

U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria , Virginia 22313-1450

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

**Instructions Regarding Revision No. 9**

**Introduction**

Appendix L has been updated to incorporate the Leahy-Smith America Invents Act, Public Law 112-29, 125 Stat. 284.

Appendix R has been updated to incorporate rule changes and corrections subsequent to July 2010.

This revision consists of replacements for the **Title Page** in the front of the Manual, **entire Chapters 500, 600, 700, 1200, 1400, and 2100, Appendix L - Patent Laws, Appendix R - Patent Rules, Appendix ii - List of Decisions Cited, and entire Index.**

Sections of the Manual that have been changed by this revision are indicated by "[R-9]" after the section title. Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (\*) where a single word was deleted and by two asterisks (\*\*) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule that was not reproduced.

Robert A. Clarke, Editor  
Manual of Patent Examining Procedure

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

**CHAPTER 500:**

<a href="#">502.03</a>	Revised to delete reference to a paper copy of an e-mail communication being placed in an application file.
<a href="#">502.05</a>	Revised to list web-based e-petitions as documents permitted to be filed via EFS-Web.
<a href="#">503</a>	Revised to include series codes 13 for nonprovisional applications.
508.01	Deleted section directed to papers sent to the wrong technology center.
<a href="#">508.02</a>	Revised to delete unnecessary references to the technology center and the IFW Manual.
508.03	Deleted section directed to unmatched papers.
<a href="#">509.01</a>	Revised to include a reference to <a href="#">MPEP § 607.02</a> for refunds to a deposit account.
<a href="#">512</a>	Section revised to delete reference to placement of Certificates of Mailing or Transmission in paper file wrappers.

**CHAPTER 600:**

<a href="#">601</a>	Revised to include a reference to MPEP Chapter <a href="#">1800</a> for international applications filed under the Patent Cooperation Treaty (PCT).
<a href="#">601.01(c)</a>	Revised to indicate conversion from a nonprovisional application to a provisional application requires, in addition to the processing fee set forth in <a href="#">37 CFR 1.17(q)</a> , the provisional application filing fee ( <a href="#">37 CFR 1.16(d)</a> ) and the surcharge set forth in <a href="#">37 CFR 1.16(g)</a> .
<a href="#">601.01(d)</a>	Revised in view of "Change in Procedure for Handling Nonprovisional Applications Having Omitted Items," 1315 O.G. 103 (February 20, 2007).
<a href="#">601.01(g)</a>	Revised in view of "Change in Procedure for Handling Nonprovisional Applications Having Omitted Items," 1315 O.G. 103 (February 20, 2007).
<a href="#">601.02</a>	Form PTO/SB/81 has been updated.
<a href="#">601.05</a>	Updated to reference fillable form PTO/SB/14 for Application Data Sheet (ADS) submissions and to indicate form PTO/SB/14 cannot be used for the filing of a supplemental application data sheet.
<a href="#">602</a>	Deleted from applicant's options "an amendment that cancels the subject matter not supported by the originally filed specification and drawings" when responding to examiner's requirement for a supplemental oath or declaration referring to a preliminary amendment present on the filing date of the application. Forms PTO/SB/01 and PTO/SB/01A have been updated.
<a href="#">602.03</a>	Form paragraph 6.05.05 has been revised.
<a href="#">605.04(b)</a>	Revised because oath or declaration is not required for a provisional application.
<a href="#">607</a>	Revised to include discussion of the 15 percent fee surcharge effective September 26, 2011 and the non-electronic filing fee effective November 15, 2011.
<a href="#">608.01(b)</a>	Revised to remove reference to "the computer tape by the printer" from the GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS. Form paragraph 6.16 has been revised.
<a href="#">608.01(g)</a>	Removed subsection entitled "USE OF SYMBOL "Phi" IN PATENT APPLICATION."
<a href="#">608.01(n)</a>	Revised subsections II and III for consistency with "Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications," 76 Fed. Reg. 7162 (2011) (Supplemental Section 112 Examination Guidelines). Form paragraph 7.36 has been revised to provide a statement of statutory basis for rejections under 35 U.S.C. 112, <a href="#">fourth paragraph</a> . New form paragraph 7.36.01 has been added for rejecting a dependent claim that fails to further limit the subject matter of the claim upon which it depends, or which fails to include all the limitations of the claim upon which it depends.
<a href="#">608.01(p)</a>	Revised to change "Specific operative embodiments or examples" to "At least one specific operative embodiment or example."
<a href="#">608.02</a>	Revised to indicate that while color drawings are not permitted to be transmitted by facsimile, black and white drawings may be transmitted by facsimile in appropriate circumstances. Deleted reference to examiner pencil notations in drawings.

