

INSTRUCTIONS REGARDING THE NINTH EDITION

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
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MANUAL OF PATENT EXAMINING PROCEDURE **Ninth Edition**

Instructions Regarding the Ninth Edition

Introduction

The USPTO is revising its process of updating the MPEP in order to more efficiently use its new electronic publication tools as well as issue more frequent MPEP updates. Specifically, the USPTO will electronically republish the entire MPEP with each update, and in the MPEP chapters, each section that is revised will be identified with the date the subject matter therein was last revised.

The practice of making revisions to the MPEP by replacing MPEP chapters in their entirety has been discontinued. The practice of providing revision marks likewise has been discontinued. The new publication process will improve the ability of the USPTO to timely publish single topic revisions to the MPEP, such as in response to judicial decisions that are determined to require rapid changes to examination policy. Therefore revisions to MPEP chapters will be made on a section by section (rather than chapter by chapter) basis.

Editor Notes

The Ninth Edition of the MPEP incorporates most of the changes to the laws, rules, and practice necessitated by the Leahy-Smith America Invents Act, Public Law 112-29, 125 Stat. 284. Editor Notes have been added to sections having limited applicability as a result of such changes.

MPEP chapter sections that have not been substantively revised since the last publication (Eighth Edition, Revision 9, August 2012) have a revision indicator of [R-08.2012], meaning that the section as reproduced in this Edition is the same as the version in force in August 2012. Sections that have been substantively revised have a revision indicator of [R-11.2013] meaning that the section has been updated as of November 2013. When the only revision to a section is the addition of an Editor Note, or an Editor Note and the insertion of "pre-AIA" before the reference to a law or rule that was in effect in August 2012, the section has a revision indicator of [R-08.2012]. Note, however, in the MarkLogic and xml versions of the Ninth Edition the revision indicators do not display in sections having a third level of indentation, e.g., section 711.04(a). All of the revision indicators display in the publication in pdf format regardless of the level of indentation of the section.

As a result of the new publication process, most links to both internal and external Web sites are active; however, for particularly long Web site addresses (URLs), a space has been added to the content of the text for readability in the PDF rendering. Clicking on a link will direct the user to the referenced Web page, however copying the text and thereafter pasting it in a browser may not open the referenced Web site.

Executive Summary

This Edition includes revisions to all Chapters of the MPEP **except** Chapters 800, 900, 1000, 1300, 1700, 1800, 1900, 2000, 2300, 2400, and 2500. For chapters not substantively revised for the Ninth Edition of the

MPEP, each section has a revision indicator of “[R-08.2012],” meaning that the section as reproduced in this Edition is the version in force in August 2012 with the following exceptions: 1) As a result of the publication process, form paragraphs reproduced in this chapter reflect the text used by examiners effective November 2013 rather than those in force in August 2012; 2) The marks indicating added or deleted text from prior revisions have been removed; and 3) The notation “[Reserved]” has been added for section numbers previously missing in the hierarchy (i.e., section numbers that were never used or no longer have text). See the ninth revision of the Eighth Edition of the MPEP published August 2012 as posted on the USPTO Web site on the MPEP Archives page (<http://www.uspto.gov/web/offices/pac/mpep/old/index.htm>) for the text of form paragraphs in force in August 2012 and the prior revision marks.

Robert A. Clarke, Editor
Manual of Patent Examining Procedure

Summary of Effective Dates of MPEP Appendices

Appendix I (Partial List of Trademarks) has been removed and reserved.

App II (List of Decisions Cited) includes the decisions cited in this Edition of the Manual.

Appendix L (Patent Laws) and Appendix R (Patent Rules) include the laws and rules in effect on or before November 29, 2013.

App. T is as in force effective January 1, 2013.

App. AI is as in force effective September 16, 2012.

Appendix P is as in force effective October 2, 1979.

Summary of Changes to MPEP Chapters

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

ALL REVISED CHAPTERS:

<i>Passim</i>	Revised “Board of Patent Appeals and Interferences” to read “Patent Trial and Appeal Board” throughout for consistency with the title change for the Board as set forth in the section 7 of the AIA, effective September 16, 2012.
<i>Passim</i>	Revised references to “interferences” to add either “or derivation proceedings” or “or trials” as applicable based on the first inventor to file provisions of section 3 of the AIA and the addition of 37 CFR Part 42.
<i>Passim</i>	Deleted discussion of paper-based processing. Deleted references to the Image File Wrapper (IFW) Manual, and where appropriate, inserted description of IFW process.
<i>Passim</i>	Revised references to specific paragraphs of 35 U.S.C. 112 to reference both the current and pre-AIA versions where appropriate. Specifically, replaced references to “35 U.S.C. 112, first paragraph” with “35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph;” “35 U.S.C. 112, second paragraph” with “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph;” “35 U.S.C. 112, fourth paragraph” with “35 U.S.C. 112(d) and pre-AIA 35 U.S.C. 112, fourth paragraph;” and “35 U.S.C. 112, sixth paragraph” with “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112 sixth paragraph.”
<i>Passim</i>	Cross-references to 37 CFR Part 10 revised to reference corresponding sections of 37 CFR Part 11 for consistency with Changes to Representation of Others Before The United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 2013)

CHAPTER 100:

101	<p>Revised to update 35 U.S.C. 122 and 37 CFR 1.14; replaced the reference to 15 U.S.C. 15(b) with a reference to 5 U.S.C. 2635.701 - 2635.703 (setting forth statutory requirements and curbs regarding the use of information obtained by an employee through government employment).</p> <p>Revised to delete text related to employees carrying, removing, or otherwise handling paper application files.</p> <p>Revised to include "inventor" along with "applicant," "assignee of record," and "attorney or agent of record" as an individual to whom information may be provided for consistency with the provisions of section 4 of the AIA regarding who can apply for a patent.</p>
102	<p>Revised to update 37 CFR 1.14. Added cross-reference to 37 CFR 1.14(c) and MPEP § 104 for additional information pertaining to who can provide written authority granting access to the application.</p>
103	<p>Revised to update 37 CFR 1.11(e) and 1.14.</p> <p>Revised the description of the Image File Wrapper (IFW) system in subsection I. Also added to subsection I the following items: (1) for patent applications in the IFW system, the IFW file is the Official file and no access is granted to the original paper document sheets used to create the IFW file, and (2) if an IFW file has been created for a patented application, published application, or an application to which a patented or published application claims domestic priority, the IFW file (with the exception of non-patent literature) is accessible through public PAIR.</p> <p>In subsection II, added explanation that pursuant to 35 U.S.C. 374, the publication by the International Bureau of an international application designating the United States is deemed to be a publication under 35 U.S.C. 122(b), and added notation that the U.S. is automatically designated in all international applications filed on or after January 1, 2004.</p> <p>Subsection III has been revised to indicate that copies of a patent application-as-filed and contents of a patent application file wrapper may be ordered on-line or requested by facsimile.</p> <p>Subsection V revised to remove citation to a 1922 Comm’r Pat. decision.</p> <p>Revised section VII to state that access or certified copies will be given to an applicant other than an inventor for applications filed on or after September 16, 2012.</p> <p>Subsection VIII revised reference to “interferences” to add “or trials.”</p> <p>Subsection X revised to indicate 37 CFR 1.11(b) opens reissue applications to inspection by the general public, and to explain that IFW reissue application files are open to inspection by the general public by way of Public PAIR via the USPTO web site. Deleted discussion pertaining to accessing pending paper reissue application files.</p> <p>Revised section XI to indicate a reexamination file is only open to inspection by the general public after it has been scanned into the IFW system and can be accessed by Public PAIR via the USPTO web site.</p> <p>In subsection XII, updated the URL of the FOIA section of the USPTO web site.</p>
104	<p>Revised for consistency with changes to 37 CFR 1.14(c) pertaining to power to inspect a pending or abandoned application.</p> <p>Added subsection I. Authority to Grant Access - Application Filed On Or After September 16, 2012, and subsection II. Authority To Grant Access - Application Filed Before September 16, 2012 to set forth the authority required based on the filing date of the application.</p> <p>Inserted subsection headings “III. Power To Inspect” and “IV. Access To Patent Applications (Provisional and Nonprovisional) and Interference Files.”</p>
105	<p>Revised to replace “applicant” with "an inventor or the applicant" for consistency with the changes made by section 4 of the AIA regarding who can apply for a patent.</p>

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<u>106</u>	Revised to include "applicant" along with "assignee of record" in the description of who may file an application or intervene in the prosecution of an application, and added reference to 37 CFR 1.46. Changes made for consistency with section 4 of the AIA regarding who can apply for a patent. Removed reference to a 1906 Comm'r Pat. decision.
<u>106.01</u>	Revised to specify that for applications filed on or after September 16, 2012, an assignee can prosecute an application after becoming the applicant under 37 CFR 1.46. Also added cross-references to information pertaining to prosecution by the assignee (MPEP § 324 for applications filed before September 16, 2012, and MPEP § 325 for applications filed on or after September 16, 2012).
<u>110</u>	Revised to delete the rationale underlying the July 30, 2003, amendment to 37 CFR 1.14(g) (which was to provide greater access to certain international applications).
<u>115</u>	Revised to insert the first paragraph of 35 U.S.C. 181. Also revised to indicate that the Office will accept national security classified applications filed with the USPTO via the Department of Defense Secret Internet Protocol Router Network (SIPRNET) and consider them as filed via the USPTO's electronic filing system for fee purposes.
<u>120</u>	Revised to update description of types of secrecy orders. Also updated 37 CFR 5.3.
<u>121</u>	Revised to explain that applications subject to Secrecy Order will be deleted from any image file system within the USPTO, converted to paper, and held with Licensing and Review. Also revised to discuss treatment of applications bearing what appear to be National Security Markings.
<u>130</u>	Revised to explain that all applications in which a Secrecy Order has been imposed are examined in a secure location by examiners possessing national security clearances under the control of Licensing and Review.
<u>140</u>	Revised to update 35 U.S.C. 184, 185, and 186, and 37 CFR 5.25. Deleted historical information relating to provisions of Public Law 100-418, sec. 9101 (102 Stat. 1567 (Aug. 23, 1988)). Revised subsection I to indicate that expedited foreign filing license petitions may be hand-carried to the Office, faxed to Licensing and Review, or submitted via EFS-Web. Revised subsection II to indicate that a petition for a retroactive filing license may be filed under 37 CFR 5.25 if an unlicensed foreign filing occurred through error, and to specify that such a petition filed prior to September 16, 2012 must specify that the error occurred without deceptive intent. Subsection II also revised to explain that petitions for retroactive foreign filing licenses are processed by Licensing and Review and decided by the Office of Petitions, and that if applicant also wishes an expedited license for future filings, a separate expedited license request must be filed with Licensing and Review.
<u>150</u>	Revised to reflect transfer of subject matter of repealed 42 U.S.C. 2457 pertaining to NASA property rights statements to 51 U.S.C. 20135.
<u>151</u>	For consistency with the changes made by section 4 of the AIA, revised definition of the word "applicant" to include "an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter" and revised "when an applicant is deceased or incompetent" to "when an inventor is deceased or legally incapacitated."

CHAPTER 200:

<u>201</u>	Section rewritten. Inserted text of 35 U.S.C. 101, 161, and 171, and discussed the three broad types of subject matter to which patent applications may be directed (i.e., utility, plant, and design). Moved information previously in this section to MPEP § 201.01.
<u>201.01</u>	Section rewritten. Title and subject matter discussed herein are directed to national applications; includes information previously in MPEP § 201. Updated 35 U.S.C. 111 and inserted paragraphs of 37 CFR 1.9 which define applications (i.e., national, provisional and non-provisional). Subsection I provides an overview of applications filed under 35 U.S.C. 111, and subsection II provides an overview of international applications designating the United States. Definition of "sole" application previously set forth in this section deleted as unnecessary.
<u>201.02</u>	Section rewritten. Title and subject matter herein revised to discuss general terms used to describe applications, and to define original application, continuing application and substitute application. Incorporates subject matter previously in MPEP § 201.04(a)(original application) and 201.09 (substitute application). Definition of "joint" application previously set forth in this section deleted as unnecessary.
<u>201.03</u>	Section removed and reserved. Subject matter previously herein moved to new MPEP § 602.01(c)(regarding correction of inventorship by filing a continuing application) and new MPEP § 602.01(c)(3)(regarding requests for correction of inventorship filed before September 16, 2012).
<u>201.04</u>	Section rewritten, and information relating to the term "parent" deleted. Added the information directed to provisional applications that was previously in MPEP § 201.04(b), with the exception of references to statutory invention registrations and historical information pertaining to Public Law 106-113 (effective November 29, 1999). Updated statute, rules, and forms reproduced therein for consistency with changes necessitated by the AIA.
201.04(a)	Section deleted; discussion of "original application" moved to MPEP § 201.02.
201.04(b)	Section deleted; discussion of provisional applications moved to MPEP § 201.04.
<u>201.05</u>	Revised to remove reference to error without deceptive intention.
<u>201.06</u>	Revised to add that a continuation-in-part application should not be designated as a divisional application. Deleted references to 37 CFR 1.60 and 1.62 and continued prosecution applications (CPAs). Revised to indicate that for applications filed on or after September 16, 2012, it is no longer suggested to include classification of a divisional application, the status, and the assigned art unit of the parent application in the application data sheet.
<u>201.06(c)</u>	Revised to add information pertaining to the oath or declaration requirement under 37 CFR 1.63 for continuing applications filed on or after September 16, 2012, as necessitated by the provisions in the AIA. In subsection I, added discussion of requirements for filing a complete application on or after September 16, 2012, and explanation that in such applications, the filing of the inventor's oath or declaration may be postponed until payment of the issue fee where the application contains an application data sheet under 37 CFR 1.76 identifying each inventor by his or her legal name, and a mailing address where each inventor customarily receives mail, and residence, if the inventor lives at a location which is different from where the inventor customarily receives mail. Subsection I also revised to set forth that in applications filed on or after September 16, 2012, reference to a prior-filed benefit application indicating the appropriate relationship (i.e., continuation, divisional, or continuation-in-part) must be presented in the application data sheet, whereas in applications filed prior to September 16, 2012 such reference may be set forth in either the first sentence(s) of the specification or the application data sheet. Subsection II revised to add an explanation of the inventor's oath or declaration requirements for continuing applications filed on or after September 16, 2012, which claim the benefit of an

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application filed before September 16, 2012. Also revised to delete a statement regarding a power of attorney included in a signed oath or declaration. Revised to specify that a newly executed oath or declaration is required in a continuation or divisional application naming an inventor not named in the prior application, and in a continuation-in-part application, for applications filed before September 16, 2012.

Subsection III revised to state that for continuing applications filed on or after September 16, 2012, claiming benefit of an application filed before September 16, 2012, the oath or declaration must comply with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012.

Also revised to indicate that in applications filed on or after September 16, 2012, reference to a prior-filed benefit application indicating the appropriate relationship (i.e., continuation, divisional, or continuation-in-part) must be presented in the application data sheet, whereas in applications filed prior to September 16, 2012 such reference may be set forth in either the first sentence(s) of the specification or the application data sheet.

Added explanation that for applications filed prior to September 16, 2012, if one or more claims are allowed in the continuation or divisional application which are directed to matter shown and described in the prior nonprovisional application but not claimed in the prior application, the applicant should be required to file a supplemental oath or declaration under 37 CFR 1.67(b).

For applications filed on or after September 16, 2012, pursuant to 37 CFR 1.67(b), no supplemental oath or declaration will be required. Deleted indication that the examiner should require a new oath or declaration along with the surcharge when it is found that the continuation or divisional application contains new matter relative to the prior application.

Subsection V revised to add discussion pertaining to the filing of a continuation or divisional application without a newly executed oath or declaration when all, or fewer than all, of the previously-named inventors are listed.

Revised the title of subsection VI to "Substitute Statement and Rule 47 Issues." Added guidance as to when a newly executed substitute statement for an inventor in a continuing application is required. Revised to clarify that pre-AIA 37 CFR 1.47 is applicable to applications filed prior to September 16, 2012 and to provide guidance on how to proceed in continuation and divisional applications where the prior application was accorded status under 37 CFR 1.47.

In subsection VII, added explanation of when a copy of the power of attorney from a prior national application has effect within a continuing application. Revised to suggest that filing a copy of the power of attorney in the continuing application in all situations (even where a change in power of attorney did not occur in the prior application) will make the record clear with respect to who has power of attorney, and to recommend that the power of attorney should be from the assignee where one exists. Also revised to indicate that for applications filed on or after September 16, 2012, the power of attorney may only be signed by the applicant (see 37 CFR 1.42) or patent owner (for reissue applications). Added explanation that with respect to the correspondence address for applications filed on or after September 16, 2012, 37 CFR 1.33(f) provides that where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted.

In subsection VIII, revised the title to "Small Entity or Micro Entity Status" and added indication that the filing of a continuing application requires a new certification of entitlement to micro entity status in the continuing application.

Subsection XII revised to state that the Office may require a substitute specification for preliminary amendments. Deleted indication that the examiner should require a new oath or declaration along with the surcharge when it is found that the continuation or divisional application contains new matter relative to the prior application. Added that if the filing date of the continuing application is on or after September 16, 2012, the inventor's oath or declaration must comply with 35 U.S.C.

	115 as revised effective September 16, 2012, even though the continuing application may claim the benefit of an application filed before September 16, 2012.
201.06(d)	<p>Revised to insert 37 CFR 1.53(d) as it applies to applications filed on or after September 16, 2012.</p> <p>Revised subsection II.E. Signature Requirement to distinguish between signature requirements for a request for a CPA filed on or after September 16, 2012, and those for a CPA request filed before September 16, 2012.</p> <p>In subsection II, added subsection heading "H. Small or Micro Entity Status." Added references to micro entity status, and to indicate that pursuant to 37 CFR 1.29(e), the refiling of an application under 37 CFR 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)) requires a new certification of entitlement to micro entity status for the continuing application.</p> <p>Revised subsection II.K. to distinguish between the signature requirements for a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in a CPA based on whether the application was filed before, or on or after, September 16, 2012.</p> <p>Deleted forms previously reproduced in subsection V.</p>
201.07	Revised to update form paragraph 2.05 and to delete reference to notation to be put in the file history.
201.08	Revised to delete reference to <i>In re Klein</i> , 1930 C.D. 2,393 O.G. 519 (Comm’r Pat. 1930) as unnecessary. Revised to update terminology regarding “inventor” or “joint inventors” consistent with terms as defined by AIA. Revised to clarify that the Office does not need to make a determination whether an earlier nonprovisional application discloses the invention of the second application in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, unless the filing date of the earlier nonprovisional application is relied upon in a proceeding. Updated form paragraphs.
201.09	Section deleted; explanation of "substitute application" moved to MPEP § 201.02.
201.10	Section deleted.
201.11	Section deleted; information pertaining to claiming the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 moved to new MPEP §§ 211 - 211.05 and updated for consistency with changes necessitated by the AIA.
201.11(a)	Section deleted; information pertaining to claiming the benefit of an international application designating the United States moved to MPEP § 211.01(c).
201.12	Section deleted.
201.13	Section deleted; information pertaining to right of priority of a foreign application moved to MPEP § 213 et seq. and updated.
201.13(a)	Section deleted; information pertaining to right of priority based on an application for an inventor's certificate moved to MPEP § 213.05.
201.14	Section deleted; information pertaining to the formal requirements of a claim for foreign priority right of priority of a foreign application moved to MPEP § 214 et seq. and updated.
201.14(a)	Section deleted; information pertaining to the time for filing the priority claim moved to MPEP § 214 et seq. and updated.
201.14(b)	Section deleted; information regarding certified copies of priority documents moved to MPEP § 215 et seq. and updated.
201.14(c)	Section deleted; information pertaining to the time for filing the priority claim moved to MPEP § 214 et seq. and updated.
201.14(d)	Section deleted; information pertaining to the time for filing the priority claim moved to MPEP § 214 et seq. and updated.

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201.15	Section deleted; information pertaining to entitlement to priority moved to MPEP § 216 and updated.
201.16	Section deleted; information pertaining to using a certificate of correction to perfect a claim for priority moved to MPEP § 216.01 and updated.
201.17	Section deleted; information pertaining to incorporation by reference moved to MPEP § 217.
<u>202</u>	Added information from previous MPEP § 202.02 as subsection I. Notation in File History Regarding Prior U.S. Applications, Including Provisional Applications. Added information from previous MPEP § 202.03 as subsection II. Notation in File History Regarding Foreign Priority Application.
202.02	Section deleted; moved information to MPEP § 202, subsection I.
202.03	Section deleted; moved information to MPEP § 202, subsection II.
<u>202.04</u>	Revised title and text to clearly limit applicability of section to applications filed before September 16, 2012.
<u>203.01</u>	Revised to note that a request for continued examination (RCE)(see 37 CFR 1.114) is not a type of new application filing.
<u>203.04</u>	Revised to delete references to the Office of Patent Publication and to IFW processing.
<u>203.05</u>	Revised to delete reference to assignee acquiescence to formal abandonment.
<u>203.08</u>	Revised to reflect current practice with regard to status inquiries. Moved general information to subsection I and revised text therein to indicate that status information relating to patent applications is available through the Patent Application Information Retrieval (PAIR) system, and that applicants and other persons seeking status information regarding an application should check the PAIR system on the Office Web site at http://www.uspto.gov/ebc . Deleted information specific to processing status letters in Technology Centers.
<u>203.08(a)</u>	Revised to update procedures to be followed when receiving Congressional and other official inquiries (e.g., from the White House, embassies, and heads of Executive departments and agencies).
<u>210</u>	<p>New section added to provide an overview of claiming priority to, or the benefit of, the filing date of a prior-filed application. Introductory paragraph explains that under certain conditions and upon fulfilling certain requirements a later-filed application may claim the benefit of a prior application, depending upon when the application is filed and what applicable laws are effective at the time of filing.</p> <p>Subsection I. Requirements of 37 CFR 1.78 (Claiming the Benefit of an Earlier Domestic Application) provides an overview of 37 CFR 1.78 depending on whether the application was filed before, on or after March 16, 2013.</p> <p>Subsection II. Requirements of 37 CFR 1.55 (Claiming Priority to an Earlier Foreign Application) provides an overview of 37 CFR 1.55 depending on whether the application was filed before, on or after March 16, 2013.</p> <p>Subsection III. Requirement for a Statement Under 37 CFR 1.55 or 1.78 for First Inventor to File Transition Applications provides an overview on how the effective filing date of each claimed invention affects whether an application is subject to examination under 35 U.S.C. 102 and 103 as effective on March 16, 2013 or under 35 U.S.C. 102 and 103 in effect on March 15, 2013 (i.e., pre-AIA 35 U.S.C. 102 or 103). Subsection III also provides guidance on whether a transition application must include statement in accordance with 37 CFR 1.55 and 1.78 and the particulars of the statement (i.e., when it must be filed, how the statement should be submitted).</p>
<u>211</u>	New section added to discuss claiming the benefit of an earlier filing date under 35 U.S.C. 120 and 119(e). Provides an overview of the procedural requirements for a later-filed application to claim benefit of the filing date of a prior-filed application, and includes the information in the

	introductory portion of previous MPEP § 201.11, updated for consistency with changes necessitated by the AIA.
211.01	<p>New section added to set forth benefit claim requirements that relate to the prior-filed application. Subsection I explains that the prior-filed application must be entitled to a filing date, and provides guidance as to when it is also necessary to have paid the basic filing fee. Includes information previously in MPEP 201.11, subsection VII.</p> <p>Subsection II explains the requirement that the prior-filed application have the same inventor or at least one common inventor. Includes information previously in MPEP § 201.11, subsection IV.</p> <p>Subsection III provides guidance on whether a transition application having an actual filing date on or after March 16, 2013 must include a statement in accordance with 37 CFR 1.55 and 1.78. Subsection IV sets forth additional requirements and provides cross-references to MPEP § 211.01(a) and MPEP § 211.01(b) for explanation of the requirements of specific to claiming benefit of provisional or earlier-filed nonprovisional applications, respectively.</p>
211.01(a)	New section added to set forth the requirements of a prior-filed provisional application in order for a later-filed application to claim the benefit of the provisional application's filing date. Includes subject matter previously in MPEP § 201.11, subsections II and VI and updates information related to providing an English translation of the earlier-filed provisional application in order for a later-filed application to claim priority benefit or alternatively, or deleting reference to the prior-filed provisional application, depending upon whether the application was filed prior to September 16, 2012, or on or after September 16, 2012.
211.01(b)	New section added to set forth the requirements of a prior-filed nonprovisional application in order for a later filed application to claim the benefit thereof. Includes information previously in MPEP § 201.11, subsection II. updated to explain the term “continuity” and to provide distinctions for applications filed on or after September 16, 2012 (AIA), and applications filed prior to September 16, 2012 (pre-AIA).
211.01(b)	New section added to set forth the requirements of a prior-filed international application designating the United States in order for a later filed application to claim the benefit thereof. Includes information previously in MPEP § 201.11(a).
211.02	<p>New section added to discuss the requirement for a later-filed application to contain a specific reference to the prior-filed application in order to claim the benefit thereof. Includes information in previous MPEP § 201.11, subsection III, and updates the information for consistency with changes necessitated by the AIA.</p> <p>Subsection I discusses the Application Data Sheet (ADS) and requirements pertaining to cross-references to related applications and specific references to benefit applications, depending on whether the present application was filed on or after September 16, 2012, or filed before September 16, 2012 (pre-AIA).</p> <p>Added subsection II to set forth requirements for referencing a prior-filed nonprovisional application, depending on whether the later-filed application was filed before, or on or after, September 16, 2012.</p> <p>Added subsection III to set forth requirements for referencing a prior-filed provisional application, depending on whether the later-filed application was filed before, or on or after, September 16, 2012.</p>
211.02(a)	<p>New section added to discuss correcting or adding a benefit claim after filing. Includes and updates information previously in MPEP § 201.11, subsection III.F.</p> <p>Subsection I provides updated guidance on how to present a request for a corrected filing receipt regarding errors in the benefit claim information.</p>

