

Manual of PATENT EXAMINING PROCEDURE

Original Sixth Edition, January 1995
Latest Revision July 1997



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Patent and Trademark Office
Washington, D.C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Sixth Edition

Instructions Regarding Revision No. 3

This revision consists of replacement pages for the **Title Page, the Forward, and the Introduction** in the front of the Manual; **entire Chapters 100 through 1000, 1200 through 1400, 1600 through 1900, 2100, 2200, 2400 and 2500, Appendices I - Partial List of Trademarks, II- List of Decisions Cited, L- Patent Laws, and R - Patent Rules, and entire Index.**

Pages which have been printed in this revision are labeled as "**Rev. 3**" on the bottom. Sections of the Manual which have been changed by this revision are indicated by "**[R-3]**" after the section title.

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.

Magdalen Y. C. Greenlief, Editor
Manual of Patent Examining Procedure

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

CHAPTER 100:

- 102 Rewritten to reflect amendment to 37 CFR 1.14 and to incorporate current procedures for obtaining status information.

- 103 Revised to reflect amendment to 37 CFR 1.14, incorporate current procedures for obtaining access to certain abandoned applications which are available to the public without a petition, and exemplify where "special circumstances" could be found which warrant a grant of access under 35 U.S.C. 122.

- 120 Revised mailing address for correspondence related to secrecy orders.

CHAPTER 200:

- 201.03 Revised to reflect changes in procedures regarding processing of applications filed with a petition to correct inventorship under 37 CFR 1.48(a). Applications filed with a petition under 37 CFR 1.48(a) will be processed by the Office of Initial Patent Examination and a filing receipt will be issued prior to a decision on the petition under 37 CFR 1.48(a), listing the originally named inventors. Petitions to correct inventorship under 37 CFR 1.48(a) are generally decided by the primary examiner assigned the application. Applications filed with petitions under 37 CFR 1.47 and 1.48(a) will be forwarded to the Office of Petitions for consideration of the petitions after mailing of the filing receipt. Also revised to reflect that the time period for response to a "Notice to File Missing Parts of Application, Filing Date Granted" is two months from the date of the notice. Form paragraph 2.14.01 has been inserted and form paragraph 10.10 has been revised

- 201.04(b) Form PTO/SB/16, provisional application cover sheet, has been revised. An example has been added to illustrate the last day of pendency of a provisional application under 35 U.S.C. 111(b)(5).
- 201.06(a) Form PTO/SB/13, request for filing a patent application under 37 CFR 1.60, has been revised.
- 201.06(b) Revised to reflect amendment to 37 CFR 1.10. Form PTO/SB/14, request for filing a patent application under 37 CFR 1.62, has been revised.
- 201.10 Deleted reference to Assignment Division endorsement of any assignment of the parent case of a substitute application.
- 201.11 Revised to exemplify a proper reference to an earlier filed application when a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application.
- 201.13 The list of countries for which 35 U.S.C. 119(a)-(d) priority is granted has been updated. Albania, Azerbaijan, Colombia, India, Panama, Saint Vincent and the Grenadines, Thailand, and the United Arab Emirates have been added. Revised to clarify when the Office is open for filing papers.
- 203.08(a) Revised to reflect changes in contacts for inquiries from designated official sources.

CHAPTER 300:

- 302.08 Revised mailing address for submitting assignment documents filed together with new applications or petitions.
- 307 Revised to reflect change to Form PTOL-85B.

315 Rewritten to indicate the Office no longer processes requests for indexing additional patent numbers or application numbers against a recorded document. Each request for recordation must include the document to be recorded, a cover sheet, and the appropriate recording fee.

317.02 Revised to reflect amendment to 37 CFR 1.10.

324 Form PTO/SB/96, certificate under 37 CFR 3.73(b), has been revised.

CHAPTER 400:

402 Revised to add a cross-reference to MPEP § 403 for Customer Number practice.

402.06 Form PTO/SB/83, request for withdrawal as attorney or agent, has been revised.

402.07 Language was added to clarify an assignee's right to revoke a power of attorney when status under 37 CFR 1.47(a) has been requested or accorded.

402.10 Revised to indicate that in an application filed under 37 CFR 1.47(a), an assignee of the available inventors may appoint or revoke a power of attorney with a petition under 37 CFR 1.182.

403 Revised to explain Customer Number practice. Forms PTO/SB/121-125 have been inserted.

403.01 Revised to indicate that an associate attorney may change the correspondence address.

409.01(a) Revised to indicate that if a court certificate is not available, a legal memorandum prepared and signed by an attorney familiar with the law of the jurisdiction involved may be submitted to demonstrate that persons

signing on behalf of a deceased inventor are heirs of the deceased and are authorized to act on his or her behalf.

