

Chapter 1300 Allowance and Issue

- 1301 Substantially Allowable Case, Special
- 1302 Final Review and Preparation for Issue
- 1302.01 General Review of Disclosure
- 1302.01(a) Fee Exempt Application
- 1302.02 Requirement for a Rewritten Specification
- 1302.03 Status Letter of Allowability, POL-255
- 1302.04 Examiner's Amendments and Changes
- 1302.04(a) Title of Invention
- 1302.04(b) Cancellation of Non-Statutory Claim
- 1302.04(c) Cancellation of Claims to Non-Elected Invention
- 1302.04(d) Cancellation of Claims Lost in Interference
- 1302.04(e) Cancellation of Rejected Claims Following Appeal
- 1302.04(f) Data of Copending Application Referred to—Brought up to Date
- 1302.04(g) Identification of Claims
- 1302.05 Correction of Drawing
- 1302.06 Prior Foreign Application
- 1302.07 Use of Retention Label to Preserve Abandoned Companion Applications
- 1302.08 Interference Search
- 1302.09 Notations on File Wrapper
- 1302.10 Notations on Drawings and on Classification (Issue) Slip
- 1302.11 Reference to Assignment Branch
- 1302.12 Listing of References
- 1302.13 Signing
- 1303 Notice of Allowance
- 1303.01 Amendment Received after Allowance
- 1303.02 Undelivered
- 1303.03 Not Withheld Due to Death of Inventor
- 1304 Withholding From Issue of "Secrecy Order" Cases
- 1304.01 Amendments After D-10 Notice
- 1305 Jurisdiction
- 1306 Public Law 690 Cases
- 1307 Change in Classification of Cases Which are in Issue
- 1308 Withdrawal From Issue
- 1308.01 Rejection After Allowance
- 1308.02 For Interference Purposes
- 1309 Issue of Patent
- 1309.01 "Printer Waiting" Cases
- 1309.02 Protest Against Issue

1301 Substantially Allowable Case, Special

When an application is in condition for allowance, except as to matters of form, the case

will be considered special and prompt action taken to require correction of formal matters. See 710.02(b) paragraph (a).

1302 Final Review and Preparation for Issue

1302.01 General Review

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

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the Examiner should require the applicant to modify his brief summary of the invention and restrict his descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the Examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (Rule 71.) Of course enough background should be included to make the invention clearly understandable. See 608.01(d) and 608.01(e).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See 608.01(o).

Where a copending application is referred to in the specification, the Examiner should ascertain whether it has matured into a patent or become abandoned and that fact or the patent number added to the specification.

The claims should be renumbered as required by Rule 126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. See 608.01(j) and 608.01(n).

The abstract should be checked for an adequate and clear statement of the disclosure.

The title should also be checked. It should be as short and specific as possible. If a satisfactory title is not supplied by the applicant, the Examiner may change the title on or after allowance. See 606 and 606.01.

All pencil notes made by the Examiners must be erased when the case is passed to issue.

1302.01(a) Fee Exempt Application

See 607.01 for checking specification to assure presence of proper stipulation by applicant.

1302.02 Requirement for Rewritten Specification

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the Examiners should require the entire portion of specification affected to be rewritten before passing the case to issue. See Rule 125 in 608.01(q).

1302.03 Status Letter of Allowability, POL-255

This letter is used whenever an application under final rejection has been placed in condition for allowance as a result of a communication from or an interview with applicant.

The date of the communication or interview which resulted in the allowance and the name of the person with whom the interview, if any, was held should be included in the letter.

Immediately after determining that a POL 255 letter is necessary, the letter should be effected before preparing the application for allowance. See 714.13.

1302.04 Examiner's Amendments and Changes

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See Rule 121.)

