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

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

#### THE APPLICATION

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

The parts of the application may be included in a single document, and an approved single-signature form may be used.

Determination of completeness of an application is covered in 506.

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

#### NOTE

Reissue patents, 1401.

Design patents, Chapter 1500.

Plant patents, Chapter 1600.

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

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

See, however, 604.04(a).

## 601 Petition

*Rule 61. Petition.* The petition must be addressed to the Commissioner of Patents and request the grant of a patent. The residence, and post office address of the petitioner must appear in the petition if not stated else-

where in the application. The petition need not be separately signed when part of and attached to the specification and oath, otherwise it must be signed by the petitioner.

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

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

The petition need not be dated.

### 601.01 Amendment of Petition

Those portions of the petition other than the post office address (see 605.03) may be amended by the attorney.

### 601.02 Power of Attorney or Authorization of Agent

The attorney's or agent's full post office address should be given in every power of attorney or authority of agent. The prompt delivery of communications will thereby be facilitated.

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

## 602 Original Oath (or Declaration)

*Rule 65. Statement of Applicant.* (a)(1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application, or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He shall state whether or not any application for patent on the same invention has been filed in any foreign country, either by the applicant or by his legal representatives or assigns. If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of

filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country.

(2) This statement (i) must be subscribed to by the applicant, and (ii) must either (a) be sworn to (or affirmed) as provided in Rule 66, or (b) include the personal declaration of the applicant as prescribed in Rule 68. See Rule 153 for design cases and Rule 162 for plant cases.

(b) If the application is made as provided in Rules 42, 43, or 47, the applicant shall state his relationship to the inventor and, upon information and belief, the facts which the inventor is required by this rule to state.

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

*Rule 68. Declaration in Lieu of Application Oath.*

(a) The applicant may, in lieu of making an oath or affirmation in the manner provided by Rule 66, set forth in the body of the statement required from him by Rule 65 his written declaration that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true, if, and only if, the applicant is, on the same paper, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

(b) A written declaration by the applicant satisfying the foregoing conditions may also be used in lieu of an oath when presenting a claim for matter not originally claimed (rule 67), when applying for a reissue patent (rules 171 and 172), when applying for a patent for a design (rules 151 and 153), when applying for a patent for a plant (rules 161 and 162), and when filing a statement concerning the making or conception of the invention as required by 42 U.S.C. 2162, or by 42 U.S.C. 2457(c).

Note that a Rule 68 Declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. When a Declaration is used, it is unnecessary to appear before any official in connection with the making of the Declaration. It must, however, since it is an integral part of the application, be maintained together therewith. Further details are given in 29 F.R. 18502; 811 O.G. 2. (Basis: Notice of March 4, 1965.)

By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent Office".

The filing of a written declaration is not acceptable in lieu of the authentication of an original application oath that is informal in that it lacks authentication by a diplomatic or consular officer of the United States. See 604.04(a).

Rule 65 has been amended with respect to the recitation of prior foreign applications. The applicant must state that no foreign applications have been filed, if such is the case. If all foreign applications have been filed within twelve months of the U.S. filing date, he is required only to recite the first such foreign application, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed more than twelve months prior to the U.S. filing. It is desirable to give the foreign serial number as well as the filing date of the first filed foreign application, especially if the inventor's name will not appear in a certified copy of said foreign application. It should be noted that an oath in the form proper before January 1, 1953 is still acceptable.

The single signature form mentioned in 605.04(a) includes the oath.

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

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

When joint inventors execute separate oaths, each oath should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that he does verily believe himself to be the original, first and joint inventor together with "A or A & B, etc." as the facts may be.

A seal is usually impressed. See 604 and Rule 66. However oaths executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina and Virginia need not be impressed with a seal.

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

### 602.01 Oath Cannot Be Amended

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

For example, if the oath does not set forth evidence that the notary was acting within his jurisdiction at the time he administered the

oath a certificate of the notary that the oath was taken within his jurisdiction will correct the deficiency. See 604.02.

### 602.02 New Oath or Substitute for Original

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

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

### 602.03 Defective Declaration or Oath, When Waived

In the first Office action the Examiner must point out every deficiency in a declaration or oath and require that the same be remedied. However, when an application is otherwise ready for issue, an Examiner with full signatory authority may waive the following minor deficiencies:

1. A delay of somewhat more than five weeks plus mailing time in filing after the time of making the declaration, or the time of execution in the case of an oath.
2. Residence of an applicant if a post office address is given.
3. Minor deficiencies in the execution of an oath.

If any of the above are waived, the Examiner should write in the margin of the declaration or oath a notation such as "Date of declaration waived; application ready for issue" and initial.

### 602.04 Foreign Oath

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

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

*Extract from Rule 66.* (b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed

with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Note that a Declaration in Lieu of Application Oath (Rule 68) need not be ribboned to the other papers. It must, however, be maintained together therewith.

### 602.05 Oath—Date of Execution

The time elapsed between the date of execution of oath and the filing date of the application should be checked for compliance with Rule 65(c). If an unreasonable time has elapsed, the Examiner should call for a new oath. What constitutes a reasonable time is a question of judgment to be determined by all the circumstances in the particular case. (Five weeks plus time of transmission in the mails was considered reasonable under the circumstances of *Ex parte Heinze*, 1919 C.D. 67; 265 O.G. 145). Note 602.05(a).

If no date of execution appears, applicant is required to file either a new oath or a certificate from the notary giving the actual date when the oath was taken.

### 602.05(a) Oath in Division and Continuation Cases

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

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

In a streamlined continuation application, the oath or declaration of the parent application can be used. Therefore, signing and execution of a new oath or declaration in the streamlined continuation is not required. See 201.07.

### 603 Supplemental Oath

*Rule 67. Supplemental oath for matter not originally claimed.* (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in

any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented in any foreign country prior to the date of his application in this country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath here required may be made on information and belief by an applicant other than inventor.

Rule 67 requires in the supplemental oath substantially all the data called for in Rule 65 for the original oath. As to the purpose to be served by the supplemental oath, the Examiner should bear in mind that it cannot be availed of to introduce new matter into an application.

### 603.01 Supplemental Oath Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 Fed. 158, many supplemental oaths covering the claims in the case have been filed after the case is allowed. Such oaths may be filed as a matter of right and when received they will be placed in the file by the Issue Branch, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under Rule 312, since they make no change in the wording of the papers on file. See 714.16.

### 604 Administration or Execution of Oath

*Extract From Rule 66. Officers authorized to administer oaths.* (a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the state or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by

a certificate from a clerk of a court of record or other proper officer having a seal.

Note: Seals, 604.01.  
When unnecessary, 604.01.  
In foreign case, 602.04(a).

### 604.01 Seal

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the Examiner should require proof of Authority. Depending on the jurisdiction, the "seal" may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

See also 602.04(a) on foreign executed oath and seal. In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina and Virginia.

