

MANUAL OF
PATENT
EXAMINING
PROCEDURE

ORIGINAL EDITION



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MANUAL OF PATENT EXAMINING PROCEDURE

Third Edition

Instructions Regarding Revision No. 19

The attached revised pages are replacements for those in the Manual having corresponding numbers, or additional pages to be placed in appropriate numerical sequence.

Change Notices 17-2, relating to the "Trial Multiple Dependent Claim Practice," and 19-1 relating to "Incorporation by Reference" should be retained since the subject matter has not been incorporated in the text of the Manual.

In the checklist on page vi of Revision 18, the Revision Nos. for pages 45-46 and 48.1-48.2 were transposed. The current page of 45-46 is Revision No. 16-16 and the current page of 48.1-48.2 is Revision No. 18-18.

The notation " \overline{R} -197" in the attached pages appears either at the title or at the end of a section that has been altered in any way. Where neither the beginning nor the end of a revised section appears on the revised page, the customary notation at the bottom of the page is the only indication of revision.

Louis O. Maassel, Editor
Manual of Patent Examining Procedure

Particular attention is called to the following alterations:

Section

- 602 The last sentence on page 34.1 has been added.
- 706.03 (s) The first sentence under (3) has been revised.
- 717.01 (a) The last three paragraphs include the subject matter of the Notice of November 21, 1968, entitled "Post Card Receipt Reminder."
- 1101.02 The second paragraph on page 172 has been revised.

(over)

1105.01 The first full paragraph on page 182 has been revised.

1603 The subject matter of the Notice of November 21, 1968 entitled "Plant Patent Applications - Filing Date" has been included.

Appendix II - The List of Decisions Cited has been completely revised.

Index The Index has been completely revised.

List of replacement pages for Revision 19:

<u>Page</u>	<u>Rev. No.</u>	<u>Page</u>	<u>Rev. No.</u>
Title page	19-19	263-264	19-19
(2 sides)		265-266	19-19
34.1-blank	19	267-268	19-19
72.1-72.2	19-16	269-270	19-19
111-112	19-1	271-272	19-19
113-114	19-19	273-274	19-19
171-172	19-19	275-276	19-19
172.1-blank	19	277-278	19-19
181-182	19-19	279-280	19-19
183-184	19-8	281-282	19-19
185-186	19-19	283-284	19-19
239-240	19-19	285-286	19-19
253-254	19-19	287-288	19-19
255-blank	19	289-290*	19-19
257-258	19-19	291-292*	19-19
259-260	19-19		
261-262	19-19		

*Added page

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice

SERIES NO. 19 - 1

(Follows Change 18 - 7)

December 30, 1968

Reference: MPEP 608.01(p)

INCORPORATION BY REFERENCE

An application for a patent may incorporate essential material by reference to a United States patent, or an allowed U. S. application, subject to the conditions set out below. *Essential material is defined as that which is necessary (1) to support the claims, or (2) for adequate disclosure of the invention (35 USC 112). Material which is essential to the referencing application may not be incorporated by reference to patents issued by foreign countries or to non-patent publications. Essential material may not be incorporated by reference to a patent or application which itself incorporates essential material by reference.

The referencing application must include (1) an abstract, (2) a brief summary of the invention, (3) an identification of the referenced patent or application, (4) at least one view in the drawing in those applications admitting of a drawing, and (5) one or more claims. Where appropriate it would be advisable to direct particular attention to specific portions of the referenced patent or application.

If an application is filed with a complete disclosure, essential material may be cancelled by amendment and the same material substituted by reference to a patent or a pending and commonly owned allowed application in which the issue fee has been paid. The amendment must be accompanied by an affidavit executed by the applicant or his attorney or agent of record stating that the material cancelled from the application is the same material that has been incorporated by reference.

If an application incorporates essential material by reference to a U. S. patent or a pending and commonly owned allowed U. S. application for which the issue fee has been paid, applicant will be required prior to examination to furnish the Patent Office with a copy of the referenced material together with an affidavit executed by the applicant or his attorney or agent of record stating that the copy consists of the same material incorporated by reference in the referencing application.

If an application incorporates essential material by reference to a pending and commonly owned application other than one in issue with the fee paid, applicant will be required prior to examination to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit executed by the applicant or his attorney or agent of record stating that the amendatory material consists of the same material incorporated by reference in the referencing application.

*Non-essential subject matter may be incorporated by reference to patents issued by the United States or foreign countries, prior filed commonly owned patent applications filed in the United States, and non-patent publications for purposes of indicating the background of the invention or illustrating the state of the art.