- 409.01(b) Revised to indicate that the examiner determines whether proof of authority of a legal representative is sufficient and notifies the applicant of whether the proof is sufficient. If proof of authority in a national stage application is insufficient, the case should be forwarded to the PCT Legal Affairs Division.
- 409.03(a) Revised to indicate that an oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor left blank may be treated as having been signed by the joint inventors on behalf of the nonsigning inventor, unless indicated otherwise.
- 409.03(d) Revised in indicate that a copy of application papers must be sent to the last known address of a non-signing inventor or to the address of the non-signing inventor's attorney if the non-signing inventor is represented by an attorney.
- 409.03(h) Revised to indicate that when papers deposited pursuant to 37 CFR 1.47 are found acceptable, a notice will be published in the Official Gazette identifying the application number, filing date, title of the invention, and the name of the non-signing inventor. Also revised to indicate a filing receipt will be sent to applicant prior to consideration of a petition filed under 37 CFR 1.47.
- 409.03(i) Revised to clarify the rights of the non-signing inventor.

CHAPTER 500:

- 501 Revised to reflect amendment to 37 CFR 1.1, to specify the "walk-up" window for filing trademark-related papers, and to indicate the effect of incorrectly addressing correspondence.

- 502 Revised to clarify addresses for documents filed directly or sent by private courier.
- 502.01 Revised to clarify the timeliness treatment provided when using a certificate of transmission in accordance with 37 CFR 1.8. Error in the text of 37 CFR 1.6 corrected.
- 503 Revised to clarify that the application number identified on a postcard receipt is the preliminary assignment of the application number, and that the filing receipt represents the official assignment of a specific application number which is controlling in the event of an inconsistency. Revised to reflect changes in procedure regarding the issuance of filing receipts. A filing receipt will be issued at the time a determination is made by the Office that the application meets the minimum requirements to receive a filing date.
- 505 Revised to indicate that new applications filed in accordance with 37 CFR 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.
- 506.02 Revised to indicate that new applications filed in accordance with 37 CFR 1.10 will be stamped with the date of deposit as "Express Mail" in the United States Postal Service.
- 510 Revised to reflect amendment to 37 CFR 1.6(a), and addition of 37 CFR 1.9(h) defining "Federal holiday within the District of Columbia."
- 512 Revised to clarify that for purposes of 37 CFR 1.8(a)(1)(i)(A), first class mail is interpreted as including "Express Mail" and "Priority Mail" deposited with the U.S. Postal Service. Also revised to clarify the timeliness treatment of correspondence transmitted by facsimile. Language has been added warning that the last day for pendency of a provisional application may occur on a Saturday, Sunday, or Federal holiday within the District of

Columbia, and indicating that new applications filed in accordance with 37 CFR 1.10 will be stamped with the date of deposit as "Express Mail" in the United States Postal Service.

- 513 Rewritten to reflect amendment to 37 CFR 1.10, specify the effective date of correspondence deposited as "Express Mail" in accordance with 37 CFR 1.10, and describe requirements and procedures set forth in 37 CFR 1.10(c) through 1.10(e) for petitioning the Commissioner to accord a filing date as of the date of deposit as "Express Mail."

CHAPTER 600:

- 601 Revised recommended arrangement and contents of the specification to reflect amendment to 37 CFR 1.77, and revised standards for application papers to reflect amendment to 37 CFR 1.52.
- 601.01(h) Forms PTO-1533, 1532, 152, 1123, 1534, 1607, 1608, 1669, and 1672 have been revised. Form PTO-457 has been replaced by Form PTO-1673.
- 601.03 Revised to reference MPEP § 403 regarding Customer Number practice.
- 602 Form paragraph 6.05.01 has been inserted and form paragraph 6.05.16 has been revised. Form PTO/SB/01, declaration for utility or design patent application, has been revised.
- 605.03 Revised to indicate that if no post office address is listed in the oath or declaration and a full street address is given for applicant's residence, the given address will be presumed to be the post office address. Form paragraph 6.09.02 has been inserted.