### 604.02 Venue

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

### 604.03 Notaries and Extent of Jurisdiction

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

#### COUNTY ONLY

Louisiana  
Mississippi

Texas

#### VARIABLE JURISDICTION

(See explanatory paragraphs below)

Alabama (a)	Missouri (e)
Florida (b)	Nebraska (a)
Hawaii (c)	Ohio (f)
Iowa (d)	Tennessee (g)
Kansas (e)	Virginia (h)
Kentucky (d)	West Virginia (d)

#### STATEWIDE

All other states

(a) Alabama and Nebraska notaries are appointed for counties and for state at large.

(b) Florida notary commissions are customarily for state at large but may be restricted by commission to less than the state at large.

(c) In Hawaii it is generally limited to the judicial circuit.

(d) In Iowa, Kentucky and West Virginia it is limited to county for which appointed, but notary in any county may qualify and act as notary in any other county.

(e) The jurisdiction of Kansas and Missouri notaries is coextensive with county of appointment and adjoining counties.

(f) In Ohio, notaries other than attorneys are appointed by the Governor for a term of 5 years and have power to act only in county for which appointed. An attorney or any person certified by a judge of the court of common pleas of the county in which he resides as qualified for the duties of official stenographic reporter of such state, may, however be commissioned for the entire state. The extent of jurisdiction is stated near the notary's signature.

(g) Tennessee notary publics commissioned in one county may file in county court of any other county and thereupon may exercise the function of his office in such other county. In such cases, however, notary must attach to his certificate a statement that he is qualified in the county in which he acts. Notaries at large are commissioned by the Secretary of the State. Notary's signature must indicate that he is so qualified. Special seal is prescribed by the Secretary of State.

(h) In Virginia, notaries are limited to city or county for which appointed except that notary for city may act in county or city contiguous thereto, and a notary for a county may act in city contiguous thereto. Notaries may be appointed for two or more counties and cities or for the state at large.

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

### 604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

- (1) All judge advocates of the Army and Air Force;
- (2) All law specialists;
- (3) All summary courts-martial;
- (4) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;
- (5) All commanding officers of the Navy and Coast Guard;
- (6) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and
- (7) All other persons designated by regulations of the armed forces or by statute.

(d) The signature without seal of any such person acting as notary, together with the title of his office, shall be prima facie evidence of his authority.

### 604.04 Consul

When the oath is made in a foreign country, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. Rule 66, 604. This proof may be through an intermediary; e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

### 604.04(a) Consul-Omission of Certificate

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer of the United States and whose authority is not authenticated, the application is nevertheless given a filing date for purposes of examination. The examiner, in his first

Office action, should note this informality and require authentication of the oath by an appropriate diplomatic or consular officer. The following language is suggested in requiring authentication of an oath:

"The oath is informal in that it lacks authentication by a diplomatic or consular officer of the United States; Rule 66(a). This informality can be overcome only by forwarding the original oath to the appropriate officer for authentication if applicant wishes to preserve his original filing date. Applicant should therefore request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. See section 604.04(a), MPEP. After the oath has been authenticated, it should be returned promptly to the Patent Office."

At the time of the next Office action the request for return of the oath, together with the application file and the copy of the oath, is submitted through the Group Manager to the Director of the Patent Examining Operation. If the request is approved by him, the oath will be returned by the examining division.

The filing of a declaration by the applicant in lieu of an authentication of the original oath cannot be accepted since the authentication is essential to preserve the original filing date.

### 604.05 Consular Fee Stamp

All papers executed on or after June 28, 1955, that formerly required the consular fee stamp, are acceptable without such stamp.

### 604.05(a) Omission of Consular Fee Stamp

In applications executed abroad prior to June 28, 1955 before a consular officer and in which a consular fee stamp is required but from which the required stamp is lacking, the Examiner should not require a consular fee stamp to be furnished. The applicant should be informed that the oath or authentication, as the case may be, does not carry the required consular fee stamp and that the applicant should obtain a statement from the consular officer that a fee stamp had been affixed when the paper was executed.

### 604.06 By Attorney in Case

The language of Rule 66 and 35 U.S.C. 115 is such that an attorney in the case is no longer barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his authority and jurisdiction and will not know-

ingly jeopardize his client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case and hence the old bar still applies in the case of oaths administered in the District of Columbia. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action for the Office to take is to strike the application since there is in effect no proper application before the Office and the Examiner will refer the file to the Solicitor's Office to initiate such action. (Riegger v. Beierl, 1910 C.D. 12; 150 O.G. 826.) See Rule 66 and 604.

## 605 Applicant

*Rule 41. Applicant for patent.* A patent must be applied for and the application papers must be signed and the necessary oath executed by the actual inventor in all cases, except as provided by rules 42, 43, and 47. See rule 147.

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

*Extract from Rule 45. Joint inventors.* (a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in rule 47.

For convertibility from a joint to sole or sole to joint application, see 201.03.

*Rule 46. Assigned inventions and patents.* In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made by the inventor or one of the persons mentioned in rules 42, 43, or 47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in rule 334.

This section concerns filing by the actual inventor. If filed by other, see 409.03.

### NOTE

Streamlined continuation application, 201.07.  
Disposition of application by inventor, 301.  
Inventor dead or insane, 409.

## 605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant to state his citizenship. Where an

applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement; but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

## 605.02 Applicant's Residence

Applicant's place of residence (not to be confused with his Post Office address) can be furnished by the attorney. In the case of an applicant who is in the U.S. Army or U.S. Navy, a statement to that effect is sufficient as to residence. For change of residence see 717.02(b).

## 605.03 Applicant's Post Office Address

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

The object of requiring applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instructions to send communications to applicant in care of the attorney is not sufficient.

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

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

## 605.04 Applicant's Signature and Name

*Rule 57. Signature.* The application must be signed by the applicant in person. The signature of the oath will be accepted as the signature to the application provided the oath is attached to and refers to the petition, specification and claim to which it applies. Full names must be given, including the full first name without abbreviation, and the middle initial or name if any.

*Rule 76. Signature to the specification.* When the oath is attached to and refers to the petition, specification and claim to which it applies, the specification need not be signed. Otherwise it must be signed by the applicant in person.



The signing and execution by the applicant of certain Divisional and Streamlined Continuation applications may be omitted. Rule 147, Sections 201.06, and 201.07.

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

### 605.04(a) Single Signature Form

The single signature form should be executed only when attached to a complete application as the last page thereof. Such a form is shown as No. 16 in the List of Forms in the Rules of Practice booklet.

### 605.04(b) Full First Name Required

All applications which disclose the full first and last names with middle initial or name, if any, of the applicant at any place in the application papers will be received and considered as a sufficient compliance with Rules 57 and 76 of the Rules of Practice.

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

No affidavit should be required.

The requirement should be made only when for the first name in the signature a mere initial appears or what can be only an abbreviation of a name.

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

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

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

If applicant, in reply, gives the name without the middle name or initial unaccompanied by any instructions to amend the typewritten name, the reply may be interpreted as a direction to cancel the middle name or initial from the preamble; though such amendment is not material, since the preamble is no longer printed in the patent. It is necessary how-

ever, that such surplus portion of the name, if it appears printed on the drawing, should be removed therefrom. This can be done by the Office draftsman.

