Chapter 1300 Allowance and Issue

1301 Substantially Allowable Case, Special

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action taken to require correction of formal matters. See § 710.02(b).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole case meets all formal requirements and particularly that the brief summary of the invention and the descriptive matter are confined to the invention to which the allowed claims are directed and that the language of the claims finds clear support or antecedent basis in the specification. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the examiner should require the applicant to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (rule 1.71.) Of course enough background should be included to make the invention clearly understandable. See §§ 608.01(d) and 608.01(e).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See § 601.01(o).

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or become abandoned and that fact or the patent number added to the specification.

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The claims should be renumbered as required by 37 CFR 1.126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. An examiner's amendment should be prepared if the order of the claims is changed. See §§ 608.-01(j), 608.01(n) and 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosure. See § 608.01(b).

The title should also be checked. It should be as short and specific as possible. If a satisfactory title is not supplied by the applicant. the examiner may change the title on or after allowance. See §§ 606 and 606.01.

All pencil notes made by the examiner must be erased when the case is passed to issue.

The Mail Room receipt date of all amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the case to issue. See 37 CFR 1.125 in § 608.01(q).

1302.03 Status Letter of Allowability, POL–327

Form PTOL–327 is used whenever an application has been placed in condition for allowance as a result of a communication from or an interview with applicant except where an examiner's amendment will be mailed promptly.

The date of the communication or interview which resulted in the allowance and the name of the person with whom the interview, if any, was held should be included in the letter.

Immediately after determining that a PTOL 327 letter or examiner's amendment is necessary, it should be prepared and mailed before preparing the application for allowance. See § 714.13.

1302.04 Examiner's Amendments and Changes

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See 37 CFR 1.121.)

Correction of the following obvious errors and omissions only may be made with pen by the examiner of the case who will then initial the sheet margin and assume full responsibility for the change. When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.
5. Entry of "Patent No. ____" to identify a patent which has been granted on a U.S. application referred to by serial number in the specification.
6. Entry of ", abandoned", if a U.S. patent application referred to by serial number in the specification has become abandoned.
7. Entry of ", now Defensive Publication No. T ____," following the filing date if a patent application referred to in the specification by serial number has been published as a Defensive Publication.
8. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
9. Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

The fact that applicant is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Serial No. ____, filed _____." should appear as the first sentence after the abstract except in the case of design applications where it should appear as set forth in § 1503.01. Any such statements appearing elsewhere in the specification should be relocated. The clerk indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

Other obvious informalities in the application may be corrected by the examiner, but such corrections must be by a formal examiner's amendment, signed by the primary examiner, placed in the file, and a copy sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his attorney or agent) in a telephone or personal interview. The examiner's amendment

should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts under special conditions. Such charges must not exceed $50.00 for any one patent application.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to expedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (drawing correction, additional claims, etc.), and the deposit account number. Further identifying data, if deemed necessary and requested by the attorney, should also be included in the examiner's amendment.

A change in the abstract may be made by examiner's amendment.

Where a reference to the parent application in an otherwise allowable §1.60 case has inadvertently been omitted by the applicant, the examiner should insert the required reference by examiner's amendment (see § 201.11).

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PTO–892, a copy of which will be attached to examiner's amendment form PTOL–37.

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will note in pencil on the drawing the addition or alteration to be made. The examiner will also prepare an examiner's amendment indicating the changes made and send the drawing to the Draftsman for the required correction.

See also § 608.02(w).

No other changes may be made by any person in any record of the Patent and Trademark Office without the written approval of the Commissioner of Patents and Trademarks.

In reviewing the application all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time a case is being prepared for issue by the examiner. However, the need for such may not be noted until after the proof of the patent is read and the case is sent up to the examiner with a "printer waiting" slip (Form PTO–97). A copy of any formal examiner's amendment is sent to applicant even if the application is already in the printer's hands. See § 1309.01.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed, In re Willingham, 127 USPQ 211 (CCPA 1960).

In all instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of form letter PTOL–327 or an examiner's amendment.

If after reviewing, screening or surveying an allowed application in the Office of Quality Review, an error or omission of the type noted in items 1 through 9 under the second paragraph above is noted, the error or omission may be corrected by the Patentability Review Examiner in the same manner as set forth in the second paragraph. Since all other obvious informalities may only be corrected by a formal examiner's amendment, if the Office of Quality Review discovers any such informality, the Patentability Review Examiner will return the application to the Group examining personnel via the Group Director suggesting, as appropriate, specific changes for approval and correction by the Examiner through the use of an Examiner's amendment. [R–5]

1302.04(a) Title of Invention

Where the title of the invention is not specific to the invention as claimed, see § 606.01.