- 605.04(b) Revised to specify procedures for correcting typographical or transliteration errors in the spelling of an inventor's name.
- 605.04(g) Revised to specify procedures for correcting typographical or transliteration errors in the spelling of an inventor's name.
- 605.07 Revised to clarify that a claim in a U.S. application which relies on the combination of prior foreign applications may not be entitled to the benefit under 35 U.S.C. 119(a) if the subject matter of the claim is not sufficiently disclosed in the prior foreign application.
- 606.01 Form paragraph 6.11.01 has been inserted.
- 608.01 Revised to reflect amendments to 37 CFR 1.52 with regard to standards for application papers (e.g. paper size, legibility, etc.). Also revised to specify that the failure to submit application papers in compliance with 37 CFR 1.52(a) or (b) does not effect the grant of a filing date. Form paragraph 6.30 has been revised.
- 608.01(a) Revised to reflect amendment to 37 CFR 1.77 and to specify the preferred format of the specification. Form paragraphs 6.01 and 6.02 have been revised.
- 608.01(m) Revised to indicate that the claims must commence on a separate sheet and to clarify preferred arrangement of the claims. Form paragraphs 6.18.01, 7.29.01, 7.29.02, and 7.29.03 have been inserted.
- 608.01(n) Revised to indicate that improperly dependent claims and dependent claims that fail to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c). Form paragraph 7.36 has been inserted.
- 608.01(q) Form paragraphs 6.28.02 and 6.28.03 have been inserted.
- 608.02 Revised to reflect amendments to 37 CFR 1.84 and to indicate drawings are accepted in two different size

formats. Definitions of "plan" and "elevation" views have been added. Form paragraphs 6.22.01-6.22.07, 6.23.01, 6.25.01, 6.38.01 and 6.38.02 have been inserted.

608.05 Revised to reflect amendments to 37 CFR 1.96 and to indicate that computer program listings of ten or less pages must be submitted as drawings or as part of the specification and listings over ten pages must be submitted as microfiche. Form paragraphs 6.02.02-6.02.04 have been inserted. Revised to indicate that micrographic standards are now found in 36 CFR part 1230. Revised to indicate that 37 CFR 1.77(a)(6) requires a statement in the specification that a microfiche appendix is included.

609 Revised to reflect amendments to 37 CFR 1.97 and to indicate that information submitted in a parent application must be resubmitted in a divisional application, which is not an FWC under 37 CFR 1.62, to be considered. Revised to indicate that to ensure consideration of information in a continuing application which was not considered in the parent application, applicant must either resubmit the information or, in an application filed under 37 CFR 1.62, request that the previously submitted information be considered. Also revised to reflect amendment to 37 CFR 1.10. Form paragraphs 6.49.01-6.49.09 and 6.52 have been inserted.

CHAPTER 700:

706 Added language succinctly describing examination procedure.

706.02 Added cross-references to sections of Chapter 200 and 1800 for determining the effective filing dates of applications filed under 35 U.S.C. 371.

706.02(b) Deleted reference to filing a petition under 37 CFR 1.183 along with an affidavit or declaration under 37 CFR 1.131

in a common ownership situation in view of the addition of 37 CFR 1.130.

- 706.02(k) Revised to indicate that where commonly owned applications are claiming the same patentable invention, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103 if the earlier filed application has matured into a patent.
- 706.02(m) Form paragraph 7.21.02 has been revised in view of the addition of 37 CFR 1.130.
- 706.03(a) Form paragraph 7.05.04 has been added.
- 706.03(c) Form paragraph 7.30.01 has been added. Revised to specify when form paragraphs 7.31.02, 7.31.03, and 7.33.01 should be used.
- 706.03(d) Form paragraphs 7.30.02 and 7.34.07 through 7.34.14 have been added.
- 706.03(k) Revised to indicate that when two claims in an application are duplicates or cover the same thing, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75.
- 706.07(a) Revised to discuss when it is proper to make a rejection final when there is a new ground of rejection which relies upon information submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee. Form paragraph 7.40.01 has been added.
- 706.07(f) Revised to indicate an authorization for an extension of time for an examiner's amendment must be made of record in an examiner's amendment by indicating, among other information, when the authorization was given.

- 707.05(e) Revised to delete requirement for designating in an Office action the class and subclass in which an original publication located outside the Office will be filed.
- 707.07 Form paragraphs 7.37.01 through 7.37.13 have been added.
- 708.02 Revised to indicate that a petition to make special may be filed for applications relating to biotechnology filed by applicants who are small entities and applications relating to inventions for countering terrorism. Also revised to indicate that all petitions to make special are decided by the Group Director of the examining group to which the application is assigned.
- 710.02(b) Revised to indicate the shortened statutory period for response to a restriction or election requirement is one month (not less than thirty days).
- 711.02 Revised to set forth the showing that is required to make a petition to withdraw the holding of abandonment grantable.
- 711.03(c) Revised to reflect amendment to 37 CFR 1.10 and to change mailing address for a conditional petition to revive. Forms PTO/SB/61, PTO/SB/63 and PTO/SB/64 have been revised.
- 711.04 Revised to reflect amendment to 37 CFR 1.14.
- 713 Revised to indicate a video conference is considered an interview.
- 713.01 Revised to incorporate Office policy and procedures with regard to video conference interviews.
- 713.04 Revised to indicate where a complete record of an interview has been incorporated in an examiner's amendment, it is not necessary for the examiner to