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	<p>Subsection II provides updated guidance on the procedure for adding a benefit claim, depending on whether the application was filed on or after September 16, 2012, or before September 16, 2012 (pre-AIA).</p> <p>Subsection III provides updated guidance on the procedure for deleting a benefit claim and the implications of doing so, depending on whether the application was filed on or after September 16, 2012, or before September 16, 2012 (pre-AIA).</p>
<u>211.03</u>	<p>New section added to explain the time periods for making a claim for benefit under 37 CFR 1.78. Includes and updates information previously in MPEP 201.11, subsection V; historical information pertaining to the American Inventors Protection Act (AIPA) and Public 106-113 is not included.</p>
<u>211.04</u>	<p>New section added directed to the delayed submission of benefit claims. Includes subject matter previously discussed in MPEP § 201.11, subsection V.</p>
<u>211.05</u>	<p>New section added to discuss the requirement that to be entitled to the benefit of the filing date of an earlier-filed application, the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application. Includes information previously in MPEP § 201.11, subsection I.</p>
<u>213</u>	<p>New section added to discuss the right of priority to a foreign application. Information herein moved from previous MPEP § 201.13, with revisions necessitated by the AIA.</p>
<u>213.01</u>	<p>New section added to discuss recognized countries and regional offices of foreign filing. Includes and updates information from subsection I of previous MPEP § 201.13.</p> <p>Subsection I adds a Table of States Party to the PCT and the Paris Convention and Members of the World Trade Organization; the right of priority under 35 U.S.C. 119(a)-(d) has been recognized with respect to these organizations. Subsection II discusses the right of priority based upon an international application filed under the PCT. Subsection III provides updated information on the right of priority based on various treaties.</p>
<u>213.02</u>	<p>New section added directed to the formal requirements for priority claims that relate to the foreign priority application. Includes and updates information previously in MPEP § 201.13.</p> <p>Subsection I updates requirements for identifying foreign applications for which priority is claimed based on whether the application was filed on or after September 16, 2012 (AIA) or filed before September 16, 2012 (pre-AIA).</p> <p>Subsection II explains that the foreign application to which priority is claimed must have been filed by the same applicant as the applicant in the United States, or by his or her legal representatives or assigns. Consistent with longstanding Office policy, this is interpreted to mean that the U.S. and foreign applications must name the same inventor or have at least one joint inventor in common.</p> <p>Subsection III provides guidance on submitting a statement under 35 CFR 1.55(j) when an application filed on or after March 16, 2013, claims priority to a foreign application filed prior to March 16, 2013.</p>
<u>213.03</u>	<p>New section added to provide guidance on the time period for filing a U.S. nonprovisional application claiming priority to a foreign application, consistent with 35 U.S.C. 21(b), 37 CFR 1.7(a), and PCT Rule 80.5. Includes and updates information previously in MPEP § 201.13.</p>
<u>213.04</u>	<p>New section added to explain the requirement to file the priority claim and certified copy during the pendency of the application. Section also explains when the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in 37 CFR 1.55.</p>
<u>213.05</u>	<p>New section added to discuss the right of priority based upon an application for an inventor's certificate. Includes and updates information set forth in previous MPEP § 201.13(a); does not include historical information.</p>
<u>213.06</u>	<p>New section added to discuss the right of priority based upon an international application filed under the PCT. Includes and updates information set forth in previous MPEP § 201.13(b).</p>

	Added clarification that if the applicant submitted a certified copy of the foreign priority document in compliance with PCT Rule 17 during the international phase, the International Bureau (IB) will forward a copy of the certified priority document to each Designated Office that has requested a copy of the foreign priority document and the copy received from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document. If, however, the International Bureau is unable to forward a copy of the certified priority document because the applicant failed to submit a certified copy of the foreign priority document during the international phase, the applicant will need to provide a certified copy of the priority document or have the document furnished in accordance with the priority document exchange program during the national stage to fulfill the requirements of 37 CFR 1.55.
<u>214</u>	New section added to discuss formal requirements for claiming foreign priority. Includes and updates information previously in MPEP § 201.14. Includes note that as a result of recent changes to the applicable laws and rules, the procedural requirements for claiming priority to an earlier-filed foreign application and submitting a certified copy thereof may vary based on the filing date of the later-filed nonprovisional application.
<u>214.01</u>	New section added to discuss the time for filing a priority claim. Includes and updates information previously in MPEP § 201.14.
<u>214.02</u>	New section added to discuss unintentionally delayed priority claims.
<u>214.03</u>	New section added to discuss Office acknowledgement of priority claims. Includes and updates information in previous MPEP § 201.14(c).
<u>214.04</u>	New section added to discuss proper identification of the foreign application in a priority claim. Includes Table I (Countries or Organizations Having Annual Series of Application Numbers) and Table II (Countries or Organizations Having Other Than Annual Systems).
<u>215</u>	New section added to discuss the requirement for a certified copy of the foreign application to which priority is claimed. Includes and updates information in previous MPEP §§ 201.14(b) and 201.14(c). Subsection I provides updated guidance for submitting a certified copy of a foreign application, based on the applicability of AIA provisions. Subsection II explains that certified copies include those retrieved by the Office in accordance with a priority document exchange program. Subsection III discusses proper procedure when the certified copy is filed in a parent or related application. Deleted references to the French patent stamp and actual models originally filed in Germany. Subsections IV-VII include additional information relating to certified copies of priority documents.
<u>215.01</u>	New section added to provide information regarding Electronic Priority Document Exchange (PDX) agreements.
<u>215.02</u>	New section added to discuss time requirements for filing a certified copy in an application filed on or after March 16, 2013.
<u>215.02(a)</u>	New section added to explain that the timeliness requirement may be met by priority document exchange and to discuss 37 CFR 1.55(h).
<u>215.02(b)</u>	New section added to discuss meeting the timeliness requirement by filing an interim copy of the foreign application.
<u>215.03</u>	New section added to discuss the time for filing a certified copy in an application filed before March 16, 2013. Includes and updates information in previous MPEP § 201.14(a).
<u>216</u>	New section added to discuss the requirements for entitlement to foreign priority. Includes information from previous MPEP § 201.14(b)(scope of priority claim review before the examiner) and MPEP § 201.15 (overcoming a reference based on right of priority).
<u>216.01</u>	New section added to discuss using a certificate of correction to perfect a claim for priority under 35 U.S.C. 119(a)-(d) or (f). Information herein moved from previous MPEP § 216 and revised

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	to add example of perfecting a priority claim using a certificate of correction when the certified copy of the foreign application (and required processing fee) is filed after the date the issue fee is paid.
<u>217</u>	New section added to discuss incorporation by reference under 37 CFR 1.57(a). Information herein moved from previous MPEP § 201.17.

CHAPTER 300:

301	Revised subsection I to add information that for applications filed on or after September 16, 2012, the original applicant is presumed to be the initial owner of an application for an original patent. Revised subsection V to add information that for applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012, an assignment may contain the statements required to be made in an oath or declaration (“assignment-statement”) and may be used as the oath or declaration if the assignment is made of record in the assignment records of the Office (consistent with the inventor oath or declaration provisions of section 4 of the AIA).
301.01	Revised to update 37 CFR 1.12 (Assignment records open to public inspection), and to distinguish between who may provide proper written authority for access to copies of assignment records relating to pending or abandoned patent applications, which is dependent on whether the application filing date is before, or on or after, September 16, 2012.
302	Revised to delete references to 1992 and 2004 effective dates of 37 CFR Part 3 and 37 CFR 3.11(c), respectively.
302.04	Updated 35 U.S.C. 293.
302.07	Added 37 CFR 3.31(h) and discussion thereof, which provides that for applications filed on or after September 16, 2012, if the assignment document is also intended to serve as the required oath or declaration, the cover sheet must contain a conspicuous indication of an intent to utilize the assignment as the required oath or declaration under 37 CFR 1.63. Updated Recordation Form Cover Sheet and guidelines, Form PTO-1595.
302.09	Revised the list of documents that cannot be submitted via facsimile to the Office to delete requests for corrections to documents previously recorded and resubmission of a non-recorded assignment. Also revised to specify that the customer’s fax machine should be (rather than must be) connected to a dedicated line.
307	Revised section title and information therein such that it is limited to issue of patent to a non-applicant assignee. Added cross-reference to new MPEP § 308 regarding issuance of a patent to an assignee who is the applicant in an application filed on or after September 16, 2012.
308	New section added to discuss 35 U.S.C. 118 and 37 CFR 1.46 as in effect on September 16, 2012. 35 U.S.C. 118 requires that where a patent is granted on an application filed by a person other than the inventor, the Office must grant the patent to the real party interest; 37 CFR 1.46(e) requires applicants, other than the inventor, to notify the Office of any change in the real party of interest in reply to a notice of allowance.
313	Revised to add cross-reference to new MPEP § 325 discussing establishing rights of an assignee to take action in an application filed on or after September 16, 2012.
315	Revised to delete historical information with regard to requests for indexing against a recorded document.
317.03	Revised to add cross-reference to new MPEP § 325 discussing establishing rights of an assignee to take action in an application filed on or after September 16, 2012.
324	Title of section revised to “Establishing Right of Assignee to Take Action - Application Filed Before September 16, 2012” because the information therein is limited to applications not subject to section 4 of the AIA (provisions pertaining to who may apply for a patent, and to the inventor’s oath or declaration). Added cross-reference to new MPEP § 325 for information relating to the right of assignee to take action in an application filed on or after September 16, 2012. Revised to explain that pursuant to 37 CFR 1.31, effective September 16, 2012, an owner or assignee who is a juristic entity must be represented by a patent practitioner, without regard to the filing date of the application. However, juristic entities may sign small entity assertions, disclaimers, and submissions under 37 CFR 3.73 to establish ownership, powers of attorney, and powers to inspect

	<p>an application. Any other paper submitted on behalf of a juristic entity on or after September 16, 2012, must be signed by a patent practitioner.</p> <p>Subsection II. Establishing Ownership revised to specify that the provisions therein apply to when an assignee first seeks to take action in a matter before the Office with respect to a patent application filed before September 16, 2012, or with respect to a patent or a reexamination proceeding relating to a patent that issued from an application that was filed before September 16, 2012.</p> <p>Revised subsection III to clarify that when a continued prosecution application (CPA) under 37 CFR 1.53(d) is filed in a design application, the statement filed under pre-AIA 37 CFR 3.73(b) in the parent application will serve as the statement for the CPA.</p> <p>Revised subsections VI and VII (discussing when ownership must or need not be established, respectively) to remove references to assignee filing of a continued prosecution application under 37 CFR 1.53(d). Subsection VI further revised to deleted references to assignee acquiescence to express abandonment and filing an application under 37 CFR 1.47(b).</p>
325	<p>New section added, “Establishing Right of Assignee to Take Action – Application Filed On or After September 16, 2012.” Added to explain implementation of the provisions of section 4 of the AIA pertaining to who may apply for a patent. Format of new section parallels that of MPEP § 324 which explains the right of assignee to take action in applications filed before September 16, 2012. Introductory portion of section explains that an assignee who is not the original applicant must become the applicant under 37 CFR 1.46 in order to request or take action in a patent application. This portion further explains that a juristic owner or assignee must be represented by a patent practitioner, and describes the limited types of papers that may be signed by a juristic entity.</p>

CHAPTER 400:

400	Revised title of chapter to “Representative of Applicant or Owner” for consistency with changes necessitated by section 4 of the AIA (provisions pertaining to who may apply for a patent and to the inventor’s oath or declaration).
401	Updated 37 CFR 1.31. Revised text of section and form paragraph 4.10 for consistency with the updated rule, which requires an applicant who is a juristic entity (e.g., organizational assignee) to be represented by a patent practitioner.
402	<p>Revised to limit subject matter of the section to discussion of powers of attorney and naming a representative and to add subsection headings (I. Naming Representative in a Power of Attorney, II. Registered Practitioners, III. Ineffective Power of Attorney). Moved information pertaining to acting in a representative capacity and information pertaining to signature requirements for papers filed in the Office to new MPEP § 402.03.</p> <p>Deleted information pertaining to removing names from the register (as provided for in former 37 CFR 10.11).</p> <p>Revised to incorporate (in subsection I) information from MPEP § 402.01 that a power of attorney to a joint inventor will be recognized even though the one to whom it is given is not a registered practitioner. Also added cross-references to MPEP sections discussing changes in powers of attorney.</p> <p>Revised to delete information specific to registered Canadian patent agents and to insert instead in subsection II a general description of 37 CFR 11.6(c) whereby certain foreigners who are in good standing before the patent office of the country in which they reside and practice may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country.</p> <p>For consistency with changes to power of attorney practice (see 37 CFR 1.31 and 1.32), revised to delete indication that in the case of an ineffective appointment, the examiner will communicate only with applicant. Noted that papers filed on the behalf of a juristic entity applicant in an application filed on or after September 16, 2012, however, may only be signed by a registered practitioner.</p>
402.01	Revised title to “Limited Recognition in Patent Matters” and updated 37 CFR 11.9. Moved information pertaining to a power of attorney to a joint inventor to MPEP § 402.
402.02	Revised to add cross-references to newly added MPEP § 402.02(a) for appointment of a power of attorney in applications filed on or after September 16, 2012 and MPEP § 402.02(b) for appointment of a power of attorney in applications filed before September 16, 2012.
402.02(a)	New section added discussing requirements for appointments of powers of attorney in applications filed on or after September 16, 2012 for consistency with changes necessitated by section 4 of the AIA (provisions pertaining to who may apply for a patent, and to the inventor’s oath or declaration), including general requirements (subsection I), powers in continuing applications (subsection II), and forms (subsection III).
402.02(b)	New section added discussing requirements for appointments of powers of attorney in applications filed before September 16, 2012, i.e., in applications not subject to section 4 of the AIA, including general requirements (subsection I), powers in continuing applications (subsection II), and forms (subsection III).
402.03	New section added pertaining to signature requirements for papers filed in an application.

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	<p>Subsection I incorporates information previously in MPEP § 402 pertaining to the signature and certificate requirements of 37 CFR 11.18, and adds text emphasizing that pursuant to 37 CFR 11.18(a), every paper filed by a practitioner must be personally signed by the practitioner, except those required to be signed by the applicant or party. Subsection II incorporates information previously in MPEP § 402 pertaining to acting in a representative capacity pursuant to 37 CFR 1.34, and revises such information for consistency with changes necessitated by section 4 of the AIA (provisions pertaining to who may apply for a patent, and to the inventor’s oath or declaration).</p>
402.05	<p>Revised title to “Revocation of Power of Attorney” and added cross-references to newly added MPEP § 402.05(a) for revocation by applicant in applications filed on or after September 16, 2012 and MPEP § 402.05(b) for revocation by applicant in applications filed before September 16, 2012. Also added cross-reference to MPEP § 402.07 which discusses assignee revocation of a power of attorney. Deleted reference to revocation of associated powers.</p> <p>Revised to add that any power of attorney (or revocation thereof) in an interference or derivation proceeding should be forwarded to the Patent Trial and Appeal Board for consideration.</p>
402.05(a)	<p>New section added to discuss requirements for revocation of a power of attorney by applicant in an application filed on or after September 16, 2012.</p>
402.05(b)	<p>New section added to discuss requirements for revocation of a power of attorney by applicant in an application filed before September 16, 2012.</p>
402.06	<p>Revised to update 37 CFR 1.36(b) and add 37 CFR 11.116 discussing withdrawal from representation. Revised information regarding the treatment of requests for withdrawal and the requirements of such requests for consistency with Changes to Representation of Others Before The United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 2013), and Change in Procedure for Requests to Withdraw from Representation in a Patent Application, 1329 O.G. 99 (April 2008).</p> <p>Updated forms for requesting withdrawal from representation.</p>
402.07	<p>Revised to add that in an application filed on or after September 16, 2012, any power of attorney must be signed by the applicant or patent owner, and for an assignee to appoint or revoke a power of attorney in such an application, the assignee must become the applicant under 37 CFR 1.46(c).</p>
402.08	<p>Revised to indicate that any power of attorney (or revocation thereof) in an interference or derivation proceeding should be forwarded to the Patent Trial and Appeal Board for consideration.</p>
402.09	<p>Updated 37 CFR 11.9.</p>
402.10	<p>Revised to clarify that when a power of attorney (or revocation thereof) is signed by less than all applicants or owners, the change in power is not accepted until a petition under 37 CFR 1.36(a) or 1.183 is granted.</p>
403	<p>Revised title to reflect that the section discusses customer number practice. Added cross-references to newly added MPEP § 403.01(a) for information pertaining to correspondence in applications filed on or after September 16, 2012 and MPEP § 403.01(b) for information pertaining to correspondence in applications filed on or after September 16, 2012. Moved information pertaining to 37 CFR 1.33 as in effect on September 15, 2012 to MPEP § 403.01(b).</p> <p>Revised to provide link to USPTO Web site for instructions for submitting requests to change the correspondence address (or fee address) of a list of applications or patents. Deleted as unnecessary indication that electronic requests to change the power of attorney have not been accepted since 2003.</p>

	Revised to add that certain inconsistencies between correspondence addresses will generally be resolved in favor of the address of the Customer Number or the application data sheet. Updated forms pertaining to customer number practice.
403.01	Section deleted as unnecessary; associate powers of attorney have not been accepted since June 25, 2004.
403.01(a)	New section added to discuss 37 CFR 1.33 and correspondence in applications filed on or after September 16, 2012. Text discusses resolution of inconsistencies in correspondence addresses, who may change the correspondence address, and who must sign correspondence.
403.01(b)	New section added to incorporate information from MPEP § 403 pertaining to 37 CFR 1.33 (Correspondence respecting patent applications, reexamination proceedings, and other proceedings) as in effect on September 15, 2012.
403.02	Revised to indicate that if applicant simultaneously appoints two patent practitioners, applicant should indicate with whom correspondence is to be conducted by specifying a correspondence address, and to indicate that correspondence will be mailed to the latest correspondence address of record.
404	Section deleted as unnecessary in view of removal of 37 CFR 10.66.
405	Revised title to more accurately reflect content of section (interviews with a registered practitioner not of record). Text revised for consistency with MPEP §§ 713.01 and 713.05.
406	Revised to eliminate references to a “principal” or “associate” patent practitioner and to condense information pertaining to the death of a sole practitioner of record. Revised text indicates that upon the death of the sole practitioner of record, the power of attorney is terminated, and correspondence is mailed to the office of the deceased patent practitioner and to the party who originally appointed the deceased patent practitioner. Deleted from paragraphs 4.02 and 4.04; revised form paragraph 4.03 to reflect the information in the revised text of the section.
407	Revised to replace form paragraph 4.06 and 4.07 with an updated form paragraph 4.07, attorney or agent suspended (sole practitioner) for consistency with changes to power of attorney practice (see 37 CFR 1.31 and 1.32).
408	Revised to incorporate an explanation of the “Applicant Initiated Interview Request” form (PTOL-413A).
409	Deleted information previously therein and added cross-references to MPEP sections where the death, legal incapacity, or unavailability of the inventor or a joint inventor are discussed.
409.01	Removed and reserved. Content previously therein moved to MPEP § 409.01(b), subsection I (termination of power of attorney in an application filed before September 16, 2012).
409.01(a)	Deleted information previously therein (prosecution by administrator or executor) and moved that information to the introductory text and subsection II of MPEP § 409.01(b). Added new section to address who may file an application or be issued a patent involving a deceased or legally incapacitated inventor in an application filed on or after September 16, 2012.
409.01(b)	Revised to consolidate information pertaining to a deceased or legally incapacitated inventor in an application filed before September 16, 2012. Subsection I (Termination of Power of Attorney) contains text of former MPEP § 409.01; subsection II (Prosecution by Legal Representative, Administrator, or Executor)

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	contains text of former MPEP §§ 409.01(a) and 409.02; subsection III (Proof of Authority of Administrator or Executor) retains the text from the former version of this section; subsection IV (After Administrator of Executor Has Been Discharged) contains the text of former MPEP § 409.01(c); subsection V (Exception in Some Foreign Countries) contains the text of former MPEP § 409.01(d); subsection VI (If Inventor of Assigned Application Dies) contains the text of former MPEP § 409.01(e), changing the references to “applicant” to read “inventor’s” for accuracy; subsection VII (Intervention of Executor Not Compulsory) contains the text of former MPEP § 409.01(f).
<u>409.01(c)-409.01(f)</u>	Sections deleted and content moved to MPEP § 409.01(b).
<u>409.02</u>	Deleted information previously therein (legal incapacity of an inventor) and moved the information to MPEP § 409.01(b), subsection II. Added information to address situations wherein there is an unavailable joint inventor in an application filed on or after September 16, 2012.
<u>409.03</u>	Revised title of section and text therein to reflect that it is limited to the unavailability of an inventor in an application filed before September 16, 2012.
<u>409.03(a)-409.03(j)</u>	Editor note inserted before text of each section indicating that the section is not applicable to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012.
<u>409.03(c)</u>	Revised section title.
<u>409.03(g)</u>	Revised to clarify that proof of irreparable damage may be establish by a pre-AIA 37 CFR 1.47(b) applicant.
<u>409.03(j)</u>	Revised to indicate that an application filed under pre-AIA 37 CFR 1.47 can be published as a Statutory Invention Registration provided the request for a Statutory Invention Registration was filed before March 16, 2013.
<u>409.05</u>	Added new section directed to the filing of an application on or after September 16, 2012, by an assignee, obligated assignee, or person who otherwise shows sufficient proprietary interest.
<u>410</u>	Revised to replace 37 CFR 10.18 and references thereto with 37 CFR 11.18. Replaced list of rules which do not require a separate verification statement with a reference to “several rules” and added 37 CFR 1.64 to the list of rules that do require a separate verification statement. Revised to update Rule 11(b) of the Federal Rules of Civil Procedure to the 2007 version.

CHAPTER 500:

501	Revised to update 37 CFR 1.1 and 1.4. Deleted requests for publication of a statutory invention registration and petitions to institute a public use proceeding from the list of correspondence that should be addressed to the Commissioner for Patents.
502	<p>Revised to update 37 CFR 1.5 and 1.6. Added suggestion that applicants consider filing new patent applications (as well as patent-related correspondence) via the Office Electronic Filing System (EFS-Web) whenever permitted; provided URL of the EFS-Web Guidance and Resources page of the USPTO Web site (http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp). Clarified that if there is a minor obvious error in the identification of the application such that the Office readily recognizes both the existence of the error and the appropriate correction, the error can be corrected by the Office.</p> <p>Discussion of “Express Mail Service” moved to subsection I with an explanation that the United State Postal Service (USPS) changed the name of "Express Mail" to "Priority Mail Express" effective July 28, 2013.</p> <p>Revised information under subsection II to explain that a petition under 37 CFR 1.313(c) to withdraw an application from issue may be filed as a Web-based ePetition.</p> <p>In subsection III, revised reference to “interferences” to add “and trials.” Revised to indicate that trial related correspondence may only be hand-carried as authorized by the Board.</p>
502.01	Revised to update 37 CFR 1.6. Revised the text in subsection II (Correspondence Relative To Patents And Patent Applications Where Filing By Facsimile Transmission Is Not Permitted) for consistency with the changes to 37 CFR 1.6(d).
502.02	<p>Revised to update 37 CFR 1.4 and to explain that 37 CFR 1.4(e) requires payments by credit cards to be submitted with an original handwritten signature personally signed in permanent dark ink or its equivalent where the payment is not being made via the Office's electronic filing systems.</p> <p>Updated subsection II to specify that an S-Signature cannot be used for correspondence that requires a person's signature and relates to 1) registration to practice before the USPTO, 2) payments by credit card (other than such payments submitted via the Office's electronic filing systems) and 3) filing a document required by statute to be certified. Also revised subsection II to explain that for an application filed on or after September 16, 2012, when a practitioner is signing as an applicant as defined in 37 CFR 1.42 (e.g., as an inventor), a registration number is not required and should not be supplied to avoid confusion as to which basis the practitioner is signing, e.g., as a practitioner or as the applicant; a patent practitioner signing on behalf of a juristic entity applicant (see 37 CFR 1.33(b)(3)) is signing as a patent practitioner and thus must provide his or her registration number.</p> <p>Subsection III revised to delete indication that where an assignee was involved in the transmission of the declaration form and/or the executed declaration, a showing of chain of custody involving the assignee would be required.</p> <p>Subsection IV revised for consistency with the amendment to 37 CFR 1.48(f) which provides that a change to the inventor's name must be by way of a request under 37 CFR 1.48(f).</p> <p>Subsection V revised to explain that for applications filed under 35 U.S.C. 111(a), foreign priority documents retrieved by the Office from a foreign intellectual property office that participates with the Office in a priority document exchange agreement can serve as the certified copy provided the requirements of 37 CFR 1.55(h) are met.</p>
502.05	Content of section not revised, however Editor Note added to indicate that the current version of the Legal Framework for EFS-Web is posted on the USPTO Web site at http://www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.jsp

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503	Revised to add subsection headings. In subsection I. Application Number added explanation that for applications filed electronically, EFS-Web provides an Acknowledgement Receipt that contains a time and date stamp indicating when the correspondence was received at the Office, an application number, a confirmation number, and a full listing of the correspondence submitted. The Electronic Acknowledgement Receipt is the electronic equivalent of a postcard receipt. Information in subsection II. Filing Receipts updated to explain that for non-reissue applications filed on or after September 16, 2012, the filing of the inventor's oath or declaration may be postponed until the date the issue fee is paid if an application data sheet in accordance with 37 CFR 1.76 is timely filed providing the required inventor information.
505	Revised title of section to "Date of Receipt Stamp." Deleted discussion of the Public Law 106-113 (1999) amendments to 35 U.S.C. 119(e). Added that correspondence submitted via the USPTO electronic filing system (EFS-Web) will be accorded a receipt date on the date the correspondence is received at the correspondence address for the Office set forth in 37 CFR 1.1 (i.e., local time in Alexandria, VA), without regard to whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.
506	Updated 37 CFR 1.53. Added information explaining the conditions under which applicant may postpone filing the inventor's oath or declaration until the application is in condition for allowance. Added explanation of the modifications to missing parts practice with regard to applications filed on or after September 16, 2012 without the inventor's oath or declaration or with a deficient inventor's oath or declaration.
506.02	Revised to add that for applications filed on or after September 16, 2012, the Office does not require the person who has executed an oath or declaration in compliance with 35 USC 115 and 37 CFR 1.63 or 1.162 to provide an additional inventor's oath or declaration for the application.
507	Revised to limit the subject matter discussed to current practice with regard to the review of drawings in the Office of Patent Application Processing.
508.01	Section deleted as unnecessary (relevant only to paper processing) and reserved.
509	Revised to update 37 CFR 1.26 and add subsection headings. Revised information in subsection I. Itemization and Application of Fees to add the non-electronic filing fee under 37 CFR 1.16(t) as the second item to which fees will be applied if the filing fee payment is insufficient and applicant has not specified the order in which the fees are to be paid. Revised information in subsection II. Payment by Credit Card to indicate that the credit card payment form is not required (and should not be used) when making a credit card payment via EFS-Web or other electronic filing systems. For consistency with the revision to 37 CFR 1.4(e), added that credit card payments not made via the electronic filing systems may only be submitted with a handwritten signature personally signed in permanent dark ink. Deleted historical information.
509.01	Revised to add that the Office will treat a deposit account authorization to charge the filing fee as an authorization to charge the following applicable fees under 37 CFR 1.16: basic filing fee; search fee; examination fee; any excess claims fees; any application size fee; and any non-electronic filing fee (see 37 CFR 1.16(t)).
509.02	Revised to add indication that if applicant qualifies as a small entity, applicant may also qualify for "Micro Entity Status" under 35 U.S.C. 123 and 37 CFR 1.29. Added information regarding the extension of the small entity discount to certain petition fees, request for reexamination fees, fees for submitting an information disclosure statement in certain time frames, fees for an unintentionally delayed claim for priority, and PCT international stage fees. Also revised to explain that the fee for a statutory disclaimer under 37 CFR 1.20(d) is now ineligible for a small entity discount.
509.03	Updated 37 CFR 1.4 and 37 CFR 1.27(c).

