

## Chapter 1700 Miscellaneous

- 1701 Examiners Not to Express Opinion on Validity nor Testify as Patent Experts
- 1702 Restrictions on Examiners Resigning From the Office
- 1703 Official Gazette
- 1704 Records Kept in Examining Groups
- 1705 Examiner's Work Report and Actions To Be Counted
- 1706 Disclosure Documents
- 1710 U.S.-German Search Exchange
  - 1710.01 U.S. Origin Application
  - 1710.02 German Origin Application
- 1711 U.S.-Philippines Search Exchange
- 1712 U.S.-Swedish Search Exchange

### 1701 Examiners Not To Express Opinion on Validity Nor Testify as Patent Experts [R-32]

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.

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.

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 corps. 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.

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.

Patent examiners are forbidden to testify as patent experts or to express opinions, in testimony or otherwise, as to the invalidity of any issued patent. Patent examiners have, in connection with litigation involving patent validity, been called to testify on factual matters. In those cases, the practice has been to permit the examiner to testify only upon the issuance of a subpoena.

However, under current practice, patent examiners are permitted to testify on deposition in patent suits, without the need for a subpoena, provided the following conditions are satisfied:

- 1) The party proposing to take the testimony will state in writing, that the questions to be asked of the examiner will be phrased to comply with the permissible scope of inquiry as outlined in the protective orders contained in the Court opinions in *In re Mayewsky*, 162 USPQ 86, 89, and *Shaffer Tool Works v. Joy Manufacturing Co.*, 167 USPQ 170, 171:

“\* \* \* the scope of the oral depositions of the patent examiners is hereby limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses or conclusions of the patent examiners in acting upon the patent applications maturing into the patent [in suit].” 167 USPQ 171.

2) That in addition to complying with the requirements of Rule 30 of the Federal Rules of Civil Procedure, the party taking the testimony will agree to give notice of the taking of the deposition of the patent examiner to the Solicitor, at least thirty days prior to the date on which the taking of the deposition is desired.

3) That the party taking the deposition arrange with the Solicitor to notice the deposition at a place convenient to the Patent Office.

If the party desiring to take the testimony of the examiner does not agree to the conditions enumerated, the Patent Office will not permit the examiner to be deposed without a subpoena and compliance with the procedure set forth in Section 7.02, Department of Commerce Administrative Order 205-12, June 29, 1967 as amended April 10, 1970. That section states:

In any case where it is sought by subpoena, order or other compulsory process or other demand of a court or other authority (hereinafter referred to as a "demand") to require the production or disclosure of any record in the files of the Department of Commerce or other information acquired by an officer or employee of the Department as a part of the performance of his official duties or because of his official status, the matter shall be immediately referred for determination to the appropriate official described in subsection 4.01 of this order. If such official has discretion with respect to disclosure and he determines that it would be improper to comply with the demand, or if he has no discretion with respect to disclosure, the matter shall be promptly referred to the Secretary of Commerce for final determination. Unless and until the Secretary determines that the records or information should be produced, the officer or employee who appears in answer to the demand shall inform the court or other authority (a) that the section 7 of this order prohibits the officer or employee from producing or disclosing the records or other information demanded without the prior approval of the Secretary of Commerce, and (b) that the demand has been, or is being, as the case may be, referred for the prompt consideration of the Secretary. The officer or employee shall also provide the court or other authority with a copy of the regulations prescribed in this section 7 of this order, and shall respectfully request the court or other authority to stay the demand pending the receipt of instructions or directions from the Secretary of Commerce concerning the demand.

## 1702 Restrictions on Examiners Resigning From the Office [R-31]

*Extract from Rule 341, Registration of Attorneys 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 group during his period of service therein; 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 group, and assigned to such group, without the specific authorization of the Commissioner. Associated and related classes in other groups 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 further 18 U.S.C. 207).

See also § 309.

