907 C. D. 93; 127 O. G. 1580.

As is suggested in Heidbrink v. McKesson, 1924 C. D. 407; 320 O. G. 227, a claim which defines a method only by its result may be properly rejected as functional. Holland v. Perkins Glue, 1928 C. D. 266; 372 O. G. 517, applies the doctrine of functionality to product claims and holds them to be invalid if the product is defined only by its desirable properties. This rejection is not based on the prior art and is to be distinguished from a rejection as *differing from the prior art only by a functional statement.* General Electric Co. v. Wabash, 1938 C. D. 813; 491 O. G. 463. Obviously this last-mentioned rejection requires that the Examiner find in the prior art everything called for by the claim with the exception of a functional limitation. The rejection as functional should not be confused with a rejection of a claim as being the *mere function* of the machine. See 706.03 (r).

706.03 (d) Indefinite

The rejection of a claim as *indefinite* would appear to present no difficulties. On occasion,

however, a great deal of effort is required to explain just what is wrong with the claim, when writing the Examiner's letter. Although cooperation with the attorney is to be commended, undue time should not be spent trying to figure out what the attorney was trying to say in the claim. Sometimes, a rejection as indefinite plus the statement that a certain line is meaningless is sufficient. Inclusion of a negative limitation, such as a "metal, excepting nickel", may make a claim indefinite. Expressions such as: "anhydrous", "colorless" and "non-poisonous" have been permitted because they are definite and by far the least cumbersome way to express the limitation.

Alternative expressions such as "brake or locking device" may make a claim indefinite if the limitation covers two different elements. If two equivalent parts are referred to such as "rods or wires", the alternative expression may be considered proper.

Still another way in which a claim can be indefinite is where a *non sequitur* occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference or *no antecedent* in the claim to a lever. An *indirect limitation* also affords a ground of rejection as indefinite. If a "lever" is set forth and, later in the claim, "said aluminum lever" is recited, the claim is rejected as indefinite.

706.03 (e) Product by Process

An article which cannot be described in any other manner, may be claimed by a process of making it. In re Moeller, 1941 C. D. 316, 527 O. G. 559. Applicant must, however, make a showing that the product cannot be described except by reference to the process of making it, In re Dreyfus and Whitehead, 1935 C. D. 386, 457 O. G. 479. Accordingly both product claims described by characteristics and product by process claims concurrently presented are inconsistent. As a rule, the product-by-process claims should be limited to one, unless it appears that there are material differences between the products produced by the processes recited in the different claims.

706.03 (f) Incomplete

A claim can be rejected as *incomplete* if it omits essential elements, steps or necessary structural cooperative relationship of elements, such omission amounting to a gap between the elements, steps or necessary structural connections. Greater latitude is permissible with respect to the definition in a claim of matters not essential to novelty or operability than with respect to matters essential thereto.

706.03 (g) Prolix

Claims are rejected as prolix when they contain long recitations of unimportant details which hide or obscure the invention. Ex parte Iagan, 1911 C. D. 10; 162 O. G. 538, expresses the thought that very long detailed claims setting forth so many elements that invention cannot possibly reside in the combination should be rejected as prolix.

706.03 (h) Nonstatutory Claim

Many applications when filed contain an omnibus claim such as "A device substantially as shown and described".

Such a claim can be rejected as follows:

> Claim _____ is rejected for failing to "particularly point out and distinctly claim" the invention as required in R. S. Sec. 4888.

For cancellation of such a claim by Examiner's Amendment, see 1302.04 (b).

706.03 (i) Aggregation

Rejections on the ground of *aggregation* should be based upon a lack of cooperation between the elements of the claim. No prior art should be relied upon in this rejection. However, if art is found showing the various elements, an additional rejection on the prior art may be advisable. Many decisions and some legal writers extend the term to include old and exhausted combination (706.03 (j)). Rejections on the latter grounds, however, involve the state of the art, and cooperation *is* present. Confusion as to what is meant can be avoided by treating all claims which include more than one element as combinations (patentable or unpatentable) if there is actual cooperation between the elements, and as aggregations if there is no cooperation.

Example of aggregation: A washing machine combined with a dial telephone.

Example of old combination: An improved carburetor claimed in combination with a gasoline engine.

A claim is not necessarily aggregative because the various elements do not function simultaneously. A typewriter, for example, is a good combination.

706.03 (j) Old Combination

The rejection on the ground of *old combination* (synonymous with "exhausted combination") requires the citation of a reference, but is treated here because of its relation to aggregation. The reference is cited, not to anticipate

the claim, but to anticipate the broad combination set forth in the claim. Moreover, the cooperation between the elements in the reference must be the same as it is in the claim.

Example: An improved (specifically recited) carburetor claimed in combination with a gasoline engine. A reference is cited which shows a carburetor combined with a gasoline engine. This shows the broad combination to be old. Both in the reference and in the claimed combination, the cooperation between the carburetor and engine is the same. The claimed combination is an improvement over the prior art only because of the improved carburetor. The carburetor has separate status, since entire subclasses are devoted to carburetors, claimed as such. A reference is preferably cited to show the separate status and development. (See 904.01 (d).)

706.03 (k) Duplicate Claims; Double Patenting

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) his invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. Also, it is possible to reject one claim on an allowed claim if they differ only by subject matter old in the art. The latter ground of rejection is set forth in the following paragraph quoted from Ex parte Whitelaw, 1915 C. D. 18; 219 O. G. 1237:

"Claim 54 is not patentable over claim 51 and claims 53, 55 and 56 are not patentable over claim 50 in view of Comstock, No. 590,657, which shows that it is old to employ an engine-casing in tools of this character. The claims held patentable are considered as fully covering applicant's invention, and applicant cannot be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function."

This rejection (the ex parte Whitelaw doctrine) is usually not applied if only one application is involved and there are only a few claims in that application.

Where a claim of an application is for the same, or substantially the same, subject matter as that claimed in a patent to the same inventor (Chapter 800) or of common ownership (305), the claim of the application may be rejected on the ground of *double patenting*. The same rejection may be used where the claim of the application is unpatentable over a claim of the patent in view of prior art.

The rejection on the ground of double patenting applies also where a claim in the application under examination fails to distinguish patentably over a claim in another application by the same applicant (822 through 822.03) or of common ownership. It is improper to grant more than one patent for a single invention to the same applicant or assignee even though the several applications issue on the same day.

The fact that the subject matter claimed in the application under examination was disclosed in the other application or patent does not, of itself, justify a rejection on the ground of double patenting. Such subject matter must also have been claimed in the other application or patent (305, 801). See Ex parte Mullen and Mullen, 1890 C. D. 9; 50 O. G. 837.

See also 304, 305, and Chapter 800.

706.03 (l) Multiplicity

An unreasonable number of claims; that is unreasonable in view of the relative simplicity of applicant's invention and the state of the art, affords a basis for a rejection on the ground of *multiplicity*. A rejection on this ground should include all the claims in the case inasmuch as it relates to confusion of the issue. The examiner may in his letter, indicate the number of claims which, in his opinion, would be adequate. See Rule 75 (b).

706.03 (m) Nonelected Inventions

See 821 to 821.03 (a).

706.03 (n) Correspondence of Claim and Disclosure

Rule 117 Amendment and revision required. The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

[Old Rule 71]

Another category of rejections not based on the prior art is based upon the relation of the rejected claim to the disclosure. In chemical cases, a claim may be so broad as to not be supported by disclosure, in which case it is rejected as unwarranted by the disclosure. If aver-

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ments in a claim do not correspond to the averments or disclosure in the specification, a rejection on the ground of inaccuracy may be in order. It must be kept in mind that an original claim is part of the disclosure and might adequately set forth subject matter which is completely absent from the specification. Applicant is required in such an instance to add the subject matter to the specification. If subject matter capable of illustration is claimed and it is not shown in the drawing, applicant is required to add it to the drawing. (See 608.01 (l).)

706.03 (o) New Matter

In the examination of an application following amendment thereof, the Examiner must be on the alert to detect new matter.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it is *drawn to new matter.* New matter includes not only the addition of wholly unsupported subject matter, but also, adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See 608.04 to 608.04 (c).

706.03 (p) No Utility

A rejection on the ground of *lack of utility* includes the more specific grounds of *inoperativeness, involving perpetual motion, frivolous, fraudulent, against public policy,* and *insufficiently useful and important* under Sec. 4893 R. S., 35 U. S. C. 36. (See 608.01 (p).)

706.03 (q) Obvious Method

An applicant may invent a new and useful article of manufacture. Once the article is conceived, it often happens that anyone skilled in the art would at once be aware of a method of making it. In such a case, if applicant asserts both article and method claims, the article claims are allowed but the method claims may be rejected as being drawn to the *obvious method of making the article.* Similarly, method claims to the *obvious method of using* a new device may be rejected.

706.03 (r) Mere Function of Machine

Judicial decisions on *mere function of the machine,* like those on aggregation, cannot be fitted into a single pattern. There is logic, as well as precedent, in limiting such rejections to the following cases: First, method claims only should be rejected on this ground. Compare 706.03 (c). Second, the method must be such that it cannot be carried out by hand, nor by a machine which differs materially from applicant's. This rejection, which is rarely availed of, appears to be based upon the theory that, in such cases, claims to the machine alone suffice.

706.03 (s) Statutory Bar

Another category of rejections not based on the prior art finds a basis in some prior act of applicant, as a result of which the claim is denied him.

Sec. 4887 R. S.; 35 U. S. C. 32 (First Paragraph).

> No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

The first paragraph of R. S. 4887, above quoted, establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. These four conditions are as follows:

(1) The foreign application must be filed more than one year before the filing in the United States (Modified by Public Law 690, 201.16).

(2) It must be filed by the inventor, his legal representatives or assigns.

(3) The foreign patent must be actually granted (e. g., by sealing of the papers in Great Britain).

(4) The same invention must be involved.

If such a foreign patent is discovered by the Examiner, the rejection is made on the ground of *statutory bar.*

Further, claims to an invention in public use or on sale in the United States more than twelve months before his effective filing date are similarly rejected. (Sec. 4886 R. S.; 35 U. S. C. 31.)

706.03 (t) Assigned Application

Where there is a conflict in the ownership of two applications by the same inventor, see 304.

706.03 (u) Disclaimer

Claims may be rejected on the ground that applicant has disclaimed the subject matter in-

volved. Such disclaimer may arise, for example, from the applicant's failure.

(a) to make claims suggested for interference with another application under Rule 203 (1101.01 (m)),

(b) to copy a claim from a patent when suggested by the Examiner (1101.02 (f)), or

(c) to respond or appeal, within the time limit fixed, to the Examiner's rejection of claims copied from a patent (see Rule 206 (b) and 1101.02 (f)).

The rejection on disclaimer applies to all claims not patentably distinct from the disclaimed subject matter as well as to the claims directly involved.

706.03 (v) After Interference or Public Use Proceeding

For rejections following an interference, see 1109 to 1110.

The outcome of public use proceedings may also be the basis of a rejection. (See Rule 292).

706.03 (w) Res Judicata

A prior adjudication against the inventor on the same or similar claims constitutes a proper ground of rejection as *res judicata*. Where a different question of patentability is presented the rejection of *res judicata* does not apply.

The rejection should only be used when the earlier decision was a final, appellate one, such as a Board of Appeals decision where the time limit for further remedies has expired, or a decision by the Court of Customs and Patent Appeals.

"When making a rejection on res judicata, action should ordinarily be made also on the basis of prior art." (Extract from Notice of April 20, 1938.)

See also 201.07 and 822.02.

706.03 (x) Defective Reissue Oath

A *defective reissue oath* affords a ground for rejecting all the claims in the reissue application. See 1401.08.

706.03 (y) Improper Markush Group

Ex parte Markush, 1925 C. D. 126; 340 O. G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology may be claimed under the Markush formula but it has consistently been held to be improper to extend it to purely mechanical features or process steps. The use of the disjunctive, as in "group consisting of A, B *or* C" is improper. In re Archbold, 1946 C. D. 63; 582 O. G. 178. It is also improper to use the term "comprising" instead of "consisting of". Ex parte Dotter, 12 U. S. P. Q. 382. Markush groupings of varying scope are not permitted in the same case. Ex parte Burke, 1934 C. D. 5; 441 O. G. 509. An example of this would be: Claim 1. "group consisting of A, B and C", and Claim 2. "group consisting of B and C".

The materials set forth in the Markush group must belong to a recognized physical or chemical class or to an art-recognized class. The test should be applied as liberally as possible. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

A rejection of a Markush type claim based on any of the grounds pointed out above relates to the merits and is appealable.

A situation may occur in which a patentee has presented a number of examples which, in the examiner's opinion, are sufficiently representative to support a generic claim and yet a court may subsequently hold the claim invalid on the ground of undue breadth. Where this happens the patentee is often limited to species claims which may not provide him with suitable protection.

The allowance of a Markush type claim under a true genus claim would appear to be beneficial to the applicant without imposing any undue burden on the Patent Office or in any way detracting from the rights of the public. Such a subgenus claim would enable the applicant to claim all the disclosed operative embodiments and afford him an intermediate level of protection in the event the true genus claims should be subsequently held invalid.

The examiners are therefore instructed not to reject a Markush type claim merely because of the presence of a true genus claim embracive thereof. (Notice of Sept. 23, 1949. Revised.)

See also 608.01 (p) and 715.03.

706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary Examiner or, in his absence, to the Assistant Chief, for consideration of

all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See Ex parte Grier, 1923 C. D. 27; 309 O. G. 223; Ex parte Hay, 1909 C. D. 18; 139 O. G. 197 (Order 3157).

Because it is unusual to reject a previously allowed claim, the Examiner should point out in his letter that the claim now being rejected was previously allowed.

706.05 Rejection After Allowance of Application

See 1308.01 for a rejection based on a reference.

For rejection of claims in an allowed case which has failed to make the date of a senior application in correspondence under Rule 202, see 1101.01 (i).

706.06 Rejection of Claims Copied From Patent

See 1101.02 (f).

706.07 Final Rejection

Rule 113 Final rejection or action. (a) On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim (rule 191) or to amendment as specified in rule 116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (rule 181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Before final rejection is in order a clear issue should be developed between Examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the Examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination; i. e., either an allowance of the case or a final rejection.

While the Rules no longer give to an applicant the right to "amend as often as the Examiner presents new references or reasons for rejection", present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his case. But the applicant who dallies in the prosecution of his case, resorting to technical or other obvious subterfuges in order to keep the application pending before the Primary Examiner, can no longer find a refuge in the Rules to ward off a final rejection.

The Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and Examiner should be developed, if possible, before appeal is prosecuted. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits.

Ex parte Hoogendam 1939 C. D. 3; 499 O. G. 3, states the attitude of the Office on the matter of final rejections. The position therein taken holds that neither the Statutes nor the Rules of Practice confer any right on an applicant to a more extended prosecution of his application than is comprised in an "*examination*" and a re-examination thereof. It is recognized, however, that the equities in a given case may justify a larger number of Office actions than the two specified in the Statute.