- complete an Interview Summary Form. Also revised to add references to video conference interviews.
- 713.05 Revised to add references to video conference interviews.
- 713.07 Revised to clarify that prior to an interview in the examiner's office, all papers not necessary to the interview should be placed out of view.
- 714.07 Revised to reflect amendment to 37 CFR 1.52(a).
- 714.13 Revised to indicate that an amendment filed after final rejection but before the filing of an appeal brief may be entered upon or after the filing of an appeal brief in certain situations. Added language indicating the Office does not recognize "conditional" authorizations to charge an appeal fee if an amendment after a final Office action is not entered, and that any such authorization will be treated as an unconditional payment of the fee.
- 714.17 Revised to reflect amendment to 37 CFR 1.10.
- 715 Added language explaining when a rejection under 35 U.S.C. 103 may be overcome by a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130. Also revised to clarify the effective date as a prior art reference of a U.S. patent granted on an application filed under 35 U.S.C. 371.
- 715.05 Deleted reference to filing a petition under 37 CFR 1.183 along with an affidavit or declaration under 37 CFR 1.131 in a common ownership situation and added reference to 37 CFR 1.130 instead.
- 716 Revised to reflect amendment to 37 CFR 1.132. Form paragraphs 7.66.01 through 7.66.05 have been added.
- 716.02(f) Rewritten to reflect recent Federal Circuit decision in *In re Chu*.

- 716.03 Added references to recent Federal Circuit decisions.
- 716.03(b) Added reference to recent Federal Circuit decision.
- 717 through 717.07 These sections have been deleted and their contents have been moved to sections 719 through 719.07 respectively.
- 718 This section has been added to discuss the requirements of an affidavit or declaration to disqualify a commonly owned patent as prior art under 37 CFR 1.130.
- 719 through 719.07 These sections have been added and the contents of sections 717 through 717.07 respectively have been incorporated therein.
- 720 Revised to reflect amendments to 37 CFR 1.292 and to clarify who may file a petition under 37 CFR 1.292. Also revised to set forth the conditions under which a public use petition will be entered in the application file, the content requirements for a petition under 37 CFR 1.292, and the service requirements for all papers relating to a petition under 37 CFR 1.292 or a subsequent public use proceeding.
- 720.01 Revised to reflect amendment to 37 CFR 1.292 and to set forth procedures for handling timely and untimely petitions filed under 37 CFR 1.292. Also revised to set forth procedures for filing a petition under 37 CFR 1.292 with regard to reissue applications.
- 720.02 Revised to clarify that public use or on sale must be in this country.
- 720.04 Revised schedule of times for taking testimony and for filing and serving copies of the record and briefs in a public use proceeding. Also revised discussion of the use of affidavits or declarations as testimony.

CHAPTER 800:

- 803.04 New section added to address restriction of nucleotide sequences.
- 804 Form paragraph numbering has been corrected in Chart II-B. Revised the discussion of *In re Schneller* regarding nonstatutory type double patenting rejection and to set forth the analysis which an examiner should make to determine whether this type of nonstatutory double patenting rejection is appropriate.
- 804.02 37 CFR 1.78(d) has been deleted and 37 CFR 1.130(b) has been inserted instead.
- 804.03 Revised to reflect amendment to 37 CFR 1.78(c) and the addition of 37 CFR 1.130. Form paragraph 7.21.02 has been revised.
- 806.04(c) Revised example illustrating when a subcombination is not generic to different combinations.
- 808.01 Form paragraph 8.20.02 has been revised.
- 809 Revised to indicate that the one month statutory period may not be less than 30 days.
- 809.03 Form paragraph 8.12 has been revised to state that the restriction requirement between the linked invention is subject to the nonallowance of the linking claim and that upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn.
- 809.04 Form paragraphs 8.45, 8.46 and 8.47 have been added to be used to notify applicant of the allowance of a linking claim.

817 Form paragraph 8.21 has been deleted and form paragraphs 8.21.01-8.21.03 have been inserted.

821.04 Revised to insert form paragraphs 8.42 through 8.44 which should be used to notify applicant of the rejoinder of process claims which include all of the limitations of an allowable product claim.