## 1703 The Official Gazette [R-31]

The *Patent Official Gazette* reports every Tuesday the patents, and design patents issued and defensive publications published 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 U.S. classification by class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, (11) an abstract of the disclosure, (12) international classification, (13) U.S. parent application data, if any, and (14) foreign priority application data, if any. 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.

The Patent Official Gazette also includes notices of patent and trademark suits, indexes of patents, disclaimers filed, Certificates of Correction issued, list of patents available for license or sale, and general information such as orders, notices, changes in rules, changes in classification, certain adverse deci-

sions in interferences, the condition of work in the Office, disbarment and registration of attorneys, and notices to parties not reached by mail. Annual subscription \$89 (\$22.25 additional for foreign mailing). Single copy \$2.

*Trademark Official Gazette.* The official journal of the Patent Office relating to trademarks. Published every Tuesday, it contains an illustration of each trademark published for opposition, a list of trademarks registered, classified list of registered trademarks and Patent Office notices. Annual subscription \$17 (\$4.25 additional for foreign mailing). Single copy 40 cents.

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

#### **1704 Records Kept in Examining Groups [R-21]**

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 groups, 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 examiner to whom the examination is entrusted or the assigned docket designation and the class and subclass considered most pertinent for examination, 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 groups, cases involving classification questions and applications or references charged out.

#### **1705 Examiner's Work Report and Actions To Be Counted Thereon [R-32]**

##### REPORTS

All reporting of examiner's production, docket, and time activities is on a bi-weekly basis corresponding to the period covered by the Time and Attendance Reports, PO-516.

Data Processing Branch makes the following reports for each art unit:

Examiner's Bi-Weekly Docket Activity Report, PO-290—This report covers information regarding the new and amended applications awaiting action. The information is

from the PO-690 prepared by the clerk and from PO-526 Case Disposition Record Cards prepared by the Examiner.

Examiner's Bi-Weekly Time and Activity Report, PO-912—This report is based on the Examiner's Case Action Record, Case Action Correction, Case Disposition, and Substitution Cards, PO-525, PO-531, PO-532 and PO-533, respectively.

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.

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 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 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.

Non-Examining time is listed on Examiner's Periodic Record of "Other" Time PO-690E. Examiners should check this in order to make sure that they are properly credited with such time.

## 1706 Disclosure Documents [R-26]

The Patent Office accepts and preserves, for a limited time, "Disclosure Documents" as evidence of the dates of conception of inventions.

### THE PROGRAM

A paper disclosing an invention and signed by the inventor or inventors may be forwarded to the Patent Office by the inventor (or by any one of the inventors when there are joint inventors), by the owner of the invention, or by the attorney or agent of the inventor(s) or owner. It will be retained for two years and then be destroyed unless it is referred to in a separate letter in a related patent application within two years.

The Disclosure Document is not a patent application, and the date of its receipt in the Patent Office will not become the effective filing date of any patent application subsequently filed. However, like patent applications, these documents will be kept in confidence by the Patent Office.

This program does not diminish the value of the conventional witnessed and notarized records as evidence of conception of an invention, but it should provide a more creditable form of evidence than that provided by the popular practice of mailing a disclosure to oneself or another person by registered mail.

### CONTENT OF DISCLOSURE DOCUMENT

Although there are no restrictions as to content and claims are not necessary, the benefits afforded by the Disclosure Document will depend directly upon the adequacy of the disclosure. Therefore, it is strongly urged that the document contain a clear and complete explanation of the manner and process of making and using the invention in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention. When the nature of the invention permits, a

drawing or sketch should be included. The use or utility of the invention should be described, especially in chemical inventions.

#### PREPARATION OF THE DOCUMENT

The Disclosure Document must be limited to written matter or drawings on paper or other thin, flexible material, such as linen or plastic drafting material, having dimensions or being folded to dimensions not to exceed 8½ by 13 inches. Photographs also are acceptable. Each page should be numbered. Text and drawings should be sufficiently dark to permit reproduction with commonly used office copying machines.