Richard A. Wahl
Assistant Commissioner

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.

Change Notice

Reference: MPEP 608.01(n)

SERIES NO. 17-2
(Follows Change 17-1)

June 4, 1968

TRIAL MULTIPLE DEPENDENT CLAIM PRACTICE

For the trial period running from July 1, 1968 through December 31, 1968, all applications and amendments to applications filed in the Patent Office will be permitted to include multiple dependent claims which refer back to any of the preceding claims in the alternative whether independent or dependent. In this manner a claim may have a single number but would effectively be considered and treated as a plurality of claims. Entry into this program will require (1) the filing of a written request in which the applicant agrees to abide by the conditions of the program, and (2) the filing of appropriate fees and a showing of the fee calculation. Although the trial period terminates December 31, 1968, the prosecution of all applications placed in this program will continue under the program guidelines.

A claim dependent upon any of a plurality of preceding claims will be considered in acceptable form and entered provided it is otherwise acceptable and does not (1) cross statutory classes with any of its parent claims, or (2) depend from any other multiple dependent claim, or (3) refer back to preceding claims in the conjunctive rather than the disjunctive form (e.g., "The tool as defined in any one of claims 1, 2, and 4 . . ." is acceptable, but "The tool as defined in claims 1 and 2 . . ." is not acceptable. Likewise, "The tool as defined in claims 1, 2, or 4 . . ." is acceptable, whereas "The tool as defined in claims 1, 2 and/or 4 . . ." is not acceptable). Should any dependent claim include a claim association that violates any of the above prohibitions the claim will be rejected as indefinite for failure to comply with 35 U.S.C. 112 and will not be further treated with regard to any other claim association. Also, multiple dependent claims will not be considered for entry after final rejection. Further, during this trial period, for the applications involved in this program the total numbered claims may not exceed ten. Non-compliance with this condition will result in applicant being given one month to reduce the total numbered claims to ten. In newly filed cases, the failure to comply within the one month period will result in loss of filing date. In all other cases the entire amendment will not be entered in the absence of compliance with this requirement.

It is suggested that the claims be arranged in order of narrowing scope whereby the first claim presented is the broadest. Claims dependent upon the broad claim should come next, followed by claims which are dependent upon any of the plurality of preceding claims.

Practice and Rejections

When acting on a multiple dependent claim, the examiner will consider the patentability of the various claim associations encompassed by said claim and apply any pertinent prior art in the usual manner. Each of these associations should be compared with the prior art, exactly as if it were presented as an independent claim. If a claim having multiple dependency should include both patentable and unpatentable claim associations, the Examiner will identify each of the patentable claim associations and identify and specifically reject each of the unpatentable claim associations. However, mere failure to reject a claim association does not give rise to a presumption of allowability.

For fee purposes every claim which refers to any of the preceding claims will be considered effectively as a dependent claim for each association of claims that it represents, thereby effectively increasing the number of claims in the case. Therefore, in these cases the additional fees required for claims in excess of ten will be two dollars (\$2.00) times the total effective number of claims in excess of ten. This fee is based on the fact that such a claim is, in substance and so far as the work of examination is concerned, equivalent to a number of dependent claims each based on a single preceding claim.

(over)

In applications not under this program but having multiple dependent claims, it will be assumed that applicant intends these claims as effectively only a single claim. Accordingly, such claims will be considered alternative and therefore indefinite under 35 U. S. C. 112.

Rule 75(c) is hereby suspended for the duration of the trial period in those cases presenting multiple dependent claims under this program insofar as conflict exists between the requisites of the rule and the proposed practice.

Richard A. Wahl
Assistant Commissioner

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MANUAL OF
**PATENT
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PROCEDURE**

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U.S. DEPARTMENT OF COMMERCE • PATENT OFFICE

Rev. 19, Jan. 1960

The Patent Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

Correspondence relating to any of the above items should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents
Mail List Section
P.O. Box 1533
Washington, D.C. 20013

Orders for individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

Commissioner of Patents
Washington, D.C. 20231
Attn.: Document Services Branch

The cost per page will be 30¢ (see rules 13(a), 21(b), and 21(t) Rules of Practice).

Charges may be made to deposit accounts if the requestor is an account holder in good standing at the time the request is received. Checks or money orders should be made payable to the Commissioner of Patents. Requests must identify the specific pages required and the number of copies of each page.

Employees of the Patent Office should direct their orders for the Manual, replacement pages, notices, and revisions to the Scientific Library.