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated and clearly developed to such an extent that applicant may readily judge the advisability of an appeal. (Extract from Notice of February 18, 1949.)

The final rejection should include a summary indicating the final disposition of each claim.

To insure against applicant's failure to note that the rejection stated in the body of the letter was made final, it is advisable to conclude such a letter with:

"The above rejection is made FINAL", or "This is a FINAL rejection".

For amendments filed after final rejection, see 714.12 and 714.13.

706.07 (a) Final Rejection, When Proper

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. Where a claimed subject matter has been held unpatentable over a reference or combination of references, finality of rejection cannot be avoided by presenting that subject matter anew in a re-worded claim, especially if the state of prosecution of the case is beyond the second Office action; nor can final action be forestalled by adding to the claim limitations clearly disclosed in the reference patent.

It may therefore be proper to make the rejection final even though the references are applied and combined in a manner different from that employed in the prior Office actions.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the Examiner should be on guard not to allow such claims. See 714.04. The claims, however, may be finally rejected if, in the opinion of the Examiner, they are clearly open to rejection on grounds of record.

706.07 (b) Final Rejection, When Proper on First Action

In certain instances, the claims of a new application may be finally rejected in the first action. This may be done when the claims of the new application are similar to those of an earlier application filed by the same applicant, and if the claims of the earlier application were rejected on the grounds which are also applicable against the claims of the new application. Such procedure is quite consistent with the provisions of Rule 113, since the action on the claims in the new application is, in effect, a "re-examination" or a "reconsideration" of claims which had been treated previously in the earlier application.

For example, if the claims of a continuation application are, in the examiner's opinion, met by the art of record of the parent application, the examiner may make the rejection final in the first action on the continuation. If the rejection is based on *res judicata*, however, it may not be made final in the first action, since this would constitute a new ground of rejection.

706.07 (c) Final Rejection, Premature

The examiner should guard against premature final rejections. A premature final rejection may result from failure to permit a full development of clear-cut issues, especially in cases involving complex machines or processes. Or, again, if the Examiner waits until the final rejection before giving an adequate explanation of the application of the references against the claims, such final rejection may be premature. This would hold even if the references and reasons relied on in the final rejection are the same as those advanced in a prior Office action.

Any question as to prematureness of a final rejection should be raised, if at all, while the case is still pending before the Primary Examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Appeals.

706.07 (d) Final Rejection, Withdrawal of, Premature

If, on request by applicant for reconsideration, the Examiner finds the final rejection to have been premature, he should withdraw the final rejection, if the approval of the Supervisory Examiner is obtained. (1004.)

706.07 (e) Withdrawal of Final Rejection, General

See 714.12 and 714.13, Amendments after final rejection.

Once a final rejection that is not premature has been entered in a case, however, it should not be withdrawn at the applicant's request except under 711.06 (e) (publication of abstract reserving interference benefits) or on the showing of Rule 116. This does not mean that no further amendment or argument will be considered. An amendment that will place the case either in condition for allowance or in better form for appeal may be admitted.

The Examiner may withdraw the rejection of finally rejected claims whenever he deems the conditions appropriate for such action. If, for example, new facts or reasons are presented such as to convince the Examiner that the previously rejected claims are in fact allowable, then the final rejection should be withdrawn. Occasionally a final rejection may be withdrawn in order to apply a new ground of rejection.

If the Examiner's action in which the prior final rejection is withdrawn is not itself made

final, it must be submitted to the Supervisory Examiner for approval. (See 1004.)

707 Examiner's Letter or Action

Extract from Rule 104. (b) The applicant will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant to judge of the propriety of continuing the prosecution of his application.

707.01 Primary Indicates Action for New Assistant

After the seach has been completed, action is taken in the light of the references found. Where the assistant Examiner has been in the Office but a short time, it is the duty of the Primary Examiner to go into the case thoroughly. The usual procedure is for the assistant Examiner to explain the invention and discuss the references which he regards as most pertinent. The Primary Examiner may indicate the action to be taken, whether division or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, he may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

Until a new assistant becomes familiar with Patent Office phraseology, his letters will generally be dictated to him by the Primary Examiner. Later, the wording of the Office action is usually left to the assistant, the character of the action being supervised by the Primary.

707.02 Actions Which Require the Personal Attention of the Primary Examiner

The Primary Examiner, though responsible for all of the actions and decisions made in the conduct of the work of his division, must, in view of the amount of that work, delegate to the experienced and reliable assistant Examiners of his division authority to pass on many of the questions to be decided in the prosecution of cases. There are some questions, however, which existing practice requires the Primary Examiner, personally, to decide. The following actions fall in this category:

1. Third action on any case (707.02 (a)).
2. Action on a case pending 5 or more years (707.02 (a)).
3. Final rejection.
4. Withdrawal of final rejection. (Submitted to Supervisory Examiner 706.07 (e).)
5. Decision on reissue oath.
6. Decision on affidavit under Rule 131 (715.08).
7. Sealing of Rule 131 affidavit prior to interference.
8. Setting up an interference. (Order 2687, revised, 1101.01 (c).)
9. Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (1111.05).
10. Decisions on interference motions under Rules 232 to 235; also, actions taken under Rule 237 (1105.02 to 1105.05).
11. Rejection of a previously allowed claim (706.04).
12. Proposed rejection of a copied patent claim. (If applicable to a patentee, see 1101.02 (f).)
13. Classification of allowed cases (903.07).
14. Holding of abandonment for insufficient response.
15. Suspension of Examiner's action (Rule 103).
16. Treatment of newly filed application which obviously fails to comply with Section 4888 R. S.; 35 U. S. C. 33 (702.01).
17. Consideration of the advisability of a patentability report (705.01).

For a list of actions that are to be submitted to the Supervisory Examiners before mailing and for action requiring the attention of the Commissioner, see 1003 and 1004.

707.02 (a) Cases Up for Third Action and Five-Year Cases

The Principal Examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The Principal Examiners are expected to personally consider every application which is up for the third official action with a view to finally concluding its prosecution.

Any case that has been pending five years should be carefully studied by the Principal Examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered "special" by the Examiner. (Notice of October 11, 1930.)

707.03 Sample of Conventional "First Action" Letter

POL-90

ADDRESS ONLY
THE COMMISSIONER OF PATENTS
WASHINGTON 25, D. C.

ABC:ab

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

PAPER No. 3

All communications respecting this application should give the serial number, date of filing, and name of the applicant.

(Date Stamp)

Please find below a communication from the EXAMINER in charge of this application.

John A. Marzall
Commissioner of Patents.

John A. Smith
16,753 Main Street
Detroit 2, Michigan

Applicant: James A. Brown

Ser. No. 733,946
Filed August 1, 1948
For Air Circulator

This application has been examined.

References applied:

Spears	389,335	Apr. 11, 1888	255-69
Sutton	2,452,699 (Filed Feb. 18, 1944)	Nov. 12, 1948	255-64 uxr
Renoir (French)	860,963 (3 pp.)	Oct. 15, 1940	167-75
(Corresponding U. S. - Renoir	2,537,757	Dec. 9, 1948	167-75)
Monnet (French)	975,000 (4 shts. dwg. - 8 pp. spec.)	July 17, 1945	167-75

(Only Fig. 4 of the drawing and page 6 of the specification are relied on)

References further showing the state of the art:

Halsey	Re. 100,176	Feb. 20, 1888	255-70

Mead, abstract of application serial number 11,520 published May 1, 1948, 615 O. G. 71 255-70

"Ventilating Machinery" (Johnson) Published by Simms, Bombay, 1931 (Page 3 relied on. Copy in Scientific Library and in Div. 9)

The Official Draftsman has objected to the drawing because the lines are rough and blurred. Correction of the drawing is required.

The oath is defective, some nine months having elapsed between the date of the jurat and the date of filing of the application. A new oath is required. It should identify this application by title, serial number and date of filing.

The title of the invention should be made more specific to meet the requirements of Rule 72. The objects of invention set forth on page 3 are too general and should be either canceled or directed to the specific invention claimed.

On page 4, line 21, "37" should be --73--.

Claim 1 is rejected as fully met by Sutton. Element 87 of Sutton is the spring-pressed latch claimed.

Claim 5 is objectionable because it reads "Circulator as in claims 1-4 wherein ----" and hence is directly dependent upon more than one preceding claim. If corrected so as to depend upon either claim 2 or claim 3, it would appear to be allowable.

Claim 6 is rejected as being drawn to the old combination of a motor, a fan driven thereby, and a common base for supporting the motor and fan. This combination is shown to be old by the patent to Spears which discloses the same elements functionally interrelated in the same manner. The combination of claim 6 differs from that shown in Spears only in setting forth a specific construction of the motor itself. Therefore, claim 6 is rejected because it is believed that the improvement over the prior art is not in the combination, which is old, but in the specific motor. Attention is called to the patents to Renoir and Monnet which indicate that motors have been recognized as being separate subjects of invention, capable of independent use, and as having a distinct status of their own.

Claim 7 is rejected as unpatentable over Sutton. The fan blades in Sutton are driven directly from the motor shaft, whereas the claim calls for a flexible drive. In view of the common practice of providing yielding drive means from electric motors for various reasons, it would not be considered invention to substitute a flexible drive for the direct drive shown in Sutton.

Claims 2, 3 and 4 are allowable as at present advised.

Claims 1, 6 and 7 are rejected and claim 5 is objected to.

Examiner

707.04 Initial Sentence

The initial sentence of each letter should indicate the status of that action, as, "This application has been examined" if it is the first action in the case, or, "This is in response to amendment filed * * *" if such is the case.

Preliminary amendment in a new case should be acknowledged by adding some sentence such as "Amendment filed (date) has been received" following the initial sentence. It should be noted, however, that in cases in which claims in excess of the number supported by the filing fee are presented before the first official action in the case, action is given only on the claims originally presented and applicant advised accordingly. See 714.10.

707.05 Citation of References

The citation of all references used for the first time in the prosecution of the case should then be made.

Rule 107 Citation of references. If domestic patents be cited, their numbers and dates, the names of the patentees, and the classes of inventions must be stated. If foreign patents be cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents, the number of pages of specification and sheets of drawing must be specified, and in case part only of the patent be involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications be cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given. When a rejection is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

[Old Rule 66, par. 2]

707.05 (a) Grouped at Beginning of Letter

In citing references for the first time, the identifying data of the citation should be placed immediately following the initial introductory sentence (707.04), or acknowledgment of preliminary amendment (if any). (Extract from Order No. 2938.)

707.05 (b) References Applied

The references selected as needed for treating the claims should be preceded by a heading such as: "References Applied." (Extract from Order No. 2938.)

707.05 (c) References Pertinent

Any references selected to cover subject matter disclosed but not claimed should be separately listed under a heading such as "References further showing the state of the art," or some similar expression.

707.05 (d) References Cited in Subsequent Actions

When references are cited in a subsequent action, the heading should be "Additional references made of record," or "Additional references relied upon." (Extract from Order 2938.)

Where an applicant in an amendatory paper refers to a reference which is subsequently relied upon by the Examiner, such reference shall be cited by the Examiner in the usual manner. (Notice of December 20, 1946.)

If an English language patent is found corresponding to an earlier cited foreign language patent, see 707.05 (e).

707.05 (e) Data Used in Citing References

Rule 107 (707.05 and 901.05 (a)) requires the Examiner to give certain data when citing references. See 901.04 for details concerning the various series of U. S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U. S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

If the patent date of a U. S. patent is after the effective U. S. filing date of the application, the filing date of the patent must be set forth in parentheses below the citation of the patent. This calls attention to the fact that the particular patent relied on is a reference because of its filing date and not its patent date. Similarly, when the reference is a continuation-in-part of an earlier-filed application which discloses the anticipatory matter and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated.

Official cross-references should be marked "XR" and unofficial cross-references "UXR." (Extract from Order 3217.)

Cite abstracts as in 711.06 (f) giving class and subclass.

Data to be used in citing foreign patents is given in Rule 107, in 901.05 (a).

In citing the number of pages of specification and sheets of drawing of foreign patents a number should be given which corresponds to

the number of items to be photostated. For example, if the Examiner's copy of a foreign patent has two pages of drawing but in the bound volume of patents used for photostating, there is only one sheet of drawing, then only one sheet should be cited.

"In some instances the entire copy of a foreign patent will not be needed for the purpose of a rejection. In these instances the number of sheets of drawing and pages of specification must be specified and also the particular part of the drawing and the particular pages of specification relied upon must be given." (Order No. 3251, Revised.) See citation of foreign patent in sample letter of 707.03.

In order to direct attention of interested parties to English translations of foreign language patents, the following practice should be observed:

Cite the foreign language patent as usual. If at that time the Examiner knows of a corresponding English language patent, but because of date or disclosure, the Examiner must rely upon the foreign language patent, he should cite both, thus:

Herrmann French 860,963 3 pp. Oct. 15, 1940 167–75
(Corresponding U. S.—Herrmann 2,537,757 Jan. 9, 1951 167–75)

If the corresponding English language patent is found later, the Examiner should cite it in the next regular Office action or, if the application is being sent to issue, in an Examiner's Amendment calling attention to its correspondence to the previously cited foreign language patent in the following manner:

Herrmann 2,537,757 Jan. 9, 1951 167–75
(U. S. Corresponding to Herrmann—French Cited in paper No. _____)

To insure inclusion of both patents and to indicate the correspondence between them in the list of references (Form PO–98), the Examiner should make a marginal notation adjacent the citation of the foreign language patent, such as:

"See Paper No. ____ for corresponding U. S. patent."

This should be in pencil and initialed by the Examiner. (Extract from Notice of September 27, 1951.)

In citing publications, sufficient information should be given to facilitate the location of the publications. The data required by Rule 107 (Sec. 707.05) should be given and it should be stated that a copy is in the Scientific Library, if this is known. Otherwise, the place where a copy is known to be available should be stated. In the instances where another copy or reproduction of the publication may be found in a particular subclass, the Examiner, for his convenience, may cite the class and subclass in addition to stating that a copy is in a particular library or division. Where the only known copy can be found in an Examining Division, the Examiner should indicate the division, stating the class and subclass if appropriate.

Whenever in citing references in applications and in Form PO–98 (1302.12) the titles of periodicals are abbreviated, the abbreviations of titles used in Chemical Abstracts and printed in the list of periodicals abstracted by Chemical Abstracts should be adopted with the following exceptions: (1) the abbreviation for the Berichte der deutschen chemischen Gesellschaft should be Ber. Deut. Chem. rather than Ber., and (2) where a country or city of origin is a necessary part of a complete identification, the country or city of origin should be added in parentheses, e. g., J. Soc. Chem. Ind. (London). (Extract from Memorandum of Feb. 3, 1947.)

