

**Manual of
PATENT
EXAMINING
PROCEDURE**

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

MANUAL OF PATENT EXAMINING PROCEDURE
Fifth Edition

Instructions Regarding Revision No. 15

This revision consists of replacement pages for the title page in the front of the Manual, the Table of Contents, entire Chapters 300, 400, 1000, 1300, 1800, Appendix L (Patent Laws), Appendix R (Patent Rules), entire Index, and portions of Chapters 200, 600, 700, 900, 1100, 1200, 1400, 2100 and 2300. A new Chapter 2400 - Biotechnology has been added.

Pages which have been printed in this revision are labeled as "Rev. 15" on the bottom. Sections of the Manual which have been changed by this revision are indicated by "[R-15]" after the section title.

With the exception of Chapter 1800, which has been completely rewritten, and Chapter 2400, which is newly added, additions to the text of the chapters in the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule which was not reproduced.

J. Michael Thesz, Editor
Manual of Patent Examining Procedure

Magdalen Y.C. Greenlief
Special Program Examiner

Remove PageInsert Pages

[NOTE: PARTIAL CHAPTERS ARE IN BOLD PRINT]

Title page
Table of Contents

Title page
Table of Contents

200-1 through 200-18

200-1 through 200-18

300-1 through 300-6
400-1 through 400-12

300-1 through 300-10
400-1 through 400-12

600-19 through 600-20
600-39 through 600-44
700-11 through 700-14
700-27 through 700-30
700-85 through 700-90
900-29 through 900-32

600-19 through 600-20
600-39 through 600-44.1
700-11 through 700-14
700-27 through 700-30
700-85 through 700-90
900-29 through 900-32

1000-1 through 1000-10

1000-1 through 1000-8

1100-15 through 1100-16
1200-25 through 1200-26

1100-15 through 1100-16
1200-25 through 1200-26

1300-1 through 1300-14

1300-1 through 1300-14

1400-19 through 1400-20

1400-19 through 1400-20

1800-1 through 1800-127

1800-1 through 1800-110

2100-19 through 2100-26
2300-21 through 2300-24
2300-45 through 2300-48

2100-19 through 2100-26
2300-21 through 2300-24
2300-45 through 2300-48

New Chapter

2400-1 through 2400-38

L-1 through L-46
R-1 through R-160
I-1 through I-68

L-1 through L-46
R-1 through R-162
I-1 through I-78

Particular attention is called to the changes in the following sections:

<u>SECTION</u>	<u>CHANGE</u>
201.06(a)	New paragraph (d) has been added to 37 CFR 1.60 to provide for filing the fee and/or copy of the declaration later than the filing date of the application with a surcharge
Chapter 300	The assignment rules effective September 4, 1992 have been incorporated
324	New section has been added to deal with establishing right of assignee to take action under 37 CFR 3.73(b)
402.06	The procedure for an attorney or agent withdrawing from a file has been updated
402.10	New section has been added to set forth the procedure for appointment /revocation of powers by less than all applicants or owners
409.03(j)	The section has been amended to specify that a continuing application under 37 CFR 1.62 of a 37 CFR 1.47 application must be forwarded to the Office of Special Programs when allowable
608.01(o)	Part B. Incorporation By Reference has been updated in accordance with a notice published in the <i>Official Gazette</i> on December 15, 1992
Chapter 1000	The chapter has been amended to set forth where the various petitions are handled in the Office
1112.05 and 2309.02	An amended Form PTO-850 has been included, eliminating the requirement for an accompanying title report
1302.13	The Primary Examiner's <u>signature</u> is now required on the file wrapper at allowance
Chapter 1800	The chapter has been rewritten to be more helpful to examiners
Chapter 2400	A new chapter has been added to deal with biotechnology

Manual of PATENT EXAMINING PROCEDURE

Original Fifth Edition, August 1983
Latest Revision August 1993



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

The Patent and Trademark 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 existing subscriptions should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents Telephone: (202)512-2267
Mail List Section
Washington, D.C. 20402

Inquiries relating to purchasing the Manual should be directed to:

Superintendent of Documents Telephone: (202)783-3238
United States Government Printing Office
Washington, D.C. 20402

Orders for reproduced copies of individual replacement pages or of previous revisions of the Manual should be sent to the following address:

Commissioner of Patents and Trademarks
Attention: Certification Branch
Washington, D.C. 20231

Previous editions and revisions of the Manual are available on microfilm in the Public Search Room.

The Manual is available on CD-ROM and on diskette from:

U.S. Patent and Trademark Office Telephone: (703)308-0322
Office of Electronic Information Products and Services
Washington, D.C. 20231

Employees of the Patent and Trademark Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Patent Academy.

Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule which was not reproduced.

First Edition, November 1949
Second Edition, November 1953
Third Edition, November 1961
Fourth Edition, June 1979
Fifth Edition, August 1983
Revision 1, October 1985
Revision 2, December 1985
Revision 3, May 1986
Revision 4, October 1986
Revision 5, July 1987
Revision 6, October, 1987
Revision 7, December, 1987
Revision 8, May 1988
Revision 9, September 1988
Revision 10, January 1989
Revision 11, April 1989
Revision 12, July 1989
Revision 13, November 1989
Revision 14, November 1992
Revision 15, August 1993

Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark 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 a patent application. The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations.