First Edition, November 1949

Revision 1, November 1950

Revision 2, December 1951

Revision 3, May 1952

Second Edition, November 1953

Revision 1, April 1955

Revision 2, June 1956

Revision 3, June 1957

Revision 4, July 1958

Third Edition, November 1961

Revision 1, January 1964

Revision 2, November 1964

Revision 3, January 1965

Revision 4, April 1965

Revision 5, July 1965

Revision 6, October 1965

Revision 7, January 1966

Revision 8, April 1966

Revision 9, July 1966

Revision 10, October 1966

Revision 11, January 1967

Revision 12, April 1967

Revision 13, July 1967

Revision 14, October 1967

Revision 15, January 1968

Revision 16, April 1968

Revision 17, July 1968

Revision 18, October 1968

Revision 19, January 1969

Foreword

This Manual is published to provide Patent Office patent examiners, patent applicants, and representatives of patent applicants with a reference work on the practices and procedures relative to the prosecution of applications before the Patent Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications.

Examiners will be governed by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated in the text. Orders and Notices, or portions thereof, relating to the examiners' duties and functions which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

EDWARD J. BRENNER,
Commissioner.

Acknowledgments

Preparation of the text of the Third Edition was directed by Ernest A. Faller, Editor, under the supervision of Manuel C. Rosa, Director, Patent Examining Operation.

The Supervisory Examiners, Isaac G. Stone, Norman H. Evans, Burnham Yung Kwai, Sam Spintman, John S. Hull, Thomas F. Murphy, Harvey E. Kauffman and George A. Gorecki took an active part in this work, especially in rewriting Chapter 700.

Others who assisted were Pasquale J. Federico, Hyman B. Freehof, Examiners-in-Chief; Joseph Schimmel, Deputy Solicitor; Samuel Levin, LaVerne L. Williams, Interference Examiners; and Florence A. Hoffman, Division Clerk.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

Commissioner of Patents,
Washington, D.C. 20231

Contents

	Page
Checklist of Pages.....	vi
Introduction.....	1
Chapter 100 Secrecy and Access.....	3
200 Types, Cross-Noting, and Status of Applications.....	7
300 Ownership and Assignment.....	21
400 Representative of Inventor or Owner.....	23
500 Receipt and Handling of Mail and Papers.....	31
600 Parts, Form and Content of Application.....	33
700 Examination of Applications.....	61
800 Restriction; Double Patenting.....	117
900 Prior Art, Classification, Search.....	137
1000 Matters Submitted to Commissioner and Group Directors.....	159
1100 Interference.....	163
1200 Appeal.....	209
1300 Allowance and Issue.....	221
1400 Correction of Patents.....	229
1500 Design Patents.....	235
1600 Plant Patents.....	239
1700 Miscellaneous.....	243
Appendix J Table of Orders and Notices.....	247
Appendix II List of Decisions Cited.....	253
Appendix III Form Paragraphs.....	255.1
Index.....	257

**Checklist of Pages Needed To Form a Complete Set of the Third Edition of the M.P.E.P.
Through Revision 18**

DATES OF REVISIONS 1-18

<i>Rev. No.</i>	<i>Date</i>	<i>Rev. No.</i>	<i>Date</i>
1	Jan. 1964	10	Oct. 1966
2	Nov. 1964	11	Jan. 1967
3	Jan. 1965	12	Apr. 1967
4	Apr. 1965	13	July 1967
5	July 1965	14	Oct. 1967
6	Oct. 1965	15	Jan. 1968
7	Jan. 1966	16	Apr. 1968
8	Apr. 1966	17	July 1968
9	July 1966	18	Oct. 1968