If applicant gives the name with the middle name or initial, interpret the reply as a direction that the middle name or initial is to be used in the name on the printed patent. As the printer takes the name from the face of the file wrapper, the middle name or initial should be added thereto in red ink.

If applicant fails to answer the request and the case is otherwise ready for issue, prepare an Examiner's Amendment indicating that the name on the drawing has been corrected to correspond with the signature or signatures, have the Draftsman correct the drawing, and pass the case to issue. This cannot be done if there are inconsistencies in the signatures.

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

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

### 605.04(c) Applicant Changes Name

In cases where an applicant's name has been changed after his application has been filed and the applicant desires that the patent when issued carry an endorsement as to the change in his name, he must submit a recording fee accompanied by either an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the Court order. Such papers are recorded by the Assignment Branch where the new name is added on the file wrapper. The Assignment Branch forwards the file to the Application Branch for a change in their records.

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

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

**605.04(d) Applicant Unable to Write**

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

**605.04(e) May Use Title With Signature**

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

**605.04(f) Signature on Joint Applications—Order of Names**

It is not essential that the names appear in the same order in the signatures to the petition, specification, oath, and drawing.

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath accompanying the application papers. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except for good reasons and by permission of the Commissioner. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath.

In those instances where the joint applicants file separate oaths, the order of names is taken from the order in which the several oaths appear in the application papers unless a different order is requested at the time of filing.

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

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

**605.04(h) Signature to Drawing**

*Rule 82. Signature to drawing.* Signatures are not required on the drawing if it accompanies and is referred to in the other papers of the application, otherwise the drawing must be signed. The drawing may be signed by the applicant in person or have the name

of the applicant placed thereon followed by the signature of the attorney or agent as such.

*Extract from Rule 84, Drawings.* (h) *Location of signature and names.* The signature of the applicant, or the name of the applicant and signature of the attorney or agent, may be placed in the lower right-hand corner of each sheet within the marginal line, or may be placed below the lower marginal line.

The signature when placed on the drawing should never cross the marginal line. The signature on the drawing must not be inconsistent with the other signatures and typed names in the application. Moreover, it cannot include a middle name if the other signatures include only a middle initial consistent therewith. It can, however, include initials for the first and middle names. Drawings filed without the inventor's name thereon, will have the name applied in pencil by the Mail Branch.

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

The drawing may be signed by the applicant, attorney, or agent in person after the drawing has been filed. The signature need not be dated. Prohibition against changing name of the attorney on drawing is discussed at 608.02(u). For return of drawing to applicant for signature see 608.02(y).

The name or signature of the inventor must be identified as such by an appropriate legend. Each sheet must be signed when the signature is necessary. The printed name of the inventor without a signature is also acceptable and may appear, if desired, only on the first sheet.

**605.05 Administrator, Executor, or Other Legal Representative**

In an application filed by a legal representative of the inventor, the specification should not be written in the first person. Instead of the usual "I have found," the wording should be "it was found."

For prosecution by administrator or executor, see 409.01(a).

For prosecution by heirs, see 409.01(a) and 409.01(d).

For prosecution by representative of legally incapacitated inventor, see 409.02.

For prosecution by other than inventor, see 409.03.

**605.05(a) Signature of Legal Representative**

If the drawing is signed by the legal representative it must follow this form:

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

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

Mary A. Jones  
Administratrix of Estate of  
John A. Jones, deceased.  
If the drawing is signed by the attorney, this form must be used:  
John A. Jones, deceased,  
by Mary A. Jones, Administratrix,  
by William A. Smith, Atty.

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

**605.06 Filing by Other Than Inventor**

See 409.03.

**606 Title of Invention**

Rule 72(a). The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

**606.01 Examiner May Require Change in Title**

Where the title is not descriptive of the invention claimed, the Examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the Examiner may change the title by Examiner's Amendment on or after allowance.

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

However, if an Examiner's Amendment must be prepared for other reasons any change in title will be incorporated therein.

**607 Filing Fee**

Applications filed before October 25, 1965, required only a basic filing fee. That part of the new Fee Act, effective October 25, 1965, pertaining to claims presented after an application is filed, does not apply to these applications. See 714.10.

Applications filed on or after October 25, 1965, are subject to the following fees and practices:

When filing an application, a basic fee of \$65 entitles applicant to present (10) claims including not more than (1) in independent form. If claims in excess of the above are included at the time of filing, an additional fee of \$10 is required for each independent claim in excess of one, and a \$2 fee for each claim in excess of ten (10) claims (whether independent or dependent).

Upon submission of an amendment (whether entered or not) affecting the claims, payment of the following additional fees is required in a pending application:

- \$10--for each independent claim pending in excess of the number of independent claims already paid for.
- \$2--for each claim pending in excess of the total number already paid for. (It should be recognized that the basic \$65 fee pays for ten (10) claims, one of which may be independent, regardless of the number actually filed.)

Amendments before the first action, or not filed in response to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive thereto and the practice set forth in section 714.03 will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim, and the replacement of a claim by a claim of the same type do not require any additional fees.

For purposes of determining the fee due the Patent Office, a claim will be treated as dependent if it contains reference to one other claim in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact is not, as for

example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, non-elected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the Examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

### 607.01 Fee Exempt

There were two types of Fee Exempt applications: (a) those filed under 35 U.S.C. 266, repealed as of October 25, 1965 and (b) those filed under a ruling of the Comptroller General's Opinion B-111,648 also abrogated as of the same date:

#### FILED UNDER 35 U.S.C. 266

*35 U.S.C. 266. Issue of patents without fees to Government employees. The Commissioner may grant,*

subject to the provisions of this title, to any officer, enlisted man, or employee of the Government, except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent. (Based on Act Mar. 3, 1883, amended Apr. 30, 1928. Repealed October 25, 1965.)

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

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

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

If the substance of this statement is not present at any point in the record of the application, an action should be made requiring such statement, signed by the applicant, and an amendment directing insertion of same as the

first paragraph of the specification. A shortened statutory period for response should be set and the application withheld from issue until such response has been made.

#### FILED UNDER COMPTROLLER GENERAL'S OPINION

The Comptroller General ruled (Comptroller General's Opinions B-111,648 and B-117,353) that fees need not be paid in applications filed by one not a Government employee.

(1) Where there is an assignment of all right, title and interest in the invention and application to the Government or a Government agency; or

(2) Where the invention and application are the result of research sponsored and financed by the Government under contract or agreement requiring that the results thereof be made available to the public, and the application contains a clause dedicating the invention and patent to be granted to the free use of the people in the territory of the United States.

Beginning October 25, 1965, there are no longer any applications which are exempt from the filing fee or the issue fee. Applications filed before this date without the filing fee under the provisions previously in effect are subject to payment of the issue fee if the notice of allowance is dated on or after October 25, 1965.

The following two sections (607.01a, 607.01b) are applicable only to old cases.