1302.04(b) Cancellation of Non-Statutory Claim

When a case is otherwise in condition for allowance the examiner may cancel an obviously non-statutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Non-Elected Invention

See §§ 821.01 and 821.02.

1302.04(d) Cancellation of Claim Lost in Interference

See § 1109.02.

1302.04(e) Cancellation of Rejected Claims Following Appeal

See §§ 1214.06, 1215.03, and 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date

Where a patent application which is ready for issue refers by serial number to a U.S. application which has matured into a patent, the examiner is authorized to enter the patent number without a formal examiner's amendment. This entry should be in the following form: ", Patent No. ____." Where a referred to patent application has been published as a Defensive Publication, the examiner should enter ", now Defensive Publication No. T——, ——" following the filing date. They entry is to be initialed and dated in the margin by the examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the application referred to has become abandoned, the entry ", abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

1302.04(g) Identification of Claims

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

1302.05 Correction of Drawing

Where a case otherwise ready for issue requires correction of the drawing, the examiner should send revised issues to the Patent Issue Division without having the drawing corrections made beforehand. The Patent Issue Division will send the drawings to the draftsman after the Notice of Allowance has been sent. Since the Drafting Division sends out a print of any correction, the applicant can check to see that the correction was properly made.

The procedure is as follows:

1. The drawing correction letter, APPROVED BY THE EXAMINER, should be stapled to the inside of the front page of the file (over the index of claims).

2. A yellow tag should be attached to the file so it sticks out the top.

3. The application forwarded to Quality Review as a normal revision.

Slight defects may be corrected on the examiner's initiative as set forth in § 608.02(w) and a formal examiner's amendment prepared.

Correction of some slight defects may be obviated, see § 608.02—"Waiving of Corrections".

1302.05(a) Original Drawings Cannot be Located [R–5]

When the original drawings cannot be located and the application is otherwise in condition for allowance, no "Official Search" need be undertaken. The examining group should check its own area and attempt to obtain the drawing from abandoned files. If the drawing cannot be located, a yellow tag should be placed on the application to flag it as having a drawing problem. A memorandum as outlined below should be stapled to the outside of the file when forwarding it to the Patent Issue Division.

Memorandum

Serial No. _____

Date forwarded _____

ATTENTION PATENT ISSUE DIVISION, DRAWING MISSING

I have attempted to locate the drawing in this application without success. The drawing cannot be located in the examining group. (The drawing cannot be obtained from Abandoned Files.)

Issue Revision Clerk

Print O.G. Fig._____

Class _____

Subclass _____

1302.06 Prior Foreign Application

See §§ 201.14(c) and 202.03.

1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications

Related applications referred to in patent specifications are preserved from destruction by a retention label (Form PTO–150) which is attached to the outside of the file wrapper. The final review clerk of the group prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath or declaration of the application ready for allowance (or in any Office letter therein).

If the case referred to is

Still pending:

Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

Abandoned for failure to pay issue fee:

If file has been forwarded to abandoned files, fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded, treat the same as pending case.

Abandoned:

If file has been forwarded to the abandoned File Unit, fill in label and send it to

Abandoned Files Unit for attachment to the wrapper. If not forwarded, treat the same as pending case. Add ", abandoned" by red ink and initialing to the allowable application.

Already patented:

No label is required. Insert patent number in specification if not already present. Formal examiner's amendment not necessary if this is only change.

In issue:

Fill in label. Make no change in the specification of the allowable application. Clip the label to the serial register card of the case in issue. If case in issue is abandoned or is withdrawn from issue, it is returned to the group, where the serial register card is pulled. The label is attached at this time. If case in issue is patented, the label is destroyed when the card is pulled.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the serial number cited thereon.

→ 13002.08 Interference Search [R–5]

Assuming that the case is found ready for issue, the examiner makes an "interference search" and notes the date and class and subclasses searched in the file wrapper. To do this, the examiner inspects all the pending prints and drawings (or all the digests if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, → whether in his or her group or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, the corresponding file is reviewed.

Note also § 1101.01(c)

If the search does not disclose any interfering application, the examiner should prepare the case for issue.

An interference search may be required in Group 220. Inspection of pertinent prints, drawings, brief cards and applications in Group 220 will be done on request by an examiner in Group 220.

