

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

**MANUAL OF PATENT EXAMINING PROCEDURE**  
**Eighth Edition**

The enclosed is the Eighth Edition to the Manual of Patent Examining Procedure. The Manual has been revised extensively to incorporate the changes necessitated by The American Inventors Protection Act of 1999 and the following final rules:

- (1) "Request for Continued Examination Practice and Changes to Provisional Application Practice," which became effective on August 16, 2000;
- (2) "Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term," which became effective on October 18, 2000;
- (3) "Changes To Implement the Patent Business Goals," which became effective on November 7, 2000;
- (4) "Treatment of Unlocatable Patent Application and Patent Files," which became effective on November 17, 2000;
- (5) "Changes to Implement Eighteen-Month Publication of Patent Applications," which became effective on November 29, 2000;
- (6) "Rules to Implement Optional *Inter Partes* Reexamination Proceedings," which became effective on February 5, 2001;
- (7) "Revision of Patent Cooperation Treaty Application Procedure," which became effective on March 1, 2001; and
- (8) "Changes to the Time Period for Making Any Necessary Deposit of Biological Material," which became effective on May 29, 2001.

Changes are highlighted on the following pages.

This Edition of the Manual was prepared with the assistance of the Senior Legal Advisors and Legal Advisors of the Office of Patent Legal Administration. Their efforts are greatly appreciated.

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

August 2001

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

**CHAPTER 100:**

- 101 Revised to reflect amendments to 35 U.S.C. 122 and 37 CFR 1.14.
- 102 Revised to reflect amendments to 37 CFR 1.14(a) and (b).
- 103 Revised to reflect amendments to 37 CFR 1.11 and 1.14, and to include a discussion of published patent applications. A copy of form PTO/SB/68, Request For Access To An Application Under 37 CFR 1.14(e) has been included. Also revised to include a discussion of FOIA requests.
- 104 Revised to reflect amendments to 37 CFR 1.14(d).
- 110 Revised to reflect amendment to 37 CFR 1.14(i). 37 CFR 1.14(i) was amended, effective November 29, 2000, to provide greater access to international application files kept by the USPTO.
- 120 Revised to reflect amendments to 37 CFR 5.1, and 5.2.
- 130 Revised to indicate that applications in which a secrecy order has been imposed are examined by TC Working Group 3640 and Art Unit 3662.
- 140 Revised to reflect amendments to 37 CFR 5.12.
- 150 Revised to reflect amendments to 42 U.S.C. 2182 and 37 CFR 1.14(f), and to indicate that provisional applications are not subject to DOE or NASA property rights review.

**CHAPTER 200:**

- 201 Revised to reflect amendments to 35 U.S.C. 111.
- 201.03 Rewritten to reflect amendment to 37 CFR 1.48. Correction of inventorship under 37 CFR 1.48 now requires a “request” along with a “processing fee” under 37 CFR 1.17(i) rather than a petition and a petition fee. Revised to indicate that 37 CFR 1.48(f) operates to automatically correct the inventorship upon filing of a first executed oath or declaration under 37 CFR 1.63 by any of the inventors in a nonprovisional application.
- 201.04(b) Revised to reflect amendments to 35 U.S.C. 111(b) and 37 CFR 1.53(c). Revised to indicate that if applicant attempts to claim the benefit of an earlier U.S. or foreign application in a provisional application, the filing receipt will not reflect the improper priority claim. Also revised to include

a discussion of a request to convert a provisional application to a nonprovisional application

- 201.06 Revised to indicate that divisional applications of utility or plant applications filed on or after May 29, 2000 should be filed under 37 CFR 1.53(b) rather than as a CPA under 37 CFR 1.53(d) since the prior application of a CPA must be filed before May 29, 2000.
- 201.06(c) Revised to reflect amendments to 37 CFR 1.53(b) and 1.63(d). Revised to indicate that a priority claim does not amount to an incorporation by reference of the application to which priority is claimed and furthermore, a mere reference to another application, patent, or publication is not an incorporation by reference unless a statement is included that such referenced application, patent, or publication is “hereby incorporated herein by reference.” Also revised to indicate that material needed to accord an application a filing date may not be incorporated by reference.
- 201.06(d) Revised to reflect amendment to 37 CFR 1.53(d) and to indicate that the prior application of a CPA must be filed before May 29, 2000. Applicant may wish to consider filing an RCE under 37 CFR 1.114 for utility or plant applications filed on or after May 29, 2000. Revised to clarify that for examination priority purposes only, the USPTO will treat continuation CPAs as if they were “amended” applications and not as “new” applications. This treatment is limited to CPAs in which the prior application has an Office action issued by examiner. If no Office action has been issued in the prior application, the CPA will be treated, for examination purposes, like a “new” application unless a petition to make special under 37 CFR 1.102 is filed in the CPA. Revised to indicate that if a CPA is improper because the prior utility or plant application was filed on or after May 29, 2000, the improper CPA will be automatically treated as an RCE under 37 CFR 1.114. Also revised to indicate that a filing receipt will be mailed in a CPA filed on or after November 29, 2000 to notify applicant of the projected publication date of the application. A discussion is added to address publication of CPAs. A discussion is added to indicate that applicant may file a request for suspension of action under 37 CFR 1.103(b) if applicant needs more time to prepare a preliminary amendment or to file an IDS in a CPA. The request for suspension of action must be filed at the time of filing of the CPA.
- 201.07 Revised to indicate that an application under 37 CFR 1.53(d) must be filed prior to the payment of the issue fee unless a petition under 37 CFR 1.313(c) is granted in the prior application.
- 201.11 Revised to reflect amendments to 35 U.S.C. 119(e) and 120. Revised to include two additional conditions for receiving the benefit of an earlier

filing date under 35 U.S.C. 119(e) or 120. Also revised to indicate that if a nonprovisional application that is filed on or after November 29, 2000 claims benefit to an international application, the first sentence of the specification must be amended to indicate whether the international application was published in English under PCT Article 21(2). A new subsection is added to set forth the time period requirement under 37 CFR 1.78(a)(2) and (a)(5) for making a claim for benefit under 35 U.S.C. 120 and 119(e) respectively.

- 201.13 Revised to reflect amendment to 35 U.S.C. 119(a) - (d), (f) and (g) and 37 CFR 1.55(a). The list of countries for which 35 U.S.C. 119(a)-(d), and (f) priority is granted has been updated to include WTO member countries. Revised to indicate that the foreign priority claim may be submitted in an application data sheet. Also revised to indicate that if the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a processing fee. In such case, the patent will not include the priority claim unless corrected by a certificate of correction.
- 201.13(b) Revised to reflect amendments to 35 U.S.C. 365 and 37 CFR 1.451.
- 201.14 Revised to indicate that for original applications filed on or after November 29, 2000, the claim for foreign priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the foreign application.
- 201.14(a) Revised to reflect amendments to 37 CFR 1.55(a) and (c) and to indicate that if a claim for foreign priority is presented after the time period set in 37 CFR 1.55(a)(1)(i), the claim may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. Also revised to indicate that if the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a processing fee. In such case, the certified copy of the foreign application will be placed in the application file but will not be reviewed and the patent will not include the priority claim unless corrected by a certificate of correction.
- 201.14(b) Revised to indicate that for original applications filed on or after November 29, 2000, the claim for foreign priority must identify the foreign application for which priority is claimed by specifying the application number, the country (or intellectual property authority), day, month, and year of its filing.
- 201.14(c) Revised to add a new subsection to address untimely claim for priority. Also revised to indicate that if the claim for priority or the certified copy of

the foreign application is filed after the date the issue fee is paid, it must be accompanied by a processing fee. In such case, the certified copy of the foreign application will be placed in the application file but will not be reviewed and the patent will not include the priority claim unless corrected by a certificate of correction.

- 201.16 Revised to reflect amendment to 35 U.S.C. 119(b) and to indicate that a claim for foreign priority may be added (or corrected) in an issued patent by reissue or certificate of correction provided the original application, which issued as the patent, was filed on or after November 29, 2000. In addition to the filing of a reissue application or a request for a certificate of correction, a petition to accept a delayed claim for priority along with the surcharge and a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional must be submitted.
- 202.01 Revised to reflect amendments to 37 CFR 1.78(a)(1) and (a)(2).
- 203.08 The procedures for processing status letters by the Technology Centers have been revised to indicate that the status letter along with the reply must be matched with the application file.

**CHAPTER 300:**

- 301 The title of the section has been changed to read “Ownership/Assignability of Patents and Applications.” New subsections have been added to address ownership, assignment, licensing, individual and joint ownership and making the assignment of record.
- 301.01 Revised to reflect amendment to 37 CFR 1.12 and to indicate that assignment documents relating to published patent applications are open to public inspection.
- 302.07 Revised to add form PTO-1595, “Recordation Form Cover Sheet - Patents Only.”
- 302.08 Revised to reflect amendment to 37 CFR 3.27 and to indicate that requests for recording documents which accompany new applications should be addressed to the Assistant Commissioner for Patents. Requests under 37 CFR 3.81 will be processed by the Office of Patent Publications and therefore, should be marked to their attention.
- 307 Revised to reflect amendment to 37 CFR 3.81.
- 311 Revised to reflect amendment to 35 U.S.C. 294.

- 320 Revised to indicate that examiners may obtain a title report using the PALM Intranet, Patent Assignment Information.
- 324 Revised to reflect amendments to 37 CFR 3.71 and 3.73. Revised to set forth examples of instances where the owner or assignee of a patent property can take action in a patent application or patent proceeding. Also revised to indicate that duplicate copies of the statement under 37 CFR 3.73(b) is not required and should not be submitted.

**CHAPTER 400:**

- 401 The title of this section has been changed to read “U.S. Patent and Trademark Office Cannot Aid in Selection of Attorney.”
- 402.05 Revised to reflect amendment to 37 CFR 1.36.
- 402.07 Revised to reflect amendment to 37 CFR 3.71.
- 403 Revised to reflect amendment to 37 CFR 1.33 and to indicate that applicant must specify a correspondence address in an application data sheet or elsewhere in any papers submitted with an application filing in a clearly identifiable manner. Revised to indicate who may change a correspondence address. Also revised to identify the persons who are authorized to change the information associated with an established Customer Number.
- 405 Revised to indicate that a change of correspondence address or a document granting access may only be signed by an attorney or agent who is not of record if an executed oath or declaration has not been filed in the application.
- 409 The title of this section has been changed to read “Death, Legal Incapacity, or Unavailability of Inventor.” Revised to indicate that a minor may sign an oath or declaration under 37 CFR 1.63 as long as the person understands the document that he or she is signing.
- 409.01 Revised to indicate that the heirs of a deceased inventor should identify themselves as the legal representatives of the deceased inventor in the oath or declaration submitted under 37 CFR 1.63. A certificate from a court indicating that they are all the heirs are no longer necessary.
- 409.01(b) Revised to indicate that the Office no longer requires proof of the authority of the legal representative of a deceased inventor.