#### 607.01(a) Inventor Leaves Service of United States

An opinion of the Attorney General, dated January 14, 1936, rules that an application filed under the Act of 1883, as amended, now 35 U.S.C. 266, which meets the requirements of this statute as to the status of the inventor at the time of filing, is sufficient warrant for the issuance of a patent to the inventor if the invention claimed therein is found patentable, whether or not he is in the service of the United States at the time the patent issues.

#### 607.01(b) Fee Exempt Changed to Fee Filed

Where an application was filed under 35 U.S.C. 266, the regular filing fee can be subsequently paid and proper amendment made by the inventor, concurred in by the Head of the Department concerned, cancelling the offer of dedication, the fee being entered on the file and the original date of the application retained.

#### 607.02 Returnability of Fees

All questions pertaining to the return of fees are referred to the Refund Unit of the Finance Branch of the Budget and Finance Division. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases.

#### 608 Disclosure

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

#### 608.01 Specification

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

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

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

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be cancelled. Rule 78, 202.01.

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

(b) The specification and claims, and also papers subsequently filed, must be plainly written on but one side of the paper. A wide margin must be reserved on the left-hand side and on the top of each page and the lines must not be crowded too closely together. Legal paper, 8 to 8½ by 12½ to 18 inches, typewritten and double spaced with margins of one and one-half inches on the left-hand side and top is deemed preferable. Typewritten or printed papers suitable for use by the Office may be required if the papers originally filed are not correctly, legibly and clearly written.

(c) Any interlineation, erasure or cancellation or other alteration made before the application was signed and sworn to should be clearly referred to in a marginal note or footnote on the same sheet of paper, and initialed or signed and dated by the applicant to indicate such fact. (See Rule 56.)

In order that specifications may be expeditiously handled by the Office, page numbers should be placed at the center of the bottom of each page. It is a common practice and a commendable one, to consecutively number all the lines of each page (and the lines of each claim). A top margin of at least 1½ inches should be reserved on each page to prevent possible mutilation of text when the papers are punched for insertion in a file jacket.

Typed, mimeographed, xeroprinted, multi-graphed or good carbon copy forms of reproduction are acceptable provided the paper used has a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy. Rule 52(a). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant that it will be necessary for him to order a copy of the specification and claims to be made by the Patent Office at his expense for incorporation in the file. It is *not* necessary to return this copy to applicant for signature.

See in re Benson, 1959 C.D. 5; 744 O.G. 353. Reproductions prepared by heat-sensitive, hectographic or spirit duplication processes are also not satisfactory.

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

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

The requirement that the specification must be in the English language is not satisfied by the filing of a signed specification in a foreign

language together with a sworn translation thereof. In re Incomplete Application 659 O.G. 917.

The specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See 702.01.

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

Rule 52(c) relating to interlineations and other alterations is strictly enforced. See in re Swanberg, 129 U.S.P.Q. 364.

### 608.01(a) Arrangement of Application

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

- (a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.
- (b) Abstract of the disclosure.
- (c) Cross-references to related applications, if any.
- (d) Brief summary of the invention.
- (e) Brief description of the several views of the drawing, if there are drawings.
- (f) Detailed description.
- (g) Claim or claims.
- (h) Signature. (See rule 76.)

#### NOTE

Design patent specification, 1503.01.  
Plant patent specification, 1601.5.  
Reissue patent specification, 1401.06.

The following order of arrangement is preferable in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated.

- (a) Title of the Invention.
- (b) Abstract of the Disclosure.
- (c) Cross-References to Related Applications (if any).
- (d) Background of the Invention.
  1. Field of the Invention.
  2. Description of the Prior Art.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).

**608.01(b) Abstract of the Disclosure**

**Rule 78(b).** A brief abstract of the technical disclosure in the specification must be set forth immediately following the title and preceding the disclosure in a separate paragraph under the heading "Abstract of the Disclosure". The purpose of the abstract is to enable the Patent Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure, and the abstract shall not be used for interpreting the scope of the claims.

The submission of an "Abstract of the Disclosure" as part of the patent application is required of each patent application received in the Patent Office on or after January 1, 1967. An abstract is also required in all patent applications already on file which have not received a first Office action of any kind from the Examiner by November 1, 1968, except those passed to issue on the first action.

The Examiner in the first Office action should require the submission of a brief abstract of the technical disclosure in the specification, the abstract to appear immediately after the title of the invention and preceding the disclosure in a separate paragraph under the heading "Abstract of the Disclosure."

Responses to such actions should be treated under Rule 111(b) practice like any other formal matter.

Upon passing the case to issue, the Examiner should see that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines in the following paragraphs; the abstract shall be changed by the Examiner's Amendment in those instances where deemed necessary.

1. The purpose of the abstract is to provide a nonlegal technical statement of the contents of the disclosure. The abstract should be an objective condensation (rather than a description) of the disclosure, in clear and concise language. Statements as to the relative merits or value, or speculative applications of the invention should be omitted.

2. The abstract should be especially designed to serve as a searching-scanning tool for the scientist, engineer or researcher in the particular art, and therefore should serve to indicate whether there is a need for consulting the full specification for details.

3. The abstract should be as brief as the subject permits. A single paragraph of 50-100 words should be sufficient.

4. Especially in the chemical field, the abstract should include a statement of the utility of the subject matter of the disclosure, particularly that which is related to the invention.

5. The abstract should be separate and independent of the "Summary of the Invention." One of the purposes of the abstract is to determine quickly the nature and gist of the technical disclosure.

**608.01(c) Background of the Invention**

The Background of the Invention ordinarily comprises two parts:

(1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) **Description of the Prior Art:** A paragraph(s) describing to the extent practical the state of the prior art known to the applicant, including references to specific prior art where appropriate. Where applicable, the problems involved in the prior art, which are solved by the applicant's invention, should be indicated. See also 60801(a).

**608.01(d) Brief Summary of Invention**

**Rule 78. Summary of the invention.** A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

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

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the patent

in future searches. See 905.04. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under Rule 73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, 1302.

### 608.01(e) Reservation Clauses Not Permitted

*Rule 79. Reservation clauses not permitted.* A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

### 608.01(f) Brief Description of Drawings

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

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

### 608.01(g) Detailed Description of Invention

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by Rule 71, 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the Examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter

case, the reference character, applied to the "given part," with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See Rule 75 in 608.01(i), 608.01(o), and 1302.01.

*NOTE.*—Completeness 608.01(p).

### 608.01(h) Mode of Operation of Invention

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

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

*NOTE.*—Completeness 608.01(p).

### 608.01(i) Claims

*Rule 75. Claim(s).* (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

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

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

(d) (1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

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

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

#### NOTE

Numbering of Claims, 608.01(j).  
Form of Claims, 608.01(m).



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

### 608.01(j) Numbering of Claims

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

In a single claim case, the claim is not numbered.

### 608.01(k) Statutory Requirement of Claims

Sec. 35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he regards as his invention. The portion of the application in which he does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

### 608.01(l) Original Claims

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

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

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

### 608.01(m) Form of Claims

While there is no set statutory form for claims, the present Office practice is to insist

that each claim must be the object of a sentence starting with "I (or we) claim" whether or not the words "I (or we) claim" are stated. The claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claim except for abbreviations. Reference numerals may appear in a claim. See 706.03(d). A claim may be typed with the various elements subdivided in paragraph form.

