

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

U. S. DEPARTMENT OF COMMERCE
Patent Office
Washington, D. C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions regarding Revision No. 36

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

The notation "[R-36]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel, Editor
Manual of Patent Examining Procedure

Particular attention is called to the following sections:

Introduction	Price of "Rules" and "Laws" pamphlets updated. 35 U.S.C. 1 and Rules 351 and 352 added.
201.06	First full paragraph and item 10(c) of Form 54 (modified) revised.
201.11	Ahlbrecht decision cited in paragraph "1".
305.01	Deleted matter covered in Section 804.03.
608.02	Material under "Waiving of Corrections" deleted.
608.02(a)	Processing of form POL-1094 added at end of first paragraph.
608.02(b), (s), (x)	Necessity of correcting drawings upon filing of an appeal added.
608.02(w)	Under item 3, it is no longer required to delete "Fig. 1" when all but one figure have been cancelled.
707.07(d)	Paragraphs under 35 U.S.C. 102 and 103 deleted since they now appear in Section 706.02.

- 713.05 Amended to indicate that only registered attorneys and agents or applicants may conduct interviews.
- 714.01(c) Paragraph added.
- 714.09 Revised to refer to Rule 60.
- 714.13 First paragraph amended to more clearly indicate practice where previous extensions have been granted. Also, hand delivery material is revised.
- 904 Second paragraph on review of prior art in parent applications added.
- 905.02 Second paragraph and last five paragraphs added.
- 1101.02 Fourth paragraph on page 172 added.
- 1208.02 Paragraph under "Supplemental Examiner's Answer" amended to indicate examiner notation on reply brief if no answer will be written.
- 1210 Item 4 amended to include examiner initialing.
- 1306 Rule 314 added.
- 1309 35 U.S.C. 2 and 154 added.
- 1309.01 Completely revised.
- Appendix I "DAA" added.
- Appendix II Completely updated.

All other changes are corrections in matters of clarification, terminology, capitalization or form.

List of replacement pages:

<u>Page No.</u>	<u>Rev. No.</u>	<u>Page No.</u>	<u>Rev. No.</u>
- Title Page	36-36	- 155-156	36-36
- 1-2	36-36	- 157-158	36-36
- 9-10	36-36	- 171-172	36-36
- 10.1-10.2	36-36	- 172.1	36
- 16.1	36	- 175-176	36-36
- 17-18	31-36	- 176.1	36
- 22.1	36	- 181-182	36-36
- 53-54	36-36	- 183-184	36-36
- 57-58	36-36	- 213-214	36-36
- 76.3-76.4	36-36	- 217-218	36-36
- 81-82	36-36	- 218.1	36
- 83-84	36-31	- 227-228	36-36
- 97-98	36-36	- 228.1	36
- 98.1	36	- 247-248	36-36
- 99-100	36-36	- 253-254	36-36
- 102.1-102.2	36-36	- 255-256	36-36
- 102.3	36		

MANUAL OF
**PATENT
EXAMINING
PROCEDURE**

Original Third Edition, dated November 1961

Latest Revision April 1973



U.S. DEPARTMENT OF COMMERCE • PATENT OFFICE

Rev. 36, Apr. 1973

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: Customer Services Division

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 requests for the Manual, replacement pages, notices, and revisions to the Scientific Library.

First Edition, November 1949	Revision 14, October 1967
Revision 1, November 1950	Revision 15, January 1968
Revision 2, December 1951	Revision 16, April 1968
Revision 3, May 1952	Revision 17, July 1968
Second Edition, November 1953	Revision 18, October 1968
Revision 1, April 1955	Revision 19, January 1969
Revision 2, June 1956	Revision 20, April 1969
Revision 3, June 1957	Revision 21, July 1969
Revision 4, July 1958	Revision 22, October 1969
Third Edition, November 1961	Revision 23, January 1970
Revision 1, January 1964	Revision 24, April 1970
Revision 2, November 1964	Revision 25, July 1970
Revision 3, January 1965	Revision 26, October 1970
Revision 4, April 1965	Revision 27, January 1971
Revision 5, July 1965	Revision 28, April 1971
Revision 6, October 1965	Revision 29, July 1971
Revision 7, January 1966	Revision 30, October 1971
Revision 8, April 1966	Revision 31, January 1972
Revision 9, July 1966	Revision 32, April 1972
Revision 10, October 1966	Revision 33, July 1972
Revision 11, January 1967	Revision 34, October 1972
Revision 12, April 1967	Revision 35, January 1973
Revision 13, July 1967	Revision 36, April 1973

Foreword

This Manual is published to provide Patent Office examiners, applicants, attorneys, agents, and representatives of 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 application.

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.

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 Decided by Various Patent Office Officials.....	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 I Partial List of Trademarks.....	247
Appendix II List of Decisions Cited.....	253
Index.....	257

**Checklist of Pages Needed To Form a Complete Set of the Third Edition as of
Revision 34.**

DATES OF REVISIONS 18, 20, 22-26, and 28-34

All pages issued in other revisions have been revised.