- 409.01(f) Revised to indicate that the legal representative of a deceased inventor must submit an oath or declaration in compliance with 37 CFR 1.63 stating that he or she is the legal representative of the deceased inventor and providing his or her residence, citizenship and post office address.
- 409.03 Revised to reflect amendments to 35 U.S.C. 116, 118 and 37 CFR 1.47 and to indicate that an application filed with a petition under 37 CFR 1.47 must be forwarded to the Office of Petitions for a decision before the application is sent to the Technology Center for examination.
- 409.03(b) Revised to include a Chief Executive Officer as an officer of a corporation who may sign the necessary oath or declaration under 37 CFR 1.63 on behalf of the corporation as the 37 CFR 1.47(b) applicant.
- 409.03(c) Revised to indicate that proof of the authority of the legal representative of the deceased inventor is no longer required.
- 409.03(d) Revised to indicate that the fact that an inventor is hospitalized is not an acceptable reason for filing under 37 CFR 1.47. However, 37 CFR 1.43 may be available in such circumstances.
- 409.03(h) Revised to indicate that petitions filed under 37 CFR 1.47 are decided by the Office of Petitions.

**CHAPTER 500:**

- 501 Revised to reflect amendment to 37 CFR 1.4 and to indicate that persons who correspond with the USPTO are encouraged not to include correspondence which will have to be directed to different areas of the Office in a single envelope. By including multiple papers in a single envelope will increase the likelihood that one or more of the papers will be delayed before reaching the appropriate area.
- 502 Revised to reflect amendment to 37 CFR 1.6. Revised to indicate that a confirmation number should be included on all incoming papers pertaining to an application. Also revised to indicate that the Office prefers identifying indicia to be provided on the drawings.
- 502.01 Revised to reflect amendment to 37 CFR 1.6(d) and (f) and to indicate that the Office will fax back a receipt of a CPA filing if applicant submits the Office receipt form along with the CPA filing.
- 502.02 Revised to reflect amendments to 37 CFR 1.4(d) - (f).
- 502.04 New section added to address duplicate copies of correspondence.

- 503 Revised to indicate the information that is provided on the filing receipt. A discussion is added to address confirmation number. Also revised to clarify that by incorporating by reference in the postcard receipt the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.
- 506 Revised to reflect amendment to 37 CFR 1.53.
- 507 The title of the section has been changed to read “Drawing Review in the Office of Initial Patent Examination.” Revised to set forth the drawing review process to implement the eighteen-month publication of patent applications. New subsections have been added to address voluntary submission of replacement drawings for purposes of patent application publication, replacement drawings submitted on paper, and replacement drawings submitted with a specification through EFS.
- 508.01 The title of this section has been changed to read “Papers Sent to Wrong Technology Center (TC).”
- 508.04 New section added to set forth the procedures for the reconstruction of the file of a patent application, patent, or any other patent-related proceeding that cannot be located after a reasonable search.
- 509 Revised to reflect amendments to 37 CFR 1.22, 1.23 and 1.26. A new subsection is added to address payment by credit card. A copy of the Credit Card Payment Form, PTO-2038 is reproduced.
- 509.01 Revised to reflect amendment to 37 CFR 1.25 and to indicate that an authorization to charge the issue fee to a deposit account may be filed in an individual application only after the mailing of the notice of allowance. Revised to indicate that an authorization to charge fees under 37 CFR 1.16 in an application filed under 35 U.S.C. 371 will be treated as an authorization to charge fees under 37 CFR 1.492.
- 509.02 Revised to reflect amendment to 37 CFR 1.27.
- 509.03 Revised to reflect amendments to 37 CFR 1.27, 1.4(d)(2), 10.18(b), and 1.28. Revised to set forth the procedures for establishing small entity status. Also revised to include the procedures for obtaining a refund based on a later establishment of small entity status and the procedures for correcting in small entity status. The small entity forms, PTO/SB/09 to PTO/SB/12 have been deleted since these forms are no longer necessary to claim small entity status.



510 The title of this section has been changed to read “U.S. Patent and Trademark Office Business Hours.”

511 Revised to reflect amendment to 35 U.S.C. 21

513 Revised to reflect amendment to 35 U.S.C. 21.

**CHAPTER 600:**

601 Revised to reflect amendments to 35 U.S.C. 111 and 37 CFR 1.51 and to indicate that if an application data sheet under 37 CFR 1.76 is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet.

601.01 Revised to reflect amendment to 37 CFR 1.53 and to indicate that the CPA practice under 37 CFR 1.53(d) does not apply to applications (other than design) if the prior application has a filing date on or after May 29, 2000.

601.01(a) Revised to indicate that if the basic filing fee is not timely paid or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid during the pendency of the application, the application will be disposed of. The information regarding what combinations of information supplied in an oath or declaration are acceptable as minimums for identifying a specification has been moved to MPEP § 602.

601.01(c) The title of this section has been changed to read “Conversion to or from a Provisional Application.” A new subsection has been added to set forth the procedures for converting a provisional application to a nonprovisional application.

601.01(d) The reference to a fee set forth in 37 CFR 1.17(q) for provisional applications has been deleted because a petition under 37 CFR 1.53(e) along with the petition fee set forth in 37 CFR 1.17(h) for review of a notification from the Office that the original application papers lack a portion of the specification or drawings is applicable to provisional applications and nonprovisional applications. A new subsection has been added to set forth the procedures to follow when it is discovered that an application, located in a Technology Center, was filed without all of the pages of the specification and a notification has not been mailed by the Office of Initial Patent Examination.

- 601.01(f) The reference to a fee set forth in 37 CFR 1.17(q) for provisional applications has been deleted. See explanation in § 601.01(d) above.
- 601.01(g) The reference to a fee set forth in 37 CFR 1.17(q) for provisional applications has been deleted. See explanation in § 601.01(d) above. A new subsection has been added to set forth the procedures to follow when it is discovered that an application, located in a Technology Center, was filed without all of the drawing figures referred to in the specification and a notification has not been mailed by the Office of Initial Patent Examination.
- 601.01(h) All the forms previously included in this section have been deleted since the Office of Initial Patent Examination is no longer using pre-printed forms and is instead using individualized notices generated by a computer to notify application of defects.
- 601.02 A copy of form PTO/SB/81, Power of Attorney or Authorization of Agent, is reproduced.
- 601.03 Revised to reflect amendment to 37 CFR 1.33(a) and to indicate who may change the correspondence address.
- 601.05 A new section has been added to address application data sheet submitted under 37 CFR 1.76.
- 602 Revised to reflect amendments to 35 U.S.C. 25, 26, 115 and 37 CFR 1.63. The information from MPEP § 601.01(a) regarding what combinations of information supplied in an oath or declaration are acceptable as minimums for identifying a specification has been moved to this section. The section has been rearranged with appropriate heading being provided. A copy of the current Form PTO/SB/01, Declaration For Utility or Design Patent Application (37 CFR 1.63), is reproduced.
- 602.01 Revised to indicate that a deficiency in the oath or declaration can be corrected by an application data sheet.
- 602.05(a) Revised to indicate that if the examiner determines that a continuation or divisional application contains new matter relative to the prior application, the examiner should notify applicant in the next Office action and require applicant to submit a new oath or declaration along with the surcharge and to redesignate the application as a continuation-in-part. The requirement of a petition under 37 CFR 1.182 has been deleted.

- 603 Revised to reflect amendment to 37 CFR 1.67 and to indicate that a deficiency or inaccuracy relating to the information required by 37 CFR 1.63 may also be corrected with an application data sheet. Examples are provided to illustrate how certain deficiencies or inaccuracies in an oath or declaration may be corrected.
- 604.06 The title of this section has been changed to read “By Attorney in Application.”
- 605 Revised to reflect amendment to 37 CFR 1.41 and to indicate that the name, residence, and citizenship of each person believed to be an actual inventor should be provided as an application identifier when application papers under 37 CFR 1.53(b) are filed without an oath or declaration, or application papers under 37 CFR 1.53(c) are filed without a cover sheet.
- 605.02 Revised to indicate that applicant’s residence may be provided in an application data sheet.
- 605.03 The title of this section has been changed to read “Applicant’s Mailing or Post Office Address.” Revised to indicate that effective November 7, 2000, 37 CFR 1.63 was amended to use the phrase “mailing address” rather than “post office address” since the phrase “post office address” as previously used in 37 CFR 1.63 may be confusing. Also revised to indicate that effective November 7, 2000, the mailing address of each inventor may be provided in an application data sheet.
- 605.04(a) Revised to reflect amendment to 37 CFR 1.64 and to clarify that applicant may sign his or her name using non-English characters. Such a signature will be accepted. Revised to indicate that it is acceptable to print out a copy of the specification prepared using traditional word processing software for the inventor to review as he or she signs the declaration and then cut and paste from the electronic document to prepare the EFS version of the specification and to submit a scanned copy of the declaration with the EFS submission. Also revised to clarify that if a legal representative executes an oath or declaration on behalf of a deceased inventor, the legal representative must state that the person is a legal representative and provide the citizenship, residence, and mailing address of the legal representative.
- 606 Revised to reflect amendment to 37 CFR 1.72.
- 606.01 Revised to set forth the procedures for changing the title of the invention and making the changes in PALM.

- 607 Revised to indicate that a preliminary amendment filed concurrently with a response to a Notice to File Missing Parts of Application that required the filing fee, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice.
- 607.02 Revised to reflect amendment to 37 CFR 1.26. New subsections added to address the manner of making a refund, the time period for requesting a refund, fees paid by deposit account, and later establishment of small entity status.
- 608.01 Revised to reflect amendments to 37 CFR 1.52 and 1.58. Revised to indicate that if a provisional application is filed in a language other than English, an English translation of the non-English language provisional application will not be required in the provisional application. The English translation of the non-English provisional application and a statement that the translation is accurate must be submitted in any nonprovisional application claiming the benefit of the non-English language provisional application. Revised to clarify that examiners should not object to hyperlinks where the hyperlinks and/or other forms of browser-executable codes are part of applicant's invention and are necessary to be included in the patent application to comply with the requirements of 35 U.S.C. 112, 1<sup>st</sup> paragraph, and applicant does not intend to have these hyperlinks be active links.
- 608.01(a) Revised to reflect amendment to 37 CFR 1.77.
- 608.01(b) Revised to reflect amendment to 37 CFR 1.72(b) and to indicate that OIPE will review all applications filed under 35 U.S.C. 111(a) for compliance with 37 CFR 1.72 and will require an abstract, if one has not been filed. Also revised to indicate that the abstract of a national stage application filed under 35 U.S.C. 371 may be found on the front page of the PCT publication (i.e., pamphlet).
- 608.01(f) Revised to reflect amendment to 37 CFR 1.84. Revised to indicate that if a figure contains several parts, as for example, figure 1A, 1B, and 1C, the figure may be described as figure 1. If only figure 1A is described in the brief description, the examiner should object to the brief description, and require applicant to either add a brief description of figures 1B and 1C or describe the figure as "figure 1."
- 608.01(n) An additional example is added to illustrate an acceptable multiple dependent claim wording. Revised to clarify that if none of the multiple dependent claims is proper, the multiple dependent claim fee set forth in

37 CFR 1.16(d) will not be require. However, if at least one multiple dependent claim is proper, the multiple dependent claim is required.