	<p>In subsection II, added subsection A to discuss the requirements of 37 CFR 1.27(c) with regard to applications filed on or after September 16, 2012. In particular, for applications filed on or after September 16, 2012, the written assertion of entitlement to small entity status can be signed by: (1) the applicant (37 CFR 1.42 or 1.421); (2) a patent practitioner of record or acting in a representative capacity under 37 CFR 1.34; (3) the inventor or a joint inventor, if the inventor is the applicant; or (4) the assignee. The assignee can sign a written assertion of small entity status even if the assignee is not the applicant or is a juristic entity.</p> <p>In subsection II, added subsection heading B to precede discussion of parties who can assert and sign an entitlement to small entity status in applications filed before September 16, 2012.</p> <p>Subsection III revised to that the discussion of parties who can file the written assertion once signed is limited to applications filed before September 16, 2012.</p>
509.04	New section added to define “micro entity status” in accordance with 35 U.S.C. 123 and to set forth the basic requirements for certification of entitlement to micro entity status and the bases for establishing micro entity status.
509.04(a)	New section added to provide detailed information with regard to the gross income basis for micro entity status as implemented by 37 CFR 1.29(a)-(c), including the certifications with regard to the small entity requirement, application filing limit, and gross income limits.
509.04(b)	New section added to provide detailed information with regard to the institution of higher education basis for micro entity status as implemented by 37 CFR 1.29(d).
509.04(c)	New section added to explain that a certification of micro entity status, on either the gross income basis or the institution of higher education basis, can be signed only by an authorized party as set forth in 37 CFR 1.33(b).
509.04(d)	New section added to explain the continued obligation to determine micro entity qualification with each fee payment.
509.04(e)	New section added to explain the requirement to file a notification of loss of entitlement to micro entity status prior to paying or at the time of paying, any fee after the date on which status as a micro entity is no longer appropriate. Payment of a fee in other than the micro entity amount is not sufficient notification that micro entity status is no longer appropriate.
509.04(f)	New section added to explain how to correct errors in micro entity status.
510	Updated to set forth current procedures and regulations governing public conduct on all Office premises as well as additional procedures specific to the use of public information facilities.
511	<p>Revised to add subsection I to explain that references to “Express Mail” or “Express Mail from the USPS in accordance with 37 CFR 1.10” throughout the MPEP should be construed as applicable to the “Priority Mail Express” service of the USPS on or after July 28, 2013 (the date the USPS renamed the service).</p> <p>Information in subsection III revised to replace suggestion that applicants should consider filing correspondence by facsimile when permitted with the suggestion that applicants should consider filing new patent applications (as well as patent-related correspondence) via the Office electronic filing system (EFS-Web) whenever permitted.</p>
512	Revised to update 37 CFR 1.8(a)(2) and to indicate that it is preferred that a certificate under 37 CFR 1.8 be signed by the applicant or a registered practitioner. Deleted historical information.
513	<p>Revised title to change “Express Mail” to “Priority Mail Express” and added explanation that effective July 28, 2013, the United States Postal Service (USPS) changed the name of “Express Mail” to “Priority Mail Express.” All characteristics of the “Priority Mail Express” service are the same as those of the former “Express Mail” service (although the mailing labels differ).</p> <p>References to “Express Mail” or “Express Mail from the USPS in accordance with 37 CFR 1.10,” throughout the MPEP should be construed as applicable to the “Priority Mail Express” service of the USPS on or after July 28, 2013.</p> <p>Deleted historical information.</p>

CHAPTER 600:

<i>Passim</i>	Revised text for consistency with changes necessitated by section 4 of the AIA (provisions pertaining to who may apply for a patent, and to the inventor's oath or declaration), to clarify whether the subject matter applies to an applicant or inventor.
601	Revised to update 35 U.S.C. 111 and 37 CFR 1.51. Revised to indicate that if an application data sheet (37 CFR 1.76) is used, data supplied in the application data sheet need not be provided elsewhere in the application with the following exception. For applications filed before September 16, 2012, the citizenship of each inventor must be provided in the oath or declaration under pre-AIA 37 CFR 1.63 even if this information is provided in the application data sheet. Revised list of preferred section headings in the arrangement and contents of the specification to remove "Microfiche appendix" for computer listings filed on or prior to March 1, 2001, and to add "Statement regarding prior disclosures by an inventor or joint inventor." Deleted request for applicants to include a preliminary classification on newly filed patent applications.
601.01	Revised to update 37 CFR 1.53 and to note that the substantive requirements under 37 CFR 1.53 for applications filed on or after September 16, 2012 as compared to those filed prior to September 16, 2012 (pre-AIA) are the same except for 37 CFR 1.53(f)(pertaining to the completion of a nonprovisional application subsequent to filing).
601.01(a)	Added subsection heading "I. Application Filing Requirements" and revised the information thereunder to delete historical information regarding filing-related fee practices for nonprovisional applications filed prior to July 1, 2005. Added subsection heading "II. Completion of Nonprovisional Application Subsequent to Filing." Added subsection heading "A. Completion of Nonprovisional Application Filed On or After September 16, 2012" and the text therein to explain that 37 CFR 1.53(f) revises the former missing parts practice to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. Added subsection heading "B. Completion of Nonprovisional Application Filed Before September 16, 2012" to precede remainder of text in the section. Also revised to indicate that applicant does not need to submit a copy of the notice to file missing parts or the notice of incomplete application when the reply to the notice is being submitted via EFS-Web.
601.01(c)	Revised to update 37 CFR 1.53(c) and to delete reference to filing a request for a statutory invention registration.
601.01(d)	Revised to specify that for applications filed before September 16, 2012 the submission of omitted pages of the specification must be accompanied by an oath or declaration in compliance with pre-AIA 37 CFR 1.63 and pre-AIA 37 CFR 1.64 referring to the omitted pages. Added cross-reference to MPEP §§ 601.01(a) and (b) for treatment of incomplete nonprovisional and provisional applications, respectively.
601.01(e)	Revised to update quoted text of 35 U.S.C. 111. Revised to specify that if a nonprovisional application filed before September 16, 2012 does not contain at least one claim, the submission of a claim must be accompanied by an oath or declaration in compliance with pre-AIA 37 CFR 1.63 and pre-AIA 37 CFR 1.64 referring to such claim.
601.01(f)	Revised to specify that for applications filed before September 16, 2012 the submission of omitted drawings must be accompanied by an oath or declaration in compliance with pre-AIA 37 CFR 1.63 and pre-AIA 37 CFR 1.64 referring to such drawings.
601.01(g)	Revised to add subsection headings "I. Review By The Office Of Patent Application Processing" and "II. Review by Examiner."

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	<p>Revised to specify that for applications filed before September 16, 2012 the submission of omitted drawings must be accompanied by an oath or declaration in compliance with pre-AIA 37 CFR 1.63 and pre-AIA 37 CFR 1.64 referring to such drawings.</p> <p>Added cross-reference to MPEP §§ 601.01(a) and (b) for treatment of incomplete nonprovisional and provisional applications, respectively.</p>
601.01(h)	Section deleted.
601.02	Revised to delete text that indicated a power of attorney may be incorporated in the oath or declaration, and to add cross-references to MPEP §§ 402.02(a) and (b) for detailed information and relevant forms pertaining to appointment of a power of attorney.
601.03	Revised title to “Correspondence Address” and limited subject matter discussed to information pertaining to the requirements to provide a current correspondence address. Moved subject matter directed to a change of correspondence address (which pertains to applications filed before September 16, 2012) to MPEP § 601.03(b).
601.03(a)	New section added section to discuss change of correspondence address in applications filed on or after September 16, 2012.
601.03(b)	New section added to set forth information moved from MPEP § 601.03 regarding change of correspondence address in applications filed before September 16, 2012.
601.05	Revised to limit subject matter to general information pertaining to an application data sheet (ADS). Moved information directed to ADS requirements in an application filed before September 16, 2012 to MPEP § 601.05(b).
601.05(a)	New section added to discuss ADS requirements in an application filed on or after September 16, 2012. Section includes, inter alia, discussion of bibliographic information, correcting and updating an ADS, and treatment of inconsistent information.
601.05(b)	New section added to set forth information moved from MPEP § 601.05 regarding ADS requirements in an application filed before September 16, 2012. Revised information to explain that a supplemental application data sheet must be signed as it is a paper and/or amendment filed in the application, and to clarify that any ADS submitted after the filing date of the application is a supplemental ADS, regardless of whether an original ADS was submitted with the application papers on filing. Deleted list of information that should be provided on an ADS.
602	<p>Revised title to "Oaths and Declarations” and limited subject matter discussed to information generally applicable to all oaths or declarations (e.g., submitted under 37 CFR 1.63 or 37 CFR 1.132).</p> <p>Revised subsection I. Oaths to add the information previously in MPEP §§ 604-604.03(a) pertaining to administration or execution of oath, seal, venue, and notary powers of military officers, and information previously in MPEP § 604.06 pertaining to an attorney administering the oath as notary.</p> <p>Revised subsection II. Declarations to add 37 CFR 1.68 and 18 U.S.C. 1001 and to delete form paragraphs pertaining to defective oaths or declarations.</p> <p>Moved information pertaining to an oath or declaration under pre-AIA 35 U.S.C. 115 and pre-AIA 37 CFR 1.63 in an application filed before September 16, 2012 to MPEP § 602.01(b).</p> <p>Moved information pertaining to identification of the application in the oath or declaration to new MPEP § 602.08(c).</p>
602.01	Section rewritten. Revised title to “Inventorship” and added subsections I. Naming Inventorship in Application Filed On or After September 16, 2012, II. Naming Inventorship in an Application Filed Before September 16, 2012, and III. Correction of Inventorship. Moved subject matter previously in this section (amendment of an oath or declaration) to MPEP § 602.03.

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<u>602.01(a)</u>	New section added to discuss requirements of the inventor's oath or declaration in an application filed on or after September 16, 2012. Discussion includes subsections I. Identity of Inventor(s), Application, and Required Statements, II. Assignment - Statement As Oath or Declaration, and III. Execution of Inventor's Oath or Declaration.
<u>602.01(b)</u>	New section added to discuss requirements of the inventor's oath or declaration in an application filed before September 16, 2012. Includes information previously set forth in MPEP § 602 with regard to such an oath or declaration.
<u>602.01(c)</u>	New section added to provide overview of correction of inventorship, name of an inventor, and order of inventors' names in an application. Subsection I explains how the inventorship is set forth in applications filed on or after September 16, 2012, as compared to those filed before September 16, 2012. Subsection II provides an overview of requests for correction of inventorship, and explains that requests under 37 CFR 1.48 filed on or after September 16, 2012 will be handled by the Office of Patent Application Processing (OPAP). Subsection III includes information moved from previous MPEP § 201.03 regarding correction of inventorship by filing a continuing application. Text also notes that the requirements for a request under 37 CFR 1.48 filed on or after September 16, 2012 are minimal.
<u>602.01(c)(1)</u>	New section added to discuss requests for correction of inventorship filed under 37 CFR 1.48(a) or (d) on or after September 16, 2012 (without regard to the filing date of the application).
<u>602.01(c)(2)</u>	New section added to discuss requests filed on or after September 16, 2012, under 37 CFR 1.48(f) to correct or update inventor names, or to change the order of inventor names.
<u>602.01(c)(3)</u>	New section added to discuss requests for correction of inventorship filed before September 16, 2012 (without regard to the filing date of the application). Information herein moved from previous MPEP § 201.03, with revisions as necessary to clarify the applicability of pre-AIA 37 CFR 1.48. For applications filed prior to September 16, 2012, where a 37 CFR 1.48 request is filed on or after September 16, 2012, the provisions of 37 CFR 1.48 in effect as of September 16, 2012 apply because it is the date of the request for correction that controls which version of the rule is applicable.
<u>602.02</u>	Revised to indicate situations under which a new oath or declaration is not needed, depending on whether the applications was filed before, or on or after, September 16, 2012. Deleted reference to examiner requiring a new oath or declaration in non-reissue applications because such documents are now reviewed non-examiner staff.
<u>602.03</u>	Section rewritten to consolidate information pertaining to defective oaths or declarations; to indicate that non-examiner staff, rather than examiners, will review inventor's oaths or declarations; and to delete form paragraphs pertaining to defective oaths or declarations. Subject matter previously in MPEP § 602.01 (amendment of oath or declaration) and § 602.05 (date of execution) added. Also added that required inventor's oath or declaration must be submitted no later than the date on which the issue fee is paid.
<u>602.04</u>	Updated 37 CFR 1.66. Revised to delete form paragraph and add subsection heading "I. Hague Convention Apostille." Added subject matter previously in MPEP §§ 604.04 and 604.04(a) to subsection II. Certificate of Diplomatic or Consular Officer.
<u>602.05</u>	Section rewritten. Added general information pertaining to filing a copy of an oath or declaration in a continuing application, distinguishing between an application filed before, or on or after, September 16, 2012. Indicates that a copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application, or with a continuation-in-part application filed on or after September 16, 2012, even if the oath or declaration identifies the application number of the prior application.

	Moved subject matter previously in this section, i.e., date of execution of an oath or declaration, to MPEP § 602.03.
602.05(a)	Section rewritten and discussion limited to oaths or declarations in continuing applications filed on or after September 16, 2012. Moved information previously in this section that is generally applicable to oaths or declarations in continuing applications to MPEP § 602.05; moved information specific to oaths or declarations in continuation or divisional applications filed before September 16, 2012 to new MPEP § 602.05(b).
602.05(b)	New section added to discuss oaths or declarations in continuation or divisional applications filed before September 16, 2012. Includes information previously in MPEP § 602.05(a).
602.08	New section added to provide overview of inventor and application information required in the inventor's oath or declaration.
602.08(a)	New section added to set forth required inventor bibliographic information. Includes information previously in MPEP §§ 605.01, 605.02, and 605.03 in subsections I. Inventor's Citizenship, II. Inventor's Residence and III. Inventor's Mailing or Post Office Address, respectively.
602.08(b)	New section added directed to inventor signature and name requirements. Includes, and updates for consistency with changes necessitated by the inventor's oath or declaration provisions of the AIA, information previously in MPEP §§ 605.04(a) – 605.04(f).
602.08(c)	New section added directed to the identification of the application in the inventor's oath or declaration. Information herein was formerly in MPEP § 602, subsection VI.
602.09	New section added directed to joint inventorship. Includes discussion of the provisions of 35 U.S.C. 116 previously in MPEP § 605.07.
603	Revised to add information relating to a supplemental oath or declaration in an application filed on or after September 16, 2012.
603.01	Revised to delete reference to a 1921 court decision and to simplify discussion to indicate that supplemental oaths and declarations covering the claims in the application may be filed after allowance as a matter of right.
604	Title changed and text rewritten to discuss substitute statements under 37 CFR 1.64. Information previously in this section (administration of execution of oaths) moved to MPEP § 602, subsection I. Oaths. This section sets forth the requirements for a substitute statement under 37 CFR 1.64 and is only applicable to applications filed on or after September 16, 2012. Pursuant to 37 CFR 1.64, an applicant may execute a substitute statement in lieu of an oath or declaration by the inventor if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under § 1.63, or cannot be found or reached after diligent effort.
604.01	Section deleted; moved subject matter to MPEP § 602, subsection I.A. Seal.
604.02	Section deleted; moved subject matter to MPEP § 602, subsection I.B. Venue.
604.03(a)	Section deleted; information pertaining to notary powers of military officers added to MPEP § 602, subsection I. Oaths.
604.04 - 604.04(a)	Sections deleted; information pertaining to diplomatic and consular officers moved to MPEP § 602.04, subsection II.
604.06	Section deleted; moved information regarding attorney administration of an oath to MPEP § 602, subsection I. Oaths.
605	Rewritten to indicate that effective September 16, 2012, the Office revised the rules of practice to permit a person to whom the inventor has assigned or is under an obligation to assign an invention to file and prosecute an application for patent as the applicant, and to permit a person who otherwise shows sufficient proprietary interest in the matter to file and

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	<p>prosecute an application for patent as the applicant on behalf of the inventor. See MPEP § 605.01 for information regarding the applicant in applications filed on or after September 16, 2012.</p> <p>For applications filed before September 16, 2012, a person to whom the inventor assigned an invention could file and prosecute an application for patent, but the inventor is considered the applicant. See MPEP § 605.02 for information regarding the applicant in applications filed before September 16, 2012.</p>
605.01	<p>Rewritten to provide information regarding the definition of applicant and change of applicant in applications filed on or after September 16, 2012. Information previously in this section moved to MPEP § 602.08(a), subsection I. Inventor’s Citizenship.</p> <p>Added explanation that the owner or assignee of a patent property can take action in a patent application as the applicant, and that the original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom, in the absence of an assignment. An assignee who is not the original applicant must become the applicant under 37 CFR 1.46 in order to request or take action in a patent application.</p>
605.02	<p>Rewritten to provide information regarding the applicant in applications filed before September 16, 2012. Information previously in this section moved to MPEP § 602.08(a), subsection II. Inventor’s Residence.</p>
605.03	<p>Section deleted; information therein moved to MPEP § 602.08(a), subsection III. Inventor’s Mailing or Post Office Address.</p>
605.04(a) - 605.04(f)	<p>Sections deleted; information previously in these sections moved to new MPEP § 602.08(b) Inventor Signature and Name.</p>
605.04(g)	<p>Section deleted as unnecessary (pertained to paper processing of correction of inventorship).</p>
605.05	<p>Section deleted. See MPEP §§ 605.01 and 605.02 for information regarding administrator, executor, or other legal representative.</p>
605.07	<p>Section deleted. Information previously therein pertaining to the provisions of 35 U.S.C. 116 and joint inventorship moved to MPEP § 602.09; discussion relating to assumption of common ownership removed.</p>
606.01	<p>Revised to indicate that a change in title made by an examiner at the time of allowance must be by way of a formal examiner’s amendment.</p>
607	<p>Revised to explain that patent application filing fees are set in accordance with 35 U.S.C. 41 and the Fee Setting Authority set forth in section 10 of Public Law 112-29, Sept. 16, 2011. Deleted references to fee “on or after December 8, 2004.”</p>
607.02	<p>Revised to update 37 CFR 1.26(c) and to delete references to practices effective November 7, 2000; December 8, 2004; and March 10, 2006.</p>
608	<p>Revised to update language pertaining to the disclosure requirement by adding a reference to 35 U.S.C. 112 and explaining that the requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent, and clarifying that no new matter may be introduced into an application after its filing date.</p> <p>Added cross-reference to MPEP § 714.25 for information pertaining to amendments and other papers presented in violation of the decorum and courtesy requirements of 37 CFR 1.3.</p>
608.01	<p>Revised to update 37 CFR 1.52 and 1.77. Updated section "II. Alteration of Application Papers" to indicate that effective September 16, 2012, 37 CFR 1.52(c) no longer prohibits interlineations and other alterations of the application papers from being made after the signing of the inventor's oath or declaration.</p>

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608.01(a)	Revised to indicate that for applications filed on or after September 16, 2012, if there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors.
608.01(b)	Revised to delete a sentence in sample abstract 2.
608.01(f)	Revised to update 37 CFR 1.84.
608.01(g)	Revised to add a cross-reference to MPEP § 2111.01.
608.01(h)	Revised to delete discussion of patent invalidity for lack of compliance with the best mode requirement.
608.01(m)	Revised to delete cross-reference to MPEP § 706.03.
608.01(n)	Revised to insert 35 U.S.C. 112(e) and to delete historical information pertaining to multiple dependent claims.
608.01(n)	Revised to delete citation to <i>Ex parte Kotler</i> , 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901) as unnecessary and to add a cross-reference to MPEP § 2103 with regard to construing claims in light of the specification.
608.01(p)	Revised title to "Completeness of Specification." Updated text for consistency with the discussion of the written description and enablement requirements of 35 U.S.C. 112 as explained in MPEP § 2163 et seq. and MPEP § 2164 et seq., respectively, and for consistency with the discussion of the utility requirement in MPEP § 2107. Added cross-references to MPEP § 2161.01 regarding computer programming and 35 U.S.C. 112; and MPEP § 2181 and § 2185 regarding 35 U.S.C. 112 in the context of functional claims. Revised subsection I. Incorporation By Reference to update 37 CFR 1.57(c), to delete citation to <i>Ex parte Schwarze</i> , 151 USPQ 426 (Bd. App. 1966) as unnecessary, and to delete historical information pertaining to incorporation by reference policy. Revised discussion of 37 CFR 1.57(g)(1) (authorizing correction of certain noncompliant incorporation by reference statements) to replace the sentence that indicated when a correction cannot be made with an explanation of when a correction can be made. A correction can be made when the application as filed clearly conveys an intent to incorporate the material by reference, for example, when an originally filed claim of an application identifies an amino acid or nucleotide sequence by database accession number. In making the determination of clear intent the examiner should consider the language used in referencing the sequence, the context in which it is disclosed, and any additional arguments or evidence presented by applicants.
608.01(q)	Revised to explain that legibility of application papers includes the ability to be photocopied and scanned so that suitable reprints can be made and papers can be electronically reproduced by use of digital imaging and optical character recognition.
608.01(t)	Revised to state that drawings cannot normally be transferred to another application.
608.01(u)	Section deleted.
608.01(v)	Revised to change the title and limit subject matter discussed to "Trademarks and Trade Names." Deleted prior subsections headings and inserted new subsection headings "I. Permissible Use In Patent Applications" and "II. Proprietary Nature of Trademarks." Deleted and moved to MPEP § 608.01(w) the content of former subsection II (information pertaining to the inclusion of copyright or mask work notices in patents).
608.02(w)	New section added to set forth copyright and mask work notice information previously in MPEP § 608.01(v), subsection II.
608.02	Revised to update 37 CFR 1.81 and 1.84.