<i>Rev. No.</i>	<i>Date</i>	<i>Rev. No.</i>	<i>Date</i>
18	Oct. 1968	28	Apr. 1971
20	Apr. 1969	29	July 1971
22	Oct. 1969	30	Oct. 1971
23	Jan. 1970	31	Jan. 1972
24	Apr. 1970	32	Apr. 1972
25	July 1970	33	July 1972
26	Oct. 1970	34	Oct. 1972

<i>Page</i>	<i>Revision No.</i>	<i>Page</i>	<i>Revision No.</i>
Title Page (2 sides)	34-34	56.1	32
III	33	57-58	29-29
V-VI	34-34	59-60	23-23
VII	34	Chapter 700	
Introduction		61-62	25-25
1-2	22-22	63-64	31-31
Chapter 100		65-66	31-33
3-4	30-30	66.1-66.2	34-34
4.1-4.2	32-32	67-68	34-34
5-6	28-28	69-70	34-34
Chapter 200		70.1-70.2	34-34
7-8	29-29	71-72	34-34
9-10	33-33	72.1-72.2	34-34
10.1-10.2	33-33	73-74	34-32
11-12	24-24	74.1	34
13-14	34-30	75-76	29-34
14.1	34	76.1-76.2	34-34
15-16	31-31	76.3	34
16.1	31	77-78	32-32
17-18	31-31	79-80	34-34
19-20	31-31	81-82	31-31
20.1	31	83-84	31-31
Chapter 300		85-86	31-31
21-22	30-30	87-88	30-30
22.1	30	88.1	32
Chapter 400		89-90	34-34
23-24	30-30	90.1-90.2	34-34
25-26	30-30	90.3	34
27-28	30-30	91-92	26-26
29-30	30-30	93-94	24-24
30.1	30	95-96	24-24
Chapter 500		96.1-96.2	24-24
31-32	28-28	97-98	24-26
32.1-32.2	31-30	98.1	26
32.3	30	99-100	30-30
Chapter 600		101-102	25-25
33-34	29-29	102.1-102.2	25-25
34.1-34.2	29-29	102.3	30
34.3	29	103-104	32-32
35-36	25-25	105-106	32-32
37-38	31-31	106.1	32
38.1	31	107-108	25-25
39-40	29-29	108.1	25
41-42	29-29	109-110	34-29
43-44	29-29	110.1	34
44.1	29	111-112	34-34
45-46	22-22	112.1	34
46.1	32	113-114	25-25
47-48	22-22	115-116	18-11
48.1-48.2	22-22	Chapter 800	
48.3-48.4	29-29	117-118	18-18
49-50	29-29	119-120	34-34
51-52	33-33	120.1-120.2	34-34
52.1	33	121-122	18-18
53-54	29-32	123-124	25-25
55-56	32-32	125-126	25-25
		127-128	34-34
		129-130	18-18
		131	18
		133-134	18-18
		135-136	29-29

Page	Revision No.	Page	Revision No.
Chapter 900		219-220	28-28
137-138	30-30	220.1-220.2	28-28
138.1	30	220.3-220.4	28-28
139-140	30-30	220.5-220.6	34-34
141-142	30-30	220.7	34
143-144	30-30	Chapter 1300	
145-146	34-34	221-222	30-31
147-148	26-26	223-224	30-30
149	26	225-226	31-31
151-152	33-33	226.1	31
152.1	33	227-228	24-24
153-154	32-32	228.1	26
154.1-154.2	32-32	Chapter 1400	
154.3-154.4	32-32	229-230	31-34
155-156	24-24	231-232	31-31
157	33	232.1	31
Chapter 1000		233-234	22-22
159-160	32-32	234.1-234.2	29-29
161-162	32-32	Chapter 1500	
162.1-162.2	32-32	235-236	20-20
162.3	32	237-238	20-20
Chapter 1100		Chapter 1600	
163-164	31-31	239-240	29-30
165-166	33-33	241-242	31-31
166.1	33	Chapter 1700	
167-168	28-28	243-244	32-32
169-170	32-32	244.1	32
171-172	25-25	245-246	34-34
172.1	22	246.1-246.2	34-34
173-174	32-32	246.3	34
174.1	32	Appendix I	
175-176	22-22	247-248	34-34
176.1	22	249-250	34-34
177-178	28-28	251	34
179-180	28-28	Appendix II	
181-182	25-25	253-254	28-28
183-184	25-25	255	28
185-186	25-25	Index	
186.1	31	257-258	33-33
187-188	31-31	259-260	33-33
189	23	261-262	33-33
191-192	omitted	263-264	33-33
193-194	25-25	265-266	33-33
194.1	25	267-268	33-33
195-196	26-26	269-270	33-33
197-198	26-26	271-272	33-33
199-200	23-23	273-274	33-33
201-202	28-28	275-276	33-33
203	25	277-278	33-33
205	23	279-280	33-33
207-208	omitted	281-282	33-33
Chapter 1200		283-284	33-33
209-210	32-32	285-286	33-33
211-212	32-32	287-288	33-33
213-214	30-30	289-290	33-33
214.1	30	291-292	33-33
215-216	31-28	293	33
216.1	28		
217-218	30-32		
218.1	30		

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 provision of the Constitution, Congress has over the years 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.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. 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 96 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 patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents for 75 cents) reprints the patent code and some additional statutes.

35 U.S.C. 1 Establishment. The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents, subject to the approval of the Secretary of Commerce, to establish regula-

tions, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rule 351. Amendments to rules will be published. All amendments to these rules will be published in the Official Gazette and in the Federal Register.

Rule 352. Publication of notice of proposed amendments. (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments to these rules will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

These rules are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases" (available from the Superintendent of Documents for \$3.50). These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. 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. 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 other Office Officials 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. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that por-

tion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in rules 181 and 191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.