- 608.01(p) Revised to indicate that an application may incorporate by reference essential material by reference to a U.S. patent application publication.
- 608.01(q) Revised to reflect amendment to 37 CFR 1.125. Revised to indicate that the paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraphs.
- 608.02 Revised to reflect amendment to 37 CFR 1.84. The material in this section has been rearranged with new subsection headings to address drawing requirements, receipt of drawing after the filing date, and how to handle the drawing requirements under the first and second sentences of 35 U.S.C. 113. Some of the material from MPEP § 608.01(a) has been moved to this section. Also revised to delete the definition for the term “formal drawing” since the Office no longer considers whether drawings are formal or informal. The Office currently reviews drawings to determine whether the drawings are acceptable or not acceptable for publication purposes. Revised to indicate that the Office is *sua sponte* waiving the requirement of 37 CFR 1.84(a)(2)(iii) for a black and white photocopy of color drawings or color photographs.
- 608.01(a) The title of this section has been changed to read “New Drawing - When Replacement is Required Before Examination.” Revised to indicate that drawings in utility and plant applications filed on or after November 29, 2000, other than CPAs, will be reviewed by OIPE for compliance with certain requirements of 37 CFR 1.84. If the drawings are not acceptable for publication purposes, OIPE will send a notice to applicant giving applicant a time period of 2 months from the mailing date to the notice to file acceptable drawings.
- 608.01(b) Revised to reflect amendment to 37 CFR 1.85. Revised to indicate that examiners should review the drawings for disclosure of the claimed invention and for proper use of reference numerals. Unless applicant is notified in an Office action, objections to the drawings will not be held in abeyance.
- 608.02(e) The title of this section has been changed to read “Examiner Determines Completeness and Consistency of Drawings.”
- 608.01(h) Revised to delete the reference to a draftsman “Approved” stamp since a draftsman’s “stamp” indicating approval is no longer required on patent drawings.

- 608.02(p) Revised to reflect amendments to 37 CFR 1.121(d) and 1.85.
- 608.02(q) Revised to indicate that if applicant wishes to amend the original drawings, at his or her own initiative, applicant is encouraged to submit new drawings as soon as possible, and preferably before allowance of the application.
- 608.02(r) The title of this section has been changed to read “Separate Letter.”
- 608.02(x) The title of this section has been changed to read “Disposition of Applications with Proposed Drawing Corrections.”
- 608.02(y) Revised to indicate that nonentered drawings that have been finally denied admission will not be returned to the applicant.
- 608.02(z) The title of this section has been changed to read “Allowable Applications Needing Drawing Corrections or Corrected Drawings.” Revised to indicate that examiners should not require new drawings merely because applicant indicated that the drawings submitted on filing were informal. If an application is being allowed, and corrected drawings have not been filed, form PTOL-37 provides an appropriate check box for requiring corrected drawings. Extension of time to provide acceptable drawings after the mailing of a notice of allowability are no longer permitted.
- 608.03 Revised to reflect amendment to 37 CFR 1.91.
- 608.04 Revised to reflect amendment to 37 CFR 1.121(f).
- 608.05 The material that was previously in MPEP § 608.05 directed to deposit of computer program listings has been moved to MPEP § 608.05(a). New section 608.05 is directed to sequence listing table, or computer program listing appendix submitted on a compact disc. This new section reflect amendments to 37 CFR 1.52(e) and 1.77.
- 608.05(a) The material that was previously in MPEP § 608.05 directed to deposit of computer program listings has been moved to this new section. A new subsection has been added to indicate that the Office will provide for the continuation of prior microfiche appendix practice for computer listings until February 28, 2001.
- 608.05(b) A new section has been added to address compact disc submission of large tables.

- 608.05(c) A new section has been added to address compact disc submissions of biosequences.
- 609 Revised to reflect amendments to 37 CFR 1.97 and 1.98 and to clarify that consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed next to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalents mean that the information has been considered by the examiner to the extent noted above. Only where the relevancy of the information is actually discussed in the application file or where the information is relied upon to reject a claim in the application, will the information deemed to have been considered for the purposes of reexamination under the *Portola* guidelines set forth in MPEP § 2242. New subsection headings have been added to address the procedures for handling IDSs in RCEs and continuing applications, and in national stage applications. Added discussion of holding in *Semiconductor Energy Laboratory Co., v. Samsung Electronics Co.*
- 610 A new section has been added to set forth the procedures for third party submission of patents and publications in a published application pursuant to 37 CFR 1.99.

#### **CHAPTER 700:**

- 701 Revised to reflect amendments to 35 U.S.C. 100 and 131.
- 704 The title of this section has been changed to read “Search and Requirements for Information.” The material that was in § 704 has been moved to new § 704.01.
- 704.01 The material from § 704 has been moved to this new section.
- 704.10 through 704.14(d) New sections added to describe policy and procedures for making a requirement for information under 37 CFR 1.105.
- 706 Revised to reflect amendment to 37 CFR 1.112. Revised to include a discussion regarding requirement for information under 37 CFR 1.105.
- 706.02 Revised to reflect amendments to 35 U.S.C. 102 and 103.
- 706.02(a) The discussion regarding 35 U.S.C. 102(e) has been revised to address when the pre-AIPA version of 35 U.S.C. 102(e) should be applied and when the post-AIPA version of 35 U.S.C. 102(e) should be applied.

- 706.02(b) Revised to indicate that the specific reference to the prior application as required by 37 CFR 1.78(a) may be included in an application data sheet.
- 706.02(c) Revised to indicate that an examiner may make a requirement for information under 37 CFR 1.105 where the evidence of record indicates reasonable necessity.
- 706.02(i) Form paragraphs have been revised.
- 706.02(k) Revised to include examples to illustrate rejections under 35 U.S.C. 102(e)/103 in applications filed on or after November 29, 2000.
- 706.02(l)(2) Revised to include additional examples to illustrate common ownership. The discussion regarding what evidence is required to establish common ownership has been rewritten to include the guidelines published in the *Official Gazette* on December 26, 2000 at 1241 O.G. 96.
- 706.02(l)(3) The examination procedure with respect to 35 U.S.C. 103(c) regarding the establishment of common ownership has been simplified in view of the guidelines published in the *Official Gazette* as noted in § 706.02(l)(2) above.
- 706.02(m) Form paragraphs have been revised.
- 706.02(n) Revised to reflect amendment to 35 U.S.C. 103(b).
- 706.03(a)(1) This section has been deleted and the material has been moved to MPEP § 2107.
- 706.03(o) Revised to reflect amendment to 35 U.S.C. 132(a).
- 706.03(s) Revised to reflect amendments to 35 U.S.C. 182, 184, and 185.
- 706.07 Revised to reflect amendment to 37 CFR 1.113.
- 706.07(f) Revised to indicate that Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a fee to a credit card.
- 706.07(g) Revised to reflect amendment to 37 CFR 1.129(a).
- 706.07(h) Added new section to address request for continued examination under 37 CFR 1.114.



- 707 Revised to reflect amendment to 37 CFR 1.104 and to indicate that applicants are encouraged to include the 4-digit confirmation number on every paper filed in the Office.
- 707.05 Revised to reflect amendment to 37 CFR 1.104(d).
- 707.05(b) The title of this section has been changed to read “Citation of Related Art and Information by Applicants.” Added discussion regarding requirement for information under 37 CFR 1.105.
- 707.05(e) Revised to indicate the kind of data that the examiner should provide when citing references on the form PTO-892.
- 707 Form paragraphs 7.37 and 7.38 have been moved to MPEP § 707.07(f).
- 707.07(f) Form paragraphs 7.37 and 7.38 from MPEP § 707 have been moved to this section. Form paragraphs 7.37.01 - 7.37.13 have been added.
- 707.07(i) The title of this section has been changed to read “Each Claim To Be Mentioned in Each Office Action.”
- 707.07(l) Added reference to MPEP § 2161 to § 2164.08(c) regarding written description and enablement requirements of 35 U.S.C. 112, 1<sup>st</sup> paragraph.
- 708.01 Revised to reflect amendment to 37 CFR 1.102.
- 708.02 Revised to reflect amendment to 37 CFR 1.102.
- 709 Revised to reflect amendment to 37 CFR 1.103 and rewritten to address suspension of action (1) at applicant’s request, and (2) at the initiative of the Office.
- 710 Revised to reflect amendments to 35 U.S.C. 133 and 267.
- 710.01 Revised to reflect amendment to 37 CFR 1.135.
- 710.02 Revised to reflect amendment to 37 CFR 1.136.
- 710.02(e) Revised to reflect amendment to 37 CFR 1.136 and to indicate that extensions of time under 37 CFR 1.136(a) or (b) are not available to extend the time period set in a Notice of Allowability (or in Office action having a mail date after the mail date of the Notice of Allowability), to submit an oath or declaration in compliance with 37 CFR 1.63, to submit formal drawings, or to make a deposit of biological material.

- 710.05 Revised to reflect amendment to 37 CFR 1.7 and added a discussion regarding Inauguration Day. Revised to indicate that the period of pendency of a provisional application will be extended to the next succeeding secular or business day which is not a Saturday, Sunday, or a Federal holiday, if the day that is twelve months after the filing date of the provisional application falls on Saturday, Sunday, or a Federal holiday within the District of Columbia.
- 711 The title of this section has been changed to read “Abandonment of Patent Application.” Revised to reflect amendments to 37 CFR 1.135 and 1.138.
- 711.01 Revised to indicate that if a letter of express abandonment is being submitted in an allowed application, the express abandonment should be accompanied by a petition to withdraw from issue under 37 CFR 1.313 and the fee set forth in 37 CFR 1.17(h). The express abandonment may not be recognized by the Office unless it is actually received by appropriate officials in time to act on it before the date of issue. Added a discussion regarding a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application.
- 711.02(b) Added additional examples involving abandonment.
- 711.03(a) The title of this section has been changed to read “Holding Based on Insufficiency of Reply.”
- 711.03(c) Revised to reflect amendments to 37 CFR 1.137, 1.181(a), and 1.181(f). This subsection regarding abandonment for failure to reply in a nonprovisional application has been rewritten and reformatted. A new subsection has been added to address abandonment for failure to notify the Office of a foreign filing pursuant to 35 U.S.C. 122(b)(2)(B)(iii) after a nonpublication request has been filed. The discussion regarding terminal disclaimers has been revised.
- 711.04 The title of this section has been changed to read “Public Access to Abandoned Applications.” This section has been rewritten to set forth the conditions recited in 37 CFR 1.14(e)(2).
- 713.01 Revised to reflect amendment to 37 CFR 1.133 and to indicate that interviews must be conducted on the Office premises, such as in the examiner’s office, conference rooms, or the video conference center.
- 714 Revised to reflect amendment to 37 CFR 1.121. This section has been rewritten to set forth the manner of making amendments that became effective on March 2, 2001.