CHAPTER 900:

901.02 Revised to reflect amendment to 37 CFR 1.14.

901.05 Revised to indicate that beginning in October 1995, the Office no longer classified paper copies of foreign patents into the U.S. Classification System.

901.05(c) Revised to indicate the Office now receives foreign patents in the form of CD-ROM disks which are accessible through the Foreign Patent Access System in the Scientific and Technical Information Center.

901.07 Revised to indicate that in most reclassification projects undertaken after October 1, 1995, foreign patents associated with the reclassified art have not been reclassified into the new classification schedule. Foreign patents in this category are available for searching in a "foreign patent art collection," which appears at the end of the class which includes the newly created classification schedule. Also revised to clarify meaning of "original" and "cross-reference" designations.

902.01 Rewritten to correspond to the contents of the current Manual of Classification.

902.01(a) Added language indicating the Index to the U.S. Classification System is available to PTO personnel on-line in the "Examination ToolKit."

- 902.02 Added language indicating the classification definitions are available to PTO personnel on-line in the "Examination ToolKit."
- 902.03(d) Rewritten to describe patent information and search tools available in the Cassis CD-ROM series.
- 903.03 Rewritten to explain that foreign patent documents received in the Office before October 1, 1995 were placed in the shoes in the examining groups, and foreign patents received thereafter are available on CD-ROM from the Foreign Patents Division of the Scientific and Technical Information Center.
- 903.07 Revised to clarify the procedure for determining the classification of an issuing application.
- 903.08(d) Revised to modify the transfer process when there is a dispute as to both classification issues and examining issues. Also revised to clarify classification of applications filed under the Patent Cooperation Treaty (PCT).
- 903.08(e) Revised to clarify the general guidelines for the assignment of nonprovisional applications.
- 903.09(a) This section has been added to discuss Locarno International Classification designations for design patent applications.
- 904.01(d) Revised to indicate the examiner should keep in mind the criteria to establish a *prima facie* case of obviousness when outlining a field of search.

CHAPTER 1000:

- 1002.02(b) Revised to update list of petitions and requests decided by the Office of Petitions.

1002.02(c) Revised to update list of petitions decided by Group Directors.

1002.02(c)(2) Revised to indicate that petitions to make biotechnology applications special where the applicant is a small entity are decided by the Group Director of Group 1800.

1002.02(c)(3) Revised to update list of petitions decided by the Director of Group 2900.

1002.02(d) Revised to update list of petitions decided by Supervisory Examiners.

1002.02(e) Revised to indicate that generally all 37 CFR 1.48 petitions for correction of inventorship are decided by Primary Examiners.

1002.02(l) Revised to indicate that requests to change inventorship pursuant to court order are decided by the Certificates of Correction branch.

1002.02(p) Revised to update list of petitions decided by the PCT Legal Administrator.

1002.02(q) Revised to update list of petitions decided by the Director of the Office of Initial Patent Examination.

1002.02(r) New section listing petitions decided by the Director of the Office of Patent Publication.

CHAPTER 1200:

1205 Revised to indicate that current fees are listed in 37 CFR 1.17(e)-(g). The recommended letter for a notice of appeal has been replaced by form PTO/SB/31.

1207 Revised to indicate that amendments filed after final may be entered upon or after the filing of the appeal brief.

1208.03 Form paragraph 12.48 has been inserted.

1216.01 Revised to clarify the filing date of a Notice of Appeal to the Federal Circuit sent by Express Mail. Revised to indicate that the examiner should set forth reasons for allowance, incorporating appellate briefs and the court decision, after a decision by the Federal Circuit allowing some of the claims.

CHAPTER 1300:

1302.09 Revised instructions for selecting a claim for printing in the *Official Gazette*.

1302.14 Added language indicating a statement of reasons for allowance which refers to and incorporates a copy of the briefs and the court decision should be added to the record following a decision by the Court of Appeals for the Federal Circuit or the District Court of the District of Columbia.

1309 Revised to reflect change to Form PTOL-85B.

CHAPTER 1400:

1404 Revised to indicate that all reissue litigation papers should be mailed to the Assistant Commissioner for Patents.

1412.03 Added reference to recent Federal Circuit decision.

1418 Form paragraph 14.11.01 has been inserted.

1456 Rewritten to discuss monitoring and review of reissue applications by the Office of the Special Program Examiner in the Examining Groups.