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	<p>Revised subsection VI. Definitions for consistency with current practice. Provided definition for “unacceptable drawing,” noting that the Office no longer considers drawings as formal or informal; drawings are either acceptable or not acceptable. Drawings that do not comply with all of the form requirements of 37 CFR 1.84, e.g., because they are not on the proper size sheets, or the quality of the lines is poor, may be acceptable for the purposes of publication and examination if the drawings are readable and reproducible for publication purposes. An objection will generally only be made to a drawing that does not comply with the form requirements of 37 CFR 1.84 if the Office is unable to reproduce the drawing or the contents of the drawing are unacceptable to the examiner. Definitions of drawing print and interference print deleted.</p> <p>Revised subsection IX. Drawing Symbols to delete references to specific publications that pertain to graphical symbols. Also revised to explain that The American National Standards Institute (ANSI) (www.ansi.org) and the International Organization for Standardization (ISO) (www.iso.org) are organizations whose numerous publications include some that pertain to graphical symbols, and that the symbols therein are considered to be generally acceptable in patent drawings. Although ANSI and ISO documents and other published sources may be used as guides during the selection of graphic symbols for patent drawings, the Office will not “approve” any published collection of symbols as a group because their use and clarity must be decided on a case-by-case basis.</p>
608.02(a)	Revised to indicate that if drawings considered acceptable by OPAP have been indicated by the applicant as “informal,” the examiner should not require new drawings.
608.02(b)	Revised to change title to “Acceptability of Drawings” because the Office no longer considers drawings as formal or informal; drawings are either acceptable or not acceptable.
608.02(c)	Revised to change title to "Location of Drawings" and deleted references to paper processing. Updated to indicate that originally submitted drawings that are photographs or in color may be maintained in an IFW artifact folder.
608.02(h)	Revised to delete references to paper processing and updated section to indicate that if an applicant states that replacement sheets of drawings are filed with an amendment but such drawings are not in the IFW, in the next communication by the examiner, the applicant must be notified that replacement drawings do not appear to have been received and thus have not been entered in the application.
608.02(i)	Revised to reflect current practice such that drawings will not normally be transferred from a first pending application to another. Drawings that do not comply with all of the formal requirements of 37 CFR 1.84 may be acceptable if the drawings are readable and reproducible for publication purposes.
608.02(m)	Section deleted.
608.02(n)	Section deleted.
608.02(o)	Section deleted.
608.02(p)	Updated form paragraphs pertaining to drawing changes.
608.02(q)	Section deleted.
608.02(w)	Revised to clarify that the drawing corrections listed are illustrative of those that may be suggested without requiring annotated sheets from the applicant.
608.02(z)	Rewritten to set forth current practice with regard to allowable applications needing corrected drawings. Added that if the examiner makes an objection to the drawings, the examiner should require correction in reply to the Office action that sets forth the objection, and deleted information relating to processing applications in paper.
608.03(a)	Revised to delete information relating to processing applications in paper.

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608.04(a)	Revised to replace references to Board of Appeals decisions from the 1950's with cross-references to MPEP sections that address new matter issues.
608.04(c)	Revised to replace references to CFR sections with a cross-reference to MPEP section relevant to determining whether a new matter issue is appealable or petitionable.
608.05	Revised title to replace phrase "on a Compact Disc" with "in Electronic Form." Updated 37 CFR 1.77. Revised to add subsection I. Text Files Submitted via EFS-Web which includes information from the current Legal Framework for EFS-Web. Revised to add subsection heading "II. Submissions on Compact Disc" and to delete information therein pertaining to processing of compact discs in paper applications files. Revised to indicate that a received compact disc will be placed in an artifact folder.
608.05(a)	Revised to delete reference to statutory invention registration. Also revised to delete discussion regarding processing of compact discs in paper applications files and to add indication that a received compact disc will be placed in an artifact folder. Deleted description of microfiche appendix practice for computer listings filed on or before March 1, 2001.
608.05(c)	Revised title to read "Submissions of Biological Sequence Listings as ASCII Files" to reflect that biological sequence information may be submitted on compact disc or in text format via EFS-Web.
609	Revised to delete references to 37 CFR 1.99 and to indicate that third parties may only submit patents and publications in compliance with 37 CFR 1.290 in applications published under 35 U.S.C. 122(b) or protests in compliance with 37 CFR 1.291 in unpublished applications. Any third party submission that does not comply with the requirements of 37 CFR 1.290 or 37 CFR 1.291 will not be entered into the application file and will be discarded. Added instructions to Office personnel to: (1) not reply to or act upon any third-party inquiry or other submission in an application, except those in compliance with 37 CFR 1.290 or 37 CFR 1.291; and (2) decline to accept oral or telephone comments or submissions about applications from third parties.
609.04(a)	Revised to clarify that the waiver of the requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of a cited pending U.S. patent application that is stored in the USPTO's IFW system is limited to the specification, including the claims, and drawings in the U.S. application. If material other than the specification, including the claims, and drawings in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material.
609.04(b)	Revised to correct cross-reference in subsection II and to update the office to which the Office of Petitions reports in subsection IV.
609.05(a)	Revised to delete references to paper processing.
609.05(b)	Revised to delete reference to marking the margin of a specification containing citations.
609.07	Revised to delete reference to applications maintained in paper.

CHAPTER 700

701	Revised to include 35 U.S.C. 112 (among 35 U.S.C. 101, 102, and 103) as one of the statutes setting forth the main conditions precedent to the grant of a patent. Reference to form paragraph 7.04 changed to reference form paragraph 7.04.01. Included 35 U.S.C. 100 as revised in the AIA and added a note explaining when it is applicable. Revised to include a note explaining when pre-AIA 35 U.S.C. 100(e) remains applicable.
702	Revised to include a discussion of initial patent application review in the Office of Patent Application Processing (OPAP). Revised discussion of initial review by the Examiner before an application is taken up for examination. Revised to include cross-references to MPEP §§ 601.01(d) and 601.01(g).
702.01	Changed “is reached for its first Office action” to “is taken up for examination.” Revised item (B) to indicate that any form that lists informalities and any additional formal requirements to be made should be included in the first Office action. Revised form paragraph 7.01 and the discussion following form paragraph 7.02 to change “when the drawing is informal” to “when the drawing is not acceptable.”
703	This section discussing publication and availability of the “General Information Concerning Patents” booklet has been removed and reserved.
704.02 – 704.09 -	Reserved.
704.10	Revised to update 37 CFR 1.105. Revised to indicate the scope of 37 CFR 1.105 is extended to any assignee or anyone to whom there is an obligation to assign the application.
704.11	Changed “37 CFR 10.18(b)(2)” to “37 CFR 11.18(b)(2).”
704.11(a)	Revised item (M) to change “35 U.S.C. 102(a) or (b)” to “35 U.S.C. 102(a) or pre-AIA 35 U.S.C. 102(a) or (b).” Revised item (N) to change “35 U.S.C. 102(f)” to “35 U.S.C. 101 and 115, and pre-AIA 35 U.S.C. 102(f).” Revised item (R) to change “35 U.S.C. 112, first paragraph (written description)” to “35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph (written description),” and “35 U.S.C. 112, second paragraph” to “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph.” Revised item (S)(2) to change “35 U.S.C. 112, paragraph 6” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, paragraph 6.” Revised to insert item (T) regarding a third party submission under 37 CFR 1.290. Revised to insert item (U) regarding rescission of a statement under 37 FR 1.55 or 1.78 and added a reference to form paragraphs 7.104.02.fti and 7.104.02.aia.
704.14(b)	Revised to include a discussion of the “Search Notes” page in OACS . Revised to indicate the examiner may annotate an Information Disclosure Statement using the Stamper tool in Adobe Acrobat.
705.01(a)	Revised to indicate that the field of search covered must be recorded in the appropriate section of the OACS “Search Notes” page. Revised the discussion of the procedure followed when an appeal is taken from the rejection of all claims, all of which are examinable in the TC preparing a Patentability Report.
705.01(d)	Section deleted and reserved.
706	Updated 37 CFR 1.104.

	Revised to change the description of the requirements for patentability from “novelty, usefulness and unobviousness” to “patent eligible, useful, novel, nonobvious, enabled, and clearly described,” and to include 35 U.S.C. 112 along with 35 U.S.C. 101, 102, and 103.
706.01	Revised to change “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board.”
706.02	Revised to include AIA and pre-AIA 35 U.S.C. 102 and 103 and Editor Notes explaining their applicability. Subsection I, item (C) revised to include a discussion of prior art likely avoided by invoking an exception in a 37 CFR 1.130 declaration. Subsection III revised to include a cross-reference to MPEP § 2152.03. Subsection V Revised to include a cross-reference to MPEP §§ 2150 - 2159.04. Subsection VI, language in the title changed from “the effective filing date of the application” to “the effective filing date of a claimed invention.” Subsection VI, “effective filing date of a U.S. application” changed to “effective filing date of an invention claimed in a U.S. application.” Subsection VI, moved discussion of priority under 35 U.S.C. 119(e) from item (D) to item (C). Item (C) renumbered as item (D) and revised to include a discussion of applications subject to current 35 U.S.C. 102 in addition to pre-AIA 35 U.S.C. 102. Subsection VII, revised the cross-reference to Chapter 2300 to mention derivation proceedings.
706.02(a)	Revised the title to include references to 35 U.S.C. 102(a)(1) and (a)(2). Revised to include a cross-reference to MPEP § 2159 for guidance on determining whether the application is subject to the pre-AIA prior art regime.
706.02(a)(1)	New section applicable only to applications subject to examination under the first inventor to file provisions of the AIA. Subsection I added including a discussion of the availability of a reference as prior art under 35 U.S.C. 102(a)(1). Subsection II added including a discussion of the availability of a reference as prior art under 35 U.S.C. 102(a)(2).
706.02(a)(2)	New section containing the content formerly found in MPEP § 706.02(a), subsection II. Revised to indicate this section is not applicable to applications subject to the first inventor to file provisions of the AIA. Subsection II content revised to include a cross-reference to MPEP § 2136.03. Subsection III added containing the discussion of international applications filed before November 29, 2000.
706.02(b)	The content applicable only to applications subject to the first inventor to file provisions of the AIA has been moved from this section to new MPEP § 706.02(b)(1). The content not applicable to applications subject to the first inventor to file provisions of the AIA has been moved from this section to new MPEP § 706.02(b)(2).
706.02(b)(1)	Revised from content formerly in MPEP § 706.02(b) in view of the change to 37 CFR 1.78 requiring, for applications filed on or after September 16, 2012, that the specific reference to a prior application must be in an application data sheet. Updated the cross-references to reference new MPEP § 211 and §§ 213-216.
706.02(b)(2)	New section added including the content formerly found in MPEP § 706.02(b) that is applicable to applications not subject to the first inventor to file provisions of the AIA.

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	<p>Revised from content formerly in MPEP § 706.02(b) to change “the same patentable invention as defined in 37 CFR 41.203(a)” to “interfering subject matter as defined in 37 CFR 41.203(a).”</p> <p>Revised in view of changes to 37 CFR 1.55.</p> <p>Revised in view of changes to 35 U.S.C. 112.</p> <p>References to 37 CFR 1.131 changed to reference 37 CFR 1.131(a).</p>
706.02(c)	<p>Revised to indicate the examiner may consider making a requirement for information under 37 CFR 1.105 where the evidence of record indicates reasonable necessity.</p> <p>Revised to include a cross-reference to MPEP § 704.10.</p> <p>Revised to insert a paragraph related to time period set by the examiner for reply to a requirement.</p> <p>Revised to include a cross-reference to MPEP § 2133.03.</p> <p>Revised to indicate 1- or 2-month time period should be set by the examiner (will be changed in view of the Patent Law Treaty in the next MPEP revision)</p> <p>Replaced form paragraph 7.104 with form paragraphs 7.104.fti and 7.104.aia (time period for reply will be updated in view of the Patent Law Treaty in the next MPEP revision).</p>
706.02(c)(1)	<p>New section added for applications subject to the first inventor to file provisions of the AIA.</p> <p>Indicates that public use and on sale rejections may be based on uses and sales from anywhere in the world and must be “public.” Indicates that secret commercial sales should not be applied as “on sale” prior art under 35 U.S.C. 102(a)(1). Revised to include a cross-reference to MPEP § 2154.02 for uses or sales that are subject to the exceptions set forth in 35 U.S.C. 102(b)(1).</p>
706.02(c)(2)	<p>New section added for Public Use or On Sale under pre-AIA 35 U.S.C. 102(a) and (b). This section does not pertain to applications subject to the first inventor to file provisions of the AIA.</p>
706.02(d)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p>
706.02(e)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p>
706.02(f)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p>
706.02(f)(1)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Revised to indicate that all references in the examples and flowcharts apply to pre-AIA 35 U.S.C. 102.</p>
706.02(f)(2)	<p>Revised to include a discussion of provisional rejections under 35 U.S.C. 102(a)(2) for applications subject to the first inventor to file provisions of the AIA.</p> <p>Revised to indicate form paragraph 7.15.01.aia should be used when making a provisional rejection under 102(a)(2), and 7.15.01.fti when making a provisional rejection under pre-AIA 102(e).</p> <p>Revised to replace form paragraph 7.15.01 with form paragraphs 7.15.01.aia and 7.15.01.fti.</p> <p>Subsection II revised to include a cross-reference to MPEP § 2154.</p>
706.02(h)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Changed all references from “35 U.S.C. 102(f)” to “pre-AIA 35 U.S.C. 102(f)” in this section.</p>

706.02(h) 706.02(h)	Revised to include an Editor Note indicating this section is not applicable to applications subject to examination under the first inventor to file provisions of the AIA except in limited circumstances as explained in 35 U.S.C. 100 (note) and MPEP § 2159. Changed all references from “35 U.S.C. 102(g)” to “pre-AIA 35 U.S.C. 102(g)” in this section.
706.02(i)	<p>Former form paragraph 7.06 (for treating claims directed to a “tax strategy”) is now form paragraph 7.06.01 and a new form paragraph numbered 7.06 has been added for use in all Office Actions when a prior art rejection is made in an application with an actual filing date on or after March 16, 2013 that claims priority to, or the benefit of, an application filed before March 16, 2013.</p> <p>Removed form paragraphs: ¶ 7.07, ¶ 7.08, ¶ 7.09, ¶ 7.10, ¶ 7.11, ¶ 7.12, ¶ 7.12.01, ¶ 7.13, ¶ 7.14, ¶ 7.15, ¶ 7.15.01, ¶ 7.15.02, ¶ 7.15.03, ¶ 7.16, ¶ 7.17, ¶ 7.18 and ¶ 7.19;</p> <p>Added form paragraphs: 7.07.fti regarding statutory basis under pre-AIA 102, ¶ 7.07.aia regarding statutory basis under 102, ¶ 7.08.fti regarding pre-AIA 102(a), ¶ 7.08.aia regarding 102(a)(1), ¶ 7.09.fti regarding pre-AIA 102(b), ¶ 7.10.fti regarding pre-AIA 102(c), ¶ 7.11.fti regarding pre-AIA 102(d), ¶ 7.12.fti regarding pre-AIA 102(e), ¶ 7.12.01.fti regarding pre-AIPA 102(e), ¶ 7.12.aia regarding 102(a)(2), ¶ 7.13.fti regarding pre-AIA 102(f), ¶ 7.14.fti regarding pre-AIA 102(g), ¶ 7.14.aia regarding pre-AIA 102(g), ¶ 7.15.fti regarding pre-AIA 102(a), (b), and (g), ¶ 7.15.aia regarding 102(a)(1)/102(a)(2), ¶ 7.15.01.fti regarding pre-AIA 102(e), ¶ 7.15.01.aia regarding 102(a)(2), ¶ 7.15.02.fti regarding pre-AIA 102(e), ¶ 7.15.02.aia regarding 102(a)(2), ¶ 7.15.03.fti regarding pre-AIA 102(e), ¶ 7.15.03.aia regarding 102(a)(2), ¶ 7.16.fti regarding pre-AIA 102(b), ¶ 7.18.fti regarding pre-AIA 102(d), ¶ 7.19.fti regarding pre-AIA 102(f), ¶ 7.17.aia regarding 102(a)(1), and ¶ 7.18.aia regarding pre-AIA 102(g).</p>
706.02(j)	<p>Revised to include cross-references to MPEP §§ 2154 and 2154.02 regarding exceptions under 35 U.S.C. 102(b), and MPEP § 2156 regarding 35 U.S.C. 102(c) and references of joint researchers.</p> <p>Changed “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c).”</p>
706.02(k)	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Revised to insert subtitle “I. Historical Background.”</p> <p>Changed all references from “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” and from “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c)” in this section. Revised to indicate that the changes to pre-AIA 103(c) apply to patents granted on or after 12/10/2004 and issuing from applications not subject to the first inventor to file provisions, and that the amendments by the AIPA regarding “one or more of subsections (e), (f), and (g)” apply to applications filed on or after 11/29/1999 which are not subject to the first inventor to file provisions.</p> <p>Changed all references to “35 U.S.C. 102(f) or (g)” to “pre-AIA 35 U.S.C. 102(f) or (g).”</p> <p>Revised to insert subtitle “II. Provisional Obviousness Rejection.”</p> <p>Changed all references to “35 U.S.C. 103(a)” to “pre-AIA 35 U.S.C. 103(a),” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” and “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c)” in this section.</p> <p>Removed reference regarding the new provisions added by the CREATE Act related to pre-AIA 35 U.S.C. 103(c).</p> <p>Revised reference to “35 U.S.C. 112” to remove “first paragraph.”</p> <p>Changed references to “the same patentable invention” to “interfering subject matter as defined in 37 CFR 41.203(a),” and “37 CFR 1.130” to “37 CFR 1.131(c).”</p> <p>Changed all references to “35 U.S.C. 102(f)” to “pre-AIA 35 U.S.C. 102(f),” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” and “37 CFR 1.130” to “37 CFR 1.131(c)”</p>

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	<p>related to applying 35 U.S.C. 103 in applications filed before 11/29/1999 for which patent was granted before 12/10/2004.</p> <p>Changed references from “35 U.S.C. 102(f) or 102(g)” to “pre-AIA 35 U.S.C. 102(f) or 102(g).”</p> <p>Revised to reference 35 U.S.C. 112(a) for applications filed on or after September 16, 2012.</p>
706.02(1)	<p>Revised title to change “35 U.S.C. 103(a)” to “Pre-AIA 35 U.S.C. 103(a)” and “35 U.S.C. 102(e), (f), or (g)” to “Pre-AIA 35 U.S.C. 102(e), (f), or (g).”</p> <p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Revised subtitle to change “35 U.S.C. 103” to “pre-AIA 35 U.S.C. 103.” Changed all references to “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c),” “35 U.S.C. 102” to “pre-AIA 35 U.S.C. 102,” “35 U.S.C. 102(a)” to “pre-AIA 35 U.S.C. 102(a),” “35 U.S.C. 103(a)” to “pre-AIA 35 U.S.C. 103(a),” “35 U.S.C. 102(e), (f), or (g)” to “pre-AIA 35 U.S.C. 102(e), (f), or (g),” and “35 U.S.C. 103” to “pre-AIA 35 U.S.C. 103” in this section.</p> <p>Revised to include a cross-reference to MPEP § 2156 for a discussion of the three conditions under 35 U.S.C. 102(c) that must be satisfied for a claimed invention and subject matter disclosed which might otherwise qualify as prior art to be treated as having been owned by the same person or subject to an obligation of assignment to the same person in applying the joint research agreement provisions of 35 U.S.C. 102(b)(2)(C).</p>
706.02(1)(1)	<p>Revised to include an Editor Note indicating the section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Revised to indicate that pre-AIA 35 U.S.C. 103(c)(1) does not apply to “applications subject to the current 35 U.S.C. 102 and 103”, and that applications subject to the AIA provisions are not subject to either the 1999 or 2004 changes, but are subject to 35 U.S.C. 102(c).</p> <p>Revised to include cross references to MPEP §§ 2156 and 2159.</p> <p>Revised to indicate that patents issued from applications subject to the current 35 U.S.C. 102 are not subject to either 1999 or 2004 changes, but are subject to 35 U.S.C. 102(c).</p> <p>Changed “Special Program Examiner” to “Quality Assurance Specialist.” Changed all references to “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c)” in this section.</p> <p>Revised the title of subsection II to change “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c)”</p> <p>Changed all references to “35 U.S.C. 102” to “pre-AIA 35 U.S.C. 102,” “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c),” and “35 U.S.C. 102(e), (f), or (g)” to “pre-AIA 35 U.S.C. 102(e), (f), or (g)” in this section.</p> <p>Revised the discussion of the effective date provision of the CREATE Act to indicate the CREATE Act shall apply to patents granted on or after December 10, 2004, except those subject to current 35 U.S.C. 102 and 103.</p>
706.02(1)(2)	<p>Revised the title to include “Under Pre-AIA 35 U.S.C. 103(c).”</p> <p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA.</p> <p>Changed all references from “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c),” “35 U.S.C. 102(e), (f), or (g)” to “pre-AIA 35 U.S.C. 102(e), (f), or (g),” “35 U.S.C. 103” to “pre-AIA 35 U.S.C. 103,” and “35 U.S.C. 104” to “pre-AIA 35 U.S.C. 104” in this section.</p> <p>Revised to indicate that pre-AIA 35 U.S.C. 104 was repealed effective March 16, 2013 and that it does not apply to applications subject to the current 35 U.S.C. 102.</p>

	<p>Subsection III, updated 37 CFR 1.71(g)(1). Replaced 37 CFR 1.104(c)(4) with updated 37 CFR 1.104(c)(5)-(6). Removed a reference to the “safe harbor” provision of 35 U.S.C. 103(c) as amended by the CREATE Act. Changed all references from “35 U.S.C. 103(c)(3)” to “pre-AIA 35 U.S.C. 103(c)(3)” in this section.</p>
706.02(l)(3)	<p>Revised title to change “35 U.S.C. 103(c)” to “pre-AIA U.S.C. 103(c).” Revised to include an Editor Note indicating the section is not applicable to applications subject to the first inventor to file provisions of the AIA. Changed all references from “35 U.S.C. 103(c)” to “pre-AIA 35 U.S.C. 103(c),” “35 U.S.C. 102(e), (f), or (g)” to “pre-AIA 35 U.S.C. 102(e), (f), or (g),” “35 U.S.C. 103(a)” to “pre-AIA 35 U.S.C. 103(a),” and “35 U.S.C. 102(a), or (b)” to “pre-AIA 35 U.S.C. 102(a), or (b)” in this section.</p>
706.02(m)	<p>Removed form paragraphs: ¶ 7.20, ¶ 7.20.01, ¶ 7.20.02, ¶ 7.20.04, ¶ 7.20.05, ¶ 7.21, ¶ 7.21.01, ¶ 7.21.02, ¶ 7.22, ¶ 7.23, and ¶ 7.27; and added form paragraphs: ¶ 7.06 regarding prior art available under pre-AIA and AIA, ¶ 7.20.fti regarding statement of statutory basis, pre-AIA 103(a), ¶ 7.20.aia regarding statement of statutory basis, 103, ¶ 7.20.01.fti regarding pre-AIA 103(a), ¶ 7.20.01.aia regarding rejection using prior art excepted under 102(b)(2)(C), ¶ 7.20.02.fti regarding joint inventors, ¶ 7.20.02.aia regarding joint inventors, ¶ 7.20.04.fti regarding pre-AIA 103(a), ¶ 7.20.04.aia regarding 102 or 103 rejections using 102(a)(2), ¶ 7.20.05.fti regarding pre-AIA 103(a), ¶ 7.20.05.aia regarding 102 or 103 Rejection Using Prior Art Under 102(a)(2) That Is Attempted To Be Disqualified Under 35 U.S.C. 102(b)(2)(C) Using the Joint Research Agreement Provisions of 35 U.S.C. 102(c), ¶ 7.21.fti regarding pre-AIA 103(a), ¶ 7.21.aia regarding rejection under 103, ¶ 7.21.01.fti regarding provisional rejection, pre-AIA 103(a), ¶ 7.21.01.aia provisional rejection, 103, ¶ 7.21.02.fti regarding rejection, pre-AIA 103(a), ¶ 7.21.02.aia regarding rejection, 103, ¶ 7.22.fti regarding rejection, pre-AIA 103(a), ¶ 7.22.aia regarding rejection, 103, ¶ 7.23.fti regarding <i>Graham v. Deere</i>, ¶ 7.23.aia regarding <i>Graham v. Deere</i>, ¶ 7.27.fti regarding rejection, pre-AIA 102 or 103(a), ¶ 7.27.aia regarding rejection, 102 or 103, and ¶ 7.06.01 regarding claim limitation related to a tax strategy.</p>
706.02(n)	<p>Revised title to change “35 U.S.C. 103(b)” to “pre-AIA 35 U.S.C. 103(b).” Revised to include an Editor Note indicating the section is not applicable to applications subject to the first inventor to file provisions of the AIA. Changed all references from “35 U.S.C. 103” to “pre-AIA 35 U.S.C. 103” in this section. Revised to indicate that “only applications subject to pre-AIA 35 U.S.C. 102 are subject to pre-AIA 35 U.S.C. 103(b),” and to include a cross-reference to MPEP § 2159. Changed all references from “35 U.S.C. 103(b)” to “pre-AIA 35 U.S.C. 103(b),” from “35 U.S.C. 103(a)” to “pre-AIA 35 U.S.C. 103(a),” from “35 U.S.C. 102 or 103” to “pre-AIA 35 U.S.C. 102 or 103,” and from “35 U.S.C. 103(b)(1)” to “pre-AIA 35 U.S.C. 103(b)(1)” in this section. Removed “without deceptive intent.” Additionally revised to include a cross-reference to MPEP § 1412.02, subsection II for the filing of a reissue application to obtain consideration of process claims which qualify for pre-AIA 35 U.S.C. 103(b) treatment, but due to error, no election was made to proceed under pre-AIA 35 U.S.C. 103(b) before the patent was granted.</p>
706.03	<p>Revised to indicate that under the compact prosecution principles, claims should be reviewed in the initial review, deficiencies should be explained clearly, and ways to overcome rejections or solve problems should be indicated. Revised to include a cross-reference to MPEP § 2124.01 for rejections based on tax strategies, and to MPEP § 2105 for subject matter directed to a human organism.</p>