- 714.01(a) Revised to reflect amendment to 37 CFR 1.33(b).
- 714.02(c) The title of this section has been changed to read “Signed by Attorney or Agent Not of Record.”
- 714.02d) The title of this section has been changed to read “Amendment Signed by Applicant But Not by Attorney or Agent of Record.”
- 714.01(e) New section added to address amendments filed before the first Office action and material from former § 714.09 has been moved to this new section.
- 714.02 Revised to reflect amendment to 37 CFR 1.111 and to indicate that an amendment which does not comply with the requirements of 37 CFR 1.121(b) and (c) may be held not fully responsive if both a clean version and a marked-up version showing changes to the respective parts of the specification/claims are not provided.
- 714.03 Revised to indicate that if an amendment submitted after March 1, 2001 does not comply with the requirements of 37 CFR 1.121, the Office will notify applicant by a Notice of Non-Compliant Amendment that the amendment fails to comply with 37 CFR 1.121 and applicant will be given a time period to reply.
- 714.03(a) New section added to address amendment that unduly interferes with the preparation of an Office action.
- 714.06 The title of this section has been changed to read “Amendments Sent to Wrong Technology Center.”
- 714.09 This section has been deleted and the material has been moved to new § 714.01(e).
- 714.12 Revised to reflect amendment to 37 CFR 1.116.
- 714.13 Revised to indicate that applicant may submit an amendment under 37 CFR 1.116 by presenting a clean set of all pending claims in one paper. Applicant may wish to consolidate all previous versions of pending claims in one amendment paper. By providing this consolidation of claims in the filed will be beneficial to both the Office and the applicant. Also revised to indicate that whenever an amendment, submitted under 37 CFR 1.116 includes new or amended claims, is entered for appeal purposes, the examiner must indicate on the advisory action which individual rejection(s) set forth in the action from which the appeal was taken (e.g., final rejection) would be used to reject the new or amended claim(s).

- 714.15 The title of this section has been changed to read “Amendment Received in Technology Center After Mailing of Notice of Allowance.”
- 714.16 Revised to reflect amendment to 37 CFR 1.312 and to indicate that after the Notice of Allowance has been mailed, applicants may wish to consolidate all previous versions of pending claims from a series of separate amendment papers into a single clean version in a single amendment paper. This consolidation of claims in the file will be beneficial to both the Office and the applicant for patent printing purposes. Entry of such an amendment is subject to 37 CFR 1.312.
- 714.16(d) Revised to indicate that if an amendment under 37 CFR 1.312 has been filed directly with the TC, the paper should be forwarded to the Publishing Division to be flagged in PALM. The paper and the file will be matched and returned to the TC for processing.
- 714.19 Additional examples added to illustrate the types of amendments that are ordinarily denied entry.
- 714.20 Revised to include an example directed to amendments filed after March 1, 2001.
- 714.22 Revised to reflect amendment to 37 CFR 1.121.
- 714.22(a) New section added to address amendments consolidating all claims.
- 715 Revised to reflect amendment to 37 CFR 1.131 and added discussion regarding when a U.S. patent application publication is available as prior art under 35 U.S.C. 102(e).
- 715.01(a) The title of this section has been revised to read “Reference Is a Joint Patent or Published Application to Applicant and Another.”
- 715.01(d) New section added to address the use of an affidavit or declaration under 37 CFR 1.131 to overcome a rejection based on an activity showing that the claimed invention was used or known prior to the filing date of the application.
- 715.04 Revised to indicate that a party qualified under 37 CFR 1.42, 1.43, or 1.47 may make an affidavit or declaration under 37 CFR 1.131.
- 715.05 The title of this section has been changed to read “U.S. Patent or Application Publication Claiming Same Invention.”

- 715.07(c) Revised to reflect amendment to 35 U.S.C. 104.
- 716 Revised to reflect amendment to 37 CFR 1.132.
- 716.08 Revised to include updated reference to MPEP § 2107.02 and § 2107.03 regarding the utility examination guidelines.
- 718 Revised to reflect amendment of 37 CFR 1.130.
- 719.03 Revised to include a discussion of classification history box entries.
- 720 Revised to reflect amendment to 37 CFR 1.292 and to indicate that a petition under 37 CFR 1.292 should be directed to the Office of Patent Legal Administration.
- 724.04 Revised to indicate that prior to publication, an original application is not open to the public under 35 U.S.C. 122(a).
- 724.04(a) The procedures for treating materials submitted under MPEP § 724.02 in an application covered by 35 U.S.C. 122 have been revised.
- 724.06 Revised to reflect amendment of 37 CFR 1.59.

**CHAPTER 800:**

- 804 Revised to indicate that the type of double patenting rejection based on *In re Schneller* is rare and is limited to the particular facts of the case. Charts I-A, I-B, II-A, and II-B have been revised and charts III-A and III-B have been added to address conflicting claims between application and a published application. Added a discussion of the holding in *Eli Lilly & Co. v. Barr Labs., Inc.* Also revised to indicate that the decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in the application, the examiner should consult with his or her SPE and if the SPE agrees, then the approval of the TC Director must be obtained before such a double patenting rejection can be made.
- 804.02 Two new subsections added to address terminal disclaimer required despite request to issue on common issue date, and disclaiming multiple double patenting references.
- 804.03 Revised to reflect amendment to 37 CFR 1.130. A new subsection added to address identifying commonly owned cases or determining invention priority.

- 804.04 The title of this section has been changed to read “Submission to Technology Center Director.”
- 819 Revised to indicate that applicant cannot as a matter of right, switch inventions by filing an RCE.
- 821 Revised to indicate that the examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention. Applicant may traverse the requirement and if the requirement for restriction is made final by the examiner, applicant may file a petition under 37 CFR 1.144 for review of the restriction requirement. Examiners should no longer make a rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph where there is disagreement between the examiner and applicant as to whether certain claims are readable on the elected invention.

#### **CHAPTER 900:**

- 901.02 Revised to indicate that if an abandoned application was previously published under 35 U.S.C. 112(b), that patent application publication is available as prior art under 35 U.S.C. 102(a) and 102(b) as of its patent application publication date because the patent application publication is considered to be a “printed publication” within the meaning of 35 U.S.C. 102(a) and 102(b).
- 901.03 Revised to indicate that pending U.S. applications filed before November 29, 2000, which are not voluntarily published and applications filed on or after November 29, 2000, which have not been published are generally preserved in confidence. Added a discussion regarding 18-month publication of patent applications.
- 901.04(a) A new section has been added to address kind codes.
- 901.05(c) Revised to indicate that foreign patents are available to the examiners from the USPTO’s automated search tools such as EAST, WEST and FPAS.
- 902.03(a) New section directed to Patent Classification Home Page on the Internet.
- 902.03(b) New section directed to Patent Classification Home Page on the USPTO Intranet.
- 902.03(c) New section directed to Classification Insight on USPTO Local Area Network (LAN).

- 902.03(e) New section directed to Automated Search Tools: EAST and WEST.
- 902.04(a) Revised to indicate that the reclassification alert report is updated quarterly and is available to USPTO personnel online from the Classification Home Page.
- 903.07 Revised to indicate that U.S. patents cannot be classified in subclasses beginning with “FOR” since there are exclusively for foreign patents.
- 903.08(d) Revised to set forth transfer procedures where the transfer is between art units within the same Technology Center, and transfers between different Technology Centers.
- 903.08(e) The title of this section has been changed to read “General Guidelines Governing the Assignment of Nonprovisional Applications for Examination.”
- 903.08(g) The title of this section has been changed to read “Transfer to Another Technology Center After Decision.”

**CHAPTER 1000:**

- 1001 Revised to reflect amendments to 35 U.S.C. 2 and 3(a) and 3(b).
- 1002 Revised to reflect amendment to 37 CFR 1.181. Revised to indicate that the 2-month time period in 37 CFR 1.181(f) applies to petitions under any section that does not specify the time period within which a petition must be filed (e.g., 37 CFR 1.182 and 1.183).
- 1002.02(b) The title of this section has been changed to read “Petitions and Requests Decided by the Office of the Deputy Commissioner for Patent Examination Policy.” Revised to update list of petitions and requests decided by the Office of the Deputy Commissioner for Patent Examination Policy.
- 1002.02(c) The title of this section has been changed to read “Petitions and Requests Decided by the Technology Center Directors.” Revised to update list of petitions and requests decided by TC Directors.
- 1002.02(c)(1) The title of this section has been changed to read “Petitions Decided by the Director of Technology Center 3640.”
- 1002.02(c)(2) The title of this section has been changed to read “Petitions Decided by the Director of Technology Center 1600.”

- 1002.02(c)(3) The title of this section has been changed to read “Petitions Decided by the Director of Technology Center 2900.” Revised to update list of petitions decided by the TC Director of 2900.
- 1002.02(d) Revised to update list of petitions and matters decided by Supervisory Patent Examiners.
- 1002.02(f) Revised to update list of petitions and matters decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences.
- 1002.02(k) This section has been deleted and replaced by new sections 1002.02(k)(1), 1002.02(k)(2), and 1002.02(k)(3).
- 1002.02(q) Revised to update list of petitions and requests decided by OIPE.
- 1002.02(r) Revised to update list of petitions and requests decided by the Director of Office of Patent Publication.
- 1002.02(s) The title of this section has been changed to read “Petitions and Matters Decided by the Special Program Examiners in the Technology Centers.”
- 1003 The title of this section has been changed to read “Matters Submitted to Technology Center Directors.” Revised to update list of matters submitted to TC Directors.
- 1004 Revised to update list of actions which require the attention of a primary examiner.
- 1005 Revised to update list of actions which may not be signed by an examiner with partial signatory authority.

#### **CHAPTER 1100:**

- 1101 Revised to indicate that art unit 3662 handles applications including a request for a SIR that are electrical in nature and those that are related to computer science. Also revised to indicate that publication of an application may be a desirable alternative to requesting a SIR since publication of the application is achieved without any waiver of patent rights.
- 1107 Revised to set forth the procedures to follow in preparing a nonprovisional application with a SIR request for publication.

#### **CHAPTER 1200:**



- 1203 Revised to reflect amendment to 35 U.S.C. 6.
- 1205 Revised to reflect amendment to 37 CFR 1.191. New subsection headings added to address appeal by patent applicant and appeal by patent owner. Also revised to indicate that the provisions of 37 CFR 1.550(c) applies to *ex parte* reexamination proceedings.
- 1208 Revised to reflect amendment to 37 CFR 1.193 and to indicate that an appeal conference is now mandatory in all cases in which an acceptable brief has been filed. Upon receipt of the appeal case by the Board of Patent Appeals and Interferences, the Board should review the application prior to assigning an appeal number to determine whether an appeal conference has been held. If there is no appropriate indication that an appeal conference has been held, the Board should return the application to the appropriate TC Director for corrective action.
- 1208.03 Revised to reflect amendment to 37 CFR 1.193.
- 1211.03 This section has been added to address remand by the Board to the examiner for further search.
- 1214.01 The material in this section has been rearranged.
- 1215.01 Revised to indicate that prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen prosecution of the application, applicant may file an RCE under 37 CFR 1.114.
- 1216 Revised to add a new subsection regarding judicial review of *ex parte* reexamination proceedings.
- 1216.01 A new subsection has been added to address the standards of review by the Court of Appeals for the Federal Circuit.

#### **CHAPTER 1300:**

- 1302.01 Revised to indicate that the abstract should be limited to 150 words.
- 1302.04 Revised to indicate that corrections of errors and omissions in the claims must be made by a formal examiner's amendment, signed by a primary examiner and placed in the application file and a copy sent to the applicant. Also revised to indicate that 37 CFR 1.121(g) permits the Office to make amendments to the specification, including claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution.