#### OTHER ENCLOSURES

In addition to the fee described below, the Disclosure Document must be accompanied by a stamped, self-addressed envelope and a separate paper in duplicate, signed by the inventor, stating that he is the inventor and requesting that the material be received for processing under the Disclosure Document Program. The papers will be stamped by the Patent Office with an identifying number and date of receipt, and the duplicate request will be returned in the self-addressed envelope together with a notice indicating that the Disclosure Document may be relied upon only as evidence and that a patent application should be diligently filed if patent protection is desired. The inventor's request may take the following form:

"The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years."

#### DISPOSITION

The Disclosure Document will be preserved in the Patent Office for two years and then will be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-year period. The Disclosure Document may be referred to in a separate letter filed in a pending application by identifying the Document by its title, number, and date of receipt. Acknowledgement of receipt of such letters is made in the next official communication or in separate letter from the Patent Office. Unless it is desired to have the Patent Office retain the Disclosure Document beyond the two-year period, it is not required that it be referred to in a patent application.

#### ACKNOWLEDGMENT

When a paper referring to a Disclosure Document is filed in a patent application within

two years after the filing of a Disclosure Document, the Group Clerk either prepares (1) a memorandum indicating that a reference to Disclosure Document No. \_\_\_\_\_ has been made in application Serial No. \_\_\_\_\_, or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the Head of the Correspondence and Mail Branch.

Upon receipt, the Correspondence and Mail Branch prepares a retention label (PO-150) and attaches it to the Disclosure Document, indicates on the forwarded memo or copy that the retention label has been applied and returns the memo or copy to the Group. The returned memo or copy is stapled to the inside left flap of the file wrapper so that the Examiner's attention is directed to it when he prepares the next Office action. If prosecution before the Examiner has been concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the Group Clerk.

After the acknowledging letter is mailed, the paper in the application file referring to the Disclosure Document is noted with the paper number of the acknowledgment. The returned memo or copy is stapled to and retained with the original paper in the file wrapper referring to the Disclosure Document.

#### FEE

A fee of \$10 is charged for filing a Disclosure Document. Payment must accompany the Disclosure Document when it is submitted to the Patent Office.

#### WARNING TO INVENTORS

The two-year retention period should not be considered to be a "grace period" during which the inventor can wait to file his patent application without possible loss of benefits. It must be recognized that in establishing priority of invention an affidavit or testimony referring to a Disclosure Document must usually also establish diligence in completing the invention or in filing the patent application since the filing of the Disclosure Document.

Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a patent on it.

If the inventor is not familiar with what is considered to be "diligence in completing the invention" or "reduction to practice" under the patent law, or if he has other questions about patent matters, the Patent Office advises him to consult an attorney or agent registered to prac-

tice before the Patent Office. A *Directory of Attorneys and agents Registered to Practice Before the U.S. Patent Office* is available for \$1 from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. Patent Attorneys and agents may be found in the telephone directories of most major cities. Also, many large cities have associations of patent attorneys which may be consulted.

### 1710 U.S.-German Search Exchange [R-21]

The German and U.S. Patent Offices have initiated a continuing program for exchanging search results in cases where applications for the same inventions are filed in both countries.

In general, the plan provides that where an application is filed in the U.S. and LATER a corresponding application claiming U.S. priority is filed in Germany (U.S. origin application), the U.S. search results are sent to the German Patent Office after the first action on the merits. Conversely, the U.S. Patent Office receives a list of references cited by the German examiner in his action on an application filed first in Germany and later in the U.S. (German origin application).

The Office of Patent Services, primarily through the newly set up Foreign Exchange Section, is responsible for processing all matters in connection with the exchange program in cooperation with the Examining Groups.

### 1710.01 U.S. Origin Applications [R-21]

The German Patent Office will identify German applications which refer to a prior application for patent in the U.S. for the same invention, and request a search report from the U.S. This request is on a printed sheet (blue), designated by them as Form B, which gives the serial number of the U.S. application, and the Application Number of the German application.