1302.09 Notations on File Wrapper [R–4]

The examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid the Patent Issue Division and the printers, examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral should be distinct and any decimal point should be shown clearly and in its proper position.

Spaces are provided on the file wrapper for identifying data of a prior abandoned application for which the instant application is a Substitute, and for the parent application(s) and prior foreign application(s).

The class and subclass and the name of the examiner which are written in pencil on the file wrapper should correspond to the class and subclass in which the patent will issue and to the name of the examiner preparing the application for issue.

See § 202.02 for notation as to parent or prior U.S. application to be placed on file wrapper.

See § 202.03 for notation as to foreign patent application to be placed on file wrapper.

See § 1302.13 for name of examiner.

Examiners, when preparing an application for issue, are to record the number of the claim selected for printing in the Official Gazette in the box labeled "PRINT CLAIM(S):" on the inside left flap of the file wrapper above the "Index of Claims".

The claim or claims should be selected in accordance with the following instructions:

1. The broadest claim should be selected.

2. Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.

3. A dependent claim should not be selected unless the independent claim on which it depends is also printed. In the case of where a multiple dependent claim is selected, the entire chain of claims for one embodiment should be listed.

4. In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

1. Write the claim number clearly in black ink.

2. If multiple claims are selected, the claim numbers should be separated by commas.

3. The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number.

1302.10 Notations on Drawings and on Classification (Issue) Slip [R–4]

On the margin of the first sheet of drawing, the examiner indicates in black ink in the spaces provided by the Draftsman's stamp the figure to be printed in the Official Gazette and also the final official classification of the case. Ordinarily a single figure is selected for printing. This figure should be consistent with the claim to be printed in the Official Gazette. The numerals should fill as much of the space provided as feasible.

If the selected figure is not on the first sheet, the examiner should indicate it also on the sheet where it does appear. If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written after "O.G. Fig." If, through inadvertence, the stamped legend for O.G. Fig. and class and subclass appears within the margin of the drawing, the examiner, should make the notations *outside* of the margin.

Under current practice, the clerk of the examining group does NOT enter any date when the case is "sent to issue". See §§ 903.07, 903.07(b) and 903.09 for notation to be applied to the Issue Classification Slip (Form PTO–270).

In all reissue applications, the number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name.

To ensure that both copies of the slip do not become separated from the file, examiners should affix the entire unit set to the inside left flap of the file wrapper by stapling it in the area above the perforation. It is not necessary to remove the carbon paper.

The Allowed Files Unit of the Patent Issue Division remove the original for use by Machine Operations Branch and leave the carbon copy in the file for use by the printer.

1302.11 Reference to Assignment Division

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See § 303.

1302.12 Listing of References [R–5]

All references which have been cited by the examiner during the prosecution, including those appearing in Board of Appeals decisions, and those submitted by applicant if they conform to the requirements set forth in §§ 707.05 (b) or 708.02, or are listed in the reissue oath must be listed on either a form PTO–892 or PTO–1449. All such reference citations will be printed in the patent.

At time of allowance, the examiner may cite pertinent art in an examiner's amendment. Such pertinent art should be listed as usual on form PTO–892, a copy of which is attached to the examiner's amendment form PTOL–37. Such pertinent art is not sent to the applicant. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See §§ 707.05 and 707.05(a).

When preparing an application for allowance, the "final review" clerk will verify that there is at least one list of references (PTO–892) in the application. All lists of references are maintained in the center section of the file wrapper.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which were pertinent to any motions to dissolve and which were discussed in the decision on motion.

In any case, otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner's amendment. See § 707.05(g).

Any new reference cited when the case is in issue, under the practice of § 1308.01, should be added by way of a PTO–892.

All copies of references placed in the file wrapper during prosecution, should be retained therein, when the allowed application is forwarded to the Patent Issue Division.

1302.13 Signing

The primary examiner and the assistant examiner involved in the allowance of an application will print or stamp their names on the file wrapper in place of their signatures. Each examiner shall place his initials after his printed or stamped name. A primary examiner who prepares an application for issue prints or stamps his or her name and initials the file wrapper *only* in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the primary examiner and the assistant examiner appearing on the face of

the application file wrapper will be listed in the printed patent.

1302.14 Reasons for Allowance

37 CFR 1.109 Reasons for allowance. If the examiner believes that the record of the prosecution as a whole does not make clear his reasons for allowing a claim or claims, the examiner may set forth such reasoning. This shall be incorporated into an Office action rejecting other claims of the application or be the subject of a separate communication to the applicant. The applicant may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant agrees with or acquiesces in the reasoning of the examiner.