- 1302.05(a) Revised to indicate that when the original drawings cannot be located and the application is otherwise in condition for allowance, a replacement drawing should be obtained from OIPE's records of the application as originally filed.
- 1302.12 Revised to indicate that references listed by the examiner on a PTO-892 form will be indicated with an asterisk in the "Reference Cited" section of the front page of a patent document.
- 1302.14 Revised to reflect amendment to 37 CFR 1.104(e). A new subsection heading directed to applicant's comments on the reasons for allowance has been added.
- 1303 Revised to reflect amendment to 37 CFR 1.311.
- 1303.01 Revised to indicate that reference to an issue batch number is no longer necessary since the Office no longer stores and tracks applications according to issue batches.
- 1306 Revised to indicate that applicants may fax post allowance correspondence to the correspondence branch in the Office of Patent Publications.
- 1306.01 Revised to reflect amendment to 37 CFR 1.314.
- 1306.03 Added a new subsection to address procedures for ordering an allowed application.
- 1308 Revised to reflect amendment to 37 CFR 1.313. New subsections added to address withdrawal from issue at the initiative of the applicant prior to the payment of the issue fee and after the payment of the issue fee.
- 1309 Revised to reflect amendments to 35 U.S.C. 2 and 153.
- 1309.01 This section has been moved to MPEP Chapter 2700.

#### **CHAPTER 1400:**

- 1402 Revised to indicate that in the situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant will have to file a petition for unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application.

- 1410 Revised to indicate that a re-typed specification is not acceptable in a reissue application. The full copy of the printed patent in double column format must be used. Also revised to indicate that if the patent is not assigned, the reissue applicant should affirmatively state that the patent is not assigned.
- 1410.01 Revised to reflect amendments to 37 CFR 1.172 and 3.73.
- 1411 Revised to reflect amendment to 37 CFR 1.173 and to indicate that for reissue applications filed on or after November 7, 2000, the application must be furnished in the form of a copy of the printed patent in double column format with one page of the patent appearing on only one side of each individual page of the specification of the reissue application.
- 1412.03 Added a new subsection to address the oath or declaration requirements in a broadening reissue application.
- 1412.04 Revised to indicate that where a reissue application seeks to correct inventorship in the patent and the inventors sign the reissue oath or declaration, the correct inventive entity must sign the reissue oath or declaration.
- 1413 Revised to reflect amendments to 37 CFR 1.173(a)(2) and (b)(3). Also revised to indicate that the prior reissue practice of transferring drawings from the patent file has been eliminated, since clean photocopies of the printed patent drawings are acceptable for use in the printing of the reissue patent.
- 1414 Revised to reflect amendment to 37 CFR 1.175.
- 1414.01 Added a new subsection to address supplemental oath or declaration in a broadening reissue.
- 1415 The title of this section has been changed to read “Reissue Filing Fees.”
- 1416 Revised to reflect amendment to 37 CFR 1.178.
- 1417 Added a new subsection to address the situation where a priority claim under 35 U.S.C. 119(a)-(d) is newly perfected in the reissue application.
- 1418 The title of this section has been changed to read “Notification of Prior/Concurrent Proceedings and Decisions Thereon, and of Information Known to be Material to Patentability.” Also revised to indicate that 37 CFR 1.178(b) requires reissue applicants to call to the attention of the

Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved and the results of such proceedings.

- 1430 Revised to indicate that the filing of a request for continued examination (RCE) under 37 CFR 1.114 of a reissue application will not be announced in the *Official Gazette*.
- 1440 Revised to reflect amendment to 37 CFR 1.176.
- 1441 The title of this section has been changed to read “Two-Month Delay Period.”
- 1441.01 Added new section to address protest in reissue applications.
- 1450 Revised to reflect amendment to 37 CFR 1.176.
- 1451 Revised to reflect amendment to 37 CFR 1.177.
- 1452 Added new section to address request for continued examination of reissue application.
- 1453 Revised to reflect amendments to 37 CFR 1.121(h) and 1.173(b) to (g), regarding the manner of making amendments in reissue applications.
- 1455 The material regarding transfer of drawings has been deleted. Revised to indicate that changes to the specification, including the claims, made by the Office in an examiner’s amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner’s amendment pursuant to 37 CFR 1.121(g). Added a new subsection to address final review of the reissue application by the examiner.
- 1470 Added a new section to address public access of reissue applications.
- 1480 Revised to reflect amendment to 37 CFR 1.322. Added a new subsection to address third party information on mistakes in patent.
- 1481 Revised to reflect amendments to 37 CFR 1.323 and 1.324.
- 1490 Revised to add new subsection headings.

#### **CHAPTER 1500:**

- 1502.01 Revised to identify additional differences between design and utility patent applications.

- 1503.01 Revised to reflect amendment to 37 CFR 1.154.
- 1503.02 Revised to reflect amendment to 37 CFR 1.152. Revised to indicate that the Office is *sua sponte* waiving the requirement of 37 CFR 1.84(a)(2)(iii) for a black and white photocopy of color drawings or color photographs.
- 1504.02 Revised to reflect amendment to 35 U.S.C. 102.
- 1504.03 Revised to reflect amendment to 35 U.S.C. 103.
- 1504.04 Rewritten to indicate that when an amendment affecting the claim is submitted that introduces new matter into the drawing, specification, or title and a rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph is made, the examiner should specifically identify in the Office action the subject matter which is not considered to be supported by the original disclosure. A statement by the examiner that merely generalizes that the amended drawing, specification, or title contains new matter is insufficient.
- 1504.06 The discussion regarding a nonstatutory double patenting rejection based on *In re Schneller* has been deleted.
- 1504.20 Revised to indicate that in the absence of a statement in the design application as originally filed incorporating by reference the disclosure of an earlier filed application, the disclosure in a continuing application may not be amended to conform to that of the earlier filed application for which priority is claimed. A mere statement that an application is a continuation or division of an earlier filed application is not an incorporation of anything into the application containing such reference for purposes of satisfying the disclosure requirements of 35 U.S.C. 112, 1<sup>st</sup> paragraph.
- 1504.30 New section added to set forth the expedited examination procedures for design applications.

### **Chapter 1600:**

- 1601 Added language describing the rights associated with a plant patent, the term of a plant patent, and the publication of plant patent applications pursuant to 35 U.S.C. 122(b).
- 1603 Revised to reflect amendment to 37 CFR 1.163(b). Also revised to indicate where information pertaining to the oath or declaration, specification, claims, and drawings is located in MPEP Chapter 1600.

- 1605 Removed plant color coding sheet (Form PTO/SB/20) and reference thereto. Added indication that the Latin name of the genus and species of the plant claimed should be stated.
- 1606 Revised to indicate that if the drawings or photographs are in color, two copies of the drawings or photographs are required. Also revised to indicate that the requirement under 37 CFR 1.165(b) for a black and white photocopy of any color drawing or photograph has been waived.
- 1612 The list of states that are party to the UPOV Convention has been updated. Revised to indicate that the United States adheres to the 1991 text of the UPOV Convention and has a reservation under Article 35(2) of the text (which allows plant patents rather than breeder's rights certificates).
- 1613 New section added to reflect addition of 35 U.S.C. 119(f), and to explain that an application for a plant patent may rely upon an application for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) for priority under 35 U.S.C. 119(a) through (c).

#### **Chapter 1700:**

- 1701 Added language to indicate that no USPTO employee may pursue a bounty offered by a private sector source for identifying prior art, and that acceptance of payments from outside sources for prior art search activities may subject the employee to administrative disciplinary action.
- 1703 Rewritten to update the description of the *Official Gazette* and the information published therein.
- 1730 Updated description of general information available on the USPTO Internet site. Updated information pertaining to patent related databases, and added description of the Patent Applications Database. Added language describing the Patent Electronic Business Center, including Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS). Updated and reorganized format of information under the heading "Miscellaneous."

#### **CHAPTER 1800:**

- Intro Updated to indicate information available from the website of the World Intellectual Property Organization (WIPO).
- 1801 Revised to reference the WTO administered Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Agreement).

- 1803 Revised to indicate that if the United States is the only PCT Contracting State designated in an international application, the international application will not be published by the International Bureau (IB) at 18 months. Nonetheless, the USPTO will publish the application under 35 U.S.C. 122(b) after it has entered the national stage in the United States.
- 1807 Revised to indicate that the PCT Applicant's Guide can be viewed or ordered online from WIPO's website.
- 1811 Updated to make reference to the procedure for receiving the international application on behalf of the International Bureau under PCT Rule 19.4 when the USPTO is not a competent receiving Office for the international application under PCT Rule 19.1(a), but at least one applicant is a resident or national of any PCT Contracting State.
- 1812 Revised to include a reference to the PCT-EASY software.
- 1817 Revised to include all PCT Member States as of August 15, 2001.
- 1820 Revised to indicate that the Chief Executive Officer, Chief Operating Officer, and Chief Financial Officer of an organization are presumed to have authority to sign on behalf of the organization. Also revised to indicate that the Office no longer requires proof of authority of the legal representative of a deceased inventor.
- 1821 Revised to reflect amendment to 37 CFR 1.434. Revised to indicate that reduced fees are payable in respect of an international application containing the request in PCT-EASY format filed, together with a PCT-EASY diskette, with a receiving Office which accepts the filing of such international applications. Also revised to indicate that the Request may not contain any matter that is not specified in PCT Rules 4.1 to 4.17 or permitted under PCT Rule 4.18(a) by the Administrative Instructions. Revised to discuss *ex officio* correction of the agent's file reference in view of *Helgott & Karas P.C. v. Dickinson*.
- 1823.02 Revised to include guidelines on how to qualify for paying a reduced basic fee (when filing an international application with a lengthy sequence listing) by filing the sequence listing on compact disc with no paper copy.
- 1825 Revised to indicate that if the drawings contain text matter not in English but in a language accepted under PCT Rule 12.1(a) by the International Bureau as a Receiving Office, the international application will be transmitted to the International Bureau for processing in its capacity as a Receiving Office, and that if the drawings contain text matter not in a language accepted under PCT Rule 12.1(a) by the International Bureau as

- a Receiving Office, the application will be denied an international filing date.
- 1826 Revised to indicate that U.S. national practice (37 CFR 1.72(b)), like PCT practice, now allows a maximum of 150 words in the abstract.
- 1827 Revised to indicate that a complete list of Patent Cooperation Treaty fee amounts can be found on the PCT Legal Office page of the USPTO web site.
- 1828 Revised in view of amended PCT Rule 4.10. An applicant may claim the priority of an application filed in or for a State which is a Member of the World Trade Organization (WTO), even if that State is not party to the Paris Convention for the Protection of Industrial Property (Paris Convention). However, a PCT Contracting State that is not a Member of the WTO would not be obliged to recognize the effects of such a priority claim.
- 1836 Updated the discussion of “obvious errors” to indicate that the improper identification of the application number has been held to be an “obvious error” under PCT Rule 91 when the applicant did include the proper agent’s file reference and other information properly identifying the application file.
- 1840 Revised to reflect amendment to 35 U.S.C. 362. Revised to add India and South Africa to the list of States (countries) for which the USPTO will act as an International Searching Authority.
- 1847 Revised to reflect amendment to 37 CFR 1.446. Revised to explain refund of the search fee under 37 CFR 1.446(d). Also revised to explain refund of the handling fee under 37 CFR 1.446(e).
- 1848 Revised to reference USPTO guidelines for accepting international applications with lengthy sequence listings under Part 8 of the Administrative Instructions. The guidelines have been reproduced in MPEP § 1823.02.
- 1851 Revised to indicate how Standard ST. 16 can be located on WIPO’s website. Updated the discussion of kind codes appearing on documents published by the USPTO and by other patent offices located throughout the world.
- 1857.01 New section added to explain when an international publication published under PCT Article 21(2)(a) is available as a reference as of its international filing date.