The Foreign Exchange Section of Special Services receives and processes the forms. Where the application has been disposed of or has already received an action on the merits, the Foreign Exchange Section will prepare from the files the list of citations for the German office. If the U.S. application has not yet been acted on, a printed Notice is placed in the inside left section of the file jacket to advise the Examiner and the Examining Group that the search results will be furnished Germany when the action is written. This Notice also contains information to assist the Group in handling such cases.

The application will be acted on by the Examiner when its regular turn is reached except that if it is over 24 months old or when it becomes 24 months old, it is to be made "Special" for the purpose of the first action, or if it is "Special" for some other reason.

When preparing the first action on the merits which contains reference citations, the Examiner, when filling out PO-892, Notice of References Cited, will check the box at the bottom marked "Foreign Exchange" and will detach the Notice and include it in the folder with PO-892 which is forwarded to the Reference Order Section.

If the first action on the merits does not cite any references, or if the application is being passed to issue on the first action, the clerk will check the appropriate place on the Notice and return it to the Foreign Exchange Section.

### 1710.02 German Origin Applications [R-21]

In the case of a U.S. application which refers to a prior German application for the same invention, German search results are requested by the Foreign Exchange Section when the U.S. applications are received in Application Branch. A form, PO-952, identifying the U.S. and German applications is completed and forwarded to the German Patent Office. At the same time, a Notice containing information to assist the Group in handling the application is inserted in the left inside section of the file jacket to advise the Group that search results may be expected.

In addition to the newly filed applications, cases already pending are included in the program. The Foreign Exchange Section will identify and locate applications in the Group, insert a copy of the Notice in the file, and send a request for search results on PO-952 to the German Patent Office.

If the Examiner notices an application in which there is a prior filed German application but which has not been marked by placing therein the Notice, he may in his own discretion request the German search results through the Foreign Exchange Section, if there is sufficient time before the case is to be reached for action.

The search report, on Form PO-952 (Form A), when received from Germany, together with copies of any references cited, will be forwarded to the Examining Group to be placed in the file, by the Foreign Exchange Section.

Normally, the search report is expected to be received before the U.S. application is reached for action in regular course. If it is not in the file of the application when it is reached for action, an inquiry may be made of the Foreign

Exchange Section to ascertain if it has been received and is in process. But otherwise examination of the application is not to be deferred to await a search report. If one is received after the Examiner's action, the references are to be considered in the same manner as references being considered for citation in the second action.

When the Examiner is acting on a case in which a search report citing references has been received from Germany (copies of the references will have been placed in the file), he is to proceed with his own search and examination of the application in the usual manner, but taking advantage of any assistance furnished by the references cited by the German examiner; for example, features or anticipations adequately supplied need not be searched for again. The references cited by the German examiner, as well as any additional ones found, are to be considered, and if pertinent, cited and used in the usual manner. References should not be cited merely because they have been listed by the German Patent Office.

As indicated in the joint report published at 838 OG 1225-6, May 23, 1967, an exchange at the present time cannot completely replace the necessity for each office to conduct its own search. In particular, it should be noted that a U.S. patent which issued after the German filing date, but which has an earlier filing date, cannot be used as a reference in the German case and that the German examiner presumably will not have searched such patents, assuming that they had reached Germany. Hence, particular attention should be paid to searching recent U.S. patents. Also, the German examiner searches according to a classification system developed along principles somewhat different from the U.S. classification, and references in related or analogous arts are not used to the same extent as here.

In recording the field of search on the file jacket, the Examiner should indicate in the usual manner those sub-classes in which he has made his usual search; where he has found it necessary to make only a partial or updating search, the listing of the sub-classes thus searched should be so marked.

The search report and the Notice are removed from the file when the application is disposed of and retained in the Foreign Exchange Section.