<i>Page</i>	<i>Revision No.</i>	<i>Page</i>	<i>Revision No.</i>
Title Page (2 sides)	18-18	Chapter 700	
III-IV	17-17	61-62	17-17
V-VI	18-18	63-64	14-13
VII	18	65-66	16-16
Introduction		66.1	16
1-2	Unrevised	67-68	18-18
Chapter 100		69-70	16-16
3-4	17-17	70.1	16
4.1	15	71-72	16-16
5-6	18-18	72.1-72.2	16-16
Chapter 200		73-74	17-17
7-8	17-17	74.1	17
8.1	17	75-76	12-12
9-10	16-14	77-78	17-17
10.1-10.2	14-14	79-80	15-15
11-12	18-18	80.1	15
12.1	18	81-82	16-16
13-14	1-1	83-84	16-16
14.1	1	85-86	16-17
15-16	18-18	87-88	18-18
16.1	18	89-90	17-17
17-18	15-15	90.1-90.2	18-18
19-20	13-13	91-92	16-16
Chapter 300		93-94	16-16
21-22	13-12	95-96	17-17
Chapter 400		96.1-96.2	17-17
23-24	Unrevised	97-98	11-11
25-26	15-15	98.1	11
26.1	15	99-100	15-16
27-28	Unrevised	101-102	16-16
29-30	Unrevised	102.1-102.2	18-18
Chapter 500		102.3	18
31-32	11-11	103-104	13-13
Chapter 600		105-106	14-14
33-34	11-11	107-108	16-16
34.1	10	108.1	15
35-36	14-13	109-110	Unrevised
37-38	12-12	111-112	1-1
39-40	13-13	113-114	13-13
41-42	11-13	115-116	18-18
42.1	13	Chapter 800	
43-44	11-11	117-118	18-18
45-46	18-18	119-120	18-18
46.1	18	120.1-120.2	18-16
47-48	15-18	121-122	18-18
48.1-48.2	16-16	123-124	18-18
49-50	16-14	125-126	18-18
51-52	14-17	127-128	18-18
53-54	14-14	129-130	18-18
54.1	12	131	18
55-56	12-12	133-134	18-18
57-58	4-7	135-136	17-17
59-60	12-12	Chapter 900	
		137-138	18-17
		138.1-138.2	17-17
		139-140	17-17
		140.1	17
		141-142	1-1
		143-144	17-17

Page	Revision No.	Page	Revision No.
145-146	4-4	Chapter 1600	
147-148	9-9	239-240	Unrevised
149-150 (one page)	1	241-242	Unrevised
151-152	6-6	Chapter 1700	
153-154	9-9	243-244	11-11
155-156	16-16	245-246	14-14
157	13	Chapter 1100 (governs interferences declared prior to July 1, 1965)	
Chapter 1000		163-164	Unrevised
159-160	8-12	165-166	2-2
161-162	15-15	167-168	Unrevised
Chapter 1100 (governs interferences declared after July 1 1965)		169-170	2-2
163-164	12-12	171-172	2-3
165-166	9-9	172. 1	3
166.1	9	173-174	Unrevised-1
167-168	5-5	175-176	2-2
169-170	5-8	176. 1	2
171-172	8-8	177-178	1-1
172.1	5	179-180	Unrevised
173-174	8-9	181-182	Unrevised
175-176	8-8	183-184	Unrevised
176.1	8	185-186	2-2
177-178	16-16	187-188	Unrevised
179-180	16-16	189-190	2-4
181-182	8-9	191-192	2-2
183-184	8-8	192. 1	2
185-186	5-5	193-194	3-Unrevised
187-188	12-12	195-196	1-1
189-190	5-blank page	196. 1	1
191-192	omitted	197-198	Unrevised
193-194	7-7	199-200	3-3
194.1	7	201-202	Unrevised
195-196	16-16	203-204	1-1
197-198	17-17	204. 1	1
199-200	11-5	205-206	Unrevised
201-202	5-5	207-208	Unrevised
203-204	5-5	Appendix I	
205	5	247-248	2-7
207-208	omitted	249-250	7-3
Chapter 1200		251-252	10-10
209-210	16-16	Appendix II	
211-212	14-14	253-254	11-11
213-214	15-16	255	11
214.1	16	Appendix III	
215-216	16-16	255. 1-255. 2	(Revision number not on these pages—distributed with Revision 3)
217-218	12-12	255. 3-255. 4	
219	12	255. 5-255. 6	
Chapter 1300		Index	
221-222	18-18	257-258	8-Unrevised
222.1	16	259-260	Unrevised-8
223-224	17-18	261-262	7-Unrevised
225-226	18-18	263-264	Unrevised
227-228	18-18	265-266	Unrevised
Chapter 1400		267-268	Unrevised
229 230	Unrevised-1	269-270	Unrevised-7
231 232	1-unrevised	271-272	8-7
233 234	13-13	273-274	5-8
Chapter 1500		275-276	2*-unrevised
235 236	2-2	277-278	Unrevised
236.1	2	279-280	Unrevised
237-238	6-10	281-282	Unrevised
		283-284	8-8
		285-286	8-8
		287-288	8-8
		Change Sheet	17-2

* No revision number appears on this page. Only the revised copy includes as the first listing under "N" the word "Name".

Introduction

Constitutional Basis

The Constitution of the United States provides:

"ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U.S.C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes. The pamphlet also contains tables showing where subject matter comparable to present title 35 may be found in prior statutes, and where subject matter of prior statutes will be found in new title 35.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the Commissioner of Patents (1002) and

MANUAL OF PATENT EXAMINING PROCEDURE

from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on formal matters is final

but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.