- 1864.02 Updated to include revised PCT Rule 54.1
- 1865 Revised to include India and South Africa in the list of countries for whose residents and nationals the USPTO will serve as an International Preliminary Examining Authority if the U.S. was the International Searching Authority.
- 1870 Updated to include revised PCT Rule 66.7.
- 1878 Revised to indicate that two copies of each newly cited reference should be included in the PCT Chapter II file when it is sent to PCT Operations for the mailing of the form PCT/IPEA/408. Updated to discuss the time limits (PCT Rule 69.2) for the IPEA to establish the international preliminary examination report (IPER). Revised to indicate that as a general rule, a 1-month time limit for reply to the written opinion should be set by the examiner if the written opinion (Form PCT/IPEA/408) has not been completed by the examiner within 24 months following the application's "priority date."
- 1879 Revised to discuss the time limits (PCT Rule 69.2) for the IPEA to establish the international preliminary examination report (IPER).
- 1890 Revised to reflect that the DO/EO, and not OIPE, mails the notice of acceptance and the filing receipt to the applicant when the national stage application is complete.
- 1893 Revised to cross-reference MPEP § 1895.01, subsection (E) and MPEP § 1896 for discussions of when the filing date of an international application is to be taken into account in determining patentability or validity. Revised to discuss the availability of patents as prior art under 35 U.S.C. 102(e).
- 1893.01 Revised to reflect amendment to 35 U.S.C. 371.
- 1893.01(a) Revised to reflect amendment to 37 CFR 1.494.
- 1893.01(b) Revised to reflect amendment to 37 CFR 1.495.
- 1893.01(e) Revised to reflect amendment to 37 CFR 1.497. Updated to cross-reference MPEP § 409.01(b) and to indicate that the Office no longer requires proof of authority of the legal representative of a deceased or legally incapacitated inventor.

- 1893.03 Updated to include the text of 37 CFR 1.496. Revised to include a discussion of the reduced basic national fee payable if an application includes only claims which have been indicated in an IPER prepared by the USPTO to satisfy the criteria of PCT Article 33(1)-(4). Revised to indicate that applications in which the reduced basic national fee has been paid will be taken up out of order by the examiner.
- 1893.03(a) Revised to include a discussion of a submission pursuant to 35 U.S.C. 154(d)(4) for establishing an effective date for provisional rights resulting from the filing of a PCT application.
- 1893.03(c) Section titled “The Certified Copy” has been revised to indicate that the requirement for the certified copy of the priority document is set forth in 37 CFR 1.55(a)(2). Section titled “Priority Claim Under 35 U.S.C. 119(e), or 120 and 365(c)” revised to reflect revisions to 37 CFR 1.78.
- 1893.03(e) Revised to indicate that it is improper for the examiner of the U.S. national stage application to require an abstract on a separate sheet during national stage processing of an international application.
- 1895 Revised to include the requirement for an indication whether the prior PCT international application was published under PCT Article 21(2) in English in the first sentence of the specification if the continuing U.S. national application was filed on or after November 29, 2000.
- 1895.01 Revised discussion under heading “E. Filing Date For Prior Art Purposes Under 35 U.S.C. 102(e).” Revised the suggested language for the first sentence of an application filed under 35 U.S.C. 111(a) to include the language “...published in English under PCT Article 21(2)...” when the application claims priority to an international application.
- 1896 Revised to include a discussion of PCT Article 64(4). Section titled “Effective Date as a Reference” revised and expanded to include subsections titled “Publications Under 35 U.S.C. 122(b) as References” and “U.S. Patents as References.”

#### **CHAPTER 1900:**

- 1901 Revised to reflect amendment to 37 CFR 1.291. Revised to indicate that all protests must be submitted prior to the publication of the application or the mailing of a notice of allowance, whichever occurs first.
- 1901.05 Revised to indicate that original applications are required by 35 U.S.C. 122 to be kept in confidence unless published pursuant to 35 U.S.C. 122(b). Revised to indicate that after an application is published pursuant

to 35 U.S.C. 122(b), a copy of the file wrapper of the published application may be requested by filing a written request under 37 CFR 1.14(c)(2) including the fee as set forth in 37 CFR 1.19(b)(2).

#### **CHAPTER 2000:**

- 2001 Revised to reflect amendment to 37 CFR 1.56.
- 2001.04 Updated to include a cross-reference to MPEP § 609. Updated discussion of withdrawal from issue under 37 CFR 1.313. Added a discussion of duty of disclosure in continuation-in-part applications under 37 CFR 1.56(e). Revised to indicate that the Office may order or conduct reexamination proceedings based on prior art that was cited but whose relevance to patentability of the claims was not discussed in any prior related Office proceeding.
- 2004 Cross-reference to MPEP § 2165-2165.04 added for additional information about the best mode requirement. Added discussion of *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*
- 2005 New section comparing meaning of “material to patentability” under 37 CFR 1.56 with meaning of “reasonably necessary to properly examine or treat the matter” under 37 CFR 1.105.

#### **Chapter 2100:**

- 2106 Revised to add examples of inventions that have a practical application because they produce a useful, concrete and tangible result. Also revised to indicate that software aspects of an invention may be described functionally, and that merely using a computer to automate a known process does not by itself impart nonobviousness to an invention.
- 2107 Rewritten to incorporate guidelines for examination of applications for compliance with the utility requirement (utility examination guidelines). Material previously in this section moved to MPEP § 2107.01.
- 2107.01 Revised to incorporate material previously in MPEP § 2107, and to update information for consistency with utility examination guidelines. Material previously in this section moved to MPEP § 2107.02.
- 2107.02 Revised to incorporate material previously in MPEP § 2107.01, and to update information for consistency with utility examination guidelines. Material previously in this section moved to MPEP § 2107.03.
- 2107.03 New section added to incorporate material previously in MPEP § 2107.02.

- 2111.02      Rewritten to clarify that the preamble has the import that the claim as a whole suggests for it, and to discuss the determination of whether claim preamble recitations are structural limitations or mere statements of purpose or use.
- 2111.03      Revised to explain that for the purposes of searching for and applying prior art under 35 U.S.C. 102 or 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, the term “consisting essentially of” will be construed as equivalent to “comprising.” Also revised to clarify the interpretation of transitional phrases such as “having” and “composed of” in view of recent Federal Circuit decisions.
- 2125            Revised to add discussion of recent Federal Circuit decision.
- 2133.03(c)    Revised to add discussion of recent Federal Circuit decisions.
- 2136            Revised to reflect amendment to 35 U.S.C. 102(e). Specifies that when examining any application filed on or after November 29, 2000 or any application that has been voluntarily published, the application is subject to the current version of 35 U.S.C. 102(e), whereas when examining any application filed prior to November 29, 2000 which has not been voluntarily published, the application is subject to the former version of 35 U.S.C. 102(e).
- 2136.01        Revised to reflect amendment to 35 U.S.C. 102(e). Also revised to indicate that for applications filed on or after November 29, 1999, a provisional rejection under 35 U.S.C. 102(e)/103 is not proper if the application contains evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made.
- 2136.02        Revised to reflect amendment to 35 U.S.C. 102(e). Also revised to indicate that for applications filed on or after November 29, 1999, a rejection under 35 U.S.C. 102(e)/103 is not proper if the application contains evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made.
- 2136.03        Revised to reflect amendment to 35 U.S.C. 102(e). Revised to indicate the prior art date of an application publication under 35 U.S.C. 122(b) that claims the benefit of the international filing date of an international application; the prior art date of an international application publication;

and the prior art date of a U.S. patent granted on an international application that met the requirements of 35 U.S.C. 371(c)(1), (2), and (4).

- 2136.04 Revised to reflect amendment to 35 U.S.C. 102(e).
- 2136.05 Revised to reflect amendment to 35 U.S.C. 102(e).
- 2137.01 Revised to indicate that a request under 37 CFR 1.48(a) is required to correct any error in naming the inventors.
- 2138 Rewritten to clarify when subject matter qualifying as prior art under 35 U.S.C. 102(g) may form the basis for an *ex parte* rejection.
- 2138.04 Revised to add discussion of recent Federal Circuit decision.
- 2138.05 Revised to add discussion of recent Federal Circuit decisions explaining that recognition of the invention by another may inure to the benefit of the inventor.
- 2143.01 Revised to add discussion of recent Federal Circuit decision.
- 2163 Rewritten to incorporate guidelines for the examination of patent applications under the 35 U.S.C. 112, 1<sup>st</sup> paragraph, written description requirement (written description guidelines).
- 2163.02 Revised to be consistent with the written description guidelines.
- 2163.03 Revised to be consistent with the written description guidelines.
- 2163.04 Rewritten to clarify the burden on the examiner with regard to the written description requirement and updated for consistency with the written description guidelines.
- 2163.05 Revised to clarify how broadening a claim can raise an issue regarding whether the inventor had possession of a broader, more generic invention. Also updated for consistency with the written description guidelines.
- 2163.07 Added discussion of recent Federal Circuit decision.
- 2163.07(a) Added an explanation of the evidence necessary to establish inherency.
- 2164.06(a) Added discussion of recent Federal Circuit decision.
- 2164.07 Updated for consistency with the utility examination guidelines.

- 2165 Added discussion of recent Federal Circuit decision.
- 2165.01 Added discussion of recent Federal Circuit decisions.
- 2173.02 Added discussion indicating that in reviewing a claim for compliance with 35 U.S.C. 112, 2<sup>nd</sup> paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope.
- 2173.05(c) Revised to clarify that while a single claim that includes both a broad and a narrower range may be indefinite, it is proper under 35 U.S.C. 112, second paragraph to present a dependent claim that sets forth a narrower range for an element than the range set forth in the range from which it depends.
- 2173.05(e) Added language indicating that a claim is not *per se* indefinite if the body of the claim recites additional elements that do not appear in the preamble.
- 2173.05(h) Revised information under the “*Subgenus Claim*” heading to indicate that genus, subgenus, and Markush-type claims, if properly supported by the disclosure, provide acceptable ways to present claims of different scope.
- 2173.05(i) Added language indicating that if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.
- 2173.05(m) Revised to clarify when claims are rejected as prolix.
- 2173.05(o) Revised to indicate that there is no *per se* rule that “double inclusion” is improper in a claim.
- 2181 Revised to incorporate supplemental examination guidelines for determining the applicability of 35 U.S.C. 112, 6<sup>th</sup> paragraph.
- 2182 Added language indicating that the specification need not describe the equivalents of the structures, material, or acts corresponding to the means- (or step-) plus-function element.
- 2183 Added factors that will support a conclusion that a prior art element is equivalent to the corresponding element disclosed in the specification.
- 2184 Updated for consistency with the supplemental examination guidelines for determining the applicability of 35 U.S.C. 112, 6<sup>th</sup> paragraph.