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	Revised to include a cross-reference to MPEP § 2163.06 in the discussion of rejections based on new matter.
706.03(a)	Revised to include subsection IV., “Improper Naming of Inventor.” Renumbered form paragraph “7.04” as form paragraph “7.04.01” for the statement of statutory basis for making a rejection under 35 U.S.C. 101. Form paragraphs revised.
706.03(c)	Revised title to change “35 U.S.C. 112, First Paragraph” to “35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph.” Changed all references to “the first paragraph of 35 U.S.C. 112” to “35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112” in this section. Revised ¶ 7.30.01 to include a quotation of current 35 U.S.C. 112(a) in addition to the first paragraph of pre-AIA 35 U.S.C. 112. Revised ¶ 7.31.01 to include references to current 35 U.S.C. 112(a) in addition to pre-AIA 35 U.S.C. 112, first (or 1st) Paragraph, and to insert that the subject matter was not described as to reasonably convey to one skilled in the art that the inventor or a joint inventor, or for pre-AIA the inventor(s) had possession of the claimed invention. Revised ¶ 7.31.02 and ¶ 7.31.03 to include references to current 35 U.S.C. 112(a) in addition to pre-AIA 35 U.S.C. 112, first (or 1st) Paragraph. Revised ¶ 7.31.04 to include references to current 35 U.S.C. 112(a) in addition to pre-AIA 35 U.S.C. 112, first (or 1st) Paragraph, and to indicate that the best mode contemplated by the inventor or joint inventor, or for pre-AIA the inventor(s) has not been disclosed. Revised ¶ 7.33.01 to include references to current 35 U.S.C. 112(a) in addition to pre-AIA 35 U.S.C. 112, first (or 1st) Paragraph.
706.03(d)	Revised title to change “35 U.S.C. 112, Second Paragraph” to “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph.” Changed references to “35 U.S.C. 112, second paragraph” to “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph.” Revised ¶ 7.30.02, ¶ 7.34, ¶ 7.34.01 to change “35 U.S.C. 112, Second Paragraph” to “35 U.S.C. 112(b) and pre-AIA 35 U.S.C. 112, Second Paragraph,” and to change reference to “the applicant” to “the inventor or a joint inventor.” Revised ¶ 7.34.11 to change reference to “35 U.S.C. 112, sixth paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.” Revised ¶ 7.34.12, ¶ 7.34.13, ¶ 7.34.14, ¶ 7.34.15, ¶ 7.35, and ¶ 7.35.01 to change “35 U.S.C. 112, Second Paragraph” to “35 U.S.C. 112(b) and pre-AIA 35 U.S.C. 112, Second Paragraph.” Revised ¶ 7.34.16, ¶ 7.34.17, ¶ 7.34.18, and ¶ 7.34.19 to change all references to “35 U.S.C. 112, Second Paragraph” to “35 U.S.C. 112(b) and pre-AIA 35 U.S.C. 112, Second Paragraph,” and “35 U.S.C. 112, Sixth Paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph.”
706.03(e)	Revised title to change “35 U.S.C. 112, Sixth Paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph.” Changed references to “35 U.S.C. 112, sixth paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph,” “35 U.S.C. 112, second paragraph” to “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph.” Revised ¶ 7.34.20 to change “35 U.S.C. 112, sixth paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.” Revised ¶ 7.34.21 to change “35 U.S.C. 112, sixth paragraph” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph,” to change references to “nonstructural term” to “generic placeholder,” to add a cross-reference to “MPEP § 2173 <i>et seq.</i> , and to

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	<p>include examiner notes indicating when/how the examiner should use this form paragraph.</p> <p>Revised to include new form paragraph 7.34.22 for use where applicant has asserted a claim limitation does not invoke 35 U.S.C. 112(f) (or pre-AIA 35 U.S.C. 112, sixth paragraph) but the claim is indefinite because no structure is recited to perform the claimed function.</p>
706.03(s)	Language of 35 U.S.C. 182, 184, and 185 revised to reflect changes made by the AIA.
706.03(u)	Replaced form paragraph ¶ 7.48 with form paragraphs 7.48.fti and 7.48.aia. Revised form paragraph 7.49 to reference 37 CFR 90.3 instead of 37 CFR 1.304, which has been removed and reserved.
706.03(b)	<p>Revised title to insert “Former.”</p> <p>Revised to indicate that effective September 16, 2012, public use proceedings are no longer authorized. Also revised to include a discussion of post-grant review proceedings under 35 U.S.C. 321-329 and protests under 37 CFR 1.291. Revised to include a cross-reference to MPEP § 1901.02.</p>
706.03(w)	<p>Changed “Board of Appeals” to “Patent Trial and Appeal Board (or its predecessor Board).”</p> <p>Revised to insert text describing that <i>res judicata</i> can preclude entry of a claim, drawing or other amendment.</p> <p>Revised to include a cross-reference to 37 CFR 42.73(d)(3).</p>
706.03(x)	<p>Revised to include a discussion of the filing of a reissue application by the assignee for reissue applications filed on or after September 16, 2012.</p> <p>Revised to include a cross-reference to MPEP § 1442 for “special” reissue applications.</p> <p>Removed references to <i>Ex parte Grier</i> and <i>Ex parte Hay</i>.</p>
706.04	<p>Revised to indicate that an Office action rejecting previously allowed claims must be signed by a primary examiner.</p> <p>Revised to include a cross-reference to MPEP § 1004.</p>
706.07	<p>Removed discussion of former rules that provided an opportunity for applicant to “amend as often as the examiner presents new references or reasons for rejection.”</p> <p>Removed reference to <i>Ex parte Hoogendam</i>.</p> <p>Changed “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board.”</p>
706.07(a)	<p>Removed a discussion of older decisions relating to questions of prematurity of final rejection and admission of subsequent amendments.</p> <p>Changed references to “35 U.S.C. 112, second paragraph” to “35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph,” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” “35 U.S.C. 102(e)/103” to “35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 112(e)/103,” and “35 U.S.C. 103(c)” to “35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c).”</p> <p>Revised to indicate that a statement averring common ownership may qualify the applicant for the exemption under 35 U.S.C. 102(b)(2)(C).</p> <p>Revised to include a cross-reference to MPEP § 2154.02(c).</p> <p>Revised to indicate that an examiner may make a rejection final even if the rejection is changed from the current 35 U.S.C. 102 to pre-AIA 35 U.S.C. 102 or vice versa.</p> <p>Replaced form paragraph ¶ 7.40.02 with ¶ 7.40.02.fti regarding a final action, necessitated by invoking the joint research agreement prior art exclusion under pre-AIA 103(c), and with ¶ 7.40.02.aia regarding a final action, necessitated by invoking the joint research agreement prior art exclusion under 35 U.S.C. 102(b)(2)(C).</p>
706.07(b)	Removed text related to a first Office action in an continuing application which may not be final if it contains a new ground of rejection.

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706.07(c)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”
706.07(f)	Replaced reference to form paragraph ¶ 7.40.02 with ¶ 7.40.02.fti and ¶ 7.40.02.aia, ¶ 7.42.03 with ¶ 7.42.03.fti, and ¶ 7.42.031 with ¶ 7.42.031.fti regarding all final rejections setting a 3-month SSP for reply. Revised text to refer to the “first” reply filed within 2 months.
707.07(g)	Replaced form paragraphs ¶ 7.41.01, ¶ 7.42.01, ¶ 7.42.02, ¶ 7.42.03, ¶ 7.41.02 and ¶ 7.42.031 with ¶ 7.41.01.fti regarding transitional after practice for a first submission, ¶ 7.42.01.fti regarding the withdrawal of the finality of the last Office action, ¶ 7.42.02.fti regarding a nonresponsive submission filed under 37 CFR 1.129(a), ¶ 7.42.03.fti regarding final action for a first action following a submission, ¶ 7.41.02.fti regarding transitional after final practice for a second submission, and ¶ 7.42.031.fti regarding final action for an action following a submission.
706.07(h)	Replaced references to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board,” and “special program examiner” with “a quality assurance specialist.”
707	Replaced 37 CFR 1.104 with the current version. Removed text stating that the examiner will call the representative within about 2 weeks. Revised to include a cross-reference to MPEP § 713 regarding interview practice.
707.01	Revised to indicate that a primary examiner may authorize allowance if all the statutory requirements are met and no further field of search is known.
707.05	Removed references to the IFW Manual. Removed text stating that the examiner won’t provide copies of documents cited by a third party.
707.05(a)	Removed references to the IFW Manual. Removed text stating that the examiner should place the form PTO-892 in front of the file wrapper in order to assists in providing copies of the references. Revised to indicate that the examiner should include all the references cited in the eRed Folder. Revised to indicate that the examiner should forward the action to the TC mailbox after review.
707.05(e)	Revised to indicate that for foreign patents “the relevant classification” must also be given. Revised to indicate that the IPC shall be cited in ““Search Notes’ FWF form” and PTO-892. Removed reference to IFW Manual.
707.05(f)	Removed section.
707.05(g)	Revised to reflect current practice for an examiner correcting a citation error including that the examiner is directed to correct the error in ink.
706.06	Revised to indicate that when citing court decisions, when it is convenient to do so, either the U.S. or Federal Reporter citation should be provided; in the alternative, the USPQ citation should be given. Revised to change “manuscript decisions” to “decisions.” Replaced references to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.” Removed reference to the “Journal of the Patent and Trademark Office Society” when citing a Director’s order, notice, or memorandum.

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707.05(f)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”
707.07(g)	Removed references to “major” and “serious” for non-prior art grounds of rejection that an examiner should apply to an application in addition to prior art rejections. Removed text related to cases where there exists a sound rejection based on prior art that discloses the “heart” of the invention. Revised to indicate that an examiner should not make certain technical rejections if the examiner is not aware of an improved “manner of reciting the claimed invention.”
707.07(i)	Removed reference to the IFW Manual.
707.07(j)	Changed “expected to be applied” to “especially useful” regarding inventor filed applications. Revised form paragraphs ¶ 7.34.01, ¶ 7.34.02 regarding allowable subject matter, claims under 112(b) or pre-AIA 112, second paragraph, and ¶ 7.34.04 regarding suggestion of allowable drafted claims, pro se.
707.07(l)	Changed reference to “35 U.S.C. 112, first paragraph” to “35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph,” and “35 U.S.C. 112, first paragraph” to “35 U.S.C. 112.”
707.08	Revised to indicate that the name and telephone number of the examiner who should be called for discussion or interview will also be provided in the Office action. Revised text describing that the surname or initials of the examiner should appear at the end of the action.
707.09	Revised text to reflect current IFW practice for signing of Office actions including inserting a signature to sign an Office action.
707.09	Revised text to reflect current IFW practice for entry of the action.
707.13	Revised text to reflect current IFW practice for mailing of Office actions.
707.13	Changed reference to “first named inventor or assignee” to “applicant.” Revised text to reflect current IFW practice for entering correspondence returned to the Office.
708	Revised to indicate that nonprovisional applications are ordinarily taken up for examination by the examiner. Changed “first” to “earliest” effective U.S. filing date regarding controlling the order of examination.
708.01	Revised to indicate that allowed cases returned and marked as “Printer Rush” must be returned and processed within the period indicated. Revised to insert text regarding applications made special and advanced out of turn for examination by reason of a ruling made in that particular case. Revised to indicate that applications can be made special as a result of a petition to make special, a request for prioritized examination, or a request for participation in PPH.
708.02	Changed reference to “37 CFR 10.18” to “37 CFR 11.18.” Revised text to reflect current practice for petitions to make special for applications filed before 08/26/2006. Revised to include a cross-reference to MPEP § 708.02(c) regarding a petition to make special filed on or after 08/25/2006. Removed sections related to manufacture, infringement, inventions relating to recombinant dna, special examining procedure for certain new applications accelerated examination, special status for patent applications relating to superconductivity, inventions relating to HIV/AIDS and cancer, and special status for applications relating

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	<p>to biotechnology filed by applicants who are small entities. Revised subtitle and text to insert “or request for advancement of examination.” Revised to indicate that the petition will be provided as a single document in the application’s image file wrapper. Removed reference to the IFW Manual.</p> <p>Revised to indicate that a petition to make special is processed by the Office of Petitions or a Quality Assurance Specialist depending on its basis.</p>
<p>708.02</p>	<p>Removed text stating that petitions to make special filed on or after 08/25/2006 must meet the requirements, and removed reference to section III and IV. Revised to include a cross-reference to MPEP § 708.02(c) regarding participation in the PPH program. Revised “requirements for petitions to make special under accelerated examination” to insert a reference to “37 CFR 1.64,” and to indicate that an executed inventor’s oath or declaration for each inventor must be filed.</p> <p>Changed reference to “37 CFR 10.18” to “37 CFR 11.18”.</p> <p>Revised text directed to claim support to change references to “the first paragraph of 35 U.S.C. 112” to “35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112,” and “35 U.S.C. 112, paragraph 6” to “35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, paragraph 6.”</p> <p>Revised text directed to cited references to change reference to “35 U.S.C. 103(c)” to “35 U.S.C. 102(b)(2)(C) or pre-AIA 35 U.S.C. 103(c).”</p> <p>Changed reference to “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board,” and “BPAI” to “PTAB.”</p> <p>Revised to include a cross-reference to MPEP § 708.02 regarding petitions to make special based on applicant’s age/health.</p> <p>Revised to indicate that petitions to make special based on participation in the PPH pilot program (MPEP § 708.02) are not eligible for the accelerated examination program.</p> <p>Revised text related to conditions for examination to indicate that the application must include an executed inventor’s oath or declaration for each inventor, and to insert reference to “37 CFR 1.64.”</p> <p>Revised text related to conditions for examination to indicate that applications filed prior to 9/16/12 do not require a petition for a non-signing inventor.</p> <p>Removed text related to suggested classification provided by Applicant.</p> <p>Removed all references to “Diskette” in form paragraphs ¶ 24.02.AE and ¶ 24.03.AE.</p>
<p>708.02(b)</p>	<p>Revised text describing the types of applications that are able to undergo prioritized examination.</p> <p>Inserted reference to http://www.uspto.gov/patents/init_events/track-1-quickstart-guide.pdf, and http://www.uspto.gov/patents/init_events/Track_One.jsp.</p> <p>Revised to indicate which applications qualify for prioritized examination.</p> <p>Removed text stating that the application must be filed via EFS-Web if it is a utility application.</p> <p>Changed all references to “37 CFR 1.17(i)” to “37 CFR 1.17(i)(1)” in this section.</p> <p>Revised to indicate that small and micro entity fees apply to certain prioritized examination fees, and to insert reference to www.uspto.gov/curr_fees.</p> <p>Revised to indicate that applicants are advised to use form PTO/IA/424 for applications filed on or after September 16, 2012.</p> <p>Revised text related to the maximum number of prioritized examinations the office will permit each fiscal year, and inserted reference to http://www.uspto.gov/aia_implementation/patents.jsp.</p>

	<p>Revised to indicate that the Office’s certification and form PTO/SB/424 are strongly recommended when requesting prioritized examination, and to indicate that the form is available at http://www.uspto.gov/forms/index.jsp.</p> <p>Revised heading to insert “Prioritized Examination for Application Filings under 35 U.S.C. 111(a) (Track 1).”</p> <p>Revised text related to applications that are able to undergo prioritized examination, and related to complete applications with executed inventor’s oath or declaration for each inventor.</p> <p>Removed text related to the situation when a joint inventor refuses to execute an oath or declaration.</p> <p>Revised to indicate that the publication fee must be paid upon request for prioritized examination.</p> <p>Revised to insert text describing EFS web submission and general processing of applications subject to prioritized examination applications (Track 1).</p> <p>Revised text related to conditions for prioritized examination for RCE to change “an original utility” to “a non-reissue utility.”</p> <p>Revised to insert text describing the conditions for filing an RCE subject to prioritized examination.</p> <p>Revised to indicate that if an applicant files a petition for an extension of time or a request for suspension, the petition or request will be acted upon but the prioritized examination will be terminated.</p> <p>Revised to indicate that the Office’s goal is to provide final disposition within 12 months of the date that prioritized status was granted.</p> <p>Replaced reference to “Board of Patent Appeals and Interferences (BPAI)” with “Patent Trial and Appeal Board (PTAB).”</p> <p>Revised to indicate that a prioritized examination application will not issue with any indication that it was a prioritized examination application.</p>
708.02(c)	New section explaining the Patent Prosecution Highway Program.
708.03	Revised to describe what the supervisory patent examiner should do with respect to applications when an examiner tenders his or her resignation. Removed text related to documenting field of search and reference to the IFW Manual.
709	Removed section related to statutory invention registration.
709.01	<p>Removed references to <i>Ex parte Jones</i>, <i>Ex parte McCormick</i>, <i>Ex parte Bullier</i>, <i>In re Seebach</i>, and <i>In re Hammell</i>.</p> <p>Revised to indicate that an examiner should consult with a TC Quality Assurance Specialist when an application or patent of the same applicant that is involved in an interference, derivation proceeding, <i>inter partes</i> reexamination or <i>inter partes</i> review contains claims which overlap with claims of an application under examination or with claims involved in an <i>ex parte</i> reexamination.</p>
710.02	<p>Replaced all references to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”</p> <p>Revised to update 37 CFR 1.136 to the version in effect as of November 2013.</p>
710.02(c)	Revised text to indicate that an applicant may be required to add a claim to provoke an interference for an application subject to pre-AIA 102(g).
710.02(d)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”
710.02(e)	<p>Replaced all references to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”</p> <p>Revised to update 37 CFR 1.136 to the version in effect as of November 2013.</p>

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	Changed reference to “37 CFR 1.304” to “37 CFR 90.3(c)” for extensions of time to appeal to the courts after final rejection.
710.05	Removed reference to “file wrapper” regarding amendments received on a succeeding day.
710.06	Revised to indicate that applicant’s period for reply will be restarted to the remaining date of the action, and to remove references to the IFW Manual.
711	Removed reference to “acquiesced in by the assignee if there is one” regarding a formal abandonment by the applicant. Removed text describing acquiescence.
711.01	Removed reference to “acquiesced in by an assignee of record.” Revised text related to petitions under 1.138(d) to insert reference to form “PTO/AIA/24B.” Changed reference to “35 U.S.C. 135” to “pre-AIA 35 U.S.C. 135” regarding an interference proceeding. Revised text related to express abandonment to insert and reference form PTO/AIA/24, PTO/AIA/24A, and PTO/AIA/24B for applications filed before 09/16/2012. Revised to include a cross-reference to 37 CFR 41.127(b)(4).
711.02(b)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”
711.02(c)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.”
711.03(c)	Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board.” Removed text stating that the showing to establish nonreceipt of an Office action has been modified in order to minimize costs and burden. Removed references to form PTO/SB/62 and added a cross-reference to MPEP § 711.03(c), subsection II.G. Revised text to indicate that the Office of Patent Legal Administration must be consulted when an untimely petition to withdraw the holding of abandonment involves a derivation proceeding. Changed “35 U.S.C. 135(a)” to “35 U.S.C. 135.” Revised to indicate that 37 CFR 1.137 allows revival of an abandoned application to provide copendency. Revised text related to abandoned applications to insert the use of the typewriter tool in Adobe Acrobat, and to remove reference to IFW processing. Removed reference to “37 CFR 1.129(a)” regarding request for further examination. Revised text describing filing electronic petitions using ePetition. Revised to insert forms PTO/SB/64, PTO/SB/64a, and PTO/SB/64PCT; and to remove forms PTO/SB/61, PTO/SB/61/PCT, and PTO/SB/63. Revised to include a cross-reference to MPEP § 1490 regarding terminal disclaimer.
711.04(a)	Revised title change “Pulling and Forwarding Abandoned Applications” to “Date of Abandonment”. Removed text related to pulling and forwarding files of abandoned applications. Revised to indicate that possible abandonments are not reviewed until the maximum period for which an extension of time under 37 CFR 1.136(a) plus 1 month expire. Replaced reference to “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board,” and “sent to the File Repository” with “treated as terminated proceedings.”

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711.04(b)	<p>Revised to indicate that certain artifact material is maintained with paper files at the Files Repository, and to remove reference to IFW Manual section 3.7.</p> <p>Removed “video display” and “video display terminal” regarding ordering patented and abandoned paper files or artifacts folders.</p> <p>Changed “periodically each day” to “regularly” regarding PALM print transactions.</p> <p>Removed text stating that it is not necessary to order or deliver files for applications stored in IFW.</p>
711.06	<p>Removed text describing that defensive publication precluded a continuing application filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application, and describing first continuing applications filed within 30 months from the earliest U.S. filing date of the published application.</p> <p>Revised to indicate that defensive publication application files are accessible by request.</p>
711.06(a)	<p>Changed all references to “35 U.S.C. 102” to “35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102” in this section.</p>
713	<p>Revised to describe purpose and advantages of conducting interviews, and to insert reference to http://www.uspto.gov/patents/law/exam/interview_best_practices.pdf for interview policy and tips.</p>
713.01	<p>Revised to insert section “Where and When to Conduct Interviews,” including: i) face-to-face interviews, ii) in-person interviews, iii) interviews during normal business hours, iv) examiners working remotely, v) video conferencing and collaboration tools, vi) examiners who normally work remotely, and vii) examiners working on campus.</p> <p>Revised heading to change “Special Procedures for Using Internet Electronic Mail” to “Special Requirements for Using Internet Communications.”</p> <p>Changed “e-mail” to “Internet communications.”</p> <p>Revised to insert a sample authorization which may be used by applicant.</p> <p>Revised to insert “Video Conferencing” section.</p> <p>Revised to insert text describing what a video conference is, where they should be originated, handling video conference requests, and written authorization as shown in MPEP § 502.03.</p> <p>Removed “Video Conference Center” section.</p> <p>Revised “Scheduling and Conducting an Interview” section to reflect current interview practice.</p> <p>Removed text related to authorizing a collect call.</p> <p>Revised to indicate that an interview should be rescheduled if the attorney is not prepared for the interview.</p> <p>Removed text related to the duty to see that an interview is not extended beyond a reasonable period.</p> <p>Revised to include a cross-reference to MPEP § 714.05 regarding inspecting all incoming papers.</p> <p>Changed “Washington” to “USPTO campus.”</p> <p>Revised to indicate that a duplicate copy of a filed amendment and/or remarks is unnecessary when the amendment and/or remarks are filed via EFS-Web. Revised to insert references to http://www.uspto.gov/patents/process/file/efs/guidance/index.jsp, and MPEP § 502.05.</p> <p>Revised to include a cross-reference to MPEP § 713.09 regarding granting interviews after final.</p> <p>Revised to indicate that the applicant should bring the equipment to display the video if the video is not in dvd format.</p> <p>Removed text related to approval of viewing of a video, and use of room or equipment.</p> <p>Revised to insert “Collaboration Tools” section.</p>

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713.02	Revised to insert text directed to conducting interviews prior to first Office actions for prioritized examination applications and the pilot program.
713.04	Revised to indicate that an email or message exchange transcript satisfies the requirement for a written record of the interview. Revised to indicate that a copy of PTOL 413 may be emailed if the Office has authorization to conduct communications via the Internet. Revised to indicate that a copy of the contents exchanged over the internet must be made if an interview via electronic mail or electronic message system is conducted. Revised to indicate that inaccuracies should be pointed out in the next Office communication, and that the examiner should “electronically annotate the record.”
713.05	Revised to indicate that no interview is normally granted after submission of an appeal brief or after a notice of allowability has been mailed. Changed reference to “37 CFR 10.57(c)” to “37 CFR 11.106” regarding authorizing other registered practitioners to conduct interviews, and “37 CFR 10.47” to “37 CFR 11.505” regarding authorizing nonpractitioners to conduct interviews. Revised to indicate that it is recommended that a power of attorney or authorization to act in representative capacity be filed preferably via EFS-Web. Removed text related to availability of personal interviews in the “Conference Period,” and text related to minor changes and major questions/suggestions.
713.09	Revised to indicate that one interview after final rejection is permitted to place the application in condition for allowance or resolve issues prior to appeal.
714	Changed reference to “the first examination and action” to “the first Office action,” and “subsequent examination or reconsideration” to “Office actions” regarding when applicant may amend.
714.01(a)	Revised to insert current version of 37 CFR 1.33 and pre-AIA 37 CFR 1.33 related to corresponding respecting patent applications, reexamination proceedings, and other proceedings. Changed reference to “applicants” to “joint inventors,” and “applicant” to “inventor.” Revised to indicate that an amendment signed by a practitioner who has been suspended or excluded from practice under 37 CFR Part 11 is not entered.
714.01(c)	Revised to remove reference to MPEP § 405, and to change “MPEP § 402” to “MPEP § 402.03” regarding a registered attorney or agent acting in a representative capacity.
714.01(e)	Revised text indicating the differences between claiming priority for applications filed before, on, or after 9/16/12. Changed “37 CFR 1.78(a)(2)(iii) and (5)(iii)” to “37 CFR 1.78(a).”
714.05	Revised title to change “Inspect” to “Review.” Revised to indicate that actions by applicant should be reviewed as soon as possible upon becoming available for the examiner. Changed “inspected” to “reviewed.” Removed text related to reviewing all amended applications forwarded to the examiner for easily erasable paper.
714.07	Revised to indicate that the type of paper is not an issue so long as the Office is able to scan and reproduce the papers that were filed. Removed text related to handling of applicant’s response submitted on easily erasable paper.
714.13	Changed reference to “7.41.03” to “7.41.03.fti.” Removed reference to <i>Ex parte Wirt</i> regarding an amendment presenting additional claims without cancelling any finally rejected claims.