<a href="#">608.02(b)</a>	Deleted references to form PTO-948 as the Office no longer routes drawings to a draftsman for review.
<a href="#">608.02(h)</a>	Deleted reference to routing replacement drawings through a draftsman.
<a href="#">608.02(o)</a>	Revised to delete reference to draftsman's stamp.
<a href="#">608.02(p)</a>	Deleted references to form PTO-948 from form paragraphs.
<a href="#">608.04(b)</a>	Deleted from applicant's options "an amendment that cancels the subject matter not supported by the originally filed specification and drawings" when responding to examiner's requirement for a supplemental oath or declaration referring to a preliminary amendment present on the filing date of the application.
<a href="#">608.05(b)</a>	Form paragraph 6.63.02 has been revised.
<a href="#">609</a>	Form PTO/SB/08A and form PTO/SB/08B replaced with updated forms including "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH" stamps.
<a href="#">609.04(b)</a>	Revised subsection IV to indicate applicants are encouraged to submit petitions under <a href="#">37 CFR 1.313(c)(2)</a> and <a href="#">37 CFR 1.313(c)(3)</a> by EFS-Web. Further revised to remove suggestion that a three-month suspension of action under <a href="#">37 CFR 1.103(b)</a> may be filed with an RCE and to indicate the IDS must accompany the RCE and the petition under <a href="#">37 CFR 1.313(c)(2)</a> if the IDS is the submission for the RCE.

## CHAPTER 700:

<a href="#">702.01</a>	Changed the name of the Office of Initial Patent Examination (OIPE) to the Office of Patent Application Processing
<a href="#">706.02</a>	Revised to add a subsection VII to address rejection of claims corresponding to patent claims.
<a href="#">706.02(l)(2)</a>	Revised to clarify that for purposes of <a href="#">35 U.S.C. 103(c)</a> , common ownership must be at the time the claimed invention was made.
<a href="#">706.03(a)</a>	Revised discussion regarding subject matter eligibility to be consistent with <a href="#">MPEP § 2106</a> . Form paragraphs have been revised and new form paragraphs have been added.
<a href="#">706.03(d)</a>	New form paragraphs have been added.
<a href="#">706.03(e)</a>	New section added to include form paragraphs for use relating to 35 U.S.C. 112, <a href="#">sixth paragraph</a> .
<a href="#">706.07(f)</a>	Form has been updated.
<a href="#">706.07(h)</a>	Form has been updated.
<a href="#">707</a>	Form paragraphs and form have been updated; reference to draftsman's drawing review has been deleted.
<a href="#">707.05(e)</a>	Revised in view of revisions made to WIPO standard ST.14.
<a href="#">707.07(a)</a>	Revised to delete references to the draftsman's review.
<a href="#">707.07(c)</a>	Deleted section pertaining to draftsman's requirements.
<a href="#">707.07(f)</a>	Form paragraphs have been revised.
<a href="#">707.08</a>	Form paragraphs have been revised.
<a href="#">708.01</a>	Revised to update <a href="#">37 CFR 1.102</a> .
<a href="#">708.02</a>	Revised to update <a href="#">37 CFR 1.102</a> . Added a cross-reference to new <a href="#">MPEP § 708.02(b)</a> for prioritized examination under <a href="#">37 CFR 1.102(e)</a> .
<a href="#">708.02(a)</a>	Revised to add a cross-reference to new MPEP § <a href="#">708.02(b)</a> for prioritized examination under <a href="#">37 CFR 1.102(e)</a> . New form paragraphs have been added.
<a href="#">708.02(b)</a>	New section added for prioritized examination under <a href="#">37 CFR 1.102(e)(1)</a> (Track I) and <a href="#">37 CFR 1.102(e)(2)</a> (PE-RCE).
<a href="#">709</a>	Form has been updated.
<a href="#">711.01</a>	Revised to add reference to electronic submission using EFS-Web. Forms have been updated.
<a href="#">711.03(c)</a>	Forms have been updated.
<a href="#">713.01</a>	Discussion regarding video conference center has been updated. Patent and Trademark Depository Library (PTDL) has been changed to Patent and Trademark Resource Center (PTRC). Revised to indicate that the Office will accept the "Applicant Initiated Interview Request" which contains the