## **CHAPTER 2200:**

- 2201 Revised to identify the statutes and rules that pertain to *inter partes* reexamination proceedings.
- 2202 Revised to reflect amendment to 37 CFR 1.501.
- 2206 Revised to indicate that prior art citations received in the Office will be forwarded to the Technology Center (TC) that currently examines the class and subclass in which the patent to which the prior art citations are addressed is classified as an original. Notification to the patent owner that a citation of prior art has been placed in the file wrapper has been modified to provide a check box for specifying whether the citation of prior art has been placed in the patent file wrapper or in the reexamination proceeding file wrapper. Revised to indicate that any unusual problems concerning the citation of prior art by the patent owner should be brought to the attention of the Office of Patent Legal Administration.
- 2210 Updated to include revised 35 U.S.C. 302. Updated to include revised 37 CFR 1.510, including the revision to 37 CFR 1.510(b)(4) which requires a copy of the entire patent in double column format.
- 2212 Revised to reflect amendment to 37 CFR 1.510(a).
- 2214 Revised to reflect amendments to 37 CFR 1.510(a) and (b). Revised to indicate that, when filing a request for the *ex parte* reexamination of a patent, a copy of the patent including the front face, drawings, and specification/claims (in double column format) is required. Updated to include revised form PTO/SB/57 (also referred to as form PTO-1465).
- 2217 Revised to reflect amendments to 35 U.S.C. 102(e) and (g).
- 2219 Revised to indicate that the copy of the patent for which reexamination is requested should be provided in a double column format.
- 2220 Revised to indicate that a third party requester must serve a copy of the request on the patent owner, and that both the copy of the request served on the patent owner and the copy of the request filed in the Office must include a certificate of service. The third party requester must set forth on the certificate of service the name and address of the party served and the method of service.
- 2222 “Dissemination Services Division” changed to --Document Services Division--
- 2226 Revised to indicate that the reexamination preprocessing staff, which handles the opening of all mail marked “Box Reexam,” and all initial

clerical processing of requests for reexamination, is now located in the Office of Patent Legal Administration, Central Reexamination Unit (CRU), rather than in the Office of Initial Patent Examination (OIPE).

- 2227 See 2226 above.
- 2228 See 2226 above.
- 2229 See 2226 above.
- 2232 Revised to include new procedures for public access to reexamination files in view of the availability of electronically scanned files from the Reexamination Processing System (REPS).
- 2233 Revised to indicate that the working groups in the Technology Centers (TCs) have designated the legal instrument examiners to act as reexamination clerks, as part of their assigned duties, and thus to perform those clerical duties and responsibilities in the groups which are unique to reexamination. The TC Special Program Examiners (SPREs) and Paralegal Specialists have the responsibility to oversee clerical processing and serve as a resource for questions. Revised to cross-reference MPEP § 2236 and to indicate that reexamination requests are assigned to an examiner other than the examiner who was involved in the examination of the patent application.
- 2234 Revised to reflect amendments to 37 CFR 1.121 and 1.530. Revised to indicate that 37 CFR 1.121(g) does not apply in reexamination proceedings. Examiners must present the entire claim or paragraph being amended by examiner's amendment.
- 2235 Revised to indicate that reexamination file data can be retrieved using PALM Intranet by entering the reexamination control number in the space provided for an application number.
- 2236 Revised to explain new policy for assigning reexamination requests to examiners. Reexamination requests are to be assigned to an examiner different from the examiner(s) who examined the patent application.
- 2239 Revised to reflect amendment to 37 CFR 1.520.
- 2239 Updated in view of revised procedure for ordering a reexamination at the Commissioner's initiative. If an order to reexamine is to be issued, the decision is prepared in the Office of Patent Legal Administration, signed by the Deputy Commissioner for Patent Examination Policy, and mailed by OPLA.



- 2240 Revised to reflect amendments to 35 U.S.C. 303 and 37 CFR 1.515. Revised to clarify that if a decision to deny an order for reexamination is made, the requester may seek review by a petition under 37 CFR 1.181.
- 2242 Revised to include a discussion of *Heinl v. Godici*. Updated to indicate that any situations requiring clarification should be brought to the attention of the Office of Patent Legal Administration (OPLA).
- 2246 Revised to reflect amendments to 35 U.S.C. 304 and 37 CFR 1.525. Revised to indicate that when granting a decision ordering reexamination, where the question is raised, or where it is not clear that a patent or printed publication pre-dates the patent claims, a discussion should be provided as to why the patent or printed publication is in fact available against the patent claims.
- 2247 Revised what is to be included by the examiner in support of his or her conclusion that no substantial new question of patentability has been raised (when denying a request for reexamination).
- 2248 Revised to reflect amendment to 37 CFR 1.515. Revised to include a discussion of the procedure for reassigning the reexamination proceeding if a petition under 37 CFR 1.515(c) is granted.
- 2249 Revised to reflect amendments to 37 CFR 1.530(a)-(c).
- 2250 Revised to reflect amendment to 37 CFR 1.121. Revised the discussion of the manner of making amendments in reexamination proceedings.
- 2250.01 Revised to reflect amendment to 37 CFR 1.530(d)(3). Revised to indicate that in the event a figure is canceled, the figure must be surrounded by brackets and identified as “Canceled.” Updated to include new procedures for reviewing patent drawings. A draftsman’s “stamp” to indicate approval is no longer required on patent drawings, and these stamps are no longer to be used by draftspersons.
- 2250.02 New section added to address Correction of Inventorship during reexamination proceedings.
- 2251 Revised to reflect amendment to 37 CFR 1.535.
- 2252 Revised to reflect amendment to 37 CFR 1.540.
- 2254 Revised to reflect amendment to 37 CFR 1.550.

- 2258 Revised to reflect amendments to 37 CFR 1.552, 102(e), and 102(g). Revised to indicate that, when a request for reexamination of a reissued patent has been filed, any amendment made by the patent owner should treat the changes made by the granted reissue patent as the text of the patent, and all bracketing and underlining is to be made with respect to the patent as changed by the reissue.
- 2260 Revised to reflect amendment to 37 CFR 1.104.
- 2265 Revised to reflect amendment to 37 CFR 1.550(c). Revised to indicate that the patent owner is entitled to know the examiner's ruling on a timely response filed after final rejection before being required to file a notice of appeal. Notification of the examiner's ruling should reach the patent owner with sufficient time for the patent owner to consider the ruling and act on it.
- 2266 Revised to reflect amendments to 37 CFR 1.111 and 1.550(b) - (h).
- 2266.01 Updated to reflect that, in a reexamination proceeding, the patent owner cannot file a request for continued examination (RCE) under 37 CFR 1.114.
- 2266.03 Revised to reflect amendments to 37 CFR 1.550(f)-(h). Revised to discuss the requirements of "proof of service" when one party to a reexamination proceeding serves a paper on another party. The party submitting the paper to the Office must attach a certificate of service to the paper. It is required that the name and address of the party served, and the method of service be set forth in the certificate of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party.
- 2268 Revised discussion of petitions based on unavoidable delay under 37 CFR 1.137(a). Added discussion of petitions based on unintentional delay under 37 CFR 1.137(b). Added discussion of renewed petitions under 37 CFR 1.137(a) and (b).
- 2271 Updated to reflect that, in a reexamination proceeding, the patent owner cannot file a request for continued examination (RCE) under 37 CFR 1.114. Revised to state that a patentability review conference is required before issuing a final rejection in a reexamination proceeding.
- 2271.01 Added discussion of patentability review conferences in detail.

- 2272 Updated to reflect that, in a reexamination proceeding, the patent owner cannot file a request for continued examination (RCE) under 37 CFR 1.114. Revised discussion of the amount of time given to respond to a final rejection in a reexamination proceeding. If a response to the final rejection is filed, the time period set in the final rejection is automatically extended by 1 month if the response is the first response after the final rejection. The period for response should be appropriately extended in the examiner's advisory action if there is insufficient time for the patent owner to consider the examiner's ruling and act on it.
- 2273 Revised to help patent owners identify when they are entitled to appeal a rejection to the Board of Patent Appeals and Interferences. In an *ex parte* reexamination of a patent that issued from an original application filed on or after November 29, 1999, the patent owner may appeal to the Board only after a claim has been finally rejected.
- 2275 Revised to reflect amendment to 37 CFR 1.193.
- 2279 Revised to help patent owners identify when they are entitled to appeal a decision of the Board of Patent Appeals and Interferences to the United States Court of Appeals for the Federal Circuit (CAFC), and when they are entitled to appeal a decision of the Board of Patent Appeals and Interferences to the United States District Court for the District of Columbia. In an *ex parte* reexamination of a patent that issued from an original application filed on or after November 29, 1999, the patent owner may appeal only to the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141.
- 2281 Revised to reflect amendment to 37 CFR 1.560. Revised to indicate that the Office of Patent Legal Administration (OPLA) may authorize interviews to take place other than in the Office within Office hours.
- 2282 Revised to reflect amendment to 37 CFR 1.565(a).
- 2283 Revised to reflect amendments to 37 CFR 1.565(a) and (c). The section on "Merger of Reexaminations" was revised to indicate that in the event that a housekeeping amendment is required by the merger decision (to place identical amendments in all files) but is not timely submitted, any claim that does not contain identical text in all of the merged proceedings should be rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.
- 2284 Revised to reflect amendments to 37 CFR 1.565(a) and (e). Revised the section titled "Attempting to Provoke an Interference With a Patent

Involved in a Reexamination Proceeding.” The section relating to motions to suspend under 37 CFR 1.635 was amended to include a discussion of the relationship between requests to suspend under 37 CFR 1.565(e) and petitions to invoke the supervisory authority of the Commissioner under 37 CFR 1.644(a)(2). Revised to indicate that petitions to stay filed subsequent to the date of the order for reexamination will be referred to the Office of Patent Legal Administration (OPLA) for decision, and that all decisions on the merits of petitions to stay a reexamination proceeding because of an interference will be made in OPLA.

2285 Revised to reflect amendment to 37 CFR 1.565(d). Revised to indicate that the decision as to whether the proceedings are to be merged, or which proceeding (if any) is to be stayed is made in the Office of Patent Legal Administration (OPLA). Revised to indicate that, when a reexamination of a reissued patent has been requested, any amendment made in the reexamination proceeding should treat the changes made by the reissue as the text of the patent, and all bracketing and underlining should be made with respect to the patent as changed by the reissue. The section titled “Conduct of Merged Reissue Application Examination and Reexamination Proceedings” was amended to include a discussion of housekeeping amendments. The section titled “Conduct of Merged Reissue Application Examination and Reexamination Proceedings” was amended to indicate that once the files are returned to the examiner for issuance of an Office action, the examiner should prepare an Office action at the most advanced point possible for the first proceeding. The section titled “Conduct of Merged Reissue Application Examination and Reexamination Proceedings” was amended to indicate that, in contrast to when a CPA of the reissue application is filed, if an RCE is filed, the reissue application is not considered to be expressly abandoned and the merged proceeding will continue.

2286 Revised to reflect amendment to 37 CFR 1.565(b).

2287 Revised to state that a patentability review conference is required before issuing a “Notice of Intent to Issue Reexamination Certificate” (NIRC), unless the NIRC is being issued: (A) following and consistent with a decision by the Board of Patent Appeals and Interferences (or court) on the merits of the proceeding; or (B) as a consequence of the patent owner’s failure to respond or take other action where such a response or action is necessary to maintain pendency of the proceeding and, as a result of which failure to respond, all of the claims will be canceled. The section titled “Reexamination Reminders” was revised, in paragraph (J), to indicate that a draftsperson’s “stamp” to indicate approval of the drawings is no longer required on patent drawings, and these stamps are no longer to be used by draftspersons. The section titled “Examiner’s Amendment” was amended

to include an indication that the exception for examiner's amendments set forth in 37 CFR 1.121(g) does not apply to examiner's amendments in reexamination proceedings.