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	<p>Revised to insert text related to processing amendments and other replies under 37 CFR 1.116 filed via EFS-Web.</p> <p>Revised to indicate that an amendment or other reply under 37 CFR 1.116 filed in paper format must be marked.</p> <p>Removed text related to makings written in a bright color with a felt point marker.</p> <p>Revised to indicate that the envelope will be specially processed by the Mail Center and forwarded to the Technology Center after being uploaded as a scanned image into the file wrapper.</p>
714.16(d)	<p>Revised to indicate that amendments under 37 CFR 1.312 are sent to OPAP to be scanned and uploaded into IFW, then OPAP will forward the message to the particular TC.</p> <p>Removed reference to “Central Scanning.”</p> <p>Revised to indicate that the examiner will indicate whether the entry of the amendment is recommended by using the typewriter tool in Adobe Acrobat. Removed text related to printing the first page of the amendment.</p> <p>Removed reference to a typed report giving reasons for nonentry.</p> <p>Revised form paragraph ¶ 7.87 by removing reference to “37 CFR 1.175(b),” and by indicating that although the amendment paper is placed in the application, it is not officially entered.</p>
714.16(e)	<p>Revised to indicate that the examiner should annotate by using the Strike-Out Line tool.</p>
714.18	<p>Removed text related to processing paper file amendments, supervisory review of after final amendments before reaching the examiner, and placing amendments or letters in the file with its number and character.</p>
714.19	<p>Revised to indicate that an amendment is denied entry if it is submitted after the notice of allowance is mailed.</p> <p>Revised to indicate that responses that violate 37 CFR 1.3 will be submitted to the Deputy Commissioner for Patent Examination Policy.</p> <p>Revised to include a cross-reference to MPEP § 1002.02(b).</p> <p>Revised to indicate that amendments that cannot be scanned or reproduced are denied entry.</p>
714.20	<p>Revised to include the use of the Stamper tool in Adobe Acrobat for entering an amendment in part.</p>
714.21	<p>Revised to include the use of the typewriter tool in Adobe Acrobat for amendments inadvertently entered.</p>
714.25	<p>Revised to include a cross-reference to MPEP § 1002.02(b) regarding situations when the attorney or agent makes discourteous remarks in his or her amendment or other submitted paper.</p> <p>Revised to indicate that the Deputy Commissioner for Patent Examination Policy will determine if the responses violate 37 CFR 1.3.</p>
715	<p>Revised title to change “37 CFR 1.131” to “37 CFR 1.131(a).”</p> <p>Revised to include an Editor Note indicating the section and the provisions of 37 CFR 1.131(a) are not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>37 CFR 1.131 updated to reflect AIA revisions.</p> <p>Changed all references to “37 CFR 1.131” to “37 CFR 1.131(a)” in this section. Revised to indicate that the date of completion may not be established under 1.131(a) before</p>

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	<p>12/08/1993 for NAFTA, and before 01/01/1996 for WTO in applications subject to pre-AIA 104.</p> <p>Changed reference to “MPEP § 201.13” to “MPEP § 213.01” regarding WTO countries.</p> <p>Revised to indicate that affidavits or declarations under 37 CFR 1.131 may be used to overcome rejections in applications subject to pre-AIA 35 U.S.C. 102, and to overcome rejections under pre-AIA 35 U.S.C. 102(g) in applications subject to pre-AIA 35 U.S.C. 102(g) and current 35 USC 102.</p> <p>Changed all references to “35 U.S.C. 102(a)” to “pre-AIA 35 U.S.C. 102(a),” “35 U.S.C. 102(b)” to “pre-AIA 35 U.S.C. 102(b),” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” and “35 U.S.C. 102(g)” to “pre-AIA 35 U.S.C. 102(g).”</p> <p>Changed reference to “same patentable invention” to “interfering subject matter as defined in 37 CFR 41.203(a),” and “same patentable invention” to “interfering subject matter.”</p> <p>Revised text related to antedating an activity that qualifies as prior art under pre-AIA 35 U.S.C. 102(g) but not under pre-AIA 35 U.S.C. 102(b).</p> <p>Changed references to “37 CFR 131” to “37 CFR 1.131(a),” “35 U.S.C. 102(b)” to “pre-AIA 35 U.S.C. 102(b),” “same patentable invention” to “interfering subject matter as defined in 37 CFR 41.203(a),” “same patentable invention” to “interfering subject matter,” “35 U.S.C. 102(a)” to “pre-AIA 35 U.S.C. 102(a),” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” “37 CFR 131” to “37 CFR 1.131(c),” “35 U.S.C. 102(d)” to “pre-AIA 35 U.S.C. 102(d),” “35 U.S.C. 102(f)” to “pre-AIA 35 U.S.C. 102(f),” “35 U.S.C. 102(g)” to “pre-AIA 35 U.S.C. 102(g),” and “35 U.S.C. 104” to “pre-AIA 35 U.S.C. 104.”</p> <p>Changed reference to “MPEP § 201.11 - 201.15” to “MPEP §§ 211-216” regarding unnecessary affidavit or declaration.</p> <p>Removed text stating that an affidavit or declaration is not appropriate where the reference is the disclosure of a prior US patent to the same party, not copending.</p> <p>Removed text stating that an affidavit or declaration is not appropriate where an application is subject to current 102(g).</p> <p>Changed references to “37 CFR 130” to “37 CFR 1.131(a).”</p> <p>Revised to include reference to “pre-AIA 35 U.S.C. 102(e)” regarding US Patents, US Applications, and International Application Publications.</p> <p>Removed text related to prior art available under 35 U.S.C. 102(e).</p> <p>Changed form paragraphs ¶ 7.57 to ¶ 7.57.fti regarding affidavit or declaration: ineffective - heading, ¶ 7.58 to ¶ 7.58.fti regarding affidavit or declaration: ineffective - claiming same invention, ¶ 7.59 to ¶ 7.59.fti regarding affidavit or declaration: ineffective, insufficient evidence of reduction to practice before reference date, ¶ 7.60 to ¶ 7.60.fti regarding affidavit or declaration: ineffective - reference is statutory bar, ¶ 7.61 to ¶ 7.61.fti regarding affidavit or declaration: ineffective - insufficient evidence of conception, ¶ 7.62 to ¶ 7.62.fti regarding affidavit or declaration: ineffective - diligence lacking, ¶ 7.63 to ¶ 7.63.fti regarding affidavit or declaration: ineffective - insufficient evidence of actual reduction to practice, and ¶ 7.64 to ¶ 7.64.fti regarding affidavit or declaration: effective to overcome reference.</p>
<p><u>715.01</u></p>	<p>Revised title to change “37 CFR 1.131” to “37 CFR 1.131(a).” Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” “35 U.S.C. 102(a)” to “pre-AIA 35 U.S.C. 102(a),” “35 U.S.C. 102(e)” to “pre-AIA 35 U.S.C. 102(e),” “35 U.S.C. 102(f)” to “pre-AIA 35 U.S.C. 102(f).”</p>

	Revised to insert reference to “pre-AIA 35 U.S.C. 102 or 103” regarding the purpose of an affidavit or declaration.
715.01(a)	Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g). Changed references to “35 U.S.C. 102(a) or (e)” to “pre-AIA 35 U.S.C. 102(a) or (e),” and “37 CFR 1.131” to “37 CFR 1.131(a).” Revised to include a cross-reference to MPEP §§ 717 and 2155.01 for applications subject to 35 U.S.C. 102.
715.01(b)	Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g). Changed references to “37 CFR 1.131” with “37 CFR 1.131(a),” “35 U.S.C. 102(g)/103” to “pre-AIA 35 U.S.C. 102(g)/103,” and “35 U.S.C. 102(e)/103” to “pre-AIA 35 U.S.C. 102(e)/103.” Revised to include a cross-reference to MPEP § 2154.02(c) for applications subject to 35 U.S.C. 102.
715.01(c)	Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” “35 U.S.C. 104” to “pre-AIA 35 U.S.C. 104,” and “35 U.S.C. 102(a)” to “pre-AIA 35 U.S.C. 102(a).” Removed reference to <i>Ex parte Lemieux</i> and <i>Ex parte Powell</i> . Revised to include a cross-reference to MPEP §§ 2153 and 2154 for applications subject to current 35 U.S.C. 102.
715.01(d)	Revised to indicate that a rejection under pre-AIA 35 U.S.C. 102 or 103 may be overcome by an affidavit or declaration unless it is statutory bar. Changed reference to “37 CFR 1.131” to “37 CFR 1.131(a).”
715.02	Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g). Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” and “35 U.S.C. 103” to “pre-AIA 35 U.S.C. 103.”
715.03	Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g). Changed references to “37 CFR 1.131” to “37 CFR 1.131(a).”
715.04	Revised title to include “Under 37 CFR 1.131(a).” Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g). Revised to indicate that less than all named inventors may make the affidavit or declaration. Revised to indicate who may make an affidavit or declaration depending on whether the submission is before, on, or after 09/16/12. Removed text related to who can make the affidavits or declarations. Revised to insert reference to affidavits and declarations submitted in applications filed before 09/16/2012. Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” and “37 CFR 1.47” to “pre-AIA 37 CFR 1.47.” Revised to include a cross-reference to MPEP § 602 regarding formal requirements of affidavits.

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<p>715.05</p>	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Revised to insert reference to applications subject to pre-AIA 35 U.S.C. 102. Revised to indicate that pre-AIA 35 U.S.C. 135(b)(1) is applicable generally to applications subject to pre-AIA 102, and to include a cross-reference to MPEP § 2159.</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” “35 U.S.C. 135(b)” to “pre-AIA 35 U.S.C. 135(b),” and “35 U.S.C. 135(b)(2)” to “pre-AIA 35 U.S.C. 135(b)(2).”</p> <p>Revised to indicate that pre-AIA 35 U.S.C. 135(b)(2) is applicable generally to applications subject to pre-AIA 102, and to include a cross-reference to MPEP § 2159. Revised form paragraph ¶ 23.14 to change “35 U.S.C. 135(b)(1)” to “pre-AIA 35 U.S.C. 135(b)(1).”</p> <p>Revised form paragraph ¶ 23.14.01 to change “35 U.S.C. 135(b)(2)” to “pre-AIA 35 U.S.C. 135(b)(2).”</p> <p>Changed references to “same patentable invention” to “interfering subject matter,” to “interfering subject matter as defined in 37 CFR 41.203(a),” and to “interfering subject matter with respect to the claims.”</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a).”</p>
<p>715.07</p>	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” and “35 U.S.C. 102(g)” to “pre-AIA 35 U.S.C. 102(g).”</p> <p>Removed reference to <i>Ex parte Homan</i>, <i>Ex parte Saunders</i>, and <i>Ex parte Donovan</i>.</p> <p>Revised to indicate that documents submitted under the Disclosure Document Program (discontinued 02/01/2007) may be used as documentary evidence of conception.</p> <p>Removed text related to sketches or models made by the applicant.</p>
<p>715.07(a)</p>	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Removed reference to <i>Ex parte Hunter</i>, <i>Ex parte Merz</i>, and <i>Christy v. Seybold</i>.</p> <p>Revised to insert reference to “37 CFR 1.131(b),” and to remove reference to <i>Ex parte Kantor</i> regarding sufficiency of a 37 CFR 1.131 affidavit or declaration.</p> <p>Revised to indicate that any lack of due diligence between and actual reduction to practice of an invention and the filing of an application is not relevant to the sufficiency of an affidavit or declaration under 37 CFR 1.131(a).</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a).”</p>
<p>715.07(b)</p>	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed reference to “37 CFR 1.131” to “37 CFR 1.131(a).”</p>
<p>715.07(b)</p>	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed references to “35 U.S.C. 104” to “pre-AIA 35 U.S.C. 104,” and “37 CFR 1.131” to “37 CFR 1.131(a).”</p>
<p>715.07(d)</p>	<p>Changed reference to “37 CFR 1.131” to “37 CFR 1.131(a).”</p>
<p>715.08</p>	<p>Revised title to “Decided by Primary Examiner.”</p>

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	<p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” and “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board.”</p> <p>Revised to indicate that the review of an examiner’s decision regarding questions of formal sufficiency and propriety of an affidavit or declaration is by petition, and the review of an examiner’s determination on the merits of an affidavit or declaration is by appeal.</p>
715.09	<p>Revised title to change “Seasonable” to “Timely.”</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” and “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board.”</p>
715.10	<p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed references to “37 CFR 1.131” to “37 CFR 1.131(a),” “35 U.S.C. 102(b)” to “pre-AIA 35 U.S.C. 102(b),” and “the first paragraph of 35 U.S.C. 112” to “35 U.S.C. 112(a) or pre-AIA 112, first paragraph.”</p>
716	<p>Changed “35 U.S.C. 112, first paragraph” to “35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph.”</p>
716.09	<p>Changed references to “35 U.S.C. 112, first paragraph” to “35 U.S.C. 112(a) or pre-AIA 112, first paragraph.”</p>
716.10	<p>Revised title to insert “Affidavit or Declaration to Overcome Rejection Under Pre-AIA U.S.C. 102 or 103.”</p> <p>Revised to include an Editor Note indicating this section is not applicable to applications subject to the first inventor to file provisions of the AIA unless being relied upon to overcome a rejection under pre-AIA 35 U.S.C. 102(g).</p> <p>Changed references to “35 U.S.C. 102(a), (b), (e), and (f)” to “pre-AIA 35 U.S.C. 102(a), (b), (e), and (f).”</p> <p>Revised to indicate that an affidavit or declaration may be submitted to overcome a rejection based on pre-AIA 35 U.S.C. 102 or prior art.</p> <p>Changed “subject matter disclosed but not claimed” to “subject matter.”</p> <p>Revised to include a cross-reference to MPEP §§ 717, 2153 and 2154 for applications subject to current 35 U.S.C. 102.</p> <p>Revised to insert text discussing the treatment of affidavits and declarations depending on whether the application is subject to only pre-AIA 35 U.S.C. 102 or current 35 U.S.C. 102.</p>
717	<p>Added section “Prior Art Exceptions under AIA 35 U.S.C. 102(b)(1) and (2)” which is only applicable to applications subject to the first inventor to file provisions.</p>
717.01	<p>Added section “Affidavit or Declaration Under 37 CFR 1.130” which is only applicable to applications subject to the first inventor to file provisions.</p>
717.01(a)	<p>Added section “Declarations or Affidavits under 37 CFR 1.130(a) – Attribution” which is only applicable to applications subject to the first inventor to file provisions.</p>
717.01(a)(1)	<p>Added section “Evaluation of Declarations or Affidavits under 37 CFR 1.130(a)” which is only applicable to applications subject to the first inventor to file provisions.</p>
717.01(b)	<p>Added section “Declarations or Affidavits under 37 CFR 1.130(b) – Prior Public Disclosure” which is only applicable to applications subject to the first inventor to file provisions.</p>
717.01(b)(1)	<p>Added section “Evaluation of Declarations or Affidavits under 37 CFR 1.130(b)” which is only applicable to applications subject to the first inventor to file provisions.</p>

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717.01(b)(2)	Added section “Determining if the Subject Matter of the Intervening Disclosure is the ‘Same’ as the Subject Matter of the Inventor Originated Prior Public Disclosure,” which is only applicable to applications subject to the first inventor to file provisions.
717.01(c)	Added section “Who May Make Affidavit or Declaration Under 37 CFR 1.130; Formal Requirements of Affidavits and Declarations” which is only applicable to applications subject to the first inventor to file provisions.
717.01(d)	Added section “U.S. Patent or Application Publication Claiming Same Invention” which is only applicable to applications subject to the first inventor to file provisions.
717.01(d)	Added section “Decided by Primary Examiner.”
717.01(d)	Added section “Timely Presentation.”
717.02	Added section “Prior Art Exception for Commonly Owned or Joint Research Agreement Subject Matter under AIA 35 U.S.C. 102(b)(2)(C)” which is only applicable to applications subject to the first inventor to file provisions.
717.02(a)	Added section “Invoking the Prior Art Exception under 35 U.S.C. 102(b)(2)(C)” which is only applicable to applications subject to the first inventor to file provisions.
717.02(a)	Added section “Evaluating Whether the Prior Art Exception under AIA 35 U.S.C. 102(b)(2)(C) is Properly Invoked” which is only applicable to applications subject to the first inventor to file provisions.
717.02(c)	Added section “Examination Procedure With Respect to the Prior Art Exception under AIA 35 U.S.C. 102(b)(2)(C)” which is only applicable to applications subject to the first inventor to file provisions.
717.02(d)	Added section “Form Paragraphs With Respect to the Prior Art Exception under AIA 35 U.S.C. 102(b)(2)(C)” which is only applicable to applications subject to the first inventor to file provisions.
718	<p>Revised title to change “37 CFR 1.130” to “37 CFR 1.131(c).”</p> <p>Changed references to “37 CFR 1.130(a)” to “37 CFR 1.131(c),” “35 U.S.C. 103” to “35 U.S.C. 103 (based on prior art under pre-AIA 35 U.S.C. 102),” “37 CFR 1.131” to “37 CFR 131(c),” “the same patentable invention” to “interfering subject matter,” “37 CFR 1.130(a)(1)” to “37 CFR 1.131(c)(1),” “37 CFR 1.130(a)(2)” to “37 CFR 1.131(c)(2),” “35 U.S.C. 104” to “pre-AIA 35 U.S.C. 104,” and “37 CFR 1.130” to “37 CFR 1.131(c).”</p> <p>Revised to indicate that 37 CFR 1.131(c) cannot be used to overcome rejections under pre-AIA 35 U.S.C. 102(b).</p> <p>Revised to indicate that a terminal disclaimer cannot overcome statutory double patenting.</p> <p>Changed “prior inventor under 35 U.S.C. 104” to “prior inventor under 35 U.S.C. 104 as in effect on March 15, 2013.”</p> <p>Replaced “37 CFR 1.130” with “37 CFR 1.131(c).”</p>
719	<p>Revised title to “Image File Wrapper.”</p> <p>Changed reference to “folder” to “electronic file record,” and “file wrapper” to “image file wrapper.”</p> <p>Revised to indicate that the electronic folder is the official record of the application.</p> <p>Revised to include a cross-reference to MPEP § 202 for notations to be made in the file history.</p>
719.01	<p>Revised title to “Papers in Image File Wrapper.”</p> <p>Revised text to reflect current IFW practice for entering papers into the image file wrapper. Particularly, revised to change “entered on the ‘Contents’ of the file wrapper”</p>

	<p>to “entered as a paper in the image file wrapper.” Removed references to MPEP § 604.04(a) and the IFW Manual.</p> <p>Revised title to “Residence of Inventor Changed.”</p> <p>Changed reference to “MPEP § 605.02 and § 605.03” to “MPEP § 608.02(a).”</p> <p>Removed reference to “MPEP § 605.04(c).”</p> <p>Revised to indicate that applicants must file a new application data sheet for a patent to issue with the new residence for applications filed on or after 9/16/12.</p>
719.04	<p>Revised to reflect current IFW practice for the index of claims. Particularly, revised to indicate that the “Index of Claims” found in the image file wrapper of an application is frequently referenced, and should be updated with each Office action.</p>
719.05	<p>Removed reference to IFW Manual section 3.7.</p> <p>Revised to insert reference to “CPC” classification regarding classification search.</p> <p>Revised to indicate that the examiners must include a complete search history in the application file any time an electronic search was performed.</p> <p>Changed “AltaVista” to “Yahoo,” and “Jux2” to “Bing” regarding internet search engines.</p> <p>Revised to indicate that all Web pages reviewed should be circled.</p>
719.06	Removed section.
719.07	Removed section.
720	<p>Revised to indicate petitions seeking the institution of public use proceedings are no longer authorized effective September 16, 2012. Revised to indicate the August 2012 revision of the MPEP may be consulted for information necessary regarding the former process.</p>
720.01	Removed section.
720.02	Removed section.
720.03	Removed section.
720.04	Removed section.
720.05	Removed section.
724.02	<p>Removed text indicating that if the application is maintained in paper, the confidential or proprietary information will be retained in the envelope or container.</p>
724.03	<p>Changed reference to “37 CFR 1.131 or 1.132” to “37 CFR 1.130, 1.131 or 1.132.”</p>
724.05	<p>Removed reference to the IFW Manual.</p>
724.06	<p>Updated 37 CFR 1.59 to reflect the current version. Particularly, revised to change “preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175” to “preliminary amendment present on the filing date of the application” regarding expungement of information or copy of papers in application file.</p> <p>Revised form paragraph ¶ 7.204, ¶ 7.205, and ¶ 7.206 to change “preliminary amendment referred to in the oath or declaration” to “preliminary amendment present on the filing date of the application.”</p>

CHAPTER 1100:

<u>1101</u>	Revised to replace existing material with an explanation that only SIRs requested prior to March 16, 2013 are timely.
<u>1102-1110</u>	Reserved
<u>1111</u>	Revised "prior art" language for consistency with the AIA revisions to 35 U.S.C. 102.
<u>1120</u>	Revised to update 37 CFR 1.211, as necessitated by the AIA, for publication of applications; retained pre-AIA 37 CFR 1.211 as instructions for publication of applications filed before September 16, 2012. Added, in subsection III, the Office may delay publication until an application includes an executed oath or declaration under 37 CFR 1.63 and/or an application data sheet for applications filed on or after September 16, 2012. In subsection IV, updated the name of the Office of Data Management – Patent Publication Branch.
<u>1121</u>	Revised to update 37 CFR 1.215 for patent application publication and retained earlier 37 CFR 1.215 given the ability to name inventors in an ADS for applications filed on or after September 16, 2012. Added subsection IV for applicant information of a patent application must be on the application data sheet (ADS) if the patent application is filed pursuant to 37 CFR 1.46. Revised previous subsection IV to be subsection V for assignee information to be published.
<u>1126</u>	Revised to add the publication fee set forth in 37 CFR 1.18(d) is \$0.00 (effective January 1, 2014).
<u>1128</u>	Revised to update 37 CFR 1.14.
<u>1130</u>	Revised subsection A, item (D), granting a request for corrected publication for a material mistake by the Office, by adding, for consistency with the AIA, for applications filed on or after September 16, 2012, a material mistake example of missing the benefit claim in an application data sheet (ADS). Also, the previous material mistake example of missing the benefit claim was updated to state “for applications filed before September 16, 2012” (pre-AIA). Revised subsection B, item (C), denying requests for corrected publication when there is a non-material mistake, by adding, for consistency with the AIA, where the priority claim was not timely filed or not properly submitted in an application data sheet (ADS) for applications filed on or after September 16, 2012. Also, the previous example of the priority claim was not timely filed was updated to state “for applications filed before September 16, 2012” (pre-AIA).
<u>1134</u>	Revised 35 U.S.C. 122 the confidential status of application and publication of patent applications to add a subsection for preissuance submissions by third parties. The newly added subsection discloses the timing and the requirements of the third party submission to the record of the patent application. Revised to add further explanation of 35 U.S.C. 122(c) and 35 U.S.C. 122 (e).
<u>1134.01</u>	Revised section by replacing 37 CFR 1.99 and its procedures with 37 CFR 1.290 for timeliness and content requirements of third party submissions to patent applications. Inserted Form PTO/SB/429, which could be used for third party submissions. Added examples of compliant concise descriptions of relevance of art submitted by third party.