	practitioner's name, signature and registration number as an indication that the practitioner is authorized to conduct an interview on behalf of the principal, which is consistent with <a href="#">37 CFR 1.34</a> . Form has been updated.
<a href="#">713.04</a>	Revised to clarify that where a complete record of the interview has been incorporated in an examiner's amendment, it will not be necessary to complete an Interview Summary form. Form has been updated.
<a href="#">713.05</a>	Revised to indicate that the Office will accept the "Applicant Initiated Interview Request" which contains the practitioner's name, signature and registration number as an indication that the practitioner is authorized to conduct an interview on behalf of the principal, which is consistent with <a href="#">37 CFR 1.34</a> .
<a href="#">714</a>	Subsection II.B. revised to include a paragraph directed to the manner of making amendments to the abstract of the disclosure.
<a href="#">714.06</a>	Deleted section directed to amendments sent to the wrong technology center.
<a href="#">714.13</a>	Revised to indicate that an examiner is expected to turn in a response to an amendment after final rejection within an average of 11 calendar days from the time the amendment is received by the examiner.
<a href="#">714.16(d)</a>	The address of the Office of Data Management has been updated.
<a href="#">715.04</a>	Revised to indicate that the owner of the patent under reexamination may make an affidavit or declaration under <a href="#">37 CFR 1.131</a> .
<a href="#">719.05</a>	Revised to indicate that it is not necessary to include the examiner's initials on the search history printout if the search engine, e.g., EAST or WEST has automatically provided the examiner's user name on the search history printout.

#### CHAPTER 1200:

<a href="#">1220</a>	New section added to include form paragraphs for use in applications and <i>ex parte</i> reexamination proceedings where the notice of appeal was filed on or after January 23, 2012.
<a href="#">1214.06</a>	Revised to delete the additional 2 week period to allow for information as to the filing of an appeal or civil action to reach the examiner to be consistent with current practice.

#### CHAPTER 1400:

<a href="#">1402</a>	Revised in view of <i>In re Tanaka</i> , to indicate that an error under <a href="#">35 U.S.C. 251</a> may be based upon the addition of a claim or claims that is/are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims. Revised to add discussion regarding <i>Medrad, Inc. v. Tyco Healthcare Group LP</i> .
<a href="#">1406</a>	Revised to indicate that if a reference cited in the original patent is no longer relevant to the claims in the reissue application, it will not be necessary for the examiner to list the reference on the PTO-892 form.
<a href="#">1410</a>	Form has been updated.
<a href="#">1412.02</a>	Added Federal Circuit decision. Form paragraph has been revised.
<a href="#">1414</a>	Revised to clarify that applicants need to state all the reasons why the patent is wholly or partly inoperative or invalid in the reissue oath/declaration. Added reference to Federal Circuit decision of <i>In re Tanaka</i> . Form paragraph has been revised.
<a href="#">1415</a>	Form has been updated.
<a href="#">1415.01</a>	Revised to clarify that maintenance fee must be directed to the latest reissue patent that has issued, i.e., the reissue patent with the highest reissue patent number.
<a href="#">1451</a>	Revised to add examples of acceptable identification providing the appropriate continuity language for a continuation or divisional reissue application.
<a href="#">1453</a>	Revised to add discussion in the subsection IV regarding the situation where the patent already has underlining or bracketing.

<a href="#">1455</a>	Revised to clarify that the examiner should list on a PTO-892 form any reference that was cited during the original prosecution of the patent which is again cited/applied in the reissue application and that applicant should file an IDS in compliance with 37 CFR <a href="#">1.97</a> and <a href="#">1.98</a> if applicant wishes to ensure that all of the references which were cited in the original patent are cited in the reissue application.
<a href="#">1457</a>	Revised to add new subsection directed to conversion to a design patent.
<a href="#">1490</a>	Revised to include additional examples as to which application constitutes the “earlier-filed” application for purposes of making a provisional non-statutory double patent rejection. Form paragraphs have been revised. Forms have been updated.