Reasons for Allowance

One of the primary purposes of Section 1.109 is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new and the rule merely formalizes the examiner's existing authority to do so and provides applicants an opportunity to comment upon any such statement of the examiner.

It should be noted that the setting forth reasons for allowance is not mandatory on the

examiner's part. However, in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his responsibility to the public, to see that the file history is as complete as is reasonably possible.

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.

In determining whether reasons for allowance should be recorded the primary consideration lies in the first sentence of § 1.109 which states:

> "If the examiner believes that the record of the prosecution *as a whole* does not make clear his reasons for allowing a claim or claims, the examiner may set forth such reasoning." (Emphasis added).

In most cases the examiner's actions and the applicant's responses make evident the reasons for allowance, satisfying the "record as a whole" proviso of the rule. This is particularly true when applicant fully complies with 37 CFR 1.111 (b) and (c), 37 CFR 1.119 and 37 CFR 1.133(b). Thus where the examiner's actions clearly point out the reasons for rejection and the applicant's response explicitly represents reasons why claims are patentable over the reference, the reasons for allowance are in all probability evident from the record and no statement should be necessary. Conversely, where the record is not explicit as to reasons, but allowance is in order, then a logical extension of 37 CFR 1.111, 1.119 and 1.133 would dictate that the examiner should make reasons of record and such reasons should be specific.

Examiners should give particular attention to whether an application file reasonably indicates the reasons for allowance when the application is being allowed in the first Office action, especially if prior art made of record in the file is very close to the claims; when an examiner withdraws a rejection for reasons not suggested by the applicant; when an applicant submits several arguments for allowing a claim and the examiner finds not all of them persuasive; and when the examiner allows a claim after remand from the Board of Appeals.

Where specific reasons are recorded by the examiner, care must be taken to insure that such reasons are accurate, precise and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his statement that may be made and its possible estoppel effects. Each statement should include at least: (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth.

Under the rule, the examiner must make a judgment of the individual record to determine whether or not reasons for allowance should be set out in that record. These guidelines, then, are intended to aid the examiner in making that judgment. They comprise illustrative examples as to applicability and appropriate content. They are not intended to be exhaustive.

EXAMPLES OF WHEN IT IS LIKELY THAT A STATEMENT SHOULD BE ADDED TO THE RECORD

1. Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits presented and a statement is necessary to identify which of these were persuasive, for example:

   a. When the arguments are presented in an appeal brief.

   b. When the arguments are presented in an ordinary response, with or without amendment of claims.

   c. When both an affidavit under 37 CFR 1.131 and arguments concerning rejections under 35 U.S.C. 102 and 103 are presented.

2. First action issue:

   a. Of a non-continuing application, wherein the claims are very close to the cited prior art and the differences have not been discussed elsewhere.

   b. Of continuing applications, wherein reasons for allowance are not apparent from the record in the parent case or clear from preliminary filed matters.

3. Withdrawal of a rejection for reasons not suggested by applicant, for example:

   a. As a result of an appeal conference.

   b. When applicant's arguments have been misdirected or are not persuasive alone and the examiner comes to realize that a more cogent argument is available.

   c. When claims are amended to avoid a rejection under 35 U.S.C. 102, but arguments (if any) fail to address the question of obviousness.

4. Allowance after remand from the Board of Appeals.

5. Allowance coincident with the citation of newly found references that are very close to

the claims, but claims are considered patentable thereover:

a. When reference is found and cited (but not argued) by applicant.

b. When reference is found and cited by examiner.

6. Where the reasons for allowance *are* of record but in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them.

7. Allowance based on claim interpretation which might not be readily apparent, for example:

a. Article claims in which method limitations impart patentability.

b. Method claims in which article limitations impart patentability.

c. Claim is so drafted that "non-analogous" art is not applicable.

d. Preamble or functional language "breathes life" into claim.

EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

1. The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant's second affidavit, in example 5 shows unexpected results from this restricted range.

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2. During two telephonic interviews with applicant's attorney, Mr. _____ on 5/6 and 5/10/77, the examiner stated that applicant's remarks about the placement of the primary teaching's grid member were persuasive, but he pointed out that applicant did not claim the member as being within the reactor. Thus, an amendment doing such was agreed to.