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in Rule 75(e) is particularly adapted for the description of improvement type inventions. It is to be considered a combination claim.

The preamble is to be considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

See Rejections not based on Prior Art 706.03.

### 608.01(n) Dependent Claims

Rule 75(c), reads as follows:

When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

For applications filed on or after October 26, 1965, the initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. Such acceptance does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but which is so worded that it, in fact is not, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

An essential characteristic of a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. Thus, for example, if claim 1 recites the combination of elements *a*, *b*, *c* and *d*, a claim reciting the structure of claim 1 in which *d* was omitted or replaced by *e* would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

The fact that a dependent claim which is otherwise proper might require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways. Note, that since Rule 75(c) requires the dependent claim to "further restrict" the preceding claim, this Rule does not apply to product-by-process claims.

#### CLAIM FORM AND ARRANGEMENT

A dependent claim 2 could read as follows:

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

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

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

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

However, a series of dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

No dependent claim should be separated from its base claim by (1) an independent claim or (2) another claim dependent on a different base claim. A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent" claim. It should be kept in mind that a dependent claim may refer back to *any* preceding independent claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant's sequence should not be changed. See 608.01(j).

#### REJECTION AND OBJECTION

If the base claim has been cancelled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be *objected to* rather than rejected, if it is otherwise allowable.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim *and* what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

Dependent claims should be carefully checked when claims are renumbered (Rule 126).

#### 608.01(o) Basis for Claim Terminology in Description

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

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

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, yet whenever by amendment of his claims, he departs therefrom, he should make appropriate amendment of his specification so as to have therein clear support or antecedent basis for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. *Ex parte Kotler* 1901 C.D. 62; 95 O.G. 2684. See Rule 75, 608.01(i) and 1302.01.

### 608.01(p) Completeness

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

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

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques where necessary, as to enable those persons skilled in the art to make and utilize the invention.

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

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

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications. If the starting material is old

but difficult to locate in the literature, the literature citation should be incorporated into the specification. This may be done by amendment. In the application as filed, preparation of a new chemical starting material may be described generally along with reference to a concurrently or previously filed application by the same inventor wherein the detailed preparation is given. If a concurrently or previously filed application of the same inventor adequately discloses the preparation of the starting material, amendments to include reference to such application by serial number and a general method of preparation are proper.

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

All essential claimed features of an invention must be fully disclosed in the application without depending upon a reference to a copending application nor to a foreign patent for completing the disclosure.

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

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

### 608.01(q) Substitute or Rewritten Specification

*Rule 125. Substitute specification.* If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the examiner.

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

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

New matter in amendment, see 608.04.

Application prepared for issue, see 1302.02.

### 608.01(r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his invention, but he is not permitted to make

derogatory remarks concerning the inventions of others.

### 608.01(s) Restoration of Canceled Matter

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

### 608.01(t) Use in Subsequent Application

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

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

### 608.01(u) Use of Formerly Filed Incomplete Application

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

### 608.01(v) Trademarks and Names Used in Trade

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

*Trademark*: a word, letter, symbol or device adopted by one manufacturer or merchant and used to identify and distinguish his product from those of others. It is a proprietary word pointing distinctly to the product of one producer.

*Names Used in Trade*: a nonproprietary name by which an article or product is known

and called among traders or workers in the art, although it may not be so known by the public generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

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

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

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

### TRADEMARKS

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

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

Where the identification of a trademark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter. (Basis: Notice of November 18, 1947 and Notice of January 23, 1964.)

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the Examiner should hold the disclosure

insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. The Examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type"; i.e., "Band-Aid type bandage."

### PARTIAL LIST OF TRADEMARKS

NOTE: Any question as to whether or not an apparent trademark is in fact a registered trademark or not should be referred to the Trademark Classification and Search Division (Ext. 5165) for determination. If a registered mark, it should be capitalized.

Acoustical Labyrinth  
Adrenalin  
Aerosol (wetting agents)  
Alemite  
Alpha (Protein)  
Al Si Mag  
Alumel  
Alundum  
Ameripol  
Anchor (fence)  
Aquadag  
Areskap  
Aresket  
Aresklene  
Atraumatic

Bactratycin  
Bakelite  
Band-Aid  
Bathinette  
Benzedrine

**Bitumastic**  
**Black Leaf 40**  
**Blus Rock (clay target)**  
**Bobbie (bobby pin)**  
**Calgon**  
**Calrod**  
**Camoquin**  
**Carbitol**  
**Carbofrax**  
**Carborundum**  
**Catalin**  
**Caterpillar (tread)**  
**Celanese**  
**Celastic**  
**Cellosolve**  
**Cellucotton (surgical dressing)**  
**Celluloid (plastics)**  
**Celotex**  
**Chevron (machinery packing)**  
**Chlorex**  
**Chloromycetin**  
**Chromax**  
**Chromel (alloy)**  
**Coca-Cola**  
**Coke (beverage)**  
**Corex**  
**Cumar**  
**Cyclone (fence)**  
  
**Dacron**  
**Danforth (anchor)**  
**Decalin**  
**Deepfreeze (home freezer)**  
**De-Ion**  
**Di-Phenolic Acid**  
**Dry Ice**  
**Dual-Seal**  
**Dulux**  
**Duraloy**  
**Duraplex**  
  
**Eidophor**  
**Electro-Silicon**  
**Elon**  
**Emulphor**  
**Erector**  
  
**Fascinator**  
**Fathometer**  
**Fiberglas**  
**Filtrol**  
**Flexowriter**  
**Foamite**  
**Formica**  
**Freon**  
  
**Gantrisin**  
**Geon**  
**Glyptal**  
**Go Kart**

**Gyropilot**  
**Gyrosyn**  
  
**Halanca**  
**Hercolyn**  
**Hiperall**  
**Hovercraft**  
**Humatin**  
**Hydrafrac**  
**Hydrosal**  
**Hyex**  
  
**Igepon**  
**Invar**  
**Intertype (typesetting)**  
**Iron-Clad (Gloves)**  
**Ironclad (Batteries)**  
  
**Jeep**  
**Jet Line**  
  
**Kaltron**  
**Kodak**  
**Kodapak**  
**Koroseal**  
**Kovar**  
  
**Laminac**  
**Lastex**  
**Lavite**  
**Leatherette**  
**Lexide**  
**Link (trainer)**  
**Linotype**  
**Liquid Lead (ink)**  
**Lucite**  
**Lux**  
  
**Masonite**  
**Methocel**  
**Micarta**  
**Microballoon(s)**  
**Modutrol**  
**Monel**  
**Monotype**  
**Mycalex**  
**Mylar**  
  