707.05 (f) Effective Dates of Declassified Printed Matter

A large amount of printed matter prepared for use during the war and classified as secret, confidential, or restricted, has been declassified and is now available to the public at large. In using this material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Commerce Department.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under Sec. 4886 R. S.; 35 U. S. C. 31 the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute a statutory bar and its printing date may be antedated by an affidavit under Rule 131. (Notice of Feb. 24, 1947, Revised.)

707.05 (g) Incorrect Citation of References

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

Where a wrong citation of a patent has been made by the Examiner and this is evidenced by the sub-

mission of the purchased copy, it is customary as a matter of courtesy to mail the applicant a correct copy. See also 710.06.

In any case otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the Examiner is directed to correct the citation by way of an Examiner's Amendment. (Extract from Notice of May 13, 1948.)

707.06 Citation of Decisions, Orders and Notices

In citing published decisions the tribunal rendering the decision should be identified and wherever possible the C. D. and O. G. citation should be given. The U. S., C. C. P. A., Federal Reporter or U. S. P. Q. citation should also be given when it is convenient to do so. (Order 3357, Revised.)

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Appeals which has not been published but which is available to the public in the patented file should be cited as, "Ex parte ____, decision of the Board of Appeals, Patent No. ____, paper No. ____, _____ pages."

The citation of manuscript decisions which are not available to the public should be avoided. If an examiner believes that a particular manuscript decision not open to public inspection would be useful, he may call it to the attention of the Supervisory Examiners who will determine whether steps should be taken to release it or an abstract thereof for publication. (Order 1370, Revised.)

When a Commissioner's Order, Notice or Memorandum is cited in any official action, the date of the order, notice or memorandum or the Official Gazette in which the same may be found should also be given. (Notice of Feb. 12, 1924, Revised.)

707.07 Completeness and Clarity

Rule 105 Completeness of examiners' action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

[Old Rule 64]

707.07 (a) Action on Formal Matters

When, upon examination, the specification and claims are such that the invention may be readily understood, Examiners ordinarily should make no requirements on matters of form in the specification until some claim is found to be allowable. In every such case the first letter should say in substance:

On allowance of any claim, revision as to form may be required (Rule 105).

In every instance requirements to correct informalities noted on Form PO–152 (pink slip) by the Head of the Application Branch and Draftsman's criticisms of the drawings should be made in the first letter.

Every action on the merits should be complete and thorough as to merits and, whenever any claim is allowed, also complete as to form. (Extract from Order 5267.)

When a claim is found allowable, or for other reasons it is deemed best to take up matters of form, the Examiner should note all of his objections, and clearly point them out. In all cases, whether or not a claim is indicated as allowable, informalities as to the drawing, oath, or signatures should be noted. See 714.02.

707.07 (b) Requiring New Oath

See 602.02.

707.07 (c) Draftsman's Requirement

The Examiner should embody the Draftsman's statement with regard to the drawing in his first letter to the applicant, and in so doing he should be careful to state distinctly that a new drawing will not be admitted or that a new drawing will be required, if the case is found to contain patentable matter, in accordance with the Draftsman's directions. See also 608.02 (a), 608.02 (e), 608.02 (t).

707.07 (d) Language To Be Used in Rejecting Claims

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the Examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

In general, the most usual ground of rejection is based on a prior patent or patents and the rejection should generally be set forth as follows:

(1) If the claim reads element for element on the references, the claim should be rejected as

(a) obviously fully met by, or
(b) clearly readable on, or

(c) fully anticipated by, (or other equivalent expression)

the reference.

While ordinarily additional comment is unnecessary where any of these phrasings is applicable, it may in some cases be helpful to point out one or more elements of the reference where their identity is not clear from a brief inspection of said reference.

The above phrasings should not be used unless the claim reads as well on the patent as it does on the application.

(2) If the claim is met in substance in the reference, but has immaterial variations thereover or involves mechanical equivalents, the claim should be rejected as

(a) substantially met by, or
(b) lacking invention over, or
(c) unpatentable over, or
(d) finding its full equivalent in, (or other equivalent expression)

the reference. Such rejection should be accompanied by a statement taking note of that feature or those features of the claim which are not fully met in the reference and pointing out why said feature or features do not render the claim patentable.

(3) If the claim is rejected on A in view of B, such rejection should be accompanied by a statement that

(a) there is no invention in substituting for the element X of A the element X′ as shown (or taught, or disclosed) in B; or

(b) it would require only mechanical skill to substitute in A for his element X the equivalent element X′ as shown in B.

It is not sufficient in a rejection based on A in view of B merely to state that B teaches (or shows) the element defined in the claim. This is not conclusive that the claim should be rejected; for even if B does disclose the element as claimed, it might require invention to incorporate this element in the A organization. In some cases, in addition to the above general statement as set forth in (a) or (b), it may be advisable to point out specifically how the substitution can be made. The pertinency of each reference should be fully set forth.

Everything of a personal nature must be avoided. Whatever may be the Examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

A constructive suggestion by the Examiner as to how some specific rejection or objection may be avoided often saves considerable time and is generally welcomed by the attorney or applicant.

An omnibus rejection of the claims "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

707.07 (e) Note All Outstanding Requirements

In taking up an amended case for action the Examiner should note in every letter all the requirements outstanding against the case. Every point in the prior action of an Examiner which is still applicable must be repeated to prevent the implied waiver of the requirement.

707.07 (f) Answer All Material Traversed

Where the requirements are traversed, or suspension thereof requested, the Examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the Examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

707.07 (g) Piecemeal Prosecution

Piecemeal prosecution should be avoided as much as possible. The Examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See 904.02.) Moreover, when there exists a sound rejection on the basis of prior art which discloses the "heart" of the alleged invention (as distinguished from prior art which merely meets the terms of the claim), secondary rejections on technical grounds ordinarily should not be made.

707.07 (h) Notify of Inaccuracies in Amendment

See 714.23.

707.07 (i) Each Claim To Be Mentioned in Each Letter

In every letter each claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the case, its history through successive actions is thus easily traceable. Each action should conclude with a summary of rejected, allowed and cancelled claims.

Claims retained under Rule 142 and claims retained under Rule 146 should be rejected as set out in 821 to 821.03 (a) and 809.02 (a).

See 1109.02 for treatment of claims corresponding to issue in application of losing party in interference.

The Index of Claims should be kept up to date as set forth in 717.04.

707.07 (j) State When Claims Are Allowable Except as to Form

When the Examiner finds that a claim is allowable except as to form, this fact should be stated, the objections as to form being specifically pointed out.

707.07 (k) Numbering Paragraphs

Paragraphs may be successively numbered on each page of the letter to facilitate identification in the future prosecution of the case.

707.08 Reviewing and Initialing by Assistant Examiner

Two carbon copies of the letter are made. All copies, together with the rough draft, if there be one, and the file are then put on the Assistant Examiner's desk, who will compare the copy with the rough draft, paying particular attention to the data of the references. If any corrections are to be made, he will note them in lead pencil and return the papers to the typist for correction. When the corrections have been properly made, or when there are no corrections required, the Assistant Examiner will initial the original copy and place the file with the several copies of the letter on the desk of the Primary Examiner for his inspection and signature to the original copy. Carbon copies should not be signed by the Assistant or Primary.

707.09 Signing by Primary or Acting Examiner

In each Examiner's letter, the word "Examiner" without the number of the Division, should appear at the end on both the original and carbon copies, the original only being signed. The words "Acting Examiner" should be used whenever that official signs the letter. (Extract from Order 2938.)

707.10 Entry

After the original copy has been signed by the Primary Examiner, the typist places it in the file wrapper on the right hand side, and enters in black on the outside of the wrapper, under "Contents", the character of the action. If any claim has been rejected, the word "Rejection" is entered on the file wrapper, or if the rejection has taken the form of a requirement for division, the entry will so indicate; otherwise, the word "Letter" is used. Errors will be avoided if the Assistant Examiner enters the character of the action on the file in lead pencil before giving the file to the typist.

707.11 Date

Since the six months statutory period begins to run from the date of mailing of the Examiner's action, the date should not be typed when the letter is written, but should be stamped on all copies of the letter after it has been signed by the Examiner and the carbon copies are about to be mailed.

707.12 Mailing

The carbon copies are mailed to the proper address after the original, initialed by the Assistant and signed by the Primary Examiner, has been placed in the file.

707.13 Returned Office Action

Letters are sometimes returned to the Office because the Post Office has not been able to deliver them. The Examiner should use every reasonable means to ascertain the correct address and forward the letter again, after stamping it "remailed" with the date thereof and redirecting it if there be any reason to believe that the letter would reach applicant at such new address. If the Office letter was addressed to an attorney, a letter may be written to the inventor or assignee informing him of the returned letter. The six months running against the application begins with the date of remailing. (Ex parte Gourtoff, 1924 C. D. 153; 329 O. G. 536.)

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the application, which is filed away

with the pending files, eventually to be sent to the Abandoned Files storage room.

707.14 Action Preceding Final

If when making a regular Office action it appears that the next Office action may be final, the Examiner should add at the end of the action a simple sentence advising applicant to prepare for final action. (Notice of Nov. 7, 1949.)

For final rejection form see 706.07.

708 Order of Examination

Rule 101 Order of examination. Applications filed in the Patent Office and accepted as complete applications (rules 53 and 55) are assigned for examination to the respective examining divisions having the classes of inventions to which the applications relate. Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed.

Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended applications) shall be taken up for such action in the order in which they have been placed in such condition (date of amendment).

[Old Rule 63, pars. 1, 2]

708.01 List of Special Cases

Rule 102 Advancement of examination. Applications will not be advanced out of turn for examination or for further action except as provided by these rules, or upon order of the Commissioner to expedite the business of the Office, or upon a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination; but in this case it shall be the duty of the head of that department to be represented before the Commissioner in order to prevent the improper issue of a patent. (See 29 Stat. 694; 35 U. S. C. 43.)

[Old Rule 63, pars. 3 and 5]

If an Examiner has a case which he is satisfied is in condition for allowance, or which he is satisfied will have to be finally rejected, he should give such action forthwith instead of making the case await its turn. (Extract from Order 3084.)

If the applicant makes prompt response to the Examiner's requirement for division, the application will thereafter be considered "special" until it has received an action on the merits. For this purpose, response within 60 days for domestic applicants and, within 90 days for foreign applicants should be considered as being prompt. (Extract from Order 5282.)

The following is a list of special cases (those which are advanced out of turn for examination):

(a) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders (Rule 102).

(b) Cases made special by the Commissioner as the result of a petition. (See 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination will continue to be special throughout its entire course of prosecution in the Patent Office, including appeal, if any, to the Board of Appeals; and any interference in which such an application becomes involved shall, in like measure, be considered special by all Patent Office officials concerned. (Notice of Aug. 9, 1950.)

(c) Applications for reissues (Rule 176).

(d) Cases remanded by an appellate tribunal for further action.

(e) Applications in which a brief has been filed under Rule 193 or wherein a petition has been filed under Rule 181. (See 1002, 1208)

(f) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents (Rule 201).

(g) Cases ready for allowance, or ready for allowance except as to formal matters. (See Order 3084 above, and Order 5267 in 710.02 (b).)

(h) Cases which are in condition for final rejection. (See Order 3084 above.)

(i) Cases pending more than five years (707.02 (a)).

(j) Cases where the first action on the case has been limited to a requirement for division and applicant has made a prompt response. (See Order 5282 above.)

(k) New cases which are obviously informal (702.01).

708.02 Petition to Make Special

A petition to make special an original application or any other application requiring a search is sent to the Examining Division to which the case is assigned for report of approximate date when the case will be reached for action in its regular course. The petition is not entered in the file; but the Examiner should note on his calendar at the date reported the serial number of the application with appropriate memorandum so that the case will not be overlooked in the event that this report date forms a factor in the Commissioner's decision on the petition. The Examiner forwards the

petition together with his report to the Law Examiner for submission to the Commissioner or the Assistant Commissioner who decides the petitions to make special.

A petition to make special a division, a continuation or a continuation-in-part of an earlier application will be referred to a Supervisory Examiner where the petition alleges that the later application contains only claims which have been searched in the prior art and held allowable in the earlier application, or claims differing from such allowable claims only in matters of form or by immaterial phraseology, and the Examiner will furnish a report stating whether the allegation in the petition is correct and including a list of the prior art references over which the claims were allowed unless such references have been listed in the petition. If, in the opinion of the Examiner, the claims in the application do not qualify it for special status as above noted, but he is able to determine from inspection that the application is allowable in matters of substance or that the claims are otherwise such as would by reason of the previous prosecution be clearly subject to immediate final action he should report that fact.

All other petitions and requests to make an application special should be forwarded with the file to the Law Examiner accompanied by a report indicating when the case will be reached for action in its regular course. (Notice of July 25, 1938, Revised.)

The petition to make special if, and when, granted becomes a part of the file record. Otherwise it is placed in the miscellaneous correspondence file.

708.03 Examiner Tenders His Resignation

Whenever an Examiner tenders his resignation, the Principal should see that the Assistant spends his remaining time as far as possible in winding up the old complicated cases or those with involved records and getting as many of his amended cases as possible ready for final disposition. (Extract from Order 3084.)

709 Suspension of Action

Rule 103. Suspension of action. Suspension of action by the Office will be granted at the request of the applicant for good and sufficient cause and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner.

If action on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

Action by the examiner may be suspended by order of the Commissioner in the case of applications owned by the United States whenever publication of the invention by the granting of a patent thereon might be detrimental to the public safety or defense, at the request of the appropriate department or agency.

[Old Rule 77, pars. 5, 6]

One suspension of action by the Office for a "reasonable time" at the request of the applicant under Rule 103, may be granted by the Examiner; but any further suspension requires the approval of the Commissioner.

It is to be noted that suspensions under this Rule are granted with respect to impending Office actions, not actions by applicants. That is, if the case is awaiting action by applicant he has the statutory or set shortened period within which to respond. While the shortened period may be extended within the limits of the statutory period, no suspension can operate to extend a statutory period that may be running against a case.

Suspension under Rule 103, which is at the instance of the applicant, is to be distinguished from suspensions originating with the examiner. Thus, where an applicant has two applications whose claims are directed to overlapping subject matter and one of them becomes involved in interference, action on the other application is, under the ex parte McCormick (1904 C. D. 575; 113 O. G. 2508) practice, sometimes suspended pending the termination of the interference. See 709.01. No suspension, however, is necessary where the subject matter claimed in the said other application is patentably distinct from the disclosure of the opposing party to the interference.

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee

Examiners should not consider ex parte, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party of interest. (See *ex parte* Jones, 1924 C. D. 59; 327 O. G. 681).

Because of this where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the other applications. Now, partly in view of In re Seebach, 1937 C. D. 495; 484 O. G. 503 the prosecution of all the cases not in the interference is required to be carried as far as possible, by treating as prior art the counts of the interference and by rejections forcing the drawing of proper lines of division. In some instances, however, suspension of action by the Office can not be avoided. See 1111.03.