Correction of the following obvious errors and omissions only may be made with pen by

the Examiner of the case who will then initial the sheet margin and assume full responsibility for the change. When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the Examiner is certain of the propriety of the change.
5. Entry of "now Patent No. ____" to identify a patent which has been granted on a U.S. application referred to by Serial No. in the specification.
6. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
7. Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

The fact that applicant is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Serial No. _____, filed _____" should appear as the first sentence after the abstract except in the case of design applications where it should appear as set forth in Sec. 1503.01. Any such statements appearing elsewhere in the specification should be relocated. (The clerk indicates the change for the printer in the appropriate margin and applicant is notified of the change by an Examiner's Amendment.)

Other obvious informalities in the application may be corrected by the Examiner, but such corrections must be in the form of an amendment, approved and signed by the Primary Examiner, placed in the file, and made a part of the record. A copy of the amendment is sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way.

The amendment or cancellation of claims by Examiner's Amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his representative) in a telephone or personal interview. The Examiner's Amendment should include a statement indicating that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was had.

A change in the abstract may be made by Examiner's Amendment.

No other changes may be made by any person in any record of this office without the written approval of the Commissioner of Patents.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. An Examiner's Amendment will be used to cite the references.

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

See also 608.02(w).

In reviewing the application all errors should be carefully noted. It is not a matter of importance whether the language is the best that could be chosen: it is, however, essential that it be clear in meaning, and free from errors in syntax. An Examiner's Amendment is usually made at the time a case is being prepared for issue by the Examiner. However, such amendment may also be necessary after the proof of the patent is read and the case is sent up to the Examiner with a "printer waiting" slip (Form PO-97). A copy of the amendment is sent to applicant even if the application is already in the printer's hands. Applicant cannot "authorize" an Examiner's Amendment to cancel certain claims in the event that others are allowed.

1302.04(a) Title of Invention

Where the title of the invention is not specific to the invention as claimed, see 606.01.

1302.04(b) Cancellation of Non-Statutory Claim

When a case is otherwise in condition for allowance the Examiner may cancel an obviously non-statutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an Examiner's Amendment. See 706.03(h).

1302.04(c) Cancellation of Claims to Non-Elected Invention

See 821.01 and 821.02.

1302.04(d) Cancellation of Claim Lost in Interference

See 1109.02.

1302.04(e) Cancellation of Rejected Claims Following Appeal

See 1214.06, 1215.03, and 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date

Where a patent application which is ready for issue refers by serial number to a U.S.

application which has matured into a patent, the Examiner is authorized to enter the patent number without an Examiner's Amendment. This entry should be in the following form: "now Patent No. _____." This entry is to be initialed in the margin by the Examiner to fix responsibility for the same. The entry and the initials should be in red ink. (Basis: Notice of May 19, 1952.)

If the application referred to has become abandoned, the entry "and now abandoned" should be made by a formal Examiner's Amendment. See 1309.01.

1302.04(g) Identification of Claims

In entering an Examiner's Amendment in a claim, the original number, as well as the number of the claim as it appears in the allowed application, should be referred to. (Basis: Notice of August 26, 1929.)

1302.05 Correction of Drawing

Where a case otherwise ready for issue requires correction of the drawing, the Examiner, before sending the file to the Draftsman, should attach thereto a slip indicating that the case is ready for allowance. Slight defects may be corrected on the Examiner's initiative as set forth in 608.02(w) and an Examiner's Amendment prepared as set forth in 1302.04.

In view of the relaxed requirements for certain fine details, the need to correct some slight defects may be obviated. See 608.02—"Waiving of Corrections."

1302.06 Prior Foreign Application

On passing to issue any application in which the requirements of 35 U.S.C. 119 are apparently complied with, the Examiner should check that the identification of the foreign case has been entered on the file wrapper. See 201.14(c).

If no foreign data is to be entered, "None" should be written in the spaces provided. This will be crossed out, if papers are subsequently filed. (Notice of January 23, 1964.)

1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications

Rule 14(b). Abandoned applications are likewise not open to public inspection, except that if an appli-

cation referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. 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.