**N.D.G.A.**  
**Nekal**  
**Neon (signs)**  
**Nichrome**  
**Nico-fume**  
**Ni-Resist**  
**Nitralloy**  
**Nonex**  
  
**Oilgear**  
**Orlon**  
  
**Paraplex**  
**Perbunan**  
**Perf-a-tape**

Permutit  
 Phosphor bronze  
 Photostat  
 Photronic  
 Phytin (pharmaceutical product)  
 Ping-pong  
 Pitocin  
 Plastacele  
 Plexiglas  
 Pliofilm  
 Pliolite  
 Pliowax  
 Polane  
 Polaroid  
 Polyfoam  
 Polymerin  
 Polynosic  
 Porocel  
 Primacord  
 Priscoline  
 Push-Back (theatre chairs)  
 Pyralin  
 Pyrex

RAM (Random Access Memory)  
 Refinite  
 Resinox  
 Revertex  
 Ripple (sole)  
 Rocklath (plaster-board)  
 Rockwell (tester)  
 Roquefort

Santomerse  
 Scintillometer  
 Scotch (pressure sensitive tape. etc.)  
 Shakeproof  
 Sheetrock  
 Snap-on  
 Solvesso  
 Sonar  
 Speed-Nut (fastener)  
 Steel-Flex  
 Stellite  
 Steri-Pad (surgical dressing)  
 Stiflex  
 Storm Choke  
 Straddle Truck  
 Styrofoam  
 Sylphon  
 Sylphrap  
 Synchronotester  
 Synpor  
 Syntron

Tagalong  
 Talon (fastener)  
 Technicolor  
 Teflon  
 Teletype

Teletypesetter  
 Tendency  
 Textolite  
 Thenfadil  
 Thermit  
 Thermos (vacuum bottle)  
 Thiokol  
 Transite  
 Triton  
 Trombone (sprayer)  
 Uformite  
 Urotropin  
 Vacuumatic  
 Varsol  
 Vaseline  
 Verichrome  
 Victrola  
 Vinylite  
 Vistac  
 Vistanex (-Medium)  
 Votator  
 Vultex  
 Vycor  
 Zip  
 Zipper (heels)

## 608.02 Drawing

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

*Rule 86. Draftsman to make drawings.* (a) Applicants are advised to employ competent draftsmen to make their drawings.

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

### NOTE

Standards for drawings, Rule 84.

A booklet "Guide for Patent Draftsmen" is available from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402, price 20 cents.

Design patent drawings, Rule 152, 1503.02.  
 Plant patent drawings, Rule 165.

Reissue application drawings, 608.02(k).

Each sheet of drawing must bear the "Approved" stamp of the Draftsman before the application is allowed.

The Patent Copy Sales Branch, Reproduction Section has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the abandoned files and drawings in the Abandoned Files Unit.

See: Correction of drawings, 608.02(p). Prints, preparation and distribution, 508, 608.02(m). Prints, Return of drawing, 608.02(y). Signature to the drawing is treated in 605.04(h). For pencil notations of classification and name or initials of assistant examiner to be placed on drawings see 717.03.

The filing of a divisional case under the provisions of the second sentence of Rule 147 (unexecuted case), does not obviate the need for formal Bristol board drawings. Ordinarily, prints of the original formal drawings will suffice for examination. See 608.02(b).

#### APPLICATIONS FILED WITHOUT DRAWINGS

Applications filed without drawing are initially inspected to determine whether or not a drawing, under the statute, is necessary before the applicant can be given a filing date. Doubtful cases are referred to the Office of the Director for decision as to the need for such a drawing. It has long been the practice to accept a process case (that is, a case having only process or method claims) which is filed without a drawing. The same practice has been followed in composition cases. Other situations where drawings are usually not considered essential for a filing date are:

*I. Coated articles or products.* Where the invention resides solely in coating or impregnating a conventional sheet, e.g., paper or cloth, or an article of known and conventional character with a particular composition, the application containing claims to the coated or impregnated sheet or article, unless significant details of structure or arrangement are involved in the article claims.

*II. Articles made from a particular material or composition.* Where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims.

*III. Laminated structures.* Where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims.

*IV. Articles, apparatus or systems where sole distinguishing feature is presence of a particular material.* Where the invention resides solely in the use of a particular material in an

otherwise old article, apparatus or system recited broadly in the claims, for example

- a. Hydraulic system distinguished solely by the use therein of a particular hydraulic fluid.
- b. Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular fluid.

#### ILLUSTRATION SUBSEQUENTLY REQUIRED

The acceptance of an application without a drawing does not preclude the Examiner from requiring an illustration in the form of a drawing under the second sentence of Rule 81. In requiring such a drawing, the Examiner should clearly indicate that the requirement is made under the second sentence of Rule 81, and be careful not to state that he is doing so "because the nature of the case admits" of a drawing, as that might give rise to an erroneous impression as to the completeness of the application when filed. While such a requirement should ordinarily not be made unless patentable subject matter has been found, the examiner may require applicant to submit a sketch of the proposed addition, together with an authorization for its entry, with the next response even though a claim has not been allowed. This will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See Rule 118. The description should of course be amended to contain reference to the new illustration. This may obviate further correspondence where an amendment places the case in condition for allowance, except for the formal requirement relating to the drawing. In the event of a final determination that there is nothing patentable in the case, the sketch and authorization for entry will not be forwarded to the Drafting Branch.

#### PHOTOGRAPHS

Clearly, photographs are not drawings. Photographs are not acceptable for a filing date nor for any purpose except as exhibits unless they come within the special categories set forth in the Notice referred to below. Photolithographs of photographs and photographs mounted on proper size Bristol board are never acceptable. See *In re Taggart et al.*, 1957 C.D. 6; 725 O.G. 397 and *In re Myers*, 1959 C.D. 2; 738 O.G. 947.

#### SPECIAL CATEGORIES

The Patent Office is willing to accept black and white photographs or photomicrographs (not photolithographs or other reproductions of photographs) printed on sensitized paper in lieu of India ink drawings, to illustrate inven-



tions which are incapable of being accurately or adequately depicted by India ink drawings, restricted to the following categories: crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the Rules concerning drawings.

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth; tint, white.

If the drawings are informal, but may be admitted for examination purposes the Draftsman writes or stamps in the margin "Inf. A. F. E." (admit for examination) together with his criticism. If the drawings can be corrected, he adds the words "can be corrected." On all informal drawings that cannot be freed from objection, he adds "New drawings required." The drawings, after being micro-filmed, are then returned to the Application Branch.

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

#### NOTIFYING APPLICANT

The Examiners are directed to advise the applicants in the first Office action of the conditions which render the drawing informal, and when indicated, that such drawings can be corrected so as to be acceptable, but will not, in any case, require new drawings because of their execution unless the necessity therefor shall have been indicated by the Head of the Drafting Branch.

As soon as allowable subject matter is found, the requirement for new drawings should be insisted upon. Before writing the action, the Drafting Branch should be consulted to ascertain if, at that time, the new drawing could be prepared by the Patent Office on request and, if so, the estimate of cost should be included in the action. Otherwise, the action should state:

"Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Drafting Branch of the Patent Office does not have the facilities at the present time, for preparing new drawings".