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3. The instant application is deemed to be directed to an unobvious improvement over the invention patented in Pat. No. 3,953,224. The improvement comprises baffle means *12* whose effective length in the extraction tower may be varied so as to optimize and to control the extraction process.

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4. Upon reconsideration, this application has been awarded the effective filing date of S.N. _____. Thus the repection under 35 USC 102(d) and 103 over Belgium Patent No. 757,246 is withdrawn.

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5. The specific limitation as to the pressure used during compression was agreed to during the telephone interview with applicant's attorney. During said interview, it was noted that applicants contended in their amendment that a process of the combined applied teachings could not result in a successful article within the amended pressure range. The examiner agreed to rely on this statement (see page 3, bottom, of applicant's amendment), and the case was allowed.

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6. In the examiner's opinion, it would not be obvious to a person of ordinary skill in the art first to eliminate one of top members 4, second to eliminate plate 3, third to attach remaining member 4 directly to tube 2 and finally to substitute this modified handle for the handle 20 of Nania (see Fig. 1) especially in view of applicant's use of term "consisting".

EXAMPLES OF STATEMENTS THAT ARE NOT SUITABLE AS TO CONTENT

1. The 3 roll press couple has an upper roll 36 which is swingably adjustable to vary the pressure selectively against either of the two lower rolls. (NOTE: The significance of this statement may not be clear if no further explanation is given.)

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2. The main reasons for allowance of these claims are applicant's remarks in the appeal brief and an agreement reached in the appeals conference.

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3. The instant composition is a precursor in the manufacture of melamine resins. A thorough search of the prior art did not bring forth any compositions which corresponds to the instant compositions. The examiner in the art also did not know of any art which could be used against the instant composition.

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4. Claims 1–6 have been allowed because they are believed to be both novel and unobvious.

The examiner should *not* include in his statement any matter which does not relate directly to the reasons for allowance. For example:

5. Claims 1 and 2 are allowed because they are patentable over the prior art. If applicants are aware of better art than that which has been cited, they are required to call such to the attention of the examiner.

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6. The reference Jones discloses and claims an invention similar to applicant's. However, a

comparison of the claims, as set forth below, demonstrates the conclusion that the inventions are noninterfering.

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases the examine should (a) check box 6 on the form PTOL–327 marked "other" and indicate "see attached statement of reasons for allowance", and (b) attach thereto a separate form containing the examiner's statement of reasons for allowance. The same general procedure will be followed in connection with an examiner's amendment (PTOL–37) by indicating thereon "see attached statement of reasons for allowance" and attaching thereto the form containing the reasons for allowance. Such a statement should be either typewritten or neatly and legibly handwritten. The form should identify the application serial number and be clearly labeled "Statement of Reasons for Allowance". It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee. Such comments will be entered in the application file by the Allowed Files Branch with an appropriate notation on the "Contents" list on the file wrapper.

In due course PTOL–327 and PTOL–37 will be revised and a new "Statement of Reasons for Allowance" form developed for attachment to the PTOL–327. "Statement of Reasons for Allowance" forms will be provided for use by examiners.

A statement may be sent applicant with other communications where appropriate but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the other data indicated above.

Examiners are expected to prepare any statement of their reasons for allowance accurately and precisely so as not to place unwarranted interpretations, whether broad or narrow, on the claims. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation _____ in all the claims which is not found in the prior art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's responses make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Finally, comments made by applicants on the examiner's statement of reasons for allowance will not be returned to the examiner after their entry in the file and will not be commented upon by the examiner.

1303 Notice of Allowance [R–2]

37 CFR 1.311. Notice of allowance. If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of a specified sum constituting the issue fee or a portion thereof, which shall be paid within three months from the date of the notice of allowance.

The appropriate form of notice of allowance is prepared and mailed, and the mailing date appearing thereon is stamped on the file wrapper.

1303.01 Amendment Received After Allowance

If the amendment is filed under 37 CFR 1.312, see §§ 714.15 to 714.16(e). If the amendment contains claims copied from a patent, see § 1101.02(g).

Issue Batch Number

All papers filed by applicant in the Office after receiving the Notice of Allowance and before the time the Issue Fee Receipt is received should include the Issue Batch Number. The Issue Batch Number is printed on the Notice of Allowance form in box 4 in the lower left hand corner below the address. The Issue Batch Number consists of a capital letter followed by two digits, for example; "AO3", "D18", "F42", "J79". Any lower case letters before the Issue Batch Number should be ignored since they are the typist's initials. Use of the Issue Batch Numbers is important since the allowed applications are filed by these numbers.