709.02 Actions Following Correspondence Under Rule 202

See 1111.01 (i).

710 Period for Response

For periods for response in connection with appeals see 1206.

710.01 Statutory Period

Extract from rule 135. (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

[Old Rule 77]

The portion of Rule 135 quoted above sets forth the provisions of Sec. 4894 R. S.; 35 U. S. C. 37, with reference to the prosecution of an application by an applicant. The normal statutory period for response to an Office action is six months.

710.01 (a) Statutory Period, How Computed

The period is computed from the day of the mailing of the Office action to the date of receipt by the Office of applicant's response. No cognizance is taken of fractions of a day and applicant's action is due on the corresponding day six months after the Office action.

The date of receipt of a response to an Office action is given by the "Office date" stamp which appears on the responding paper. See 505.

Response to an Office action dated August 30, is due on the following February 28 (or 29 if it is a leap year), while a response to an Office action dated February 28 is due on August 28 and not on the last day of August.

In some cases the Examiner's letter does not determine the beginning of a statutory response period. For example, the Examiner may write a letter adhering to a final rejection, in which case the statutory response period running from the date of the final rejection is not disturbed. In all cases where the statutory response period runs from the date of a previous action, a statement to that effect should be included at the end of the letter, and the date on which the statutory response terminates should be given.

710.02 Shortened Statutory Period and Time Limit Actions

Under Rule 136 (Sec. 4894 R. S.; 35 U. S. C. 37) an applicant does not always have six months within which to respond to an Office action. He may be required to respond in a shorter period, not less than 30 days, whenever it is deemed "necessary or expedient". Some conditions deemed "necessary or expedient" are listed in Section 710.02 (b).

In setting a shortened statutory time for response to an Office action, the date on which the shortened period ends must be specified thus:

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE (DATE).

(This should be in capital letters.)

(Notice of June 11, 1940, Revised.)

In addition to the statutory provisions for shortened periods of response the Examiner may also, in some cases, require the applicant to make response within a specified limited time. These are known as time limit actions. An example is a time limit for the response to the rejection of a copied patent claim.

Where an Office action is such as to require the setting of a time limit for response thereto, the Examiner should note at the end of the letter the date when the time limit period ends. The time limit requirement should also be typed in capital letters.

Furthermore, the legend "SHORTENED TIME FOR REPLY" is stamped on the *first page* of every action in which a shortened time for reply has been set. This legend is applied preferably across the date stamp just under the date, so prominently that a person looking merely for the mailing date of the action and not reading the action as a whole cannot reasonably avoid seeing the legend. (Notice of November 22, 1941, Revised.)

710.02 (a) Approval of Time Set in Case of Shortened Statutory Period

Before being mailed, a letter setting a shortened statutory period for response must be approved by the Commissioner, but this approval is obtained from the Supervisory Examiner, to whom the Commissioner has delegated this authority. (Extract from Order 3494.) (See 1004.)

710.02 (b) Situations in Which Used: Shortened Statutory Period

From time to time the Commissioner through the Supervisory Examiners adds to or removes from the list of types of actions calling for a shortened statutory period. In general where the prosecution has obviously been dilatory, or where the circumstances are such that the public interest requires the prosecution to be promptly closed, a shortened statutory period may be set.

Some specific cases are:

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

(b) When a prompt issue as a patent is desired to avoid futile interference proceedings, as where the junior party fails to overcome the senior party's filing date under Rule 202, a shortened period may be set for response by the senior party. See 1101.01 (i).

(c) Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered office action, final rejection or any other action, the Primary Examiner notifies the applicant of this fact. In this case response to the Office action is required within a shortened statutory period (40 days) running from the date of such notice. See Ex parte Peterson, 1941 C. D. 8; 525 O. G. 3. (Extract from Notice of April 14, 1941.)

(d) When a case has been pending for five years, in order to expedite termination of the prosecution. This also applies to any case which by relation to a prior application has an effective pendency of more than five years.

(e) When the Primary Examiner finds that a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 4888 (35 U. S. C. 33) R. S. See 702.01.

710.02 (c) Situations in Which Used: Nonstatutory Time-Limit

Under certain conditions it is deemed more desirable to set nonstatutory shortened time-limits for response, such as:

(a) Rule 203 provides that in suggesting claims for interference:

The parties to whom the claims are suggested will be required to make those claims (i.e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared.

See 1101.01(j), and 1101.01(m).

(b) Rule 206 provides:

Where claims are copied from a patent and the examiner is of the opinion that none of the claims can be made, he shall state in his action why the applicant can not make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal.

See 1101.02(f).

(c) When applicant's action is not fully responsive to the Office action, the Examiner may give applicant a limited time, usually 20 days to complete his response. See third paragraph of Rule 135 which reads as follows:

When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

See 714.03.

710.02 (d) Difference Between Shortened Statutory and Time-Limit Periods

The distinction between a limited time for reply and a shortened statutory period under Rule 136 should not be lost sight of. The first is set by the Primary Examiner, while the second requires the approval of the Supervisory Examiner. The penalty attaching to failure to reply within the time limit (from the suggestion of claims or the rejection of copied patent claims) is loss of the subject matter involved on the doctrine of disclaimer, and is an appealable matter; while failure to respond within the set statutory period results in abandonment of the entire application. This is not appealable. Further, where applicant responds a day or two after the time limit, this may be excused by the Examiner if satisfactorily explained; but a response one day late in a case carrying a shortened statutory period under the Rule 136, no matter what the excuse, results in abandonment; however, if asked for in advance extension of the period may be granted by the Examiner, provided the extension does not go beyond the six months' period from the date of the Office action. See also 1101.02(f).

710.02 (e) Extension of Time

Extract from Rule 136 (b) The time for reply, when a time less than six months has been set, will be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. Only one extension may be granted by the primary examiner in his discretion; any further extension must be approved by the Commissioner. In no case can any extension carry the date on which response to an action

is due beyond six months from the date of the action.
[Old Rule 77, par. 3]

It should be very carefully noted that neither the Primary Examiner nor the Commissioner has authority to extend the shortened statutory period unless request for the extension is filed on or before the day on which applicant's action is due. While the shortened period may be extended within the limits of the statutory six months' period, no extension can operate to extend the time beyond the six months.

Compare, however, Rule 135 (c) and 714.03.

710.03 Three Year Period, Government Owned Cases Three Year Statutory Period

A Government-owned case is, under Sec. 4894, R. S., entitled to a three year period for response to an Office action, provided there has been filed in the application a request to that effect by the head of the department concerned. Such request holds for only one three year period in such case. However, if actions by the applicant and Office are taken within the period the applicant is still privileged to delay his response to any such Office action at least until the expiration of the original three year period. The status of the application as coming within the three year provision of the statute may be continued for another three year period upon a request from the department head for reapplication of the statute. A letter from head of the department requesting such reapplication of the statute must be seasonably filed. (Notice of April 7, 1945, Revised.)

Where an application is placed under the three year statutory provision, it is required that the Office notify the head of the department within 90 days and not less than 30 days before the expiration of the three year period of the approaching end of said period.

When ready for allowance, Government-owned "Three Year" applications must be referred to Div. 70 for clearance before allowance. See 109.

710.04 Two Periods Running

There sometimes arises a situation where two different periods for response are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception, involving suggested claims, see 1101.01 (n).

710.04 (a) Copying Patent Claims

Where in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for response are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for response to the rejection (either first or final), established under Rule 206. The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. (Ex parte Milton, 164 Ms 1, 63 USPQ 132 and Ex parte Nelson, 164 Ms 361, 26 J. P. O. S. 564.) See also 1101.02 (f).

710.05 Period Ending on Sunday or Holiday

Rule 7 Times for taking action; expiration on Sunday or holiday. Whenever periods of time are specified in these rules in days, calendar days are intended unless otherwise indicated. When the day, or the last day, fixed by statute or by or under these rules for taking any action or paying any fee falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Sunday or a holiday.
[Old Rule 31, par. 6]

The holidays in the District of Columbia are: New Year's Day, January 1; Washington's Birthday, February 22; Memorial Day, May 30; Independence Day, July 4; Labor Day (first Monday in September); Armistice Day, November 11; Thanksgiving Day (fourth Thursday in November); Christmas Day, December 25; Inauguration Day (January 20, every four years).

Where an amendment is filed a day or two later than the expiration of the period fixed by statute care should be taken to ascertain whether the last day of that period was Sunday or a holiday in the District of Columbia, and if, so, whether the amendment was filed or the fee paid on the next succeeding secular day.

An amendment received on such succeeding secular or business day which was due on Sunday or a holiday is endorsed on the file wrapper with both dates, such as June 6, 1927 (June 5, Sunday). Although the Office is closed on Saturdays, any amendment or payment due on a Saturday must be presented no later than such Saturday, unless the Saturday falls on a legal holiday. (Order No. 3017, revised.)

710.06 Miscellaneous Factors Determining Date

When applicant writes the Office pointing out an incorrect citation of a reference (707.05 (g)), which was relied on for a rejection the period of six months running against the application begins anew on the date of the Office response giving the correct citation.

Where for any reason it becomes necessary to remail any action (707.13), the action should be correspondingly redated, as it is the re-mailing date that establishes the beginning of the six months period. (*Ex parte* Gourtoff, 1924 C. D. 153; 329 O. G. 536).

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If for any other reason an Office action is defective in some matter necessary for a proper response applicant's time to respond begins with the date of correction of such defect.

711 Abandonment

Rule 135 Abandonment for failure to respond within time limit. (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper.

See rule 7.

[Old Rules 77, par. 1; 171, par. 2]

Rule 138 Express abandonment. An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment, signed by the applicant himself and the assignee of record, if any, and identifying the application.

[Old Rule 171, par. 1]

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application is one which is removed from the Office docket of pending cases through:

1. formal abandonment by the applicant (acquiesced in by the assignee if there be one), or through
2. failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the case.

711.01 Express or Formal Abandonment

Applications expressly abandoned (Rule 138) present no particular problem. It should be borne in mind, however, that formal abandonment must have the signature of the assignee, if any, as well as of the inventor. But see 711.06 (e). When a letter of express abandonment which complies with Rule 138 is received the Examiner should notify the applicant that the letter of express abandonment has been received, that the application is abandoned and is being relegated to the abandoned files.

In view of the doctrine set forth in Ex parte Lasscell, 1884 C. D. 66; 29 O. G. 861, an amendment canceling all of the claims, even though said amendment is signed by the applicant himself and the assignee, is not an express abandonment. Such an amendment is regarded as nonresponsive and should not be entered, and applicant should be notified as explained in 714.03, 714.05.

711.02 Failure To Take Required Action During Time Period

Rule 135 specifies that an application becomes abandoned if applicant "fails to prosecute" his application within the fixed statutory period. This failure may result either from

1. failure to respond within the statutory period, or
2. insufficiency of response, i. e., failure to take "complete and proper action, as the condition of the case may require" within the statutory period (Rule 135)

Abandonment by entire failure to respond presents no problems.

Nor is there ordinarily any particular difficulty when an amendment reaches the Office (not the division) after the expiration of the statutory period. The case is abandoned and the remedy is to petition to revive it. The Examiner should notify the applicant or attorney at once that the application has been aban-

doned. The late amendment is endorsed on the file wrapper but not formally entered. (See 714.17.)

To pass on questions of abandonment, it is essential that the Examiner know the dates that mark the beginning and end of the statutory period under varying situations. The ex parte prosecution before the Examiner presents few departures from the ordinary type in which the applicant's response must reach the Office within six months from the mailing date of the Office letter, or not later than the date set as ending the shortened period for reply. (See 710 to 710.06.)

711.02 (a) Insufficiency of Response

A frequent case of abandonment is where a response is made by the applicant within the statutory time but, in the opinion of the Examiner, is not fully responsive to the Office action. See 714.02 to 714.04.

711.02 (b) Special Cases Involving Abandonment

The following situations involving questions of abandonment often arise, and should be specially noted:

a) Copying claims from a patent when not suggested by the Patent Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

b) A case may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Appeals. See 1215.01 to 1215.04.

c) Likewise it may become abandoned through dismissal of appeal to C. C. P. A. or suit in equity, where there was not filed prior to such dismissal an amendment putting the case in condition for issue or fully responsive to the Board's decision. See 1215.05.

d) Also, abandonment may result from applicant's failure to tender the final fee and have it accepted within the twelve months' period of forfeiture. See 712.

e) Where claims are suggested for interference near the end of the statutory period running against the case, see 1101.01 (n).

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his application, applicant may either ask for reconsideration of such holding, if he disagrees with it; or petition for revival if he acquiesces with the holding.

711.03 (a) Holding Based on Insufficiency of Response

Applicant may deny that his response was incomplete.

While the Examiner has no authority to act upon an application in which no action was taken during the statutory or shortened period, he may reverse his judgment as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. See also 714.03.

711.03 (b) Holding Based on Failure To Respond Within Period

When an amendment reaches the Patent Office (not the division) after the expiration of the statutory period and there is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the Examiner and the applicant may disagree as to the date on which the statutory period commenced to run or ends. In this situation, as in the situation involving sufficiency of response, the applicant may take issue with the Examiner and point out to him that his holding was erroneous.

711.03 (c) Petitions Relating to Abandonment

Rule 137 Revival of abandoned application. An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee.

[Old Rule 172]

Rule 181 (Reproduced and discussed in chapter 1000), is of general nature and provides remedy from the action of the Examiner in holding a case abandoned because of late or insufficient response.

A petition to revive an abandoned application should not be confused with a petition from an Examiner's holdings of abandonment. As stated above abandonment may result not only from insufficiency of response but also

from entire failure to respond, within the statutory period following an Office action.

Where the holding of abandonment is predicated on the insufficiency of the response, or disagreement as to controlling dates the petition from such holding comes under Rule 181 and does not require a fee.

Where the applicant acquiesces in the holding of abandonment, or where the petition from such holding is denied, applicant's only recourse, so far as concerns the particular case involved, is by petition to revive. Such petition must be accompanied by a fee of $10.00, a proposed amendment in response to the preceding Office action, if no such amendment had been previously filed, and a verified satisfactory showing that the delay in prosecution was unavoidable. Rule 137.

711.03 (d) Examiner's Statement on Petitions Relating to Abandonment

ON PETITION TO SET ASIDE EXAMINER'S HOLDING

Rule 181 states that the Examiner "may be directed by the Commissioner to furnish a written statement within a specified time setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner". Often, however, the Supervisory Examiner passes upon the question without requesting such statement from the Examiners, if the issue raised is clear from the record.

ON PETITION TO REVIVE

In answering a petition to revive an abandoned application the Examiner should state the date when the application became abandoned, whether the amendment, if any, is responsive and if not, in what respect it is defective, and whether it puts the application in condition for allowance. If no amendment is filed or if the petition is not verified the answer should so state. Attention should be directed to the history of the case, so far as pertinent to the question of revival, but no recommendation should be made. A copy of the answer should be sent the petitioner. (Notice of November 18, 1916.)