This procedure, by avoiding a fruitless request to have the Drafting Branch prepare the new drawing, will promote earlier issuance of the patent.

#### WAIVING OF CORRECTIONS

The Draftsman has relaxed certain of the fine detail requirements of the drawings.

In order to eliminate unnecessary requirements for drawing corrections, especially in applications filed prior to January 1965, the Examiner should inspect the drawing and, in the event that any of the following objections made by the Draftsman appear in the examiner's opinion to be of a waivable nature, should consult the Draftsman to ascertain whether the objection(s) can be waived instead of requiring applicant to make correction:

- (1) Lead lines too long.
- (2) Heavy shade lines required.
- (3) Hatching required.
- (4) Lines rough and blurred.
- (5) Pale lines (if the prints indicate the lines reproduce sufficiently).
- (6) Poor paper (if drawing is otherwise acceptable).

The following objections if made by the Draftsman must be corrected and cannot be waived:

- (1) Space for heading required.
- (2) Ink drawings required.
- (3) Paper undersize.
- (4) Signature on wrong end of sheet.
- (5) Insufficient margin.
- (6) Borderline not in ink.

#### ADDITIONAL ILLUSTRATION

If there is only one figure, it should not be designated "Fig. 1." The Examiner may require additional drawings for the purpose of illustrating the disclosure.

When a necessary additional illustration is small and may be added to the drawings on file, an additional sheet of drawing should not be required, but the Examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings.

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

#### 608.02(a) New Drawing—When Required

##### PHOTOPRINTS AS DRAWINGS

If photoprints are submitted with a new case in lieu of formal drawings and such prints are not only readable but *reproducible*, the Application Branch notifies applicant that the case is accepted for filing only and that, to be entitled to examination, formal drawings complying with Rule 84 must be filed within 60 days from the date of the letter of notification. The formal drawings when received are compared with

the prints for identity of disclosure. The comparison charge is \$10 per hour or fraction thereof per application. The papers filed and the responsibility for processing will remain with the Application Branch until the correct filing date has been finally established.

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

### 608.02(b) Informal Drawings

**Rule 85. Informal drawings.** The requirements of Rule 84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto may be admitted for purpose of examination, but in such case the drawing must be corrected or a new one furnished, as required. The necessary corrections will be made by the Office upon applicant's request and at his expense. (See Rule 21.)

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to, and that the drawing is admitted for examination purposes only. To be fully responsive, an amendment must include a request for drawing corrections when there is an indication of allowable subject matter. See Rule 111(b) and 832 O.G. 1785.

### 608.02(c) Drawings or Print Always Kept in Examining Group

The photocopies of the drawings must always be kept on top of the papers on the right of the file wrapper so as to be visible upon opening the wrapper and easily detached. This photocopy (or "print") is placed in the drawing cabinet when the corresponding drawing is removed. When the examiner removes the drawing from the 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 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 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.

#### AFTER PATENT ISSUES

Immediately upon the receipt of the hard copies of patents issued by the examining group, the docket clerk should have the corresponding prints pulled, marked in the upper left hand corner with the patent number and sent to the Record Room.

No application should be sent to issue or to abandoned files unless the original drawing, if any, accompanies it.

### 608.02(d) Complete Illustration in Drawings

**Rule 83. Content of drawing.** (a) The drawing must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g. a labeled rectangular box).

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

Likewise, any structural detail that is of sufficient importance to be described should be shown in the drawing. (Ex parte Good, 1911 C.D. 43; 164 O.G. 739.)

### 608.02(e) Examiner Determines Completeness of Drawings

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

### 608.02(f) Modifications in Drawings

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

All modifications described must be illustrated, or the text canceled. (Ex parte Peck, 1901 C.D. 136; 96 O.G. 2409.) This require-

ment does not apply to a mere reference to minor variations nor to well-known and conventional parts.

### 608.02(g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliott*, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

### 608.02(h) Additional, Duplicate or Substitute Drawings

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

Additional and substitute drawings are routed through the Drafting Branch where any defects in execution will be noted. If there are none, they will be stamped, "APPROVED BY DRAFTSMAN". When such drawings are considered by the Examiner, it should be kept in mind that the "APPROVED" stamp applies only to the size and quality of paper, lines rough and blurred and other details of execution. The Examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. Clerks will routinely "enter" all additional and substitute sheets on the file wrapper. If the Examiner decides that the sheets should not be entered, applicant is so informed, giving the reasons. The entries made by the Clerk will be marked "(N.E.)".

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

For return of drawing, see 608.02(y).

### 608.02(i) Transfer of Drawings From Prior Applications

*Rule 88. Use of old drawings.* If the drawings of a new application are to be identical with the drawings

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

Formal transfer of drawings between applications under Rule 88 are processed in the Examining Groups unless the later filed case is a newly submitted application that has not been forwarded to an Examining Group.

Transfer of all drawings from one pending application to another will be made only after the one application has been abandoned.

### NEWLY SUBMITTED APPLICATION

The transfer of drawings to newly submitted applications that have not been forwarded to the Examining Group will be effected by the Application Branch if the application is otherwise entitled to receive a filing date. A new application filed without drawings but having a request for transfer of drawings from a pending application must be accompanied by a written declaration of abandonment under Rule 138. In order to insure copendency, such an abandonment may be worded as to become effective only after the transfer of the drawings has taken place. Since the drawings will be transferred from the earlier application to the new application as of the filing date of the new application, it is not necessary to submit or order photoprints for the new application.

The above practice applies to transfer of drawings from any application except where the issue fee has been paid, in which case an express abandonment (Rule 138) must be filed together with a showing why the proposed action was not taken earlier. See Rule 313.

The name of the attorney on the drawing being transferred is not changed. See 608.02(u).

When an application becomes a patent, any canceled sheet of drawing then in the case is sent to the abandoned files. Such canceled sheet is available for applicant's use in another application directed to its subject matter. It follows that, except as provided in Rule 174, drawings printed in a patent may not be transferred to a subsequent case.

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

In the case of a divisional application, if the drawing and descriptive matter pertaining thereto have been canceled from the parent case, the canceled sheet or sheets of drawing may be withdrawn and used as the original drawing of the divisional case. The sheets involved should be taken to the Drafting Branch for erasure of the "CANCEL per" stamp.

**608.02(k) Transfer of Drawings to Reissue**

*Extract from Rule 174.* The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

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

whatsoever in the drawing, a new drawing for the reissue must be filed.

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

Transfer of the drawing is made as forth in 608.02(i), notation thereof being entered on the file wrapper of the original application.

**608.02(1) Transfer of Drawings Made But Abandonment Delayed**

Under the old policy, transfer of drawings was permitted with a letter of abandonment being filed at a later time or allowing the earlier filed application to become abandoned. In applications which have had their drawings transferred under this old policy and have not been abandoned by the time it is normally taken up for action, a letter limited to the following statement should be written therein by the examiner:

"In view of the transfer on \_\_\_ of the drawings from this application to application Serial No. \_\_\_, pursuant to applicant's request under Rule 88 and the intention to abandon this application, the filing of the express abandonment of the instant application is required.