Any paper filed after receiving the Issue Fee Receipt should include the indicated patent number rather than the Issue Batch Number. At this time in the processing, the Issue Batch Number is no longer useful since the application

has been removed from the batch at the time the patent number was assigned.

1303.02 Undelivered

In case a notice of allowance is returned, and a new notice is sent (see § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing.

1303.03 Not Withheld Due to Death of Inventor

The notice of allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See § 409.01(f).

1304 Amendments After D–10 Notice

"Secrecy Order" cases are not sent to issue even when all of the claims have been allowed. Instead of mailing an ordinary notice of allowance a D–10 Notice is sent. See § 107.02.

If the "Secrecy Order" in a case is withdrawn after the D–10 notice is mailed, the case should then be treated like an ordinary application in condition for allowance.

1304.01 Withholding From Issue of "Secrecy Order" Cases

For amendments received after D–10 Notice, see § 107.02.

→ 1305 Jurisdiction [R–2]

Jurisdiction of the application remains with the primary examiner until the notice of allowance is mailed. However, the examiner may make examiner's amendments correcting obvious errors, as, when brought to the attention of the examiner by the printer, and also may admit amendments under 37 CFR 1.312 which are confined to matters of form in specification or claims, or to the cancellation of a claim or claims. The examiner's action on other amendments under § 1.312 consists of a recommendation to the Commissioner.

To regain jurisdiction over the case, the examiner must write a letter to the Commissioner requesting it. See §§ 1112.04, 1308, and 1308.02.

Once the patent has been granted, the Patent and Trademark Office can take no action concerning it except as provided in 35 U.S.C. 135 and 35 U.S.C. 251 through 256. See chapter 1400.

1306 Issue Fee

35 U.S.C. 41 (a) 2. For issuing each original or reissue patent, except in design cases, $100; in addition, $10 for each page (or portion thereof) of specification as printed, and $2 for each sheet of drawing.

35 U.S.C. 151. If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

37 CFR 1.314. Issuance of patent. If payment of the issue fee or that portion thereof specified in the notice of allowance is timely made, the patent will issue in regular course.

The Office has discontinued the practice of estimating the number of printed pages of specification in advance of printing. Instead, a Base Issue Fee is due three months from the date of the Notice of Allowance. The amount of the Base Issue Fee is shown on the Notice of Allowance and consists of $100 plus $10 for the first page of printed specification plus $2 for each sheet of drawing.

The Office calculates the balance of issue fee due, after payment of the Base Issue Fee specified by the Notice of Allowance, at the rate of $10 a page, as provided in 35 U.S.C. 41, for each printed page of specification (including claims) for which payment has not previously been received. As the Base Issue Fee includes a $10 charge for one printed page of specification, a Balance of Issue Fee is due for each patent which consists of more than one printed page. A "page" consists of one side of a printed sheet containing any amount of specification (including claims). A notification of the Balance of Issue Fee Due is mailed in each such case along with the original patent grant.

Applicants and their attorneys or agents are urged to use the special fee transmittal forms provided with the Notice of Allowance and the Notice of Balance of Issue Fee Due when submitting their payments.

The payment of the balance of issue fee due may be simplified by using a Patent and Trademark Office Deposit Account for such a fee. A statement, in duplicate, at the time of payment of the minimum issue fee, indicating that applicant's or attorney's Deposit Account may be billed for the balance of the issue fee will be considered as sufficient authorization to make such a payment.

The above mentioned fees will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34(a).

1307 Change in Classification of Cases Which Are in Issue

See § 903.07

1308 Withdrawal From Issue [R–2]

37 CFR 1.313. Withdrawal from issue. (a) After the notice of allowance of an application is sent, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed.

(b) When the issue fee or that portion thereof specified in the notice of allowance has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue on account of any mistake or change of purpose of the applicant, his attorney or his agent, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference.

If the applicant wishes to have the case withdrawn from issue, he or she must petition the Commissioner. Withdrawal is permitted only for the reasons stated in the rule. For withdrawal procedure by examiner see § 1308.01.

1308.01 Rejection After Allowance

A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. See § 706.04.

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, and where a sufficient portion of the statutory period for payment of the issue fee remains, the examiner is authorized to enter a letter informing applicant of the proposal of requesting withdrawal from issue for the purpose of rejecting the claim or claims as fully met by, or obviously unpatentable over the new reference. The letter should apply the reference in detail and should also set a time limit (within such statutory period), within which applicant may respond by way of argument or amendment under 37 CFR 1.312 to overcome the reference and avoid the necessity for withdrawal from issue. Such a letter, with the reference and file, should be submitted to the group director before mailing. After the letter is mailed, the file wrapper should be retained by the examiner to prevent inadvertent issuance of the patent.