### 1711 U.S.-Philippines Search Exchange [R-21]

The United States-Philippines search exchange program involves patent applications filed in the United States which are subse-

quently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program will operate as follows:

The applicant will file his application in the U.S. Patent Office which will process the application in the normal manner and examine the application in the usual time sequence.

If the applicant should later file a corresponding application in the Philippines Patent Office, he may elect to use the special filing procedure. Under this special filing procedure, applicant files his application in the Philippines accompanied by a notice of election to participate in the special procedure; which notice of election contains a certification that the description (excluding references to related applications), claims and drawings are identical to those of the corresponding application originally filed in the United States. The earlier filed application must be fully identified; and, in applications without a claim of priority, a certified copy of the earlier filed U.S. application must be submitted to the Philippines Patent Office. In addition, applicant must also agree that all amendments to his U.S. application will also be made with respect to his application filed in the Philippines.

In the U.S. Patent Office, applicant will regularly file two copies of each amendment, one copy must be marked "Copy for Philippines Patent Office." Upon termination of prosecution the U.S. Patent Office shall remove all copies so marked from the U.S. file and promptly forward the same to the Philippines Patent Office.

Election forms for participation in this special program must be signed in duplicate and simultaneously accompany the application to be filed in the Philippines.

Upon receipt of properly filed notice of election, the Philippines Patent Office will notify the U.S. Patent Office of the election by forwarding one copy of the election forms to the U.S. Patent Office. The Philippines Patent Office will defer action on the Philippines application pending receipt of information as to the disposition of the application by the U.S. Patent Office. If no such information is received by the Philippines Office within a reasonable amount of time from the date of filing in the Philippines, the Philippines Office may, either on its own initiative, or at applicant's request, inquire as to the status of the U.S. application and, if desired, proceed with its own independent examination.

Upon disposal of the application by the U.S. Patent Office, appropriate information will be sent to the Philippines Patent Office which will

include all necessary identifying data, whether allowed or abandoned, notice of allowance, copies of documents cited during examination, a copy of the last office action and, when necessary, any earlier actions which may be included by reference in the last action. The Philippines Office will then make their own complete office action based upon the claims as amended with the U.S. Patent Office, performing whatever checks desired and search for copending interfering applications. Alternatively, the Philippines may request applicant to show cause why the results of the U.S. examination should not be accepted in the Philippines. All avenues of appeal will remain open to the applicant.

Where copending applications are cited and applied during examination in the U.S. Patent Office, full examination will not be forwarded to the Philippines Patent Office, and the fact that a U.S. copending application was cited would be noted as a matter of information, since such references are inapplicable in the Philippines.

Where the application originates in the Philippines Patent Office and is subsequently filed in the U.S. Patent Office, a similar procedure as outlined above consonant with U.S. Law will be followed.

It is believed that this program will facilitate the handling of U.S. origin applications filed in the Republic of the Philippines resulting in a savings in time and expense of prosecution to U.S. applicants.

Election forms for participation in this spe-

cial program are now available from The Foreign Exchange Section, Office of Patent Services.

### 1712 U.S.-Swedish Search Exchange [R-22]

A program for the exchange of search results between the patent offices of Sweden and the United States was initiated in February 1969. The program involves patent applications filed in one country which are subsequently followed by corresponding applications filed in the other.

The program operates as follows:

The applicant files an application in the U.S. Patent Office which then processes the application in the customary manner and in the usual time sequence.

If the applicant later files an application in Sweden claiming the priority of the U.S. application, the Patent Office of Sweden notifies the U.S. Patent Office of this filing by forwarding a request for a list of the references cited by the U.S. Examiner in the first office action on the merits.

Where the application originates in Sweden and is subsequently filed in the U.S. Patent Office, a similar procedure is followed whereby the U.S. Office requests and the Swedish Office supplies a list of references cited by the Swedish examiner.

This program, which involves only the furnishing of listings of references cited, could improve the quality of the patents granted by each office.