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THIRTY DAYS FROM THE DATE OF THIS LETTER.**

**608.02(m) Prints**

Preparation and distribution of prints is discussed in 508.

Photographic prints are made of the drawings of an acceptable application. Prints of the drawings as filed are entered in the application, given a paper number and kept on top of the papers on the right side of the file wrapper, see 717.01(b).

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

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

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

**608.02(n) Duplicate Prints in Patentability Report Cases**

In Patentability Report cases having drawings, the Examiner to whom the case is assigned will obtain a duplicate set of prints of the drawing for filing in the group 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 group having jurisdiction of the case to each group that submitted a P. R. The Examiner of each such reporting group 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 group, they may be destroyed.

**608.02(o) Dates Entered on Drawing**

The Mail Branch stamp and the "Corrected" stamp applied by the Drafting Branch are impressed on the back of the drawings.

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 Group does NOT enter any date when the case is "sent to issue".

Approval of the Drafting Branch is indicated by a legend associated with the "O.G. Fig. Cl. . . . Sub. . ." stamp on the front of each uncanceled sheet.

**608.02(p) Correction of Drawings**

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

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

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

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description.

**608.02(q) Conditions Precedent to Amendment of Drawing**

Correction and alterations in the disclosure of the drawings of a pending application may be made only under the supervision of, or by the Chief Draftsman.

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

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

**608.02(r) Separate Letter to Draftsman**

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

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

**608.02(s) Estimating Cost of Correcting Drawings**

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

If the Examiner approves of a proposed correction of a drawing for which an estimate is requested he will note his approval on the order for the estimate, attach the order to the outside of the file and have the Docket Clerk of the Group forward the file and drawing to the Draftsman. The Draftsman will note the estimate on the order and also on the drawing. If the application is not up for action the Draftsman sends the estimate to the Applicant. If the application is up for action the Draftsman does not send an estimate, but the Examiner should include the estimate in the next action. (Basis: Notice of July 13, 1906.)

When giving an estimate in a case where no allowable subject matter has been found the Examiner should inform the applicant that no correction will be made until a claim is found to be allowable. If specifically requested by the applicant, the drawing will be corrected whether or not a claim is allowable. (Basis: Notice of February 1, 1932.)

If an application is ready for allowance except for a correction required by the Official Draftsman, such as in a case where the lines are rough and blurred, the Examiner will ascertain (by calling Ext. 2589 or 2887) whether or not the attorney in the case has a Deposit Account. If there is no such account, the Examiner will obtain an estimate of the cost of this work from the Draftsman even though applicant has not requested such an estimate. Including the estimate in the final requirement for correction of the drawing may avoid prolonging the prosecution.

**608.02(t) Cancellation of Figures**

Cancellation of one or more figures which do not occupy entire sheets of the drawings is done by the clerk in the Examining Group who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancellation or the date that substitute sheets are filed should be written in red ink within the red line. Cancellation of an entire sheet of drawings is done by stamping the words "CANCEL per" in the top right corner of the drawing within the marginal line.

When the cancellation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the Chief Draftsmen should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. Cancellation of a figure may necessitate renumbering of the remaining figures. (Basis: Order No. 1862.)

**608.02(u) Changing Name of Attorney on Drawing Forbidden**

Writing upon the drawings the names of attorneys subsequently appointed, so as to make it appear that their names were present when the drawings were originally filed, is prohibited.

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

**608.02(v) Drawing Changes Which Require Sketches**

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

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

A pencil sketch that is otherwise acceptable or a blueprint with the changes indicated in pencil, may be inked in by the Office Draftsman at applicant's request and at his expense.

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

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

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

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

In the event that several different kinds of changes are required or any of the listed changes are time consuming, an Examiner's Amendment should not be made.

### 608.02(x) Disposition of Orders for Amendment of Drawing

Where the ordered correction of the drawing in a case up for action by the Examiner is approved, the application and drawing are forwarded to the draftsman provided there is an allowable claim or there has been a specific request by applicant that the drawing be corrected regardless of whether or not a claim has been allowed (608.02(s)). Applicant's letter to the draftsman is attached to the outside of the file and the Examiner writes on said letter "approved", with the date of approval and his initials, attaching, if appropriate, a "Spe-

cial" tag (PO-204). If rough and blurred lines are to be corrected, the Examiner should at that time indicate in the margin the figure to be printed in the O.G. (Basis: Notice of January 14, 1965.) It is not necessary to carry such files to the Draftsman. Messenger envelopes should be used. After the drawing has been corrected, the Draftsman stamps the letter to the Draftsman and the back of the drawing **CORRECTED** and returns the case to the examiner.

### NEW DRAWINGS PREPARED BY PATENT OFFICE

When new drawings have been required in pending applications and have been prepared by the Office Draftsman, they are not sent to the applicant for his signature but a copy (print) is sent to him for his file. The name of the inventor(s) will be printed on the drawings by the Office Draftsman.

In the event that the application is in condition for allowance, the application can be sent to issue immediately after the drawing is prepared. (Basis: Notice of Jan. 6, 1966.)

### CORRECTION NOT APPROVED

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not sent to the draftsman. The Examiner's reasons for not approving the corrections to the drawing should be set forth in the Office action. (Basis: Notice of February 1, 1932, Revised.)

### 608.02(y) Return of Drawing

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

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

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

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

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

Before drawings are returned prints are made and put in the application file.

### 608.03 Models, Exhibits, Specimens

*Rule 91. Models not generally required as part of application or patent.* Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

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

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

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

*Rule 93. Specimens.* When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

#### 608.03(a) Handling of Models, Exhibits and Specimens

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

tive of the Property Clerk's Office or will be picked up by the examining division.

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

When an exhibit or model is received, it will be forwarded from the Model Room to the examining division. A label showing attorney's name and address should be attached to the model or exhibit so that it can be returned after prosecution of case. If exhibit is too large to be kept in the division during prosecution of case, it may be sent to the Model Room with instructions to indicate whether exhibit is to be held or returned to sender.

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

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

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

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

*NOTE.*—Plant specimens, 1607, Rule 166.

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

### 608.04 New Matter

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



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

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

A "new matter" amendment of the drawing is ordinarily not entered. Neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the Clerk. See 608.02(h).

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

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

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

Matter not in the original specification, claims or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal et al.*, 1956 C.D. 11; 705 O.G. 5 (physical properties), *Ex parte Fox*, 1960 C.D. 28; 761 O.G. 906 (new formula) and *Ex parte Ayers et al.*, 108 U.S.P.Q. 444 (new use). For

rejection of claim involving new matter see 706.03(o).

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

#### **608.04(b) New Matter by Preliminary Amendment**

As an applicant has the right to amend before action on his case provided the number of claims in cases filed before October 25, 1965, is kept within the limit imposed by his filing fee, an amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure. Its test as to involving new matter is the same as though filed on a subsequent date. *Ex parte Leishman*, 137 Ms. 336, Pat. No. 1,581,937, and *Ex parte Adams*, Pat. No. 1,789,921.

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

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