If insufficient time remains to carry out the above, or if no response is received, or if a response is filed and it fails to overcome the reference, or if the above appears fruitless, a letter is addressed to the group director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. The letter should be submitted with the reference and the file wrapper. Upon approval of this request, the letter is taken to the Patent Issue Division and the application is stamped "Withdrawn" over the name stamp and initials of the primary examiner. It is then returned to the group from which it came; the withdrawal from the issue is entered on the register, and the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The letter is given a paper number and placed in the file.

If the examiner's proposed action is not approved, the letter requesting withdrawal from issue should not be placed in the file.

1308.02 For Interference Purposes

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed see §§ 1101.01(o) and 1112.04.

1308.03 Quality Review Program for Examined Patent Applications [R–5]

The Office of Quality Review administers a program for reviewing the quality of the examination of patent applications.

The purpose of the program is to evaluate and continuously monitor the quality of the product of the patent examining process and to assist in determining where substantive and

procedural adjustments in the patent examination process are appropriate.

The quality review is conducted by Patentability Review Examiners on a randomly selected sample of 4% of the allowed applications from each Art Unit. The sample is computer generated under the office-wide computer system (PALM III). The quality review is concerned with three major aspects of the patent examining process, namely:

(1) patentability of the allowed claims in view of the prior art of record or other reasons determined by the Review Examiners;
(2) compliance with current examining practices and procedures; and
(3) correctness of the field of search and the classification of each application.

The Quality Review Program also provides for researching of some of the allowed applications in the sample.

If, during the quality review process, it is determined that one or more claims of a reviewed application are clearly unpatentable, the prosecution of the application will be reopened. Only those applications wherein the prosecution has been reopened will reflect in the record that a quality review has taken place.

When prosecution is reopened as a result of quality review determination that at least one claim is clearly unpatentable, the examiner who reopens the prosecution must include with the reopening Office Action a copy of the Patentability Review form, "Quality Review—Part II". No other Quality Review forms or papers should be included. The Office action must be consistent with and include the substance of the position set forth in the Quality Review form and must not present any comments reflecting disagreement with that position. However, no non-supervisory primary examiner will be required to reopen prosecution in an application in which he or she strongly disagrees with the decision of the reviewers. In such a situation, the application will be transferred to another examiner.

In any application where prosecution is reopened as a result of the patentability aspect of the quality review, the Office action should contain an opening paragraph such as:

"Pursuant to a Quality Review of this application, prosecution is reopened on claims _____ which are considered unpatentable for the reasons indicated below:"

When the Office action includes a rejection of *claims in addition* to the claims in the Patentability Review form, the action should contain not only the above quoted paragraph, but also a second paragraph such as:

"In addition, on further consideration of the claims in this application, prosecution is also reopened on claims _____ which are considered unpatentable for the reasons set forth below:"

Whenever an application has been returned to the Group under the Quality Review Program, the Group should promptly decide what action is to be taken in the application and inform the Office of Quality Review of the nature of that action by use of the appropriate form.

1309 Issue of Patent [R–5]

The files of allowed cases (not patented files) are kept in the Patent Issue Division, arranged in the batch number order. When the Issue fee is paid within the time allowed by law, the file is given a patent number and date, after which it is sent for printing of the specification. A bond paper copy of the drawing and specification is ribboned and sealed in the Patent Issue Division and finally signed.

See § 1303.01 for explanation of "Issue Batch Number."

Patent Printing Priority

The applications placed in the weekly formulation of an issue set aside for printing will be selected according to the following priorities:

1. Allowed cases which were made special by the Commissioner (including those under the Special Examining Procedure).
2. Allowed cases that have a U.S. effective filing date more than five years old.
3. Allowed reissue applications.
4. Allowed applications having an effective filing date earlier than that required for declaring an interference with a copending application claiming the same subject matter.
5. Allowed application of a party involved in a terminated interference.
6. Allowed applications in which the applicant has filed a request in the nature of a petition setting forth reasons for advancing the printing date.
7. Allowed applications ready for printing and not covered by any of the six preceding categories. The selection of cases in the involved category will be by chronological sequence based on the date the issue fee was paid.