CHAPTER 1200:

<p>1201</p>	<p>Revised to include "Board" to refer to the Patent Trial and Appeal Board and its predecessor organizations, the Board of Patent Appeals and Interferences and the separate Board of Appeals and Board of Interferences.</p> <p>Revised to add section to state that <i>ex parte</i> appeal practice before the Board in this chapter is primarily directed to appeals filed on or after January 23, 2012 or to proceedings commenced on or after September 16, 2012.</p>
<p>1202</p>	<p>Revised to recite current 35 U.S.C. 6 which provides for a "Patent Trial and Appeal Board" instead of "Board of Patent Appeals and Interferences".</p> <p>Revised to recite current 35 U.S.C. 6 which enumerates the duties performed by the Board, including reviewing appeals of reexaminations, conducting derivation proceedings, and conducting <i>inter partes</i> reviews.</p> <p>Revised to recite current 35 U.S.C. 6 which specifies that at least three members of the Board will hear appeals, derivation proceedings, post-grant reviews, and <i>inter partes</i> reviews.</p> <p>Revised to recite current 35 U.S.C. 6 (d) Treatment of Prior Appointments, which addresses the appointment of administrative patent judges prior to the date of the enactment of 35 U.S.C. 6.</p> <p>Revised to add that consistent with 35 U.S.C. 6(a), examiners should treat any reference to the BPAI (or its predecessors) as a reference to the PTAB and any citation of a Board decision made prior to September 16, 2012 should continue to be cited as being by the BPAI or its predecessors.</p>
<p>1203</p>	<p>Revised to clarify that documents relating to <i>ex parte</i> appeals that have not yet received docketing notices are processed by the business unit of the Office responsible for their processing.</p> <p>Revised to clarify that pre-appeal brief requests for review are processed by the Patent Appeal Center.</p> <p>Revised to add reference to 75 FR 15689, "Streamlined Procedure for Appeal Brief Review," March 30, 2010, and 75 FR 29321, "Streamlined Procedure for Appeal Brief Review in <i>Ex Parte</i> Reexamination Proceedings," May 25, 2010.</p> <p>Revised to clarify the Board's responsibility for determining whether an appeal brief is compliant is only a transfer of the specific responsibility of notifying appellant under 37 CFR 41.37(d) of the reasons for non-compliance rather than a transfer of jurisdiction for the appeal.</p> <p>Revised to clarify that the Patent Examining Corps retains jurisdiction over applications to consider appeal briefs, conduct appeal conferences, draft examiner's answers, consider evidence and information disclosure statements filed after final or after notice of appeal.</p> <p>Revised to add subsection (I.), Docketing Procedure.</p> <p>Revised to add (II.), to previous subheading "Special Case". Revised to update a cross reference to MPEP §708.01.</p>
<p>1204</p>	<p>Revised to recite current 35 U.S.C. 134 which references "Patent Trial and Appeal Board" instead of "Board of Patent Appeals and Interferences".</p> <p>Revised to recite the updated the appeal fees recited in 35 U.S.C. 41.</p> <p>Revised to provide further clarification as to what claims are considered under appeal set forth in 37 CFR 41.31(c). Appeal is presumed taken of the rejection of all claims under rejection, unless an amendment cancelling a rejected claim has been entered.</p> <p>Revised to add subsection "I. Appeal Fees" and refer to the fees set under the fee-setting authority of the AIA.</p> <p>Revised to redesignate former subsection I. Appeal by Patent Applicant as subsection II.</p> <p>In subsection II., revised to include information regarding applying 37 CFR 1.116 when an amendment, a notice of appeal and an appeal brief are filed on the same date after the mailing of a final action.</p>

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	<p>In subsection II., revised to include information regarding handling a notice of appeal where a reply under 37 CFR 1.111 in response to a second non-final rejection had previously been filed and is not yet considered.</p> <p>In subsection II., revised to include that as provided by 37 CFR 41.31(c), an appeal is presumed to be taken from the rejection of all claims under rejection in a particular application, absent any amendment cancelling claims that appellant does not wish to appeal.</p> <p>In subsection II., revised to add that effective March 19, 2013, the fee for filing an appeal brief in an application or <i>ex parte</i> reexamination was set at \$0.</p> <p>Revised to redesignate former subsection II. Appeal By Patent Owner as subsection III.</p> <p>Revised to update prior Form PTO/SB/31 – Notice of Appeal From the Examiner to the Board of Patent Appeals and Interferences to new Form PTO/AIA/31 – Notice of Appeal From the Examiner to the Patent Trial and Appeal Board.</p> <p>Revised to redesignate former subsection III. Acknowledgement as subsection IV.</p> <p>Revised to redesignate former subsection IV. Defective Notice of Appeal as subsection V.</p> <p>In subsection V., revised to state that notices of appeal are reviewed by the Patent Appeal Center and further clarify that Form PTOL-461 is completed by the Patent Appeal Center rather than by the examiner.</p> <p>In subsection V., revised to add that effective March 19, 2013, the fee for filing an appeal brief in an application or <i>ex parte</i> reexamination was set at \$0.</p>
1204.02	Revised to add section 1204.02, "Pre-Appeal Brief Review Request and Conference Pilot Program" and associated information regarding pre-appeal brief review requests.
1204.03	Revised to add section 1204.03, "Interviews After Notice of Appeal" and associated information regarding interviews after notice of appeal.
1204.04	Revised to add section 1204.04, "Official Record on Appeal" and associated information regarding the official record on appeal.
1205	Revised to update text of 37 CFR 41.37, particularly regarding the timing for filing an appeal brief, the contents thereof, and any notice of non-compliance.
1205.01	<p>Revised to set forth that any appeal brief or <i>ex parte</i> reexamination proceeding filed on or after March 19, 2013, need not be accompanied by an appeal brief fee, in accordance with 37 CFR 41.20(b)(2).</p> <p>Revised to set forth that in an <i>ex parte</i> reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c).</p> <p>Revised to delete prior form paragraph 12.110 Extension To File Brief – Granted and replace with updated form paragraph 12.210 Extension To File Brief – Granted.</p> <p>Revised to delete prior form paragraph 12.111 Extension To File Brief – Denied and replace with updated form paragraph 12.211 Extension To File Brief – Denied.</p> <p>Revised to change form paragraph 12.109.01 Appeal Dismissed – Allowed Claims, Formal Matters Remaining, to form paragraph 12.209 Appeal Dismissed – Allowed Claims, Formal Matters Remaining, and revise the associated Examiner note.</p>
1205.02	<p>Revised to set forth that any brief for which the notice of appeal was filed on or after January 23, 2012 must comply with current 37 CFR 41.37, and that information pertaining to the Board's practice prior to January 23, 2012 is available in the MPEP 8th Edition, Rev. 9 (August 2012) available on the USPTO Web site.</p> <p>Revised to provide further explanation about the time period for filing an appeal brief and that the fee for filing an appeal brief in an application or <i>ex parte</i> reexamination is \$0.</p> <p>Revised to set forth that oral arguments cannot remedy deficiencies in the brief and that briefs must set forth arguments and the basis therefor with citations of the statutes, regulations, authorities, and parts of the record relied upon.</p>

	<p>Revised to further explain contents of the appeal brief in accordance with 37 CFR 41.37(c)(1), including that the arguments must be responsive to every ground of rejection stated by the Examiner along with explanation of why the examiner erred in the ground of rejection.</p> <p>Revised to update references to 37 CFR 41.37(c)(1).</p> <p>Revised to explain that although evidence appendices are no longer required, they are appreciated in instances where evidence is relied upon.</p> <p>In subsection (i), revised to clarify that the real party in interest is not required if the named inventor(s) are themselves the real party in interest, and that if the appeal brief does not contain a statement of the real party in interest, the Office may assume that the named inventor(s) are the real party in interest rather than notifying appellant of a defect in the brief.</p> <p>Revised to update title of subsection (ii), to now recite “Related appeals, interferences and trials”.</p> <p>In subsection (ii), revised to provide appellants guidelines regarding informing the PTAB of all “related cases”.</p> <p>Revised to delete prior subsections (iii) Status of Claims, and (iv) Status of Amendments.</p> <p>Revised to redesignate prior subsection (v) Summary of claimed subject matter, as subsection (iii).</p> <p>In subsection (iii), revised to clarify guidance on providing a summary of claimed subject matter.</p> <p>Revised to delete prior subsection (vi) Grounds of rejection to be reviewed on appeal.</p> <p>Revised to redesignate prior subsection (vii) Argument, as subsection (iii).</p> <p>In subsection (iii), revised to provide further guidance (including examples) on submitting arguments to the PTAB consistent with 37 CFR 41.37(c)(1)(iv).</p> <p>Revised to delete prior subsections (ix) Evidence appendix, and (x) Related proceedings appendix.</p> <p>Revised to redesignate prior subsection (viii) Claims appendix, as subsection (v).</p> <p>In subsection (v), revised to add that if an appellant wishes to seek review of an examiner’s refusal to admit an amendment, affidavit or evidence, such review is by petition to the Director under 37 CFR 1.181.</p> <p>In subsection (v), revised to set forth that if an appellant wishes to remove claims from consideration on appeal, the appellant must submit an amendment to cancel the claims from the application, in accordance with 37 CFR 41.31(c) and 37 CFR 41.33, or waive if arguments and evidence are not presented as to certain rejections such arguments and evidence are waived for purposes of the appeal.</p>
<p>1205.03</p>	<p>Revised to update reference to "Board" instead of "Board of Patent Appeals and Interferences".</p> <p>Revised to delete reference to the prior BPAI responsibilities effective March 30, 2010.</p> <p>Revised to add that notices of appeal are reviewed by the Patent Appeal Center and further clarify that the need to prepare notifications of non-compliant appeal briefs are no longer determined by the examiner.</p>
<p>1206</p>	<p>Revised to indicate that 37 CFR 41.37(c)(2) provides that a brief shall not include any non-admitted amendments and that an amendment, affidavit, or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded for that purpose.</p> <p>Revised to indicate that any amendment, affidavit or other evidence filed after the mailing date of a final Office action and on or before the date of the notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under 37 CFR 1.116, whereas any amendment, affidavit or other evidence filed after the mailing date of a non-final Office action and on or before the date of notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under 37 CFR 1.111.</p> <p>Revised to add that Information Disclosure Statements submitted after the date of a notice of appeal are normally held in abeyance pending a decision on the appeal and that consideration of Information Disclosure Statements is based on MPEP § 609 and 37 CFR 1.97 and 1.98 ,and not on 37 CFR 41.33.</p>

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	<p>Revised to update Form PTOL-303 Advisory Action Before the Filing of an Appeal Brief. Revised to update Form PTOL-304 Advisory Action After the Filing of an Appeal Brief.</p>
<u>1207</u>	<p>Revised to update to include current 37 CFR 41.39 Examiner's Answer.</p>
<u>1207.01</u>	<p>Revised to add that if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary and the examiner may reopen prosecution and issue another Office action or may prepare a notice of allowability. Revised to indicate that if the examiner's answer contains a new ground of rejection, it must clearly designate the rejection as a new ground of rejection and must be approved by Technology Center (TC) Directors or their designee(s), consistent with 37 CFR 41.39.</p>
<u>1207.02</u>	<p>Revised to indicate that the examiner's answer is required to include two sections, under appropriate headings, "Grounds of Rejection to be Reviewed on Appeal" and "Response to Argument", with clarification on what should be included under each heading. Revised to delete prior form paragraph, 12.149 Examiner's Answer Cover Sheet and insert updated form paragraph 12.249 Examiner's Answer Cover Sheet. Revised to delete prior form paragraph, 12.154 Grounds of Rejection to be reviewed on Appeal and insert updated form paragraph 12.254 Grounds of Rejection to be Reviewed on Appeal. Revised to delete prior form paragraph, 12.154.01 Examiner's Statement of Grounds of Rejection and insert updated form paragraph 12.254.01 Statement of Grounds of Rejection, not modified Revised to add form paragraphs 12.254.02 Statement of Grounds of Rejection, modified; and 12.255 Restatement of Rejection. Revised to delete prior form paragraphs 12.150.01 Real Party in Interest; 12.150.04 Related Appeals and Interferences; 12.150.05 Identification of the Related Appeals and Interferences; 12.150.06 No Related Appeals and Interferences Identified; 12.151 Status of Claims; 12.151.01 List of Rejected Claims That Are Pending; 12.152 Status of Amendments After Final; 12.152.01 No Comment on Appellant's Statement of Status of Amendments; 12.153 Summary of Claimed Subject Matter; 12.153.01 No Comment on Appellant's Statement of the Summary of Claimed Subject Matter; 12.156 Claims Appendix; 12.156.01 No Comment on Appellant's Claims Appendix; 12.157 Evidence Relied Upon; 12.157.01 No Evidence Relied Upon; 12.157.02 Listing of Evidence Relied Upon; 12.159 Grounds of Rejection; 12.162 Related Proceeding(s) Appendix; 12.162.01 No Related Proceeding Identified; and 12.162.02 Copies Related to Proceeding. Revised to delete prior form paragraph, 12.154.04 New Grounds of Rejection - Heading and insert updated form paragraph 12.256 New Grounds of Rejection - Heading. Revised to delete prior form paragraph, 12.154.05 Withdrawn Rejections and insert updated form paragraph 12.257 Withdrawn Rejections. Revised to delete prior form paragraph, 12.161 Response to Argument and insert updated form paragraph 12.261 Response to Argument. Revised to delete prior form paragraph, 12.179 Conclusion to Examiner's Answer, No New Grounds of Rejection and insert updated form paragraph 12.279 Conclusion to Examiner's Answer, No New Grounds of Rejection which notes the requirement to pay the appeal forwarding fee. Revised to delete prior form paragraph, 12.179.01 Conclusion to Examiner's Answer Raising New Grounds of Rejection and insert updated form paragraph 12.279.01 Conclusion to Examiner's Answer Raising New Grounds of Rejection which notes the requirement to pay the appeal forwarding fee. Revised to add form paragraph 12.279.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer.</p>
<u>1207.03</u>	<p>Revised to update explanation of 37 CFR 41.39(a)(2) permitting the entry of a new ground of rejection in an examiner's answer and setting forth that supervisory approval is required.</p>

	Revised to insert new sub-section titled "III. Designation As A New Ground Of Rejection In An Examiner's Answer" and add guidance regarding what actions constitute a new grounds of rejection.
<u>1207.03(a)</u>	Revised to insert new section titled "Determining Whether a Ground of Rejection is New", including examples to provide further guidance as to when the examiner has instituted a new ground of rejection in an examiner's answer.
<u>1207.03(b)</u>	Revised to insert new section titled "Petition to Designate a New Ground of Rejection and to Reopen Prosecution" and associated information regarding petitions to reopen upon a designation of a new ground of rejection.
<u>1207.03(c)</u>	Revised to insert new section titled "Appellant's Reply to New Grounds of Rejection" and associated information regarding what options an Appellant has in the case of a new grounds of rejection. Revised to insert updated text of 37 CFR 41.39(b).
<u>1207.04</u>	Revised to provide further guidance regarding the appropriate procedure for reopening prosecution after appeal. Revised to delete prior form paragraph 12.187 Reopening of Prosecution After Appeal Brief or Reply Brief. Revised to add form paragraph 12.239 Reopening of Prosecution After Appeal Brief.
<u>1207.05</u>	Revised to change title from Supplemental Examiner's Answer" to "Substitute Examiner's Answer". Revised to replace all references to "supplemental" to "substitute". Revised to delete reference to 37 CFR 41.43 Examiner's response to reply brief. Revised to update text of 37 CFR 41.50 Decisions and other actions by the Board. Revised to delete prior form paragraphs 12.184 Supplemental Examiner's Answer – No option to Reopen Prosecution; and 12.185 Supplemental Examiner's Answer – On Remand FOR FURTHER CONSIDERATION OF A REJECTION. Revised to add form paragraph 12.285 Substitute Examiner's Answer – On Remand FOR FURTHER CONSIDERATION OF A REJECTION
<u>1208</u>	Revised to change section title from "Reply Briefs and Examiner's Response to Reply Brief" to "Reply Briefs and Fee for Forwarding Appeal". Revised to add text of 37 CFR 41.40 Tolling of time period to file a reply brief. Revised to update text of 37 CFR 41.41 Reply brief. Revised to delete reference to 37 CFR 41.43 Examiner's response to reply brief. In subsection I., revised to include reference to 37 CFR 1.181 regarding a decision refusing to grant a petition to designate a new ground of rejection in an examiner's answer. Revised to replace all references to "supplemental" to "substitute". Revised to update the requirements of a reply brief consistent with 37 CFR 41.37(c). Revised to delete prior form paragraphs 12.182 Reply Brief Not Considered; and 12. 181 Acknowledgement of Reply Brief. Revised to clarify that after receipt of a reply brief under 37 CFR 41.41, jurisdiction over the appeal passes to the Board and normally the Examiner does not need to acknowledge the reply brief.
<u>1208.01</u>	Revised to add a new section 1208.01 "Fee for Forwarding an Appeal to the Board". Revised to add the text of 37 CFR 41.45 Appeal forwarding fee. Revised to add that effective March 19, 2013, the fee for filing an appeal brief in an application or <i>ex parte</i> reexamination was set at \$0.
<u>1209</u>	Revised to update text of 37 CFR 41.47 Oral hearing. Revised to update time period for requesting an oral hearing.

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	<p>Revised to provide guidance for presenting arguments via telephone, audio-video connection, or with use of a projector.</p> <p>Revised to provide guidance on requesting additional time for arguments during an oral hearing.</p> <p>Revised to provide additional information on public attendance of oral hearings.</p> <p>Revised to delete prior form paragraph 12.163 Request to Present Oral Arguments and replace with form paragraph 12.279.03 Request to Present Oral Arguments.</p> <p>Revised to provide further guidance regarding examiner participation in an oral hearing.</p>
<u>1210</u>	<p>Revised to update text of 37 CFR 41.35 Jurisdiction over appeal.</p> <p>Revised to delete prior subsection II. Divided Jurisdiction.</p> <p>Revised to redesignate prior subsection III. Abandonment of Appeal: Application Refiled or Abandoned as subsection II.</p> <p>Revised to delete reference to the “Chief Clerk of the Board” and instead reference the “Clerk of the Board”.</p>
<u>1211</u>	<p>Revised to change title from "Remand by Board" to "Remand by Director or Board".</p> <p>Revised to indicate that both the Director and the Board have the authority to remand a case to the examiner when necessary, in accordance with 37 CFR 41.35(c), (e) and 41.40(a).</p>
<u>1211.01</u>	<p>Revised to replace all references to "supplemental" to "substitute".</p> <p>Revised to delete prior form paragraph 12.184 Supplemental Examiner’s Answer – No option to Reopen Prosecution.</p> <p>Revised to add form paragraph 12.285 Substitute Examiner’s Answer – On Remand FOR FURTHER CONSIDERTION OF A REJECTION.</p> <p>Revised to delete prior form paragraph 12.185 Supplemental Examiner’s Answer – On Remand FOR FURTHER CONSIDERATION OF A REJECTION.</p>
<u>1211.02</u>	<p>Revised to title from “Remand by Board to Consider Amendment” to “Remand to Consider Amendment”.</p> <p>Revised to delete reference to the Chief Clerk.</p> <p>Revised to indicate that if the proposed amendment is in effect an abandonment of the appeal, the appeal will normally be dismissed by the Board.</p>
<u>1211.03</u>	<p>Revised to limit the former guidance regarding consideration of affidavits or declarations after a notice of appeal to the time period before jurisdiction passes to the Board.</p>
<u>1212</u>	<p>Revised to update text of 37 CFR 41.50(d).</p> <p>Revised to indicate that an information disclosure statement filed while the Board possesses jurisdiction over the appeal will be held in abeyance until the Board's jurisdiction ends.</p> <p>Revised to incorporate reference to 37 CFR 1.136(b) regarding obtaining an extension of time to respond to additional matters required by the Board.</p>
<u>1213</u>	<p>Revised to update text of 37 CFR 41.50 Decisions and other actions by the Board.</p>
<u>1213.02</u>	<p>Revised to update text of 37 CFR 41.50(b).</p> <p>Revised to indicate that when the Board exercises its authority to make a new ground of rejection it must also designate that rejection as a new ground of rejection.</p> <p>Revised to indicate that the Board’s reversal of a rejection should not be interpreted as an instruction to the Examiner to allow the claims so rejected.</p>
<u>1213.03</u>	<p>Revised to indicate that Board decisions which are open to the public are available in electronic form on the USPTO Web site in the FOIA reading room.</p>
<u>1214</u>	<p>Revised to update text of 37 CFR 41.54 Action following decision.</p> <p>Revised to provide guidance on when the time period to take any action following a Board decision begins.</p>
<u>1214.01</u>	<p>Revised to add that if appellant believes that a Board decision that appears to be an affirmance is actually a decision including a new ground of rejection, review of any undesignated new</p>

	<p>ground of rejection is by way of 37 CFR 41.50(c) and 41.52 and not through the procedure in this section.</p> <p>Revised to provide guidance for determining when and for how long the Board retains jurisdiction where a decision designates a new ground of rejection under 37 CFR 41.50(b).</p> <p>Revised to indicate that the date of the decision is the "mailing date" or "notification date" indicated on form PTOL-90 accompanying the Board decision.</p>
<u>1214.03</u>	Revised to update text of 37 CFR 41.52 Rehearing.
<u>1214.05</u>	<p>Revised to change title from "Cancellation of Withdrawn Claims" to "Cancellation of Claims Not Appealed".</p> <p>Revised to indicate that pursuant to 37 CFR 41.31(c), an appeal is presumed to be taken from the rejection of all claims.</p> <p>Revised to indicate that where, in an appeal brief filed before January 23, 2012, an appellant withdraws some of the appealed claims (i.e., claims subject to a ground of rejection that the appellant did not present for review in the brief), and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims.</p>
<u>1214.06</u>	<p>Revised to update text of 37 CFR 41.35(b) and 41.35(b)(2).</p> <p>Revised to update text of 37 CFR 1.197 Termination of proceedings.</p> <p>Revised to indicate that in accordance with 37 CFR 90.3, the time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the Eastern District of Virginia is 63 days plus any additional time requested and granted under 37 CFR 90.3(c).</p> <p>Revised to delete prior form paragraph 12.119.01 Examiner Sustained in Part – Requirement of Rewriting Dependent Claims (No Allowed Claim) and replace with updated form paragraph 12.291 Examiner Sustained in Part – Requirement of Rewriting Dependent Claims (No Allowed Claim).</p> <p>Revised to delete reference to paper files.</p> <p>Revised to indicate that when the time for seeking court review has passed without review being sought it unnecessary for the applicant or patent owner to cancel the rejected claims, since they may be cancelled by the examiner in an examiner’s amendment.</p> <p>Revised to delete prior form paragraph 12.119.02 Examiner Sustained in Part – Requirement of Rewriting Dependent Claims (At Least One Allowed Claim) and replace with updated form paragraph 12.292 Examiner Sustained in Part – Requirement of Rewriting Dependent Claims (At Least One Allowed Claim).</p> <p>Revised to delete prior form paragraph 12.120 Period For Seeking Court Review Has Lapsed and replace with updated form paragraph 12.297 Period For Seeking Court Review Has Lapsed.</p> <p>Revised to provide further guidance regarding proceeding with prosecution in accordance with 37 CFR 41.50(b).</p>
<u>1214.07</u>	<p>Revised to update text of 37 CFR 1.198 Reopening after a final decision of the Patent Trial and Appeal Board.</p> <p>Revised to delete prior form paragraph 12.119 Amendment After Board Decision, Entry Refused and replace with updated form paragraph 12.298 Amendment After Board Decision, Entry Refused.</p>
<u>1215.01</u>	<p>Revised to add that if a brief has been filed within the time permitted by 37 CFR 41.37 (or any extension thereof) and an answer mailed and appellant withdraws the appeal prior to transfer of jurisdiction to the Board under 37 CFR 41.35(a), the application is returned to the examiner and if appellant withdraws the appeal after jurisdiction has been transferred to the Board, dismissal of the appeal will be handled by the Board.</p> <p>Revised to replace all references to "supplemental" to "substitute".</p>

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1215.03	<p>Revised to indicate that if an appellant wishes to remove claims from consideration on appeal, the appellant must submit an amendment to cancel the claims from the application.</p> <p>Revised to delete prior form paragraphs 12.121 Withdrawal of Appeal as to Some of the Claims on Appeal; 12.179.02 Dismissal Following New Ground(s) of Rejection in Examiner’s Answer; and 12.186 Dismissal Following A Supplemental Examiner’s Answer Written in Response to a Remand for Further Consideration of a Rejection.</p> <p>Revised to replace all references to "supplemental" to "substitute".</p>
1215.04	<p>Revised to delete prior form paragraph 12.109.01 Appeal Dismissal – Allowed Claims, Formal Matters Remaining and replace with updated form paragraph 12.209 Appeal Dismissal – Allowed Claims, Formal Matters Remaining.</p>
1216	<p>Revised to update text of 35 U.S.C. 141 Appeal to Court of Appeals for the Federal Circuit; 35 U.S.C. 145 Civil action to obtain patent; 35 U.S.C. 306 Appeal; and to add 37 CFR 90.1 Scope; 37 CFR 90.2 Notice; service; and 37 CFR 90.3 Time for appeal or civil action.</p> <p>Revised to clarify that pre-AIA 35 U.S.C. 315 continues to apply to <i>inter partes</i> reexamination proceedings in accordance with the Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 6(c)(3)(C) and 37 CFR 90.1.</p> <p>Revised to insert sub-section heading "III. Judicial Review of <i>Inter Partes</i> Review, Post-Grant Review, Covered Business Method Review, and Derivation Proceedings".</p> <p>Revised to add that a party dissatisfied with the final written decision of the Board in an <i>inter partes</i> review, post-grant review, or covered business method review proceeding may seek judicial review only by appealing the decision to the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. 141.</p> <p>Revised to change prior subheading “Time for Filing Notice of Appeal or Commencing Civil Action” to subsection IV.</p> <p>Revised to add that the time for filing a notice of election, and for commencing a civil action pursuant to a notice of election, in an appeal from a derivation proceeding is governed by 35 U.S.C. 141(d).</p> <p>Revised to change prior subheading “Time for Filing Cross-Appeal or Cross-Action” to subsection V.</p> <p>Revised to add that the time for filing a notice of election, and for commencing a civil action pursuant to a notice of election, in an appeal from a derivation proceeding is governed by 35 U.S.C. 141(d).</p> <p>Revised to change prior subheading “Time for Filing Cross-Appeal or Cross-Action” to subsection V.</p> <p>Revised to add that any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the U.S. Court of Appeals for the Federal Circuit.</p> <p>Revised to change prior subheading “Extension of Time to Seek Judicial Review” to subsection VI.</p> <p>Revised to add that requests for extension of time to seek judicial review under 37 CFR 90.3(c) should be addressed or served as provided in 37 CFR 104.2, or to expedite the handling of such a request, a copy of the request may be provided to the Office of the Solicitor.</p> <p>Revised to change prior subheading “Application Under Judicial Review” to subsection VII.</p> <p>Revised to change prior subheading “Service of Court Papers on the Director” to subsection VIII.</p>
1216.01	<p>Revised to change title from "Appeals to the Federal Circuit" to "Appeals to the U.S. Court of Appeals for the Federal Circuit".</p> <p>Revised to update text of 35 U.S.C. 143 Proceedings on appeal.</p> <p>Revised to provide further guidance on filing an appeal whether in an <i>ex parte</i> reexamination proceeding, or a derivation proceeding.</p>

MANUAL OF PATENT EXAMINING PROCEDURE

<u>1216.02</u>	Revised to change title from "Civil Suits Under 35 U.S.C. 145" to "Civil Suits Under 35 U.S.C. 145 and 146". Revised to include information regarding initiating an action under 35 U.S.C. 146. Revised to add further information regarding initiating an action under 35 U.S.C. 145, including cites to <i>Hyatt v. Kappos</i> , 625 F.3d 1320 (Fed. Cir. 2010) (en banc), aff'd, 132 S. Ct. 1690 (2012).
1220	Revised to delete this section.

