Chapter 1700 Miscellaneous

1701 Examiners Not To Express Opinion on Validity Nor Testify as Patent Experts

Inasmuch as public policy does not permit Examiners to decide, as judges in the Patent Office, questions upon which they have been retained to give opinions as expert witnesses in patent cases in the courts, every Examiner who shall testify as an expert in a patent case pending in any court will be dismissed, unless he shall have so testified involuntarily, upon compulsion by competent judicial authority, and without retainer or preparation. (Basis: Notice of March 6, 1880.)

Congress, in 35 U.S.C. 282, has endowed every patent granted by the Patent Office with a presumption of validity. Public policy demands that every employee of this Office refrain from expressing to any interested person any opinion or view as to the invalidity of any U.S. patent. The question of validity or invalidity is exclusively a matter for the courts to determine. Each member of the examining corps is cautioned to be especially wary of any inquiry from any person outside the Patent Office (including any employee of another government agency), the answer to which might indicate that a particular patent should not have been issued.

Whenever an examiner is asked or subpoenaed to testify in a suit concerning a patent, trademark registration, or application for either, he is directed to report that fact *immediately* to the Solicitor. (Basis: Notice, May 4, 1959.)

Examiners are cautioned against answering inquiries from any person outside the Patent Office as to whether or not a certain reference was considered and, *a fortiori*, whether or not a claim would have been allowed over that reference. This applies to anything in the patented file, including the extent of the field of search and any entry relating thereto. The record of a patented file must speak for itself. Practitioners can be of material assistance in this regard by refraining from making such inquiries of members of the examining staff. Answers to inquiries of this nature must of necessity be refused, and such refusal should be considered neither discourteous nor an expression of opinion as to validity. (Basis: Notices of May 18, 1961 and October 21, 1960.)

Also, Examiners are reminded that, in view of the long established policy of the Patent Office to refuse to permit members of the staff of the Patent Office to testify in patent suits, they should, before allowing an application, determine that the written record is accurate and complete.

1702 Restrictions on Examiners Resigning From the Office

Extract from Rule 341, Registration of Attorney and Agents. (g) *Former examiners.* No person who has served in the examining corps of the Patent Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending in any examining division in which he served, on the date he left said division; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within two years after the date he left such division, and assigned to such division, without the specific authorization of the Commissioner. Associated and related classes in other divisions may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph.

See also 309.

1703 The Official Gazette

The *Official Gazette* reports every Tuesday the patents, design patents and trademark reg-

istrations issued on that day. As to each patent, the following information is given:

(1) the name and (2) the city and state of residence of the applicant with the Post Office address in the case of unassigned patents, and (3) the same data for the assignee, if any, (4) the filing date, and (5) the serial number of the application, (6) the patent number, (7) the title of the invention, (8) the number of claims, (9) the class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, and (11) a typical claim. In the case of a reissue patent there are published the additional data of the number and date of the original patent and original application; and in the case of a design patent the term of the patent.

Various trademark notices and publications are also included.

The *Gazette* includes a section devoted to reports of patent and trademark decisions and notices of a variety of matters; disclaimers, adjudicated patents, patent and trademark suits, certain adverse decisions in interferences, the condition of work in the Office, changes in rules, disbarment of attorneys, and notices to parties not reached by mail.

The patent and trademark decisions in this section include in particular those of the United States Court of Customs and Patent Appeals, the U.S. Supreme Court, and the U.S. Court of Appeals for the District of Columbia Circuit, and selected decisions of the Commissioner of Patents and Board of Appeals. These decisions constitute such important statements of the law that the notice and decision section is separately printed in leaflet form and is distributed to the Examiners.

1704 Records Kept in Examining Groups

The principal records kept in the examining groups are two sets of cards, Form PO–205 which are arranged numerically and Form PO–206, of which those awaiting action are arranged by individual Examiners. Each card contains data concerning the applications that have been assigned to the group, identified by name of applicant, title of invention, serial number and filing date. Notation of attorneys is also made. Each set of cards also shows the name of the assistant examiner to whom the examination is entrusted and the class and subclass of prior art considered most pertinent for search, the successive actions taken, and finally the patenting or abandonment or transfer of the case.

Miscellaneous records are also kept relating to matters such as cases on appeal, cases involved in interference, patentability report cases temporarily in or out of the group, cases involving classification questions and applications or references charged out.

1705 Examiner's Work Report and Actions To Be Counted Thereon

The "Examiner's Monthly Production Report" (PO–290 Rev.) is intended to present more comprehensive information relative to workload conditions and certain phases of Examiner performance, e.g., by regularly including, in addition to the information formerly furnished, a report of each Examiner's disposals.

Shorter periods are covered in the "Examiner's Weekly Production Report" (PO–411).

The Monthly Report reflects the condition of the Examining Group on the last day of the month and it must include all cases received and all cases acted on and disposed of during that month.

Examiners are directed to count all cases in which actions have been prepared (that is, the actions that have been written in long hand or dictated) irrespective of whether they have been typed or mailed. The dates of the various desks shall be advanced and reported as the actions are counted. The oldest dates of the group reported shall not be advanced except as the actions are mailed. (Basis: Notice of December 30, 1949.)

The following only are counted as actions:

1. Regular actions in new and amended cases.
2. One action for each application which consists only in suggesting claims for interference and one for each application in declaring each interference.
3. Examiner's statements in answer to petitions from his actions.
4. Examiner's answers on appeals.
5. Decisions on motions in interference.
6. Letters advising of entry or nonentry of amendment after final action.
7. Letter advising applicant that express abandonment has taken place and the file will be sent to the Abandoned Files Unit in due course.
8. Declaration or redeclaration of an interference.

By "regular" action is meant rejections, including requirements for restriction; letters or allowances by the Examiner as the result of the examination of a new application or the reconsideration or reexamination of an amended application; requirements for formal changes or corrections; actions of the Examiner applying or carrying into effect final decisions in interference, either on motions or on

priority; actions on cases remanded by an appellate tribunal for reconsideration in view of affidavits or proposed further amendments by appellants. Where more than one amendment is filed in any case before it is reached for consideration of the first of such amendments, only one action will be counted in connection with all such amendments.

The following should not be counted as actions: Examiner's Amendments; supplemental actions citing additional references or correcting the data of references of record; letters to Law Examiner (Rule 202); letters acknowledging receipt of communications (new or supplemental oaths, orders for corrections of drawings, etc.), which do not bring the application up for action; letters stating that the Notice of Allowance will be sent in due course (Sec. 1207) and answers to petitions to revive or to make cases special, amendments under Rule 312, and to status letters. Transfers of individual cases and patentability reports are not counted as actions, but credit is given for the time spent.

Examiners are expected to make a reasonably careful examination of applications when they are first received to determine the proper classification before entering them on the register. (Basis: Order 3179 and Notice of December 14, 1961.)

Non-Examining time is listed under "Remarks". Assistant Examiners should check this in order to make sure that they are properly credited with such time.