Related applications referred to in patent specifications are preserved from destruction by a retention label (Form PO-150) which is attached to the outside of the file jacket. The Docket Clerk of the Division prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath of the application ready for allowance (or in any Office letter therein).

If the case referred to is

Still pending:

Fill in and paste label on the face of the pending file jacket so that no entry is obscured, preferably in the unused portion of the space provided for name and address of inventor. Make no change in specification of the allowable application.

Forfeited:

If file has been forwarded fill in label and send it to Abandoned Files for attachment to the jacket. If not forwarded treat the same as pending case. Make no change in specification of the allowable application.

Abandoned:

If file has been forwarded fill in label and send it to Abandoned Files for attachment to the jacket. If not forwarded treat the same as pending case. Make Examiner's Amendment, adding "now abandoned" in the allowable application.

Already patented:

No label is required. Insert patent number in specification if not already present. Examiner's Amendment not necessary if this is only change.

In issue:

No label is required.

(See Commissioner's Notice of May 19, 1952.)

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the Serial Number cited thereon. (Basis: Notice of August 1, 1952.)

1302.08 Interference Search

Assuming that the case is found ready for issue, the Examiner makes an "interference search" and notes the date and class and sub-

classes searched in the file wrapper. To do this, he inspects all the pending prints and drawings (or all the digests if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his division or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, he examines the corresponding file. See 1101.01(c).

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

1302.09 Notations on File Wrapper

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

In order to avoid misunderstanding on the part of the Printing Office or the Issue and Gazette Branch, examiners are urged to be especially careful to write the class and subclass on the outside of the file wrapper as legibly as possible. Each numeral should be carefully written to indicate its precise nature. The decimal point should be shown clearly and in its proper position. (Basis: Memorandum of July 6, 1952.)

Examiners will ordinarily designate but one claim on each invention to be published in the Official Gazette in connection with each original or reissued patent. The broadest claim should be selected. When a plurality of inventions are claimed in an application, additional claims to a maximum of five may be designated for publication. (Basis: Order 2422.)

Space is provided on the file wrapper for identifying data of the parent application. If the parent case of a division has issued as a patent, the patent number and date should be inserted. The notation "now abandoned" should *not* be entered on the file wrapper. Nor should the patent number and date of the parent case of a continuation-in-part.

See 202.02.

If the case is not a substitute or continuing case (of any kind), "None" should be written in ink by the Examiner in the spaces where data for the parent case would otherwise be entered. (Notice of January 23, 1964.)

1302.10 Notations on Drawings and on Classification (Issue) Slips

The class and subclass and the name of the Assistant Examiner which have been written in pencil in the upper lefthand corner of the drawing should not be erased. See 717.03.

On the margin of the first sheet of drawing, the Examiner indicates the figure which he selects for printing in the Official Gazette and also the final official classification of the case. Ordinarily a single figure is selected for printing. This figure should be consistent with the claim selected for the Official Gazette.

If the selected figure is not on the first sheet, the Examiner should indicate it also on the sheet where it does appear. If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written after "O.G. Fig." If, through inadvertence, the stamped legend for O.G. Fig. and class and subclass appears within the margin of the drawing, the Examiner, should make the notations *outside* of the margins.

The only date entered on the front of the drawings is the date of mailing of the Notice of Allowance, which is done by the Issue and Gazette Branch. Under current practice, the Clerk of the Examining Division does NOT enter any date when the case is "sent to issue". See 903.07 and 903.07(b) for notation to be applied to the Classification Slip (Form PO-270).

1302.11 Reference to Assignment Branch

The practice of referring certain applications to the Assignment Branch when passing them to issue is no longer followed since title searches are automatically made in all applications after payment of the issue fee.

1302.12 Listing of References

All references which have been cited during the prosecution, including those appearing in Board of Appeals decisions, and those submitted by applicant if they conform to the requirements set forth in 805 O.G. 294, will be printed in the patent. At the time of preparing the application for allowance these references are appropriately listed.