- 1481 Revised to reflect change to Form PTOL-85B. Form paragraphs 10.15-10.18 have been inserted.
- 1485 Revised to set forth the mailing address for requests for certificates of correction.
- 1490 Revised to clarify that a terminal disclaimer may be filed to overcome a judicially created double patenting rejection.
Form paragraphs 14.23-14.39 have been inserted.

CHAPTER 1600:

- 1605 37 CFR 1.163(c) and (d) have been inserted. Language has been added describing a plant color coding sheet, and Form PTO/SB/20, Plant Color Coding Sheet, has been added.

CHAPTER 1700:

- 1701.01 Revised to reflect removal of 37 CFR Part 15a, and to reference 15 CFR Part 15a instead.

CHAPTER 1800:

- 1805 Revised mailing address for international applications and related papers. Revised to indicate that if the procedures under 37 CFR 1.8 are improperly used in filing a PCT international application or related papers, the date accorded will be the date of receipt, unless that day is a Saturday, Sunday, or holiday.
- 1817 The list of PCT member states has been updated.
- 1820 Revised to explain the proof of authority requirements for a person signing on behalf of a legal entity.
- 1834 Revised to reflect amendment to 37 CFR 1.10.

- 1834.01 Revised to indicate which papers may be submitted by facsimile.
- 1840 Revised to indicate that New Zealand and Israel have been added to the list of countries for which the USPTO, as an International Search Authority, has agreed to conduct searches and prepare international search reports.
- 1850 Revised to add language describing unity of invention practice with respect to nucleotide sequences.
- 1865 Revised mailing address for filing a Demand for international preliminary examination. Also revised to add Israel and New Zealand to the list of countries for which the USPTO has agreed to serve as an International Preliminary Examining Authority.
- 1875.01 Form Paragraphs 18.19-18.21 have been inserted.
- 1878 Error in text of 37 CFR 1.484 has been corrected.
- 1893.01(a)(1) Revised to indicate that the notice of missing requirements lists several items which 37 CFR 1.497(a), (b), and 1.63 require.
- 1893.01(b)(1) Revised to indicate that the notice of missing requirements lists several items which 37 CFR 1.497(a), (b), and 1.63 require.
- 1893.01(e) 37 CFR 1.497 has been inserted. Revised to indicate that applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 CFR 1.497(a), (b), and 1.63.
- 1893.03 Revised to indicate that a national stage application will be forwarded to the appropriate examining group for examination in turn based on the 35 U.S.C. 371(c) date of the application.

1893.03(a) Form PCT/DO/EO/903 has been revised.

1893.03(c) Revised to indicate that a national stage application may include a priority claim under 35 U.S.C. 119(a)-(d), and to clarify that the national stage application file is checked to see if it contains a copy of the certified copy of the priority document. Revised to indicate that it is not necessary to amend the first sentence of the specification of an application filed under 35 U.S.C. 371 to reference the international application.

1895.01 Revised to indicate that a photocopy of the foreign priority document received from the International Bureau is sufficient to establish that applicant has filed the certified copy. References to 35 U.S.C. 119 have been changed to 35 U.S.C. 119(a)-(d).

1896 Revised to indicate that a photocopy of the foreign priority document received from the International Bureau establishes that applicant has filed a certified copy of the priority document.

CHAPTER 1900:

1901 Revised to reflect amendment to 37 CFR 1.291 and to specify the conditions under which a protest will be fully considered.

1901.02 Added language explaining that protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues.

1901.03 Added language explaining that protests which do not adequately identify a pending application will be returned to the protestor.

1901.04 Revised to reflect amendment to 37 CFR 1.291 and to set forth procedures for handling a protest which is submitted

prior to the mailing of a notice of allowance under 37 CFR 1.311.

- 1901.05 Revised to reflect amendment to 37 CFR 1.291 and to indicate that the Office will return any self-addressed postcard prior to the protest's entry in the application file or return to the protestor, as appropriate.
- 1901.06 Revised to reflect amendment to 37 CFR 1.291 and to set forth procedures for handling a protest which is not submitted prior to the mailing of a notice of allowance under 37 CFR 1.311.

CHAPTER 2100:

- 2106.01 Added language discussing satisfaction of the best mode requirement where software constitutes part of a best mode of carrying out an invention.
- 2107.01 Added discussion of holdings in *In re Citron* and *In re Brana*.
- 2112 Added language indicating that the inherent disclosures of a prior art reference may be relied upon in a rejection under 35 U.S.C. 102 or 103, and that the fact that a characteristic may be present in the prior art is not sufficient to establish the inherency of that characteristic.
- 2127 Revised to reflect amendment to 37 CFR 1.14, and to cross reference MPEP § 2136.02 and § 2136.03 for the 35 U.S.C. 102(e) date of a U.S. patent claiming priority under 35 U.S.C. 119 or 120.
- 2129 Added references to several Federal Circuit decisions.
- 2133.03(a) Added discussion of recent Federal Circuit decision.
- 2133.03(b) Added reference to recent Federal Circuit decision.