CHAPTER 1400

<i>Passim</i>	Added text and citation for 35 U.S.C. 251 (effective September 16, 2012) and 35 U.S.C. 251 (pre-AIA). Changed consult with the SPRE or QAS to the TQAS.
1400.01	Added <i>inter partes</i> review, post grant review, and covered business method review as options for how a patent may be corrected or amended.
1401	Revised to provide that pre-AIA 35 U.S.C. 251 continues to require that any error to be corrected must have been made without deceptive intent.
1402	Added subsection headings to previous text. In subsection I, revised to indicate that a reissue error may be solely directed to the failure to previously present narrower claims. In support, the revised text cites to and quotes from <i>In re Tanaka</i> , 640 F.3d 1246 (Fed. Cir. 2011). In subsection II, deleted recitation of a portion of 35 U.S.C. 116 and the citation to 37 CFR 1.45(b)(3). In subsection III, revised to state that pre-AIA 37 CFR 1.55(c) or 37 CFR 1.55(e) is applicable to a petition for an unintentionally delayed priority claim. In subsection IV, deleted citation to Section 4503 of the AIPA and revised to clarify the application of 37 CFR 1.78 for pre-AIA and AIA applications in regard to a petition for an unintentionally delayed priority or benefit claim.
1403	Revised to state that 35 U.S.C. 251(d) corresponds to pre-AIA 35 U.S.C. 251, fourth paragraph.
1404	Deleted language regarding use of a bright color felt point marker for marking papers. Changed “Office of Patent Publication” to “Office of Data Management.”
1405	Added guidance on deleting a benefit claim by a corrected ADS if filed on or after September 16, 2012, or alternatively, by an amendment to the specification for applications filed before September 16, 2012.
1410	Added text noting the required use of an ADS to make priority/benefit claims in a reissue application filed on or after September 16, 2012. Added text suggesting the use of the reissue radio button when filing electronically and updated the website address for the EFS-Web Legal Framework. Replaced form PTO/SB/50 with an updated version, form PTO/AIA/50.
1410.01	Added subsection I that explains the requirements for reissue oaths or declarations or supplemental statements in lieu of an oath or declaration for reissue applications filed on or after September 16, 2012. Moved previous text under new subsection II and clarified that it applies to applications filed prior to September 16, 2012. Also, added a statement that for a reissue application filed before September 16, 2012, the application must be made by the inventor or a person provided for in pre-AIA 37 CFR 1.42, 1.43, or 1.47, except that the assignee of the entire interest may make the application if it does not enlarge the scope of the claims of the original patent.
1410.02	Created new section using text that was located in § 1410.01, subsections I, II, and III. In subsection I, added text which explains the requirements for written consent of all assignees when a reissue is sought and the use of forms PTO/AIA/50 and PTO/SB/50. Added text regarding certification of micro entity status. In subsection II, the citation to 3.73(b) was broadened to 3.73. Also, added text to clarify when a patent practitioner may sign the consent of the assignee. Updated form paragraphs 14.16.01-14.16.03, 14.16.04.fti, and 14.16.06. Added text to clarify that a copy of a 37 CFR 3.73 submission must be submitted in the reissue application file if there was such a submission in the patent file. In subsection III, added a citation to § 325.

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1411	Deleted language directed to paper file wrappers and reissue applications filed before November 7, 2000. Paper based process steps were replaced with current electronic processing steps. Replaced “‘Final SPRE Review’ form” with “internal review form.”
1412.02	<p>In subsection I, added discussions of <i>Greenliant Systems, Inc. et al v. Xicor LLC</i>, 692 F.3d 1261 (Fed. Cir. 2012); <i>In re Mostafazadeh</i>, 643 F.3d 1353, (Fed. Cir. 2011) and <i>In re Youman</i>, 679 F.3d 1335, (Fed. Cir. 2012) in regard to surrendered subject matter, overlooked aspects, and material narrowing of claim limitations.</p> <p>Relocated examples to illustrate “overlooked aspects” of the invention that would not be barred by recapture from subsection I.C to I.B.1(B).</p> <p>In subsection I.C.2, added a statement that clarifies that a recapture finding by the Office can be rebutted by the reissue applicant.</p> <p>In subsection II, added that certain continuing broadening reissue applications claiming the benefit of a prior filed broadening reissue application filed within two years of grant of the original patent may take advantage of pre-AIA 35 U.S.C. 103(b).</p> <p>In subsection III, deleted a statement that the error in not presenting article claims must have been made as a result of error without deceptive intent.</p> <p>In subsection IV, updated form paragraph 14.17 to include a citation to <i>Greenliant Systems, Inc. et al v. Xicor LLC</i>, 692 F.3d 1261 (Fed. Cir. 2012).</p> <p>In subsection V, deleted some discussion of “materially narrow[ing]” of claims because this topic is now discussed in detail in subsection I.</p> <p>In subsection VI, inserted a revised flow chart updated to show above changes.</p>
1412.03	<p>In subsection IV, added a discussion of <i>In re Staats</i>, 671 F.3d 1350 (Fed. Cir. 2012) and the filing of broadening continuing reissue application claiming the benefit of a broadening reissue filed within two years of the original grant. Deleted text pertaining to the former version of 37 CFR 1.175 regarding the filing of a “no defect” reissue. Updated the recitation of form paragraph 14.13 to its current version.</p> <p>In subsection V, added discussions of the oath or declaration requirements of broadening reissue application filed on or after September 16, 2012 and reissue applications filed before September 16, 2012.</p>
1412.04	<p>Updated correction of inventorship to provide processing steps and to distinguish between requirements for applications filed on or after September 16, 2012 and applications filed before that date. Deleted text to simplify the example of when and how a deleted inventor needs to sign the reissue oath/declaration.</p> <p>Added citations to § 602.01(c) for correction of inventorship in applications other than reissues and to §§ 324 and 325 for the right of an assignee to take action.</p>
1412.05	Newly added section that contains text from § 1412.04 regarding correction of inventorship in broadening reissue application. Text was updated to provide processing steps and to distinguish between the requirements for applications filed on or after September 16, 2012 and the applications filed before that date.
1413	Deleted discussion of prior practice of transferring drawings from the patent file and paper processing steps.
1414	<p>Updated text to include explanations of the different requirements for oath or declarations filed in reissue applications filed before September 16, 2012 and on or after September 16, 2012. Covers different requirements for oaths/declarations filed in continuation and divisional reissues depending on the filing date of the application.</p> <p>Deleted text regarding “without deceptive intent” requirements in subsection III and the copy of form PTO/SB/51.</p> <p>Modified to recite updated form paragraphs.</p>

INSTRUCTIONS REGARDING THE NINTH EDITION

<u>1414.01</u>	Moved previous text regarding supplemental oath/declarations to § 1414.03. This section now discusses the requirements of reissue oath or declaration in reissue applications filed on or after September 16, 2012 and contains a recitation of 37 CFR 1.175.
<u>1414.02</u>	Added discussion of reissue oath or declaration in reissue applications filed before September 16, 2012. Contains a recitation of pre-AIA 37 CFR 1.175 Subsection I explains the requirement of error without deceptive intent and contains a recitation of form paragraph 14.01.04.fti. Subsection II explains that the oath/declaration must comply with pre-AIA 37 CFR 1.63 and that the Office of Patent Application Processing reviews for compliancy.
<u>1414.03</u>	Contains relocated discussion of supplemental reissue oaths or declarations and was updated to include applications filed on or after September 16, 2012 in subsection I as well as applications filed before that date in subsection II. Subsection I explains that for applications filed after September 16, 2012 where all of the previously indicated errors no longer exist that a supplemental oath is not required if applicant explicitly identifies on the record an error being relied upon as the basis of reissue.
<u>1415</u>	Deleted references to the Consolidated Appropriations Act and to applications filed before or on/after December 8, 2004. In subsection III, deleted Example 1. In subsection V, added text to discuss specific forms for use in applications filed before September 16, 2012 or for use in applications filed on or after that date.
<u>1415.01</u>	Added text expressly stating that design and plant patents do not require payment of maintenance fees. Revised text pertaining to the payment of maintenance fees if more than one reissue patent will be granted to replace a single original patent.
<u>1416</u>	Revised text to concisely state that physical surrender of the ribboned copy of the original patent is no longer required, effective October 21, 2004. Deleted all examples of the illustrated situations where the surrender of the ribboned copy of the original patent was required.
<u>1417</u>	Revised text to state the requirement for reissue applications filed on or after September 16, 2012 to make priority claims in an ADS. Modified text to reflect electronic processing steps to correct information on the bib-data sheet. Deleted text that discussed discontinued paper processing. Revised to state that pre-AIA 37 CFR 1.55(c) or 37 CFR 1.55(e) is applicable to a petition for an unintentionally delayed priority claim. Added a cross reference to § 1481.03, which relates to correction of a priority/benefit claim via a certificate of correction.
<u>1418</u>	Revised to add trials before the PTAB in the list of prior or concurrent proceedings and to note the requirement in oaths and declarations filed in reissue applications filed before September 16, 2012 to state that the signer is aware of the duty to disclose material information.
<u>1430</u>	Updated to reflect current accessibility of reissue applications by deleting reference to pre-1977 filings and outdated directions on how to access Public PAIR. Clarified to reflect current practice that all reissue application filings, other than design reissue applications filed as a continued prosecution application, will be announced in the Official Gazette.
<u>1440</u>	Revised to clarify when the claims in a reissue application may be subject to different prior art than in the original patent and include a discussion of the revision to prior art definitions in the AIA and when the revisions are in effect. Examples are provided to explain how an original patent may be subject to prior art under pre-AIA 35 U.S.C. 102 while a reissue may be subject to current 35 U.S.C. 102 and vice-versa.

MANUAL OF PATENT EXAMINING PROCEDURE

<u>1441.01</u>	Modified to separate original text into subsection I, which discusses protests are permitted but not preissuance submissions, and subsection II, which discusses the time period for filing protests. Subsection I is revised to indicate that pre-issuance submissions are not available in reissue applications because reissue applications are post-issuance proceedings. Subsection II is revised to clarify that a protest should be filed within 2 months of the Official Gazette announcement of the reissue filing, when a petition under 37 CFR 1.182 may be required, and when a protest will not be entered.
<u>1442.01</u>	Revised to indicate that examiners should determine if a reissue application should be suspended when the original patent is subject to litigation. Deleted text that discussed discontinued paper processing steps.
<u>1442.03</u>	Revised to note that the Director may stay, suspend, consolidate or terminate a proceeding (reissue application) if there is a copending <i>inter partes</i> review, post grant review, or covered business method proceedings.
<u>1442.04</u>	Revised to state that the applicant should call the Office's attention to copending derivation proceedings, <i>inter partes</i> review, post grant review, or covered business method proceedings. Deleted the reference to the Lutrelle F. Parker, Sr., Memorial Law Library.
<u>1443</u>	Added cross reference to § 325. Added parenthetical that CPAs are only available for design applications.
<u>1444</u>	Revised by creating subsections to cover requirements of oaths or declarations, review of oaths or declarations, errors no longer relied upon as the basis for reissue, supplemental oath/declarations under pre-AIA 37 CFR 1.175, and after allowance requirements. Clarified the review required of reissue oaths and declarations by separately explaining the review of oaths and declarations filed in applications on or after September 16, 2012 and applications filed before that date. Deleted the recitation of 37 CFR 1.175. Replaced the recitation of form paragraph 14.05.02 with 14.05.02.fti.
<u>1445</u>	Revised to note that overall examination is conducted in the same manner as in the original patent even in rare cases when the prior art that a reissue application is subject to may be different from the prior art that the original patent was subject to as provided in § 1440.
<u>1448</u>	Updated to limit the treatment of admissions or judicial determinations of fraud, inequitable conduct, or violation of the duty of disclosure to reissue applications filed before September 16, 2012. Replaced the recitations of form paragraphs 14.21.09 and 14.22 with 14.21.09.fti and 14.22.fti, respectively.
<u>1449</u>	Revised to indicate that if a protest is filed in a reissue application and the original patent is before the PTAB in either an interference or contested case, then the PTAB should be consulted before taking action on the reissue application. It is emphasized that the reissue application should not be allowed without the PTAB judge's approval.
<u>1449.01</u>	Subsection II was revised to explain the Office's authority and ability to stay, suspend, consolidate or terminate a proceeding (reissue application) if there is a copending <i>inter partes</i> review, post grant review, or covered business method proceedings.
<u>1449.02</u>	Revised to limit the reissue applications that may be placed into interference to reissue applications subject to pre-AIA 35 U.S.C. 102(g). Deleted the citation to <i>In re Metz</i> , 173 F.3d 433 (Fed. Cir. 1998).
<u>1449.03</u>	Added a new section to note that certain reissue applicants may file a petition to institute a derivation proceeding.

INSTRUCTIONS REGARDING THE NINTH EDITION

<u>1450</u>	Revised to indicate that cancellation of all original claims in a reissue application is not effective as an alternative to disclaiming all of the original claims because of the availability of adding the original claims in a continuing reissue application.
<u>1451</u>	Revised to list indicia of the filing of a continuing reissue application as opposed to a continuation of a reissue application, which is a non-reissue application. Revised to note that while an ADS must be used to claim benefit of a prior application in a reissue filed on or after September 16, 2012, that it is recommended to continue to provide a statement in the first line of specification to help ensure that the Office recognizes the application as a reissue application. Subsections I and II are revised to explain the different oath/declaration requirements for applications filed on or after September 16, 2012 and those filed before that date.
<u>1452</u>	Revised to indicate that requests for continued examination in reissue applications may only be filed in utility or plant reissue applications.
<u>1453</u> <u>1453</u>	Subsection III was modified to recite the current version of form paragraph 14.20.01. Subsection VI was revised to add (E) to explain how amendments in an application for reissue of a previously reissued patent should be made.
<u>1454</u>	Revised the cross reference to chapter 1200 to § 1206 from § 1205.
<u>1455</u>	Replaced “Issue Classification sheet” with “Issue Classification information”; “Final SPRE Review’ form” with “internal review form”; and “Publishing Division of the Office of Patent Publication” with “Office of Data Management.” In subsection VIII, revised to provide that for reissue applications filed after September 16, 2012 where all of the previously indicated errors no longer exist, a supplemental oath is not required if applicant explicitly identifies on the record an error being relied upon as the basis of reissue.
<u>1456</u>	Updated the review process in view of changes to the process flow. Specifically, the steps involving the Office of Patent Legal Administration (OPLA) were deleted.
<u>1457</u>	In subsection II, revised text so that the separate search and examination fees are due for all design reissue applications and not just those filed on or after December 8, 2004. In subsection V, deleted the “without deceptive intent” requirement that is no longer required by 35 U.S.C. 251.
<u>1470</u>	Deleted the discussion of applications filed before March 1, 1977. Updated the link to access public PAIR.
<u>1480</u>	Updated the address to which a certificate of correction should be addressed.
<u>1480.01</u>	Updated the address to which a request for expedited issuance of certificate of correction should be addressed.
<u>1481</u>	Updated recitation of 37 CFR 1.323.
<u>1481.02</u>	Modified to discuss the changes to 35 U.S.C. 256 by the AIA. Updated to include subsections on current 35 U.S.C. 256 and pre-AIA 35 U.S.C. 256 for requests for correction filed before September 16, 2012. Added new text in subsections I and III to provide guidance on filing and processing requests filed on or after September 16, 2012.
<u>1481.03</u>	Updated to provide subsections on correction of benefit claims under 35 U.S.C. 120 and 119(e) for applications filed: (1) on or after March 16, 2013; (2) on or after September 16, 2012 but before March 16, 2013; and (3) before September 16, 2012. Added recitation of 37 CFR 1.78 that applied to applications filed on or after March 16, 2013 and updated citation to 37 CFR 1.78 to correspond to the current version. Also included a recitation of 37 CFR 1.78 in effect from September 16, 2012 to March 15, 2013 and in effect prior to September 16, 2012.
<u>1485</u>	Updated the address to which a certificate of correction should be addressed. Updated to add guidance for processing a certificate of correction of a patent involved in a contested case.

	<p>Changed “Office of Patent Publication” to “Office of Data Management.” Updated to remove paper application processing steps. Updated web sites addresses to access information on certificates of correction.</p>
<p>1490</p>	<p>Updated to add subsections and text on disclaimers in applications filed: (1) on or after September 16, 2012, and (2) before September 16, 2012. Updated subsection II to refer to an interference “or contested case.” Modified subsection III to refer to joint research agreements generally in view of 37 CFR 1.104(c)(4)(ii) and 1.104(c)(5)(ii). In subsection V, added a discussion of filing and processing of eTerminal Disclaimers and updated the internal process steps of the review of terminal disclaimers. In subsection VI, added to the discussion of filing of a disclaimer to obviate a nonstatutory double patenting rejection of a non-commonly owned patent or application to include those disqualified under 35 U.S.C. 102(b)(2)(C); included citation to forms PTO/AIA/25 & 26; and deleted the example of a statement of common ownership. Also added a citation to <i>President and Fellows of Harvard College v. Rea</i>, 2013 WL 2152635 (E.D.Va. May 15, 2013). Updated and further explained the interpretation of “earlier filed” for determining in which application a terminal disclaimer need not be filed. In subsection VII, updated recitations of forms paragraphs to current versions. In subsection VIII, added a discussion of <i>In re Yamazaki</i>, 702 F.3d 1327 (Fed. Cir. 2012). Added that nullifying a terminal disclaimer in <i>inter partes</i> review, post grant review, or covered business method review would not be appropriate and that where a first granted terminal disclaimer is sought to be replaced on petition with a second terminal disclaimer, the second disclaimer must not operate to extend the patent term as shortened by the first disclaimer. In subsection IX, added terminal disclaimer forms for use with applications filed on or after September 16, 2012 and forms for use in applications filed before that date.</p>

CHAPTER 1500

1503.01	<p>Revised to recite current 37 CFR 1.153 regarding title, description and claim, oath or declaration to reflect and revised prior version to recite “Pre-AIA” (for applications filed prior to September 16, 2012).</p> <p>Revised to replace, in form paragraph 15.05 item (5), “descriptive statement” with “feature description” for design patent specification arrangement.</p> <p>In subsection I, updated references to 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a) and/or 35 U.S.C. 112(b) for applications filed on or after September 16, 2012 and former 35 U.S.C. 112 first and/or second paragraphs for applications filed before September 16, 2012.</p>
1503.02	<p>Revised to update references to 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a) and/or 35 U.S.C. 112(b) for applications filed on or after September 16, 2012 and former 35 U.S.C. 112 first and/or second paragraphs for applications filed before September 16, 2012.</p> <p>Revised to update form paragraph 15.07 to state preparing new or “replacement” drawings.</p> <p>In subsection III, Broken Lines, revised to incorporate <i>In re Owens</i>, 710 F.3d 1362, 106 USPQ2d 1248 (Fed. Cir. 2013), instructing on when the introduction of broken lines in an amendment or continuation application complies with the written description requirement.</p> <p>Revised to update form paragraph 15.50.02 regarding description of broken lines.</p>
1504	<p>Deleted form paragraph 15.66.01 regarding considering desirability to employ services of a professional patent draftsman.</p>
1504.01(a)	<p>In subsection B, in accordance with the “article of manufacture” requirement, revised references to 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a) and/or 35 U.S.C. 112(b) for applications filed on or after September 16, 2012 and former 35 U.S.C. 112 first and/or second paragraphs for applications filed before September 16, 2012.</p>
1504.01(e)	<p>Deleted form paragraph 15.10, Offensive Subject Matter, and replaced with form paragraph 15.09.01, Offensive Subject Matter.</p>
1504.02	<p>Revised by updating 35 U.S.C. 102, Conditions for patentability; novelty, for consistency with changes in the provisions of the AIA.</p> <p>Revised to insert “Pre-AIA” to the previous version of 35 U.S.C. 102, Conditions for patentability; novelty and loss of right to patent.</p> <p>Revised by updating 35 U.S.C. 172, Right of priority, for consistency with changes in the provisions of the AIA and newly added 35 U.S.C. 102.</p> <p>Revised to insert “Pre-AIA” to the previous version of 35 U.S.C. 172, Right of priority.</p> <p>Revised to insert “pre-AIA” to 35 U.S.C. 102(b) for experimental use exception to a statutory bar for public use or sale. See MPEP § 2133.03(e)(6).</p> <p>Revised to insert “pre-AIA” to 35 U.S.C. 102(d) for dates on which design rights can be enforced in a foreign country and thus usable in a pre-AIA 35 U.S.C. 102(d) rejection.</p> <p>Revised to insert “fti” (first-to-invent) to form paragraph 15.03.01 to become 15.03.01.fti for foreign filing more than 6 months before U.S. filing.</p> <p>Revised to incorporate form paragraphs for rejections under AIA 35 U.S.C. 102 “.aia” and pre-AIA 35 U.S.C. 102, “fti”.</p> <p>Deleted form paragraph 15.11, 35 USC 102(a) Rejection.</p> <p>Deleted form paragraph 15.12, 35 USC 102(b) Rejection.</p> <p>Deleted form paragraph 15.13, 35 USC 102(c) Rejection.</p> <p>Deleted form paragraph 15.14, 35 USC 102(d)/172 Rejection.</p> <p>Deleted form paragraph 15.15, 35 USC 102(e) Rejection.</p> <p>Revised to insert form paragraphs 15.09.02.aia and 15.09.03.aia, directed to Statement of Statutory Bases, 35 U.S.C. 171 and 35 U.S.C. 115 – Improper Inventorship and rejections for failure to set for the the correct inventorship.</p>

MANUAL OF PATENT EXAMINING PROCEDURE

	<p>Deleted form paragraph 15.16, 35 USC 102(f) Rejection. Deleted form paragraph 15.17, 35 USC 102(g) Rejection. Revised to insert form paragraph 15.24.05.fti, Identical Claim: Common Assignee, in order to update now-deleted form paragraph 15.24.05 for consistency with changes in the provisions of the AIA. Revised to incorporate form paragraph 15.15.01.aia for rejections under 35 U.S.C. 102(a)(1) or (a)(2), and form paragraph 15.15.01.fti pre-AIA 35 U.S.C. 102(a)(b)(d) or (e), to provide explanation of the rejection. Deleted form paragraph 15.15.01, Explanation of rejection under 35 U.S.C. 102(a), (b), (d), or (e). Revised to incorporate form paragraphs for provisional rejections under 35 U.S.C. 102(a)(2), “aia”, and pre-AIA 35 U.S.C. 102(e), “fti” to provide an explanation of the rejection. Form paragraph 15.15.02, Provisional 35 U.S.C. 102(e) rejection – design disclosed but not claimed in another application with common inventor and/or assignee and added new form paragraphs 15.15.02.fti and 15.15.02.aia. Deleted form paragraph 15.15.03, Provisional 35 U.S.C. 102(e) rejection – design claimed in an earlier filed design patent application with common inventor and/or assignee and added new form paragraphs 15.15.03.fti and 15.15.03.aia. Deleted form paragraph 15.15.04, Provisional 35 U.S.C. 102(e) rejection – design disclosed but not claimed in a patent and added new form paragraphs 15.15.04.fti and 15.15.04.aia.</p>
1504.03	<p>Revised to insert 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter, for consistency with changes in the provisions of the AIA, that focus on the prior art at the time of effective filing date of the claimed invention” instead of the prior art at the time of the invention that was set forth by the previous version of 35 U.S.C. 103. Revised to insert “Pre-AIA” to the previous version of 35 U.S.C. 103. The form paragraphs for making rejections were updated to provide a first form paragraph usable under the prior law and a parallel form paragraph for use under the current law.</p>
1504.04	<p>Revised to add 35 U.S.C. 112 Specification, (a) In general and (b) Conclusion, for consistency with changes in the provisions of the AIA. Revised to insert “Pre-AIA” to the previous version of 35 U.S.C. 112 Specification (for applications filed prior to September 16, 2012). Revised occurrences of 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a) and (b), as necessitated by the AIA, and specifying that 35 U.S.C. 112, first and second paragraph, is applicable for applications filed prior to September 16, 2012, 35 U.S.C. 112, when necessary. Revised to update form paragraph 15.21, Rejection, 35 U.S.C. 112(a) and (b), as necessitated by the AIA, or pre-AIA 35 U.S.C. 112, First and Second Paragraphs. Revised to update form paragraph 15.20.02, Suggestion to Overcome Rejection under 35 U.S.C. 112(a) and (b), as necessitated by the AIA, or pre-AIA 35 U.S.C. 112, First and Second Paragraphs. Revised to update form paragraph 15.51, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph Rejection (New Matter). Revised to update form paragraph 15.22.02, Rejection, 35 U.S.C. 112 (b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph (“Or the Like” In Claim). Revised to update form paragraph 15.69.01, Remove Indefinite Language (“Or the Like”) by Examiner’s Amendment. Revised to update form paragraph 15.22, Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, 2nd Paragraph. Revised to update form paragraph 15.22.03, Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph (Title Fails to Specify a Known Article of Manufacture).</p>

INSTRUCTIONS REGARDING THE NINTH EDITION

	<p>Revised to update form paragraph 15.21.01, Rejection, 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, Second Paragraph (Additional Information Requested).</p> <p>Revised to update form paragraph 15.58.01, Claimed Design Is Patentable (35 U.S.C. 112 Rejections).</p>
<u>1504.05</u>	<p>In subsection II. A., revised occurrence of 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a), as necessitated by the AIA, and specifying that 35 U.S.C. 112, first paragraph, is applicable for applications filed prior to September 16, 2012, 35 U.S.C. 112.</p>
<u>1504.06</u>	<p>Revised to update the prior rejections that must be considered in addition to the double patenting rejection in view of the changes in the AIA.</p> <p>Added references to the e-terminal disclaimer program and the use of office prepared terminal disclaimer forms.</p>
<u>1504.10</u>	<p>Revised to add 35 U.S.C. 172, Right of priority, for consistency with changes in the provisions of the AIA.</p> <p>Revised to update form paragraph 15.04, Priority Under Bilateral or Multilateral Treaties by indicating that certain information must be supplied when making a claim for priority of a foreign application.</p>
<u>1504.20</u>	<p>Revised to update the explanation of 35 U.S.C. 120, Benefit of earlier filing date in the United States, for applications filed on or after September 16, 2012 that a specific reference to the prior application must be in the application data sheet.</p> <p>Revised to update form paragraph 15.26, Identification of Prior Application(s) in Nonprovisional Applications – Benefit Claimed, to include that applications filed on or after September 16, 2012 any specific reference to a