- 2288 Revised to reflect amendments to 35 U.S.C. 307(a) and 37 CFR 1.570.
- 2289 Revised to indicate that after leaving the Technology Centers (TCs), all reexamination cases go through a screening process currently performed in the Office of Patent Legal Administration (OPLA).
- 2290 Revised to indicate that reexamination certificates published on or after January 2, 2001 include the kind code designation "C," and to cross-reference MPEP § 901.4(a) for a complete list of the kind codes used by the United States Patent and Trademark Office. Updated to include a reexamination certificate including the "C" kind code designation.
- 2293 Revised to reflect amendment to 35 U.S.C. 307(b).
- 2296 Removed the "Reasons for Patentability - PTOL 476" and the "Removal of file for copying - PTOL 470" from the list of forms to be used in reexamination actions. Added a reference to the "Request for *Ex Parte* Reexamination Transmittal Form, PTO/SB/57," available from the USPTO web site.

#### **CHAPTER 2300:**

- 2300.01 Revised to reflect amendment to 35 U.S.C. 135. Amended to cross-reference MPEP §§ 2309 through 2309.02 for the procedures for preparation of interference papers by the examiner. The list of notices and comments was revised to include the following additions:
- Final Rule:  
49 FR 48416 (Dec.12, 1984), 1050 O.G. 385 (Jan.29, 1985);
- Notices of Rulemaking:  
64 FR 12901 (Mar. 16, 1999); 65 FR 56792 (Sept. 20, 2000), 1239 O.G. 125 (Oct. 17, 2000); 65 FR 70489 (Nov. 24, 2000), 1241 O.G. 68 (Dec. 19, 2000);
- Notices:  
*Admissibility of Electronic Records in Interferences*, 1208 O.G. 35 (Mar. 10, 1998); *Publication of Opinions and Orders Entered by the Board of Patent Appeals and Interferences*, 1217 O.G. 17 (Dec. 1, 1998); *Interference Practice – Interference Rules Which Require a Party to "Show the Patentability" of a Claim*, 1217 O.G. 17 (Dec. 1, 1998); *Interference Practice – New Procedures for Handling Interference Cases at the Board of Patent Appeals and Interferences*, 1217 O.G. 18 (Dec. 1, 1998).

- 2301.01(b) Revised to indicate that in determining whether to propose an interference, the primary examiner must be of the opinion that an interference exists, and that an Interference Practice Specialist (IPS) may be consulted for advice.
- 2301.02 Revised to reflect amendment to 37 CFR 1.601. Revised to indicate the USPTO permits an interference between one or more applications and one or more patents “provided it does not create an interference between patents.”
- 2303 Revised to remove the explanation of what is required for the claim in one application to be considered to be drawn to the “same patentable invention” as a claim in a second application.
- 2304 Revised to include a cross reference to MPEP §§ 2309 through 2309.02 for the procedures for preparation of interference papers by the examiner. Revised to include a reference to 35 U.S.C. 135(b), which bars an applicant from copying a claim from an issued patent more than one year after the patent has issued, and which now also bars an applicant in a second application from copying a claim from a first application more than one year after the publication date of the first application when the second application is an application that was filed after the publication date of the first application.
- 2305 Revised to indicate that the examiner should ensure that a claim suggested to the applicant is not barred under 35 U.S.C. 135(b)(2).
- 2305.04 “Publishing Division” changed to --Office of Patent Publication--. Revised to indicate that the Interference Practice Specialist, and not the primary examiner, consults with the administrative patent judge during an interference proceeding.
- 2306 Revised to reflect amendment to 37 CFR 1.606. Revised to remove the explanation of what is required for a claim in an application to be considered to be drawn to the “same patentable invention” as a patent claim. Revised to eliminate the statement that 35 U.S.C. 291 grants the jurisdiction over an interference involving only patents to the courts. Revised to remove a discussion of the *rebuttable* presumption that any patent claim designated to correspond to a count does not embrace separate patentable inventions. Revised to remove the statement that, at the time an interference is declared, no count will be narrower in scope than any application claim that is patentable over the prior art and designated to correspond to the count or any patent claim designated to correspond to the count.

- 2307 Revised to indicate that 35 U.S.C. 122(b) may bar presenting a claim drawn to “substantially the same subject matter” as a claim appearing in a published application.
- 2309 Rewritten to indicate the steps an examiner should take once a potential interference has been identified.
- 2309.01 This section has been deleted.
- 2309.02 Revised to make reference to the fact that, in order to be entitled to foreign priority benefit for utility or plant applications filed on or after November 29, 2000, the applicant must submit the priority claim within the time required by 37 CFR 1.55(a)(1) or file a grantable petition, including the surcharge set forth in 37 CFR 1.17(t), for an unintentionally delayed priority claim under 37 CFR 1.55(c). Updated to include new form PTO-850 (revised Nov. 28, 2000). Amended to indicate that if two of the parties have the same attorney or agent, the examiner will in a separate memorandum call the attention of the Board to that fact when the Interference Initial Memorandum is forwarded. The administrative patent judge, when the interference is declared, can then take such action as may be appropriate under 37 CFR 1.613(b).
- 2309.05 This section has been deleted.
- 2340 Revised to delete the statement that under 37 CFR 1.640, an administrative patent judge will address all motions. Revised to delete the statement that a hearing (in person or by telephone) may be held on a motion in the discretion of an administrative patent judge.
- 2358 Revised to indicate that a judgment that does not resolve all counts or that remands the interference for further proceedings is not final for purposes of judicial review and not immediately appealable to the courts. Revised to eliminate the statement that the files will be retained at the Board until all court proceedings have terminated.
- 2363 “Publishing Division” changed to --Office of Patent Publication--.

**Chapter 2400:**

- 2401 Added reference to revised deposit rules and revised sequence rules.
- 2404.01 Revised to clarify the situations under which the Office will certify that a deposit has been stated to have been made under conditions which make it available to the public as of the issue date of the patent grant.

- 2405 Revised to update the list of International Depositary Authorities recognized under the Budapest Treaty.
- 2411.03 Revised to reflect amendments to 37 CFR 1.136 and 1.809 which indicate that the period of time within which a deposit may be made is not extendable if set forth in the “Notice of Allowability” or in an Office action having a mail date on or after the mail date of such notice. Also revised to advise applicants to make any necessary deposit well prior to the payment of the issue fee to leave sufficient time to make the necessary amendment to the specification.
- 2420 Revised to indicate that the sequence rules allow submissions of nucleotide and/or amino acid sequences and associated information on compact discs.
- 2421.03 Revised to indicate that applications filed on or after November 29, 2000 will be retained in the Office of Initial Patent Examination until any noncompliant sequence listing that renders an application unsuitable for examination is corrected.
- 2422.03 Revised to reflect amendment to 37 CFR 1.821, and to describe the requirements for a compact disc submission of a “Sequence Listing.”
- 2422.04 Revised to indicate that the “Sequence Listing” submitted pursuant to 37 CFR 1.821(c) , whether on paper or compact disc, is the official copy of the “Sequence Listing.”
- 2423.01 Revised to clarify how to properly use “modified base” and “modified and unusual amino acid” codes.
- 2426 Added information describing how to amend material submitted on compact disc(s).
- 2427.01 Revised to add reference to form paragraphs which should be used when notifying an applicant that a compact disc submitted in accordance with 37 CFR 1.52(e) (i.e., containing a computer program listing, Sequence Listing, or table) does not comply with all the requirements of 37 CFR 1.52(e). Also revised to renumber the form paragraphs which should be used when notifying applicant of errors in the Sequence Listing.
- 2429 Revised to add helpful hints pertaining to a Sequence Listing submitted on compact disc.



- 2430 Revised to describe the features and availability of PatentIn 3.0 and PatentIn 3.1.
- 2435 Added to indicate that, in certain patents and patent application publications with lengthy Sequence Listings, the Sequence Listings will be published only in electronic form.

**CHAPTER 2500:**

- 2501 Revised to reflect amendment to 35 U.S.C. 41. “Office of Public Records Dissemination Support Division Records Branch” changed to --Office of Public Records Document Services Division Special Handling Branch--.
- 2506 Revised to indicate that the filing of a request for *ex parte* or *inter partes* reexamination and/or the publication of a reexamination certificate does not alter the schedule of maintenance fee payments of the original patent.
- 2510 Revised to explain how to submit maintenance fee documents by facsimile or over the Internet as alternatives to mail or “Express Mail.” Revised to indicate that form PTO-2038 should be used for the payment of maintenance fees by credit card.
- 2511 This section has been deleted. The subject matter formerly in MPEP § 2511 has been moved to MPEP § 2510.
- 2515 Revised to reflect amendments to 37 CFR 1.366(c) and (f). Revised to explain how the Office intends to handle a maintenance fee payment when the payment is submitted without a clear indication of both the patent and the application number to which the payment is to be applied.
- 2520 Revised to indicate that the USPTO website may be contacted for current maintenance fee amounts.
- 2522 Revised to indicate that form PTO-2038 should be used for the payment of maintenance fees by credit card.
- 2530 Revised to explain how the Office intends to handle a maintenance fee payment when the payment is submitted without a clear indication of both the patent and the application number to which the payment is to be applied.
- 2540 Revised to indicate that the “Fee Address” Indication Form, PTO/SB/47, is available from the USPTO website.

- 2542 Revised to explain that a change of correspondence address made prior to the filing of an oath or declaration is made as provided in 37 CFR 1.33(a)(1), whereas a change of correspondence address made after the filing of an executed oath or declaration is made as provided in 37 CFR 1.33(a)(2). Revised to indicate that a change of correspondence address filed during the enforceable life of a patent may be sent to the Office of Public Records, Document Services Division, Special Handling Branch, and to suggest the use of form PTO/SB/122 to request a change of correspondence address in a patent application and the use of form PTO/SB/123 to request a change of correspondence address in an issued patent.
- 2550 Revised in view of the simplified practice for asserting small entity status under 37 CFR 1.27.
- 2560 “Office of Public Records Dissemination Support Division Records Branch” changed to --Office of Public Records Document Services Division Special Handling Branch--.
- 2595 Forms PTO/SB/45, and PTO/SB/47 replaced with updated forms.

**CHAPTER 2700:**

- Chapter 2700 Added to address issues pertaining to patent term, term extensions or adjustments for delays within the USPTO under 35 U.S.C. 154, and term extensions for delays at other agencies under 35 U.S.C. 156.
- 2701 Added to incorporate and clarify information pertaining to patent terms and extensions previously appearing in MPEP § 1309.01. Also added explanation of expiration date of patents with terminal disclaimer.
- 2710 Added to describe the adjustment (extension) provisions, if any, available for patents issuing on applications filed in specified date ranges.
- 2720 Added to describe patent term adjustment (extension) provisions available for patents issuing on applications filed between June 8, 1995 and May 28, 2000.
- 2730 Added to describe patent term adjustment provisions available for patents issuing on applications filed on or after May 29, 2000.
- 2750 through 2764 Added to describe policy and procedures relevant to patent term extension available under 35 U.S.C. 156 and 37 CFR 1.701 through 1.791 for premarket regulatory review.