A separate manual entitled "Trademark Manual of Examining Procedure" is published by the Patent and Trademark Office as a reference work for trademark cases.

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 are 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 and Trademarks,
Editor, M.P.E.P.,
Washington, D.C. 20231

Table of Contents

	Page
Title Page	
Forward	
Table of Contents	(iv)
Introduction	1
Chapter 100 Secrecy, Access, National Security and Foreign Filing	100-1
200 Types, Cross-Noting, and Status of Application	200-1
300 Ownership and Assignment	300-1
400 Representative of Inventor or Owner	400-1
500 Receipt and Handling of Mail and Papers	500-1
600 Parts, Form and Content of Application	600-1
700 Examination of Applications	700-1
800 Restriction in Applications filed under 35 U.S.C. 111; Double Patenting	800-1
900 Prior Art, Classification, Search	900-1
1000 Matters Decided by Various Patent and Trademark Office Officials	1000-1
1100 Interference (old practice)	1100-1
1200 Appeal	1200-1
1300 Allowance and Issue	1300-1
1400 Correction of Patents	1400-1
1500 Design Patents	1500-1
1600 Plant Patents	1600-1
1700 Miscellaneous	1700-1
1800 Patent Cooperation Treaty	1800-1
1900 Protest	1900-1
2000 Duty of Disclosure; Rejecting and Striking of Applications	2000-1
2100 Patentability	2100-1
2200 Citation of Prior Art and Reexamination of Patents	2200-1
2300 Interference Proceedings under Public Law 98-622 (new practice)	2300-1
2400 Biotechnology	2400-1
Appendix I Partial List of Trademarks	A - 1
Appendix II List of Decisions Cited	A - 5
Appendix L Patent Laws	L - 1
Appendix R Patent Rules	R - 1
Appendix T Patent Cooperation Treaty	T - 1
Appendix AI PCT Administrative Instructions	AI - 1
Appendix P Paris Convention for the Protection of Industrial Property	P - 1

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 and Trademark 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 and Trademark 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 substantially its present form. The patent law is Title 35 of the United States Code which governs all cases in the Patent and Trademark Office. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31.

35 U.S.C. 1 Establishment.

The Patent and Trademark Office shall continue an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and 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 and Trademarks, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

37 CFR 1.351. Amendments to rules will be published.

All amendments in this part will be published in the *Official Gazette* and in the *Federal Register*.

35 CFR 1.352. Publication of notice of proposed amendments.

(a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments in this part 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 regulations or rules and amendments thereto are published in the *Federal Register* and in the *Official Gazette*. 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, called sections, are numbered with the Part number and a decimal point prefixed to the rule number. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules as well as trademark rules and copyright rules. Persons desiring a copy of the patent rules should order a complete copy of "Title 37, Code of Federal Regulations" from the Superintendent of Documents.

The primary 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. The Rules of Practice appear in the *Manual of Patent Examining Procedure* as Appendix R.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent and Trademark 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 portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (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 Patent Appeals and Interferences (see § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his or her actions, the examiner should cite the decision in the manner set forth in § 707.06.

Publications Available from Superintendent of Documents

Orders should be addressed and remittances made payable to Superintendent of Documents, U. S. Government

Printing Office, Washington D. C. 20402.

Patent Official Gazette. The official journal of the Patent and Trademark Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and a claim of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification.

Annual Indexes. An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

Guide for Patent Draftsmen. Patent and Trademark Office requirements for Patent drawings with illustrations.

Manual of Classification. A loose-leaf volume listing the numbers and descriptive titles of the more than 300 classes and 95,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time.

General Information Concerning Patents. Contains general information concerning the application for and granting of patents, expressed in nontechnical language for the layman. Multiple copies available from Superintendent of Documents.

Manual of Patent Examining Procedure. A loose-leaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent and Trademark Office's Examining Corps >including statutes, rules, treaties, etc<. Subscription service includes basic manual, revisions, and change notices.

Patents and Inventions - An information Aid to Inventors. The purpose of this publication is to aid inventors in deciding whether to apply for patents, in obtaining patent protection, and in promoting their inventions.

Patent Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office. An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U. S. Patent and Trademark Office.

Title 37—Code of Federal Regulations. Compilation of the rules of practice of the U. S. Patent and Trademark Office.

Publications Available From the Patent and Trademark Office

Orders should be addressed to Patent and Trademark Office, Washington, D.C. 20231. Remittances should be made payable to Commissioner of Patents and Trademarks. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of Patent and Trademark Office fees.

Q & A About Patents. Brief non-technical answers to questions most frequently asked about Patents.

Q & A About Plant Patents. Same as above for plant patents.

Patents. Copies of the specification and drawings of all patents are available at one dollar and fifty cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and subclasses. Price is based upon size of publication.

Weekly Class Sheets. Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette*.