At time of allowance, the Examiner may cite pertinent art in an Examiner's Amendment. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case.

In the first action after termination of an interference, the Examiner should make of record in each application all references not already of record which were pertinent to any motions to

dissolve and which were discussed in the decision on motion.

Foreign patents are listed by the actual name of the country, as for example, "Great Britain" rather than "British" and "France" rather than "French".

German allowed applications (captioned "Patentanmeldung" or "Auslegeschrift") referred to in 901.05(b) should be listed under "OTHER REFERENCES" rather than "FOREIGN PATENTS". Care should be taken to include the letter or letters immediately preceding the number.

U.S. patents are listed in numerical order. Foreign patents are listed alphabetically by country and where there is more than one foreign patent from the same country these should be listed in numeral order. See 707.05(e) for citation of references.

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

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

In any case, otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the Examiner is directed to correct the citation in a separate letter on manifold POL-90.

Where an applicant in an amendatory paper or in a separate paper refers to a reference which is subsequently relied on by the Examiner, such reference shall be cited by the Examiner in the usual manner.

Any new reference cited when the case is in issue, under the practice of 1308.01, should be added to the list.

1302.13 Signing

After revision, the face of the file jacket is signed in the space designated "Primary Examiner" by the Primary Examiner or by the Examiner with full signatory authority who acted on the application. The signature should not appear in any other space on the file jacket.

The names of all examiners appearing in the Office actions are printed in the issued patent.

1303 Notice of Allowance

The appropriate form of notice of allowance is used and the mailing date appearing thereon

is stamped on the file wrapper by the Issue and Gazette Branch.

1303.01 Amendment Received After Allowance

If the amendment is filed under Rule 312, see 714.15 to 714.16(e). If the amendment contains claims copied from a patent, see 1101.02(g).

1303.02 Undelivered

In case a notice of allowance is returned, and a new notice is sent, as set forth in 707.13, the file is obtained from the Issue and Gazette Branch, and the date of sending the notice changed to agree with the date of such remailing.

1303.03 Not Withheld Due to Death of Inventor

The notice of allowance will not be withheld due to death of the inventor even though the executor or administrator has not intervened. See 409.01(f).

1304 Withholding From Issue of "Secrecy Order" Cases

"Secrecy Order" cases are not sent to issue even when all of the claims have been allowed. Instead of mailing an ordinary notice of allowance a D-10 Notice is sent. See 107.02.

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

1304.01 Amendments After D-10 Notice

For amendments received after D-10 Notice, see 107.02.

1305 Jurisdiction

Jurisdiction of the application remains with the Primary Examiner until the notice of allowance is mailed by the Issue and Gazette Branch. However, the Examiner may make Examiner's amendments correcting obvious errors, as, when brought to the attention of the Examiner by the printer, and also may 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. The Examiner's action on other amendments under Rule 312 consists of a recommendation to the Commissioner.

To regain jurisdiction over the case, the Examiner must write a letter to the Commissioner requesting it. See 1308 and 1308.02.

Once the patent has been granted, the Patent Office can take no action concerning it except as provided in 35 U.S.C. 135 and 35 U.S.C. 251 through 256. See chapter 14.

1306 Public Law 690 Cases

See 201.16.

1307 Change in Classification of Cases Which Are in Issue

See 903.07

1308 Withdrawal From Issue

Rule 313. Withdrawal from issue. After the notice of allowance of an application is sent, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed.

When the issue fee or that portion thereof specified in the notice of allowance has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue on account of any mistake or change of purpose of the applicant, his attorney or his agent, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. Express abandonment of the application (rule 138) may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

If the applicant wishes to have the case withdrawn from issue, he must petition the Commissioner. Withdrawal is permitted only for the reasons stated in the rule. For withdrawal procedure by Examiner see 1308.02.