## CHAPTER 2100:

<a href="#">2103</a>	Section added to set forth an overview of the patent examination process. Includes information previously set forth in <a href="#">MPEP § 2106</a> .
<a href="#">2104</a>	Section added to provide an overview of patentable subject matter and the requirements of <a href="#">35 U.S.C. 101</a> .
<a href="#">2105</a>	Added discussion of section 33 of the Leahy-Smith America Invents Act which provides that no patent may issue on a claim directed to or encompassing a human organism.
<a href="#">2106</a>	Section rewritten to incorporate Office guidance with regard to patent eligible subject matter following the Supreme Court decision in <i>Bilski v. Kappos</i> . General information pertaining to the patent examination process was moved to new <a href="#">MPEP § 2103</a> , and the discussion pertaining to functional descriptive material was revised and moved to new <a href="#">MPEP § 2111.05</a> .
<a href="#">2106.01</a>	Section rewritten to incorporate Office guidance with regard to subject matter eligibility determinations during examination of process claims that involve laws of nature/natural correlations following the Supreme Court decision in <i>Mayo Collaborative Services v. Prometheus Labs</i> .
2106.02	Section deleted in view of revision to <a href="#">MPEP § 2106</a> .
<a href="#">2107.01</a>	Revised to add explanation that a purpose of <a href="#">35 U.S.C. 101</a> is to limit an inventor to one patent for a claimed invention.
<a href="#">2111</a>	Added explanation that the focus of the inquiry regarding the meaning of a claim should be what would be reasonable from the perspective of one of ordinary skill in the art.
<a href="#">2111.01</a>	Added explanation that the plain meaning of a term means the ordinary and customary meaning given to the term by those of ordinary skill in the art at the time of the invention.
<a href="#">2111.03</a>	Added explanation that the determination of what is or is not excluded by a transitional phrase must be made on a case-by-case basis in light of the facts of each case.
<a href="#">2111.04</a>	Revised to add citation to a Federal Circuit case discussing a “wherein” clause.
<a href="#">2111.05</a>	Section add to discuss functional and nonfunctional descriptive material, updating information previously location in <a href="#">MPEP § 2106.01</a> .
<a href="#">2113</a>	Revised to add explanation of how analysis of product-by-process claims differs in validity and infringement contexts.
<a href="#">2114</a>	Revised to add discussion of examining computer implemented functional claim limitations as set forth in "Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications," 76 Fed. Reg. 7162 (2011) (Supplemental Section 112 Examination Guidelines).
<a href="#">2124.01</a>	Section added to discuss section 14 of the Leahy-Smith America Invents Act which provides that tax strategies are deemed insufficient to differentiate a claimed invention from the prior art.
<a href="#">2141</a>	Revised to reflect "Examination Guidelines Update: Developments in the Obviousness Inquiry After <i>KSR v. Teleflex</i> ," 75 Fed. Reg. 53643 (2010) (Updated <i>KSR</i> Guidelines).
<a href="#">2141.01(a)</a>	Revised to add discussion of recent Federal Circuit decision regarding analogous art.
<a href="#">2142</a>	Revised to add citation of recent Federal Circuit decision.
<a href="#">2143</a>	Revised to reflect Updated <i>KSR</i> Guidelines.
<a href="#">2143.02</a>	Revised to clarify that where there is a reason to modify or combine the prior art to achieve the claimed invention, the claims may be rejected as <i>prima facie</i> obvious provided there is also a reasonable expectation of success.

<a href="#">2144</a>	Added caution against treating any line of reasoning as a per se rule when considering obviousness.
<a href="#">2144.07</a>	Corrected citation.
<a href="#">2145</a>	Revised to reflect Updated <i>KSR</i> Guidelines.
<a href="#">2161.01</a>	Revised to incorporate portions of the Supplemental Section 112 Examination Guidelines pertaining to computer programming and the <a href="#">first paragraph</a> of 35 U.S.C. 112.
<a href="#">2165</a>	Updated to reflect changes to the best mode requirement pursuant to amendments to 35 U.S.C. <a href="#">119(e)</a> , <a href="#">120</a> , and <a href="#">282</a> .
<a href="#">2165.01</a>	Updated to reflect changes to the best mode requirement pursuant to amendments to 35 U.S.C. <a href="#">119(e)</a> and <a href="#">120</a> .
<a href="#">2173</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.01</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.02</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.03</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.04</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.05(b)</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.05(g)</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.05(h)</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.05(p)</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2173.06</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2181</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2183</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.
<a href="#">2184</a>	Updated to reflect Supplemental Section 112 Examination Guidelines.