- 2133.03(c) Added reference to recent Federal Circuit decision.
- 2136.03 Revised to clarify when the international filing date of a U.S. patent reference can be used to antedate the application being examined.
- 2144.08 Rewritten to incorporate interim guidelines for the examination of claims directed to species of chemical compositions based upon a single prior art reference (genus-species guidelines).
- 2144.09 Added references to recent Federal Circuit decisions. Added language discussing the relevance of the presence or absence of a prior art suggestion of making a claiming compound in determining *prima facie* obviousness.
- 2163.06 Revised to indicate if new subject matter is added to the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate.
- 2164 Added language distinguishing the enablement requirement from the description requirement under 35 U.S.C. 112, first paragraph.
- 2164.01 Rewritten to discuss the standard for determining whether a specification meets the enablement requirement.
- 2164.01(a) This section was added to discuss factors to be considered in determining whether any necessary experimentation is "undue."
- 2164.01(b) This section was added to discuss the determination of whether a specification would have enabled one skilled in the art to make the claimed invention.
- 2164.01(c) This section was added to discuss the determination of whether a specification would have enabled one skilled in the art to use the claimed invention.

- 2164.02 Added language discussing working examples as well as correlation between animal model assays and a disclosed or claimed method of use.
- 2164.03 Rewritten to discuss the relationship between the amount of guidance or direction needed to enable an invention, the amount of knowledge in the state of the art, and the predictability of the art. Also added language clarifying the meaning of predictability in the art.
- 2164.04 Revised to clarify the burden on the examiner in establishing a *prima facie* case of lack of enablement.
- 2164.05 Rewritten to discuss consideration of evidence submitted in an effort to overcome a *prima facie* case of lack of enablement.
- 2164.05(a) Rewritten to explain that the nature of the invention, the state of the prior art, and the level of skill in the art must be considered in determining whether a specification would have been enabling as of the filing date.
- 2164.05(b) Added language defining the relative skill of those in the art.
- 2164.06 Rewritten to discuss the relevance of the quantity of experimentation needed to be performed in determining whether a specification would have been enabling to one skilled in the art. The information previously found in this section has been incorporated in MPEP § 2164.06(a).
- 2164.06(a) This added section contains information which previously appeared in MPEP § 2164.06 pertinent to examples of enablement issues when there is missing information.
- 2164.06(b) This section has been added to exemplify enablement issues arising in chemical cases.

- 2164.07 Rewritten to clarify the relationship of the enablement requirement under 35 U.S.C. 112 to the utility requirement under 35 U.S.C. 101, the initial burden on the examiner, and the character and amount of evidence sufficient to overcome a *prima facie* case of lack of utility.
- 2164.08 Rewritten to include a detailed discussion of determining whether the specification enables the full scope of the claimed invention.
- 2164.08(a) Deleted reference to the dicta in *Fiers v. Sugano*.
- 2164.08(b) Added language discussing the presence of inoperative embodiments within the scope of a claim.
- 2164.08(c) Added language indicating that an enablement rejection based on a missing critical limitation should only be made when the specification makes it clear that the limitation is critical for the invention to function as intended.
- 2172.01 This added section clarifies information which previously appeared in MPEP § 2173.05(I).
- 2173.05(i) Revised description of facts of *Wakefield* case.
- 2173.05(l) This section was deleted and the substance thereof was incorporated in MPEP § 2172.01 for better context.
- 2181 Revised discussion of language falling within the scope of 35 U.S.C. 112, sixth paragraph.
- 2184 Added reference to recent Supreme Court decision.
- 2186 Rewritten to discuss the relationship between "equivalents" as used in 35 U.S.C. 112, sixth paragraph and the doctrine of equivalents.