To ensure that any application falling within the scope of the categories outlined above and identified by numbers 1 to 5 receives special treatment the examiners should staple on the file wrapper a tag entitled "Special in Patent Issue Division." The special tag, PTO–

1101, may be obtained from the group clerk. The examiner shall print directly on the tag the recitation "In Patent Issue Division" and the appropriate printing category outlined above. The application is then forwarded to Patent Issue Division.

The personnel in Patent Issue Division will then set the tagged cases aside and make a notation that further processing of this application will be "special." ←

In cases falling in category No. 6, the request must be filed after the Notice of Allowance has

been received and no later than the date the issue fee is paid. The request must be directed to the Head of the Patent Issue Division.

35 U.S.C. 2. Seal. The Patent and Trademark Office shall have a seal with which letters patent, certificates of trademark registrations, and papers issued from the Office shall be authenticated.

35 U.S.C. 153. How issued. Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent and Trademark Office.

35 U.S.C. 154. Contents and term of patent. Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Printing Practitioners' Names on Patents

The Office has adopted the following procedure for printing a firm name, the names of up to three registered patent practitioners, or no practitioner's name on the patent.

The Notice of Allowance form, PTOL–85, has been redesigned in part to provide a space on PTOL–85*b*, the Base Issue Fee Transmittal form, for the person submitting the base issue fee to indicate, for printing, the names of up to three registered patent attorneys and agents or, alternatively, the name of a single firm which has as a member at least one registered patent attorney or agent. If the person submitting the base issue fee desires that no practitioner's name be printed on the patent, the space provided on the revised Base Issue Fee Transmittal form should be left blank. If no name is given, no name will be printed.

This procedure is intended to solve various problems encountered since the practice of recognizing firms was discontinued. While some slight additional effort on the part of the attorney or agent is thus involved if he or she desires to have a printed entry on the patent, the following advantages are provided by the new procedure: (1) it permits printing firm names on patents even though firms are no longer registered with or recognized by the Office in new applications; (2) it allows the names of those individuals who actually performed the work of preparing and prosecuting the application to appear on the printed patent; and (3) it grants an attorney or agent the option of not having his name appear on the printed patent.

Assignment Printed on Patent

The Issue Fee Transmittal Form portion (PTOL–85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with 37 CFR 1.334. Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form PTOL–85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of PTOL–85b will not be granted as a matter of course and will be subject to adherence to all the requirements of 37 CFR 1.323.

Assignee Names

Only the first appearing name of an assignee will be printed on the patent where multiple names for the *same* party are identified on the Base Issue Fee Transmittal form, PTOL–85b. Such multiple names may occur when both a legal name and an "also known as" or "doing business as" name is also included. This printing practice will not, however, affect the practice of recording assignments with the Office in the Assignment Division. The assignee entry on form PTOL–85b should still be completed to indicate the assignment data as recorded in the Office. For example, the assignment filed in the Office and therefore the PTOL–85b assignee entry might read "Smith Company doing business as (d.b.a.) Jones Company." The assignee entry on the printed patent will read "Smith Company."

Various officials including the head of the Patent Issue Division have been designated as attesting officers to attest to the name of the Commissioner. The assistant head of the Patent Issue Division acts as attesting officer in the absence or unavailability of the head of the Division.

1309.01 "Printer Waiting" Cases

When the printer finds an apparent error in an application, the file is returned to the Office with an attached "Printer Waiting" slip noting the supposed error.

The Patent Issue Division forwards such "printer waiting" applications to the Office of Quality Review (OQR) at periodic intervals throughout each working day. The applications are recorded in OQR for control purposes and then hand carried by a messenger

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from OQR with a control list to the group director's secretary. The secretary acts as a control center in each examining group and forwards the applications to the examiner by the appropriate route. The application should be taken up and acted on immediately and returned to the group director's secretary within 24 hours (excluding weekends and holidays). Either necessary corrective action should be taken or an indication should be made that the application is considered to be correct as it stands.

If the examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by examiners' amendment. See § 1302.04.

If the required correction cannot be cured by examiner's amendment, the application may have to be withdrawn from issue. This may sometimes be avoided if the applicant or his representative is telephoned immediately, and the error is corrected by amendment under 37 CFR 1.312.

The applications are picked up from the secretary's office by the messenger from OQR and returned to OQR for processing and then returned to the Patent Issue Division for forwarding to the printer. THESE APPLICATIONS SHOULD NOT BE MAILED TO THE PATENT ISSUE DIVISION OR TO THE OQR.