711.04 Disposal of Abandoned Files

Extract from Rule 14. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

711.04 (a) Pulling and Forwarding

At the end of each month, the files of such applications as have become abandoned during the *preceding* month are pulled and forwarded to the Abandoned Files Section.

711.04 (b) Ordering Abandoned Files

Abandoned files may be obtained from the Abandoned Files Section by filling out Form PO–125 with the necessary data and leaving these forms with the clerk in charge. The name of the Examiner ordering the file should appear on the form. The file should be promptly returned when the Examiner has finished with it.

711.05 Letter of Abandonment Received After Application Is Allowed

Receipt of a letter of abandonment while an application is allowed, is acknowledged by the Issue and Gazette Branch, such acknowledgment being signed by the Executive Officer. If a letter of abandonment is received while an application is forfeited, the Docket Branch prepares and sends the acknowledgment.

711.06 Publication of Abstracts

If an owner of a pending application is willing to abandon said application, it is possible for him to have an abstract of said application published in the Official Gazette and the application simultaneously made available to the public.

711.06 (a) Requirements of the Request

The request for publication must be made by the owner or by the attorney of record. It must be received while the application is pending. It must state that the application is to be available to the public when published (this may be implied where it is clear that the request for publication of the abstract is made in accordance with the notice of Jan. 25, 1949, 619 O. G. 258). It must be accompanied by either (a) a formal abandonment of the application, which may be qualified to take effect on publication, or (b) a specific statement that the application will be or is intended to be abandoned immediately after the publication, or (c) a statement that the application will be abandoned by failure to respond, or (d) a state-

ment of the character indicated in section 711.06 (e). A proposed abstract may accompany the request. The submission of a proposed abstract is desirable.

711.06 (b) Handling of Papers by Examiner

The papers are initially referred to the examiner for consideration of (a) the formalities of the request, (b) whether the abstract should or should not be published, and (c) the nature of the abstract to be published. The examiner will prepare a letter to be sent to the applicant through the attorney or agent. This letter is signed but not dated or mailed, and the application file and drawing, together with all the papers, are forwarded to the Supervisory Examiner.

If the examiner finds that the request for publication does not comply with the requirements (see section 711.06 (a)), the letter will simply so state. The following type of letter may be used where the request is presented in an abandoned application:

> This will acknowledge the letter of _____ requesting publication of an abstract of this application. Such publication under the Commissioner's Notice of January 25, 1949, 619 O. G. 258, cannot be considered since the application was abandoned before the request was received.

If the disclosure of the application appears to the examiner to be purely fanciful, or inoperative or incomplete, publication should not be recommended by the examiner; likewise, if the disclosure is fully met by readily available prior art or if its publication is deemed to be of no value. However, questions of patentability of the claims over the prior art should not be considered. If the examiner recommends that an abstract not be published, either for one of the reasons mentioned above or for any special reason, the letter to the applicant mentioned in the first paragraph of this section will simply state that it has been determined not to publish any abstract, giving briefly the reasons. The reasons should be stated in a separate memorandum for the Supervisory Examiner.

If the request for publication is not defective and the examiner has not determined to recommend adversely, the nature of the abstract must be considered. If no abstract has been submitted, the examiner will prepare a suitable abstract of the disclosure. If the applicant has submitted a proposed abstract, this should be reviewed and compared with the specification and revised or rewritten, if necessary. If the abstract submitted by the applicant is modified by the examiner in any manner, even to the extent of adding reference numerals, a copy of the abstract in its final form for publication should be mailed with the letter to the applicant. In either of the above situations the applicant should be notified as follows:

> This will acknowledge the letter of _____ requesting publication of an abstract of this application under the Commissioner's Notice of January 25, 1949, 619 O. G. 258. In accordance with your request, an abstract of the application, a copy of which is attached, will be published in the Official Gazette.

If the abstract furnished by the applicant is accepted, it should not be retyped but merely identified in the proper space of Form PO–242 by paper number. In this event applicant should be advised as follows:

> This is to acknowledge the letter of _____ requesting publication of an abstract of this application under the Commissioner's Notice of January 25, 1949, 619 O. G. 258. In accordance with your request, an abstract of the application corresponding to the copy which you have submitted will be published in the Official Gazette.

In cases having drawings, a figure of the drawing will also be published and the abstract may refer to and use reference numerals appearing in the selected figure. In these cases the original drawings should be forwarded with the file and the prints retained in the division for interference search purposes until the file and original drawings are returned to the division, at which time the prints should be reinserted in the file.

In cases where the Primary Examiner believes that publication of more than one figure of the drawing is desirable, he should discuss the matter with the Supervisory Examiner before preparation of an abstract or before acceptance of the applicant's abstract.

The abstract should be an abstract of the specific embodiment or embodiments disclosed and should be sufficiently complete so as to serve as a disclosure of the device, process or composition. Unessential details can be omitted and theoretical matters and discussions should be omitted. The abstract should be typed on legal size paper with a suitable heading, with one carbon copy. The letter prepared by the examiner to be sent to the applicant will state that an abstract in accordance with the attached copy will be published in the Official Gazette. The papers will then be forwarded to the Supervisory Examiner together with Form PO–242. Applicant does not receive a copy of this form. A sample of this form as filled out follows:

SAMPLE FORM

INFORMATION FOR INCLUSION IN PUBLISHED ABSTRACT OF APPLICATION

Serial No. 875,473	
Title ELECTRICAL RESISTOR ELEMENT (Title should be clearly descriptive of abstracted subject matter.)	
Applicant ALLEN O. VICTOR (1) JOHN M. SMITH (2)	
Residence MADISON, NEW JERSEY (1) NEW YORK, NEW YORK (2)	
Assignor to (Here copy assignment data exactly as it appears on face of file.)	
Filed March 16, 1948	Size of Application * sheets drawings, * pages specification (Est.)
Published *	Classification Class 201 Subclass 76.2
Publish figure No. 1 ** For abstract see paper No. ***	Primary Examiner (Signature)

*Not to be filled in by Examiner.
**Where there is no drawing or no figure of the drawing to be published insert "None."
***Paper number containing abstract submiited by Applicant, or paper number containing abstract prepared by Examiner.

711.06 (c) Handling of Papers by Supervisory Examiners

The Supervisory Examiners will review all cases forwarded to them. In those cases ready for publication, the letters are mailed to the applicants and the files, including the drawing, forwarded to the Issue and Gazette Division. The papers will be entered in the file. In those cases where it has been determined not to publish an abstract, the letters will be mailed and the files returned to the examiner, the correspondence in such cases including the original request will not become part of the record in the application file, but will be kept on file for reference in the Office of the Supervisory Examiners.

The files that have been forwarded to the Issue and Gazette Division for publication of the abstract will be returned through the Office of the Supervisory Examiners to the examining division.

711.06 (d) Request Does Not Serve as Response to Office Action

In no event will a request for publication avoid abandonment of an application for failure to respond to an outstanding Office action awaiting response by the applicant, but such abandonment will not prevent publication of the abstract.

711.06 (e) If the Request Indicates That the Application Will Be Abandoned Only If No Interfering Application Is Found

The request for publication may indicate that the application will be abandoned only if no interfering applications of others are found by the examiner. These cases will be processed and the abstracts published in the same manner as above. If the application is awaiting response by the applicant to an action other than a final rejection, and no response is filed within the statutory period, the application thereby becomes abandoned and the examiner need do nothing further.

If the application is under FINAL REJECTION, the following statement should be added to the letter of acknowledgment (711.06 (b)) approving publication of the abstract:

> The office action of (date of final rejection) is hereby withdrawn, and further action on this application is suspended in accordance with Section 2 of the above notice.

The reason for the withdrawal in such cases is to relieve applicant of the burden of filing an appeal and brief solely for the purpose of maintaining pendency of the application for one year after publication of the abstract. If the application is up for action or is brought up for action by an appropriate response to the last Office action, the examiner will not act on the application until at least a year has passed after the date of the publication of the abstract. During this period if interference searches on other applications reveal an interference, the published application will be taken up for preparation for interference in the same manner as any other application. After the year has passed, and a further period of at least one month, the examiner will take up the application for the purpose of making an interference search. If interfering applications are found according to the usual standards for determining the existence of interferences, the preparations for interference will proceed in the usual manner. If no interfering applications are found, the examiner will prepare a letter stating that an interference search has been made and no applications which interfere with the application have been found, and that abandonment of the application in accordance

with applicant's request is now in order and should be promptly filed. This letter will be forwarded to the Supervisory Examiners before mailing.

After the publication of the abstract, in those cases in which the delay for interference search purposes has not been requested, the applicant will be expected to file a formal abandonment of the application, if such has not already been filed, within a reasonable period after the publication; but if the application is awaiting action by the applicant it may be permitted to abandon for failure to reply. In those cases which requested a delay for interference search purposes and a letter has been sent indicating that no interfering application was found by the examiner, a formal abandonment of the application will be expected to be filed. If the abandonments have not been filed within a reasonable time after they should be, the examiner will refer the particular applications to the Supervisory Examiners for instructions as to further action to be taken. If the parties necessary to a formal abandonment have signed the original letter stating that the application will be abandoned, formal abandonment signed by the attorney alone will be accepted. The assignee of the entire interest. as owner, is considered to have sufficient authority under the Notice of January 25, 1949, 619 O. G. 258, to abandon said application without concurrence by the applicant.

711.06 (f) Use as Reference

The published abstracts will be used as references against any application in which they may be applicable. Care must be taken by the examiner not to refer to these abstracts as patents or as applications. They may be designated and cited as follows:

> Brown, abstract of application serial number _____, published _____, ____ O. G. _____. (Give class and subclass.)

These abstracts will be used by the examiner as a basis for rejection only as printed publications effective from the date of publication in the Official Gazette (This is similar to the practice with respect to applications published for the Alien Property Custodian, see notice of May 14, 1943). If properly prepared, it should not be necessary to refer to the complete application file, but in any case in which material in the application file is used as a reference it should only be used as evidence of matters of public knowledge on the date of the publication of the abstract. (Notice of Jan. 25, 1949, Circular of Apr. 13, 1949, and Notice of May 6, 1949, Revised.)

See 901.06 (d).

712 Forfeiture

Rule 316 Forfeited application. A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. (See rule 314.)

A forfeited application is not considered as pending while forfeited, and, if the final fee is not subsequently paid and accepted as provided in rule 317, the application is abandoned, as of the date it became forfeited.

[Old Rules 174, 178]

It is seen that a forfeited application is one which had the status of an allowed case for six months and on which the final fee was not paid. (Rule 316.) Its legal status during the year dating from its forfeiture makes possible its being issued as a patent on petition to the Commissioner when the petition is supported by a verified statement and accompanied by the final fee and the petition fee ($10). (Rule 317).

When the six months' period within which the final fee might have been paid has expired, the file is returned by the Issue and Gazette Division to the examining division. The clerk of the examining division takes out the drawing, stamps it "Forfeited", stamps the file likewise, makes the proper entry in the register, and forwards the file and drawing to the proper section of the Record and Attorney's Room which is under the supervision of the Librarian. The application is recorded as forfeited and filed away in the abandoned files section. If the final fee is not tendered within eighteen months after the date of allowance and accepted, the forfeited case becomes abandoned; and such abandoned application cannot be revived. In this respect an abandoned application that has passed through the twelve months' period of forfeiture differs in status from an application that has become abandoned under the provisions of Rules 135 and 136 in that the latter may be revived under the provisions of Rule 137.

713 Interviews

The personal appearance of an applicant, attorney, or agent before the Examiner presenting matters for the latter's consideration is considered an interview.

713.01 General Policy, How Conducted

The conditions under which interviews with the Examiner may be had is governed by Rule 133 the first paragraph of which states:

(a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

[Old Rule 13.]

An interview should normally be arranged for in advance, as by letter, telegram or phone call, in order to insure that the Primary Examiner and/or the Examiner in charge of the application will be present in the Office. The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the Examiner may well justify his refusal of the interview at that time, particularly in an involved case. The right to an interview lies wholly within the discretion of the Primary Examiner.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the Examiner and the applicant, and thereby advance the prosecution of the application. Thus the attorney when presenting himself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared or does not understand the issues involved an interview should not be permitted.

The Examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the Examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the Examiner.

In no case should an interview be allowed to become protracted with the expenditure of an unreasonable amount of the Examiner's time. It is the duty of the Primary Examiner to see that an interview is not extended beyond a reasonable period even when he does not personally participate in the interview. Matters irrelevant to the subject matter should not be discussed.

During an interview with an applicant who is prosecuting his own case and is not familiar with Office procedure the Examiner may make suggestions that will advance the prosecution of the case; this lies wholly within his discretion. Too much time, however, should not be allowed for such interviews. (See 705.01 (f) for interviews in cases involving patentability reports.)

713.02 Interviews Prior to First Official Action

No interview is permitted for discussion of the patentability of an application prior to the first official action thereon. And it obviously follows that no interview can be held in advance of the filing of an application. In this regard it is the practice of many attorneys, searchers and inventors to consult the Examiner as to the field of search or as to whether he knows of any art, domestic or foreign, not covered by a search already made. Ordinary courtesy to those doing business with the Office has countenanced this practice. The Examiner when confronted by such a request may in his discretion comply with it but in no case should he permit a detailed explanation of the invention with attendant discussion thereof as to the field of search, entailing the expenditure of an unreasonable amount of time. The Office cannot act as an expounder of the patent law, nor as counsellor for individuals. Nor should the Examiner permit searching in the division without the consent of the Primary Examiner.

713.03 Interview for "Sounding Out" Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the Examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney. Such practice nullifies the real purpose of interviews and is a waste of the Examiner's time in the event the agreement is not satisfactory to the principal attorney.

713.04 Substance of Interview Must Be Made of Record

The substance of an interview must always be made of record in the application, particularly where agreement between attorney and the Examiner is reached. Rule 133 (second paragraph) specifically requires that:

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in rules 111, 135.

[Old Rules 13, 68, par. 1]

This is further brought out by the following Rule:

Rule 2 Business to be transacted in writing. All business with the Patent Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent Office is unnecessary. The action of the Patent Office will be based exclusively on the written record in the Office. No attention will pe paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

[Old Rules 1, 4]

713.05 Interviews Prohibited or Granted, Special Cases

Patent Office employees are forbidden to hold either oral or written communication with a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. See 105.

Interviews are frequently requested by persons whose credentials are of such informal character that there is serious questions as to whether such persons are entitled to any information under the provisions of Rule 14. In general, interviews are not granted to anyone who lacks proper authority from the applicant or attorney of record in the form of a paper on file in the case. A mere power to inspect is not sufficient authority for granting an interview involving the merits of the application.

However, interviews may be granted to persons who are known to be the local representatives of the attorney in the case, even though their power of attorney be not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. (See 408.)