CHAPTER 2200:

- 2204 Revised to clarify the period of enforceability of a patent.
- 2205 Revised to exemplify a situation when an affidavit or declaration may accompany a citation of prior art.
- 2206 Added a sample letter notifying patent owner and third party sender that a prior art citation under 37 CFR 1.501(a) filed after the date of the order for reexamination will be not be placed in the file until the reexamination is terminated. Also revised procedures for processing a prior art citation which does not qualify for entry under 37 CFR 1.501.
- 2207 Rewritten to clarify that the Office will accept at any time from any party for placement in the patent file, submissions of copies of notices of suits and other proceedings involving the patent and copies of decisions or other court papers, or papers filed in the court, from litigations or other proceedings involving the patent.
- 2214 Revised to indicate that a request for reexamination should not be filed to resolve issues of patentability as to certain references while at the same time urging that those references do not present a substantial new question of patentability. Revised to clarify that the copy of the patent provided should include the drawings as whole pages of drawings and may present the front page of the patent in whole page format. Form PTO/SB/57 has been updated.
- 2215 Revised to clarify that if the entire fee for reexamination is not paid, the request will be considered incomplete.
- 2217 Revised to delete discussion of handling of admissions during the examination stage of a reexamination proceeding, and to cross reference MPEP § 2258 instead.

- 2222 Revised mailing address for submitting a change of power of attorney or correspondence address in the record of a patent.
- 2227 Revised to clarify that until the entire fee is received, no control number or filing date will be assigned and no reexamination exists. Also revised to indicate that if the request is not timely completed, any partial fee will be returned to the requester along with a notice that the reexamination request has not been accepted and the process has been terminated. A request which does not comply with 37 CFR 1.501(a) will also be returned to the requester.
- 2232 Revised mailing address for orders of copies of reexamination requests, all cited references, and the file wrapper and contents of the patent file for which reexamination is requested.
- 2234 Deleted examples of proper claim amendment format and added cross reference to MPEP § 2250 instead.
- 2237 Revised to indicate the Offices of the Special Program Examiner must be notified of the transfer of a reexamination request.
- 2241 Revised to indicate that where a reexamination request is filed in a patent in which a reexamination has already been ordered, the new request should be decided immediately.
- 2242 Revised to clarify meaning of a substantial new question of patentability and to clarify policy where a federal court decision has been issued regarding the validity or enforceability of a patent.
- 2258 Revised to clarify the scope of reexamination with regard to consideration of 35 U.S.C. 112 issues, and to set forth criteria for determining whether an amendment enlarges

the scope of the claims of the patent. Also revised to clarify that in a reexamination proceeding, an admission from any source can be used with respect to interpreting or modifying a prior art patent or printed publication.

- 2265 Revised to indicate that an extension of time in a reexamination proceeding is requested pursuant to 37 CFR 1.550(c), and that a timely first response to a final rejection will be construed as including a request to extend the shortened statutory period for an additional month. Also revised to indicate that the time for filing a third party requester reply to the patent owner's statement cannot be extended under any circumstances.

CHAPTER 2400:

- 2401 Revised to include references to MPEP § 803.04 and § 1850 which discuss restriction and unity of invention practice in applications claiming nucleotide sequences.
- 2402 Reference to MPEP § 608.01(p)(C) has been deleted.
- 2405 The list of International Depository Authorities has been updated.
- 2409 Error in text of 37 CFR 1.807 has been corrected.

CHAPTER 2500:

- 2501 Revised mailing address for submitting requests to update post-issuance patent information.
- 2540 Replaced "Payor Number" with "Customer Number."
- 2580 Revised mailing address for petitions under 37 CFR 1.377.
- 2590 Revised to clarify requirements for showing "unavoidable delay" in the payment of a maintenance fee. The mailing

address for petitions under 37 CFR 1.378 has also been revised.

2595

Added section for forms related to maintenance fee payments and fee addresses.

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First Edition, November 1949

Second Edition, November 1953

Third Edition, November 1961

Fourth Edition, June 1979

Fifth Edition, August 1983

Sixth Edition, January 1995

Revision 1, September 1995

Revision 2, July 1996

Revision 3, July 1997

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:

****>Box MPEP**
Assistant Commissioner for Patents
Washington, D.C. 20231 <

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 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 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 to the regulations in this part will be published in the *Official Gazette* and in the *Federal Register*.

37 CFR 1.352. Publication of notice of proposed amendments.

(a) Whenever required by law, notice of proposed amendments to the regulations 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 MPEP § 1002) and that portion of the examiner's action

MANUAL OF PATENT EXAMINING PROCEDURE

pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Patent Appeals and Interferences (see MPEP § 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 MPEP § 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 looseleaf 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 a vast amount of general information concerning the application for and granting of patents, expressed in non-technical language for the layman. Multiple copies available from Superintendent of Documents.

Manual of Patent Examining Procedure. A looseleaf 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.

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.

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A Guide to Filing a Patent Application. Brief technical description of the required parts of a patent application.

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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.

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