When the Examiner removes the drawing from the drawing cabinet to prepare an application for issue, the print of the drawing must be taken from the application file and placed in the drawing cabinet to take the place of the original drawing. The print should remain in the drawing cabinet during the period the application is being revised for issue and until the hard copy of the patent is received in the group or the application becomes forfeited. The docket clerk should, of course, add any necessary notations on the print at the time the application is forwarded to the Issue and Gazette Branch.

This practice will insure that the drawing or a print of the drawing is available at all times in the drawing cabinet for interference searches. This is of particular importance in groups where there may be a backlog of applications awaiting revision for issue. (Basis: Notice of March 28, 1962.)

1308.01 Rejection After Allowance

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

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, and where a sufficient portion of the statutory period for payment of final fee remains, the Examiner is authorized to enter a letter informing applicant of the proposal of requesting withdrawal from issue for the purpose of rejecting the claim or claims as fully met by, or obviously unpatentable over, the new reference. The letter should apply the reference in detail and should also set a time limit (within such statutory period), within which applicant may respond by way of argument or amendment under Rule 312 to overcome the reference and avoid the necessity for withdrawal from issue. Such a letter, with the reference and file, should be submitted to the Group Supervisor before mailing. (Basis: Notice of March 15, 1950.)

If insufficient time remains to carry out the above, or if no response is received, or if a response is filed and it fails to overcome the reference, or if the above appears fruitless, a letter is addressed to the appropriate Director, requesting that the application be withdrawn

from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. This letter, with the reference and file, should be submitted to the Group Manager before it is transmitted. Upon approval of this request, the letter is taken to the Issue and Gazette Branch and the application is stamped "Withdrawn" over the allowance signature of the Primary Examiner. It is then returned to the group from which it came; the withdrawal from the issue is entered on the register, and the application is thus restored to its former status as a pending application awaiting action by the Examiner. The Examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The letter is given a paper number and placed in the file.

If the Examiner's proposed action is not approved, the letter requesting withdrawal from issue should not be placed in the file.

1308.02 For Interference Purposes

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed see 1101.01(o) and 1112.04.

1309 Issue of Patent

The files of allowed cases (not patented files) are kept in the Issue and Gazette Branch, arranged in the serial number order. When the final fee is paid within the time allowed by law, the file is given a patent number and date. The file then goes to the Assignment Branch for examination as to assignments after which it is sent to the Government Printing Office for printing of the specification. A bond paper copy of the drawing and specification is ribboned and sealed in the Issue and Gazette Branch and finally signed.

35 U.S.C. 153. How issued. Patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent Office designated by the Commissioner, and shall be recorded in the Patent Office.

In accordance with the Commissioner's Notice of July 2, 1952 (661 O.G. 13) various officials including the head of the Issue and

Gazette Branch have been designated as attesting officer to attest to the name of the Commissioner. The assistant head of the Issue and Gazette Branch acts as attesting officer in the absence or unavailability of the head of the branch.

1309.01 "Printer Waiting" Cases

After printing of the specification the proof is read by employees of the Government Printing Office. Where apparent error is found, the file with the proof is transmitted to the Examiner, attention being called on an attached "printer waiting" slip (Form PO-97) to the supposed errors.

All "printer waiting" cases must receive immediate attention and be returned to the Issue and Gazette Branch as soon as possible (preferably within three hours). (Basis: Notice of December 6, 1920.)

If the Examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by Examiners' amendment. See 1302.04.

If the required correction cannot be cured by Examiner's amendment, the application may have to be withdrawn from issue. This may sometimes be avoided if the attorney or his representative is in Washington. In such cases, he should be called in immediately, and the error may perhaps be corrected by amendment under Rule 312.

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

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

1309.02 Protest Against Issue

Rule 291. Protests to the grant of a patent. The patent statutes do not provide for opposition to the grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

When a protest is filed against the issuance of a patent the same shall, after consideration by the Examiner, be forwarded to the Supervisory Examiner and shall not be entered in the file of the application to which it refers. (Basis: Order 1805.)