If the person seeking the interview is unknown to the Examiner but has in his possession a copy of the application file, the Examiner may accept his statement that he is the person named as the attorney of record or an employee of such attorney.

In the case of an application in which there is a secrecy order, the Examiner must require more reliable identification before discussing the application.

713.06 No Inter Parte Questions Discussed Ex Parte

The Examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties. See 1111.01.

713.07 Exposure of Other Cases

Prior to an interview the Examiner should arrange his desk so that files, drawings and other papers, except those necessary in the interview, are placed out of view. See 101.

713.08 Demonstration, Exhibits, Models

The invention in question may be exhibited or demonstrated during the interview by a model thereof which may be sent to the Office prior to the interview where it is received in the model room and forwarded to the division. A model is not to be received by the Examiner directly from the applicant or his attorney. (See 608.03 and 608.03 (a).)

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the division by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the Examiner outside of the Office, (in Washington) with the approval of the Primary Examiner. It is presumed that the witnessing of the demonstration or the viewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application

The grace extended an applicant after final rejection will be determined in part by the length of prosecution prior to final rejection, and the possible patentable subject matter in the case. Interviews on finally rejected cases can be justified only on the ground that the applicant has not fully understood the position of the Examiner or that the Examiner has not fully appreciated the limitations in the claims over the prior art, or that the Examiner may be able to offer some constructive aid in amending finally rejected claims or in formulating a new claim that would distinguish over the prior art where the case contains patentable subject matter not fully protected by any allowed claims.

713.10 Interview Preceding Filing Amendment Under Rule 312

After a case is sent to issue, it is technically no longer under the jurisdiction of the Primary Examiner, Rule 312. An interview with an Examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under Rule 312 cannot be demanded as a matter of right. However, it is entirely proper, should the Examiner be confronted with a request to state whether a claim of a proposed amendment under Rule 312 is allowable, to peruse the same and inform the attorney either; (1) that the claim is patentable or (2) that it is not obvious that the proposed claim is patentable. A suggestion by the Ex-

aminer of an amendment that would render the claim allowable is always in order.

714 Amendments, Applicant's Action

Rule 115 Amendment by applicant. The applicant may amend before or after the first examination and action, and also after the second or subsequent examination or reconsideration as specified in rule 112 or when and as specifically required by the examiner.

[Old Rule 68, par. 1]

714.01 Signatures to Amendments

Note 605.04 to 605.05 (a) for a discussion of signatures to the application.

714.01 (a) Unsigned or Improperly Signed Amendment

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies, for instance, where the amendment is signed by one only of two applicants and the one signing has not been given a power of attorney by the other applicant.

714.01 (b) Unsigned or Improperly Signed Amendment, Disposal of

When an unsigned amendment or an improperly signed amendment is received it is returned, but when there is not sufficient time for the return of the paper for signature before the expiration of the time allowed by law within which to take proper action, the Examiner will endorse such amendment on the file wrapper and notify the applicant of the status of the case.

The Examiner in carrying out the provisions of the above paragraph gives applicant a specified time (as 20 days) to furnish a duplicate amendment properly signed, or to ratify the amendment already filed. [See Rule 135, 711.]

Informal amendments which are to be returned will be forwarded to the Register, Correspondence and Mail Branch with a memorandum giving the name and address of the attorney, the date of the last Office action in the case and a statement as to why the paper is to be returned. The R. C. and M. Branch will cancel the impression of the receiving stamp and conduct the correspondence incident to the return of the papers. (Order No. 1961, Revised.)

Note 717.01 on return of papers entered on File Wrapper.

Before taking action as prescribed in the preceding paragraph, the Examiner should call in the local representative of the attorney if there be one, as he may have authority to sign the amendment.

714.01 (c) Signed by Attorney Not of Record

Where an amendment is filed, signed by an attorney whose power is not of record both the attorney and applicant are notified that the amendment cannot be entered. (Extract from Notice of September 30, 1918.)

If this is after the death of an attorney of record, see 406.

714.01 (d) Amendment Signed by Applicant But Not by Attorney of Record

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to Rule 35 and a copy of the action should be mailed to the applicant, as well as to the attorney.

714.01 (e) Power of Attorney to a Firm

See 402.05 and 402.05 (a).

714.02 Must Be Fully Responsive

Rule 111 Reply by applicant. (a) After the Office action, if adverse in any respect, the applicant, if he persist in his application for a patent, must reply thereto and may request re-examination or reconsideration, with or without amendment.

(b) In order to be entitled to re-examination or reconsideration, the applicant must make request therefor in writing, and he must distinctly and specifically point out the supposed errors in the examiner's action; the applicant must respond to every ground of objection and rejection in the prior Office action (except that request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until a claim is allowed), and the applicant's action must appear throughout to be a bona fide attempt to advance the case to final action. The mere allegation that the examiner has erred will not be received as a proper reason for such re-examination or reconsideration.

(c) In amending an application in response to a rejection, the applicant must clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

See rules 135 and 136 for time for reply.

[Old Rules 65, 68, par. 1, 69]

Compliance with or discussion of a requirement for the correction of formal matters may

be deferred by applicant until a claim is indicated to be allowable. See 707.07 (a).

Formal matters generally include drawing corrections, correction of the specification and the presentation of a new oath. However, the line between formal matters and substance is not sharp, and the determination of the merits of a case may sometimes require that drawing corrections, corrections of the specifications and the presentation of a new oath be insisted upon prior to allowance of a claim.

Extract from Rule 119 Amendment of Claims . . . In presenting new or amended claims, the applicant must point out how they avoid any reference or ground of rejection of record which may be pertinent.

The prompt development of a clear issue requires that the responses of the applicant meet the objections and rejections of the Examiner.

Responses to requirements to divide are treated under 820.

714.03 Amendments Not Fully Responsive, Action To Be Taken

If there is sufficient time remaining in the six months' statutory period or set shortened period when applicant's amendment is found to be not fully responsive to the last Office action, a letter should at once be sent applicant pointing out wherein his amendment fails to fully respond coupled with a warning that the response must be completed within the time period in order to avoid abandonment. See Order 2215½, 714.05.

Where a bona fide response to an Examiner's action is filed before the expiration of a permissible period, but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted,—such as an amendment or argument as to one or two of several claims involved or signature to the amendment,—the Examiner, as soon as he notes the omission, should require the applicant to complete his response within a specified time limit (usually 20 days) if the period has already expired or not sufficient time is left to take action before the expiration of the period. If this is done the application should not be held abandoned even though the prescribed period has expired. (Circular of July 26, 1934, Revised.)

See Rule 135.

The Examiner must exercise discretion in applying this practice to safeguard against abuses thereof.

The practice outlined above does not apply where there has been a deliberate omission of some necessary part of a complete response. For example, if an election of species has been required and applicant does not make election because he holds the requirement to be wrong, the amendment on its face is not a "bona fide attempt to advance the case to final action" (Rule 111), and the Examiner is without authority to postpone decision as to abandonment.

If there be ample time for applicant's reply to be filed within the time period, no reference is made to the time limit other than to note in the letter that the response must be completed within the statutory period dating from the last Office action.

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. (Order 2801, Revised.) (See Rule 111, 714.02.)

An amendment failing to point out the patentable novelty which the applicant believes to exist in his case should be held to be non-responsive and a time limit set to furnish a proper response if the statutory period has expired or almost expired (714.03). An alternative procedure is to finally reject the claims if they are clearly open to rejection on grounds of record.

See Ex parte Peterson, 1928 C. D. 31; 376 O.G. 3, sustaining *the holding of abandonment* for a non-responsive amendment, wherein it was held that Order 2801 was intended merely to emphasize the necessity of enforcement of old Rule 68 (now 111) as to the presentation of proper arguments, reasons or showing as to patentability.

714.05 Examiner Should Immediately Inspect

Actions by applicant, especially those filed near the end of the statutory period, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the response within the statutory period. (Order 2215½.) See 714.03.

All amended cases when put on the Examiner's desk should be inspected by him at once to determine:

If the amendment is properly signed (714.01).

If the amendment has been filed within the statutory period, set shortened period or time limit (710).

If the amendment is fully responsive. See 714.03 and 714.04.

If the changes made by the amendment warrant transfer.

If the case is special. See 708.01.

If the claims are copied for interference and to ascertain the probability of an interference with any pending application.

If there is a traverse of a requirement for division, in which case the application should be promptly submitted to an Examiner of Classification for review.

714.06 Amendments Sent to Wrong Division

See 508.01.

714.07 Amendments Not in Permanent Ink

If an amendment in other than permanent ink is filed, it is entered, but a permanent copy is required to be filed. Rule 52 (a). A good carbon copy is acceptable.

714.08 Telegraphic Amendment

When a telegram amendment is received it is placed in the file but not entered. If confirmation of this amendment by a properly signed formal amendment does not follow in due time, the applicant is notified that proper confirmation is required; otherwise, the telegram will not be accepted as a response to the former Office action. If he does confirm promptly, the amendment is entered. (See Ex parte Wheary, 1913 C. D. 253; 197 O. G. 534.)

The same test as to completeness of response applies to an amendment sent by telegraph as to one sent by mail. See 714.02.

714.09 Amendments Before First Office Action

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 status as part of the original disclosure. It is entered in the case and acted on in the first Office action. In regard to the introduction of new matter by such an amendment, see 608.04 (b).

714.10 Claims Added in Excess of Filing Fee

In cases in which claims in excess of the number supported by the filing fee are presented before the first Official action on the case, the clerk will place the amendment in the file and enter it on the file wrapper but the Examiner will defer action on the claims presented in the amendment. In his first action the Examiner should act on the claims originally presented and for which the appropriate fee was paid. In this first action the Examiner also should inform the applicant that if he believes that any of the claims presented by the amendment are patentable, he can have them entered and considered in the next action but only by specifically pointing out wherein the claims presented in the amendment are patentable over the references cited by the Examiner. (Extract from Notice of August 18, 1928.)

714.11 Amendment Filed During Interference Proceedings

See 1111.05.

714.12 Amendments After Final Rejection or Action

Rule 116 Amendments after final action (a) After final rejection or action (rule 113) amendments may be made cancelling claims or complying with any requirement of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment under rule 135.

(b) If amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in rule 198, or to carry into effect a recommendation under rule 196.

[Old Rule 68, pars. 2, 3, 5]

Once a final rejection that is not premature has been entered in a case it should not be withdrawn except on the showing required by Rule 116 and the approval of the Supervisory Examiner. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal will be entered. See 706.07 (e) and 714.13.

714.13 Amendments After Final Rejection or Action, Letter Written

Whenever an amendment is filed after final rejection or action, the applicant should be promptly notified of its disposition. Whenever possible such notification should be given within the statutory period following the final rejection or action.

Where the amendment places the case in condition for allowance the notice of allowance is of course sufficient.

Where an amendment filed after final action within the statutory period, not accompanied by the filing of an appeal, does not place the case in condition for allowance, applicant is informed that the amendment has not been entered as it is not considered to be a proper response to the final rejection. When such an amendment is also presented for purposes of appeal and is considered by the Examiner to place the case in better condition for appeal, applicant also is informed that the amendment will be entered for appeal upon the filing of the appeal. The Examiner should write a letter stating the reasons for nonentry such as. for example,

(a) the claims as amended do not avoid any of the rejections set forth in the last Office action, and thus the amendment does not place the case in condition for allowance or in better condition for appeal,

(b) the claims as amended avoid the rejection on indefiniteness but do not avoid the rejection on the references. The amendment will be entered upon the filing of an appeal,

(c) the claims as amended present new issues requiring further consideration or search,

(d) since the amendment presents additional claims without cancelling corresponding finally rejected claims it is not considered as placing the application in better condition for appeal; Ex parte Wirt, 1905 C. D. 247; 117 O. G. 599.

Ordinarily, such letter should not discuss the specific deficiencies of the proposed amendment. Of course, any claims which are considered by the Examiner to be allowable in view of the amendment should be so indicated.

The refusal should never be arbitrary. The proposed amendment should be given sufficient consideration at least to determine whether it obviously places any of the claims in condition for allowance or would simplify the issues on appeal.

Applicant cannot, as a matter of right, add new claims after a final rejection (Rule 116) or reinstate previously cancelled claims for purpose of appeal.

Failure of applicant to properly respond to a final rejection within the statutory period results in a holding of abandonment of the case. For an exception see 714.20, item 3.

For amendments filed with or after appeal, see 1207 and 1211.

714.14 Amendments After Allowance of All Claims

Under the decision in Ex parte Quayle, 1935 C. D. 11; 453 O. G. 213, after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be outstanding formal objections which preclude making the action final.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See 714.12 and 714.13.

714.15 Amendment Mailed Before, But Received in Examining Division After Allowance

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under Rule 312. Its entry is a matter of grace. For discussion of amendments filed under Rule 312, see 714.16 to 714.16 (e).

If, however, the amendment is filed in the Office, but is not received by the Examiner prior to the mailing out of the notice of allowance, it has the same standing in the case as though the notice had not been mailed. Where the case has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the Examiner would recommend for entry under Rule 312.

As above implied, the case will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i. e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the case is a matter of grace and not of right (Ex parte Quayle, 1935 C. D. 11; 453 O. G. 213). To this extent the practice affecting the status of an amendment received in the Office on the date of mailing the notice of allowance, as set forth in Ex parte Miller, 1922 C. D. 36; 305 O. G. 419, is modified.

714.16 Amendment After Notice of Allowance, Rule 312

Rule 312 Amendments after allowance. Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the printing of the specification has not begun, on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

[Old Rule 78]

After a case is sent to issue, it is technically no longer under the jurisdiction of the Primary Examiner. However, the Examiner has for many years had authority to make Examiner's amendments correcting obvious errors, as when brought to the attention of the Examiner by the printer, and also to admit amendments under Rule 312 which are confined to matters of form in specification or claims, or to the cancellation of a claim or claims.

Consideration of an amendment filed under Rule 312 cannot be demanded as a matter of right; hence, if a claim requiring an additional search is presented, an adverse recommendation as to its admission on this score is made by the Examiner. New issues may not be raised for determination once a case has been allowed. Rule 312 was not intended to provide a way for the continued prosecution of an application after it has been passed for issue.

For the reason just stated, an adverse recommendation does not require a lengthy statement of reasons in support of such recommendation. The mere statement that a further search or examination would be required is usually adequate. Of course where it can be made, a suggestion of an amendment that would, in the opinion of the Examiner, render the claim allowable is always in order.

The requirements of Rule 111 (714.02) with respect to pointing out the patentable novelty of any claim sought to be added, apply in the case of an amendment under Rule 312, as in ordinary amendments.

Sometimes a supplemental oath is filed after the application has gone to issue. Such oath is not treated as an amendment under Rule 312, but is merely placed in the file by the Issue and Gazette Branch. No acknowledgment of its receipt is made. (Order 2798, Revised.) (See 603.01.)

Amendments submitted after the notice of allowance of an application which embody merely the correction of formal matters in the specification, or formal changes in a claim without changing the scope thereof, or the cancellation of claims from the application, shall be acted upon by the Primary Examiner and not forwarded to the Commissioner for approval.

[Similar practice obtains in the matter of amendment of the drawing.]

Any amendment affecting the disclosure of the specification, or adding claims, or changing the scope of any claim, shall be submitted, as heretofore, to the Commissioner for approval in accordance with the provisions of Rule 312. (Order 3311.)

714.16 (a) Amendments Under Rule 312, Copied Patent Claims

See 1101.02(g) for the procedure to be followed when an amendment is received after notice of allowance, which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See 714.19 item (4).

714.16 (b) Amendment Under Rule 312 Filed With a Motion Under Rule 234

Where an amendment filed with a motion under Rule 234 applies to a case in issue, the case is not immediately withdrawn from issue if the date set for transmitting the motion comes well within the six months' period of allowance. Otherwise, the case is withdrawn, but the amendment is not entered unless and until the motion has been granted. See 1105.03.

714.16 (c) Amendment Under Rule 312, Excess Number of Claims

When an amendment under Rule 312 which has been approved adds claims which increase the total number in the case above twenty, the Examiner's clerk in preparing the forms will see that the notice bears the statement, "The final fee in this case will now be $_____" (Form POL–95), filled in according to the number of claims that stand allowed in the case after the entry of the amendment. (Notice of Jan. 26, 1928, Revised.)

714.16 (d) Amendments Under Rule 312, Handling

Petitions to amend under Rule 312 will be sent by the Mail Room to the Issue and Gazette Branch.

The Issue and Gazette Branch will send the petition with the file to the division which allowed the case.

The application will be submitted to the Examiner for his recommendation, which must be promptly made. When the recommendation is favorable (to be indicated by applying on the amend-

POL-95 we fill in amount
30.00 for 20 claims

ment the stamp reading "Entry recommended under Rule 312"), the Examiner's clerk will enter the amendment and prepare a letter, in duplicate (Form POL–97) to the applicant, notifying him that the amendment has been entered. This letter should be placed in the file, entered on the file wrapper and in the Examiner's register. The file, together with the unmailed duplicate, should be sent back to the Issue and Gazette Branch which will forward it to the Commissioner.

If the Examiner's recommendation is adverse to the entry of the amendment, a letter (Form POL–105) should be prepared in duplicate, to the applicant so advising him, and including the Examiner's report. This letter should be placed in the file and entered on the file wrapper and in the Examiner's register. The unmailed duplicate, together with the file, should be forwarded to the Commissioner as above.

After the Commissioner has acted on the petition, the file will be forwarded to the Issue and Gazette Branch, which will mail the communication prepared by the Examiner. (Order No. 2698.)

The physical entry of the amendment by the clerk in the use of Form POL–95 does not signify that the amendment has been admitted; for, though actually entered, it is not constructively admitted unless and until approved by the Commissioner. If not approved by the Commissioner, the entry is erased.

Amendments concerning merely formal matters are entered without permission of the Commissioner. See Order 3311, 714.16. The amendment is stamped "Entered Under Order 3311" and form POL–66 is used by the typist. If such amendment is disapproved a report is prepared by the Examiner and form POL–105 is used. In each case the file and unmailed duplicate of the letter are forwarded to the Issue and Gazette Branch.

714.16 (e) Amendments Under Rule 312, Entry in Part

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under Rule 312, an amendment is proposed containing a plurality of claims, some of which may be entered and some not, the acceptable claims should be entered in the case and if necessary they should be renumbered to run consecutively with the claims already in the case. The refused claims should be cancelled in lead pencil on the amendment.

The Examiner should then submit a report on Form POL–103 recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his reasons therefor. The claims entered should be indicated by number in this report. (Notice of August 11, 1922, Revised.)

714.17 Amendment Filed After the Period for Response Has Expired

When an application is not prosecuted within six months from the date of the last Office action therein, or within a set shortened statutory period or a set time limit and thereafter an amendment is filed, such amendment shall be endorsed on the file wrapper of the application, but not formally entered and the Examiner shall immediately notify the applicant that the amendment was not filed within the time period and therefore cannot be entered. The applicant should also be notified that the application is abandoned. (Order 1854, Revised.)

714.18 Entry of Amendments

On arrival from the Mail Branch to the respective examining divisions, the amendments are put in the files to which they pertain, and the files with the unentered amendments placed on the Primary's desk for inspection and such penciled comments as he may wish to note on the margin of the amendatory papers.

The files and amendments are then turned over to the clerk, whose duty it is to enter the amendments. The clerk stamps the amendment with the date of its receipt *in the division.* It is important to observe the distinction which exists between the stamps which shows the date of receipt of the amendment in the division ("Division Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his amendment.

Every amendment entered by the clerk must be initialed by the clerk. See Clerk's Manual—Amendments—.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action", and it is very important that it should be kept separate from those applications which await action by the applicant. It is placed on the Examiner's desk, and he is responsible for its proper disposal. The Examiner should immediately inspect the amendment as set forth in 714.05. After inspection if no immediate or special action is required,

the application is placed in the amended case files to await re-examination in regular order.

Amendments or other papers filed in cases before the Law Examiner should be promptly forwarded to him. (Extract from Notice of April 18, 1919.)

714.19 List of Amendments, Entry Denied

The following types of amendments are ordinarily denied entry:

(1) An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in a case whose prosecution before the Primary Examiner has been closed, as where

(a) All claims have been allowed,

(b) All claims have been finally rejected,

(c) Some claims allowed and remainder finally rejected.

See 714.12 to 714.14.

(2) Substitute specification that has not been required and is not needed. See Rule 125, 608.01 (q) and 714.20.

(3) A patent claim suggested by the Examiner and not presented within the time limit set or a reasonable extension thereof, unless entry is authorized by the Commissioner. See Notice of September 27, 1933, revised, 1101.02 (f).

(4) While copied patent claims are generally admitted even though the case is under final rejection or on appeal, yet where, prima facie, the applicant has no basis in his disclosure for the copied patent claim or its essence, or where the patent claim is for another, even though not divisably different, invention than that claimed by the application (Patent file No. 1,927,086), the claim may be refused admission if the application falls in class (a), (b), or (c) of category (1) supra, and especially if the application is an old one. See 1101.02 (g).

(5) An unsigned amendment or one not properly signed by a person having authority to prosecute the case. See 714.01 to 714.01 (e); 714.08.

(6) An amendment filed in the Patent Office after the expiration of the statutory period or set time limit for response. See 714.17.

(7) An amendment so worded that it cannot be entered with certain accuracy. See 714.23.

(8) An amendment cancelling all of the claims and presenting no substitute claim or claims. (711,01.)

(9) An amendment in a case no longer within the Examiner's jurisdiction with certain exceptions in applications in issue (714.16), except on approval of the Commissioner.

(10) An amendment filed before the first action increasing the number of claims in excess of the filing fee. See 714.10.

(11) Amendments to the drawing held by the Examiner to contain new matter are not entered until the question of new matter is settled. This practice of non-entry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims.

(12) An amendatory paper containing objectionable remarks that, in the opinion of the Examiner, brings it within the condemnation of Rule 3, will be submitted to the Commissioner with a view toward its being returned to applicant. See 714.25.

While amendments falling within any of the foregoing categories should not be entered by the Examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

714.20 List of Amendments Entered in Part

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the statutory period. Thus,

(1) An amendment presenting an uncalled-for and unnecessary substitute specification along with other amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry in toto. The substitute specification should be denied entry and so marked, while the rest of the amendatory paper should be entered. The case as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been required and is not necessary and therefore has not been entered, and that any desired changes in the original specification must be made by specific amendments. (Notice of August 17, 1934, Revised.) See also Rule 125, 608.01 (q).

It may be noted in this connection, however, that the fact that a substitute specification, in the opinion of the Examiner, contains new matter is not in itself a proper reason for refusing entry thereof. So far as the subject matter itself is concerned, an applicant has the right to a hearing on any amendment he may see fit to present. Whether the amendment will be entered in the form of a substitute specification or a series of alterations of the original speci-

fication is an administrative matter for the Office to determine.

(2) An amendment under Rule 312, which in part is approved and in other part disapproved, is entered only as to the approved part. See 714.16 (e).

(3) In a case having some claims allowed and others finally rejected, where an amendment is received at or near the close of the statutory period cancelling the finally rejected claims and presenting one or more new ones which the Examiner cannot allow, the amendment, after the statutory period has ended, is entered to the extent only of cancelling the finally rejected claims. Of course, if any of the new claims were, in the Examiner's opinion, patentable, they too would be entered. The applicant is notified that the new claims which are held unpatentable have not been admitted, and at the same time the case is passed for issue.

(4) Where all of the claims are under final rejection and the amendment cancels these claims and presents new ones, only some of which are deemed allowable by the Examiner, the same practice is followed as indicated in (3).

(5) In a case having all claims allowed and some formal defect noted, where an amendment is presented at or near the close of the statutory period curing the defect and adding one or more claims some of which or all of which are in the opinion of the Examiner not patentable, or will require a further search, the procedure indicated in (3) is followed. After the statutory period has ended, the amendment in such a case will be entered only as to the formal matter and any of the claims that may be deemed patentable.

(6) In an amendment accompanying a motion granted only in part, only so much of the amendment as is covered in the grant is entered. See 1108.

714.21 Amendments Inadvertently Entered, No Legal Effect

If the clerk inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as, "Not Officially Entered".

An amendatory paper, even though not entered, should be given a paper number, and appropriately endorsed on the file jacket, as by "Not Entered".

714.22 Entry of Amendments, Directions for

Rule 121 Manner of making amendments. Erasures, additions, insertions, or alterations of the papers and records must not be made by the applicant. Amendments are made by filing a paper (which should conform to rule 52), directing or requesting that specified amendments be made. The exact word or words to be striken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made.

[Old Rule 73, par. 1]

714.23 Entry of Amendments, Directions for, Defective

Where the directions for the entry of an amendment are defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line, and it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining division, and notation thereof, initialed by the Examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action the applicant should be informed of this alteration in his amendatory paper and the entry of the amendment as thus amended. He will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant. (Notice of June 30, 1939, as amended May 7, 1951.)

714.24 Amendment of Amendment

Rule 124 Amendment of amendments. When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion cancelled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter cancelled by amendment can be reinstated only by a subsequent amendment presenting the cancelled matter as a new insertion.

[Old Rule 74]

However, where a relatively small amendment to a previous amendment can be made easily without causing the amendatory matter to be obscure or difficult to follow, such small amendment should be entered.

714.25 Discourtesy of Applicant or Attorney

Rule 3 Business to be conducted with decorum and courtesy. Applicants and their attorneys or agents are required to conduct their business with the Patent Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other em-

ployees must be made in communications separate from other papers.

[Old Rule 22a, b]

If the attorney is discourteous in the remarks or arguments in his amendment, either the discourtesy should be entirely ignored or the paper submitted to the Commissioner with a view toward its being returned.

715 Swearing Back of Reference Affidavit Under Rule 131

Rule 131 Affidavit of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describe but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photographic or photostatic copies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained.

[Old Rule 75]

Any printed publication dated prior to an applicant's effective filing date, or any patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application.

Such a reference may be overcome, in certain instances noted below, by applicant's filing of an affidavit under Rule 131, known as "swearing back" of the reference.

Affidavits under Rule 131 may be used:

(1) Where the date of the foreign patent or that of the publication is less than one year prior to applicant's effective filing date.

(2) Where the reference, a U. S. Patent, with a patent date less than one year prior to applicant's effective filing date, shows but does not claim the invention.

Affidavit under Rule 131 is not appropriate in the following situations:

(1) Where reference publication date is more than one year back of applicant's effective filing date. Such a reference is a "statutory bar". Sec. 4886, R. S.; 35 U. S. C. 31.

(2) Where the reference U. S. patent claims the invention. See 1101.02 (a).

(3) Where reference is a foreign patent for the same invention to applicant or his legal representatives or assigns issued on an application filed more than twelve months prior to the filing date of the domestic application.

(4) Where the effective filing date of applicant's parent application or an International Convention proved filing date is prior to the effective date of the reference, affidavit under Rule 131 is unnecessary and the reference is not used. See 201.11 to 201.15.

(5) Where the reference is a prior U. S. patent to the same party, claiming the same invention, the question involved is one of "double patenting."

(6) Where the reference is the disclosure of a prior U. S. patent to the same party, not copending, the question is one of dedication to the public.

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit is the date of the amendment. In re Williams et al., 1935 C. D. 229; 454 O. G. 535.

715.01 Reference Patent Entitled to Foreign Filing Date

In overcoming, under Rule 131, a domestic patent where the patentee has an earlier foreign filing date to which he would be entitled in establishing priority to the invention claimed in the patent, it is not necessary for the applicant to carry his date back of the patentee's foreign filing date. (Viviani v. Taylor v. Herzog, 72 U. S. P. Q. 448).

715.02 General Rule as to Generic Claims

A reference applied against generic claims may (in most cases) be antedated as to such claims by an affidavit under Rule 131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference (assuming, of course, that the reference is not a statutory bar or a patent claiming the same invention). See, however, 715.03.

715.03 Exceptions and Practice Relative to Chemical Cases

A patent showing a species was used against an application having generic claims. The affidavit showed a reduction to practice of a different species. It was held that this affidavit did not overcome the reference. A second affidavit showed a reduction to practice of the same species as the patent prior to the effective date of the patent and said second affidavit was held to overcome the reference. Ex parte Fryling, 1947 C. D. 5; 604 O. G. 5.

"The principle is well established in chemical cases, and in cases involving composition of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claims, although the disclosure in an application of a species may not be sufficient basis for a generic claim." In re Steenbock, 1936 C. D. 594; 473 O. G. 495.

A further case along this line is In re Kyrides, 1947 C. D. 254; 600 O. G. 501, wherein Kyrides had previously been in interference with Anderson. Anderson was the senior party and both parties had generic disclosures. Kyrides was awarded priority by the court as to the generic claims on the basis that he had an earlier copending application which disclosed a single species. The interference having terminated and *ex parte* prosecution resumed the examiner rejected the generic claims in Kyrides' application on the Anderson application on the ground that while the court had awarded Kyrides priority in the generic invention it did not necessarily follow that Kyrides was entitled to the allowance of claims for such generic invention. The court upheld the examiner, stating:

"We have heretofore stated that the awarding of priority to an applicant in an interference proceeding does not insure or even suggest, that he is necessarily entitled to his claim in a patent."

Kyrides by affidavit under former Rule 75 (now 131) attempted to overcome the Anderson application by Kyrides' earlier application. The affidavit was held to establish no more than that one species had been reduced to practice as of that date. A showing of species insufficient to support the genus, by either a Rule 131 affidavit or an earlier application, does not overcome a reference whose effective date is prior to the filing date of the application in which the generic claim is asserted.

The quantum of showing in an affidavit under Rule 131 necessary to overcome a rejection of generic chemical claims on disclosed but unclaimed species varies with the circumstances.

In accordance with the trend of present practice, it cannot now be stated that any arbitrary number of species will be regarded as sufficient in all cases, but the showing in the particular case should be representative at least of the class covered by the rejected generic claim.

"Markush" Type Genus Claim:

Where a claim reciting a Markush group is rejected on a reference disclosing but not claiming a specific member of the group, the reference cannot be avoided by an affidavit under Rule 131 showing different members of the group.

715.04 Who May Make Affidavit

A. The Inventor.

B. One of two joint inventors is accepted where suitable excuse is given for failure of the other applicant to sign. In re Carlson et al, 1936 C. D. 95; 462 O. G. 479.

C. The Assignee or other party in interest when it is not possible to produce the affidavit of the inventor. Ex parte Foster, 1903 C. D. 213; 105 O. G. 261.

715.05 Patent Claiming Same Invention

When the reference in question is a patent claiming the same invention as applicant and its issue date is less than one year prior to the filing date of the application being examined, applicant's remedy, if any, must be by way of Rule 204 instead of Rule 131. The Examiner should therefore take note whether the status of the patent as a reference is that of a PATENT or a PUBLICATION. If the patent is claiming the same invention as the application, this fact should be noted in the Office letter. The reference patent can then be overcome only by way of interference. Note, however, R. S. 4903, 35 U. S. C. 51, second paragraph, 1101.02 (f).

715.06 Affidavit Under Rule 131 Must Be Removed Before Interference

Where an application in which an affidavit under Rule 131 has been filed is to be involved in an interference, the affidavit must be sealed in an envelope properly labeled before forwarding the application to the interference division.

The same practice obtains with respect to a Rule 131 affidavit in the file of an application made the subject of a motion under Rule 234 or 235.

Under the practice established in Ferris v. Tuttle, 1940 C. D. 5; 521 O. G. 523, the Rule 131 affidavit is thrown open to the opposing party or parties to the interference at the time the preliminary statements are opened. See 1101.03 and 1102.01.

715.07 Facts and Documentary Evidence

The essential thing to be shown under Rule 131 is priority of invention and this may be done by any satisfactory evidence of the fact. *FACTS*, not conclusions must be shown by the evidence accompanying an affidavit under Rule 131.

(A) As shown in attached sketches.
(B) As shown in attached blueprints.
(C) As indicated by accompanying model.
(D) As shown in attached photographs.
(E) As shown in reproductions of notebook entries.

(F) If verbal disclosures were made instead of the above, supporting statements by the witness will be acceptable.

(G) If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath.

The dates in the oath may be the actual dates or, if the applicant does not desire to disclose his actual dates, he may merely allege that the acts referred to occurred prior to a specified date.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C. D. 23; 23 O. G. 1224.

"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others." *Ex parte* Donovan, 1890 C. D. 109; 52 O. G. 309.

The affidavit must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention IN THIS COUNTRY, the conception at least being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant must show diligence in the completion of his invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing of his application, which constitutes a *constructive* reduction to practice. Rule 131. In this connection, note the following:

A conception of an invention, evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited, 1909 C. D. 498; 139 O. G. 991.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C. D. 724; 81 O. G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The facts to be established under Rule 131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented.

715.07 (a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward it is not enough merely to allege that applicant had been diligent. Ex parte Hunter, 1889 C. D. 218; 49 O. G. 733.

What is meant by diligence is brought out in Christie 1. Seybold, 1893 C. D. 515; 64 O. G. 1650. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if his lack of activity is excused.

715.07 (b) Interference Testimony Sometimes Used

In place of an affidavit the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of a Rule 131 affidavit.

The part of the testimony to form the basis of priority over the reference should be pointed out. Ex parte Bowyer, 1939 C. D. 5; 505 O. G. 759.

715.07 (c) Acts Relied Upon Must Have Been Carried Out in This Country

The affidavit must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out *in this country.* See Section 9 of Public Law 690.

715.07 (d) Disposition of Exhibits Submitted as Evidence to Support Facts

Exhibits filed as part of an affidavit under Rule 131 that are too bulky to be placed in the application file are retained in the Examining Division until the case is finally disposed of. When the case goes to issue (or abandonment) the exhibits are sent to the Model Room, notation to this effect being made on the margin of the affidavit.

715.08 Passed Upon by Primary Examiner

The question of sufficiency of affidavits under Rule 131 should be reviewed and decided by the Examiner in charge of the division. (Order 2712, Revised.)

715.09 Seasonable Presentation

Affidavits under Rule 131 must be seasonably presented. Ex parte Berg, 1906 C. D. 36; 120 O. G. 903; Ex parte Romunder, 1910 C. D. 121; 157 O. G. 209; Ex parte Hale, 49 U. S. P. Q. 209; Ex parte Bowyer, 1939 C. D. 5; 505 O. G. 759.

For affidavits under Rule 131 filed after appeal, see Rule 195 and 1212.

716 Affidavits Traversing Rejections, Rule 132

Rule 132 Affidavits traversing grounds of rejection. When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits traversing these references or objections may be received.

[Old Rule 76]

Applicants sometimes file affidavits attempting to overcome rejections. Such affidavits should be directed to an issue raised in the case Ex parte Robinson, 1905 C. D. 123; 115 O. G. 1584; and should recite facts instead of conclusions and opinions Ex parte Romunder, 1910 C. D. 121; 157 O. G. 209.

As to ex parte affidavits in which the operability of a patent is attacked, this principle is followed:

A patent has the benefit of presumptive validity; and one who would attack its operativeness, especially ex parte, assumes a preponderant burden of proof. For this reason, and also since the Office has no laboratory means of checking the tests made by affiant, and since the patentee has no opportunity to defend the operativeness of his claimed invention, the affidavit should not be given the usual status of an affidavit in its binding effect as to factual statements therein made, but should be accorded merely the status of an expression of opinion of an expert in the art. With its status thus construed, the affidavit will be admitted and considered by the Examiner.

Affidavits to show inoperativeness of the reference are closely scrutinized.

". . . the failures of experimenters who have no interest in succeeding should not be accorded great weight . . ." (citations) In re Michalek, 1947 C. D. 458, 604 O. G. 223.

Affidavits under Rule 132 must be seasonably filed. In re Taub 1942 C. D. 337; 538 O. G. 29. The burden is on applicant to prove nonequivalency where examiner had held the reference to be equivalent to the claimed invention. Id.

Though affidavits are often said to be "helpful", it depends on the fact situation of each case whether they help the applicant's contentions. See In re Smith, 1947 C. D. 341; 603 O. G. 184. In re Crossley 1947 C. D. 152; 598 O. G. 323; In re Kokatnur, 1943 C. D. 436; 554 O. G. 6.

Affidavit may relate to meaning of the disclosure to those "skilled in the art". Dow v. Converse, 1903 C. D. 404; 106 O. G. 2291.

Affidavit that applicant has "produced a grease in accordance with the teachings of Patent_____" and that this grease will not pass a certain test, states nothing but conclusions. In re Kokatnur, 1943 C. D. 436, 554 O. G. 6.

In general, an affidavit concerning tests should state the precise structures or composi-

tion made and tested, or the precise process carried out with the precise conditions, and give the experimental data secured, so that the tribunal before which the affidavit comes can form its own conclusions. It is desirable that applicant in his letter of transmittal state the conclusion he draws. However "no weight can be given to statements of counsel unsupported by the record." In re Mason 1946 C. D. 268; 558 O. G. 522. In re Casey 76 USPQ 463. General expressions of opinion of an affiant in respect to patentability of claims is not entitled to weight. In re Garrett 1906 C. D. 645; 122 O. G. 1047.

717 File Wrapper

717.01 Papers in File Wrapper

Every paper entered on the "Contents" of a file should be entered in ink and not in pencil. If the paper is not to be allowed entry in the case, that fact may be noted in ink at the time the entry on the "Contents" is made. If subsequently the paper is allowed entry in the case a line may be drawn through the "not entered" note. No paper entered on the "Contents" of the file should ever be withdrawn or returned to the applicant without special authority of the Commissioner (Order 2799).

It is directed that entries shall not be made on the back of a file wrapper, containing the application papers for a patent, of papers or actions which do not become a permanent part of the contents of the file (Order 767).

The papers when placed in the file are numbered and noted in the contents column, the application papers being No. 1, the print of the drawing, if there is one, being No. 2, and the next paper, usually the first Office letter being No. 3, etc.

The papers are noted in the contents column according to their character. If it is an Office action rejecting any claim, the word "Rejection" is entered on the file, or if the rejection has taken the form of a requirement for division, the entry will so indicate, otherwise the word "Letter" is used. Papers from the applicant amending the case are designated "Amendment", "Letter to Draftsman", "Associate Attorney", etc.

Correspondence from the applicant is entered in the contents column in red ink and Office correspondence is entered in black ink.

After the notation of the character of the papers, the mailing date is entered in regard to Office correspondence and the filing date in regard to correspondence from the applicant. See Clerk's Manual Part I, Sec. 4.

717.01 (a) Arrangement of Papers in File Wrapper

All papers in applications must be arranged and marked uniformly in the following manner.

The specification and all amendments that are to be printed must be kept separate from office letters, appeals and miscellaneous correspondence. The specification and amendments must be fastened to the second or middle page of the jacket with the original specification and claims on the bottom and the last amendment on the top. The print of the drawing, the Office letters and other papers not needed by the printer must be fastened to the third page of the jacket, the print of the drawing being always kept uppermost. A communication containing amendments, and explanations should ordinarily not be divided. If the amendments and explanatory matter be presented in the same paper, it should be treated as an amendment and placed on the amendment side, or second page of the jacket, care being taken so to mark and enclose the parts to be printed by red ink that the printer can readily distinguish the amendment from the explanatory matter. All the papers in the case will be marked serially as heretofore.

Amendments will be lettered serially in the order of their receipt, all the amendments of the same date bearing the same serial letter. If the amendment is short it should be transcribed in red ink at the proper place, and the notation per "A", per "B", etc. should be written in red ink on the margin, Amendments that are transcribed should never be marked A^1, A^2, B^1, B^2. Amendments that are too long to be transcribed should be marked A^1, A^2, B^1, B^2, etc. on the margin, the first amendment of this character in amendment sheet "A" being A^1 the second A^2, etc. At the margin point at which the amendment is to be inserted should be written "Insert A^1", "A^2", etc., as the case may be, and the same letters placed in the angle of a caret at the proper point of insertion, so that when several insertions are placed in the same line these different insertions may be readily distinguished.

All insertions and substitutions should be marked on the original application, if practicable. For instance, if Amendment A provides that claims 1 to 5 should be canceled and new claims substituted, a red line should be drawn diagonally across claims 1 to 5 and in the margin should be written "Sub. A^1". If at a later date the claims contained in Amendment A^1 are canceled and a series of claims contained in Amendment B^1 are submitted, the claims in Amendment A^1 should be canceled and the proper notation made in the margin, and in addition the notation "Sub A^1" on the original paper should be canceled and in its place should be written "Sub B^1".

The last requirement is very important, as the work of the printer is needlessly delayed and complicated if he is compelled to search from paper to paper for the proper insertion.

Where amendments are submitted in duplicate, the carbon copy is destroyed except where the duplicate is received within the time period for response and the original is late. In this latter situation both copies are placed in the file.

If the attorney wishes a receipt for any paper filed, this may be had by enclosing with the paper a self-addressed postal card identifying the paper. The mail-room receiving-stamp will be placed on the card, and the card dropped in the outgoing mail. (Order 1733, Revised.)

717.01 (b) Prints

The clerks shall enter as Paper No. 2 the prints of the drawings fastened inside the file wrapper by the Application Branch. Such entry, of course, requires endorsement on the file wrapper and on each print of the appropriate date of receipt and paper number.

The prints shall always be kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the date of their receipt in the office and given their appropriate paper number. (Order 3240, Revised.)

717.02 Data Entered on File Wrapper

See also 707.10, 717.01 and 1302.08.

If the Examiner notices an error in any of the data on the file wrapper set forth in the ten following paragraphs, he should have the same corrected by the Application Branch:

1. The serial number given the application in the Application Branch.
2. The number of the Examining Division to which the case is assigned by the Application Branch.
3. The name of the applicant.
4. The residence of the applicant.
5. The title of the invention.
6. The date of receipt of the various parts of the application.
7. The date when it is considered a complete application. If the parts of the application have been received at different dates, the date of receipt of the last part is the date of the complete application or filing date.
8. The name and address of the attorney or representative.
9. The filing date and name of country of earliest foreign application, if any, and also of each additional foreign application filed outside the 12-months period, if any. This should be checked against the oath.
10. Where a case for which the filing fee was paid is brought under the Act of 1883, entry on the file wrapper is made by the Application Branch.

If the Examiner notices an error in the name and address of the assignee he should have it corrected by the Assignment Branch.

All of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the Examiner's clerk, the original entry being canceled but not erased.

717.02 (a) Statutory Period Ends on Sunday or Holiday

See 710.05.

717.02 (b) Name or Residence of Inventor or Title Changed

When the name or residence of applicant or title or invention is changed by amendment it must be changed on the face of the file in red ink by the clerk of the division.

Sec. 605.04 (c) explains the procedure to be followed concerning sending the application to the Assignment Branch and the Application Branch when Applicant changes name.

717.03 Classification During Examination

When a new case is received in a division the Primary Examiner notes in pencil in the upper left-hand corner of the face of the file wrapper the classification of the case and indicates the assistant examiner who will examine it.

In the upper right hand corner on the face of the file wrapper is noted Examiner's Book number, page and item numbers indicating where the case is recorded in the Examiner's Register. (See Clerk's Manual.)

717.04 Index of Claims

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date so as to be a reliable index of all claims standing in a case, and of the amendment in which the claims are to be found.

A line in ink should be drawn below the number corresponding to the number of claims originally presented. Thereafter, a line in ink should be drawn below the number corresponding to the highest numbered claim added by each amendment, and to the left of the number corresponding to the first

claim of each amendment there should be placed the letter designating the amendment.

As any claim is canceled a line should be drawn through its number. (Circular of February 17, 1936, Revised.)

717.05 Field of Search

In each action by an Examiner upon an application he shall make an initialed indorsement in ink on the left-hand page of the open file wrapper, stating the classes and sub-classes of domestic and foreign patents, and the publications in which search for references was made and also the date of the search. (Former Order 2146.)

In the above order "initialed indorsement" means the Examiner's initials should be noted. Also, the date of search in the Scientific Library for foreign patents issued to the applicant when sending an application to issue which was not filed within 12 months of applicant's earliest foreign application should be noted in the file wrapper.

717.06 Foreign Filing Dates

See 1302.06.

717.07 Related Applications

The file wrapper should identify earlier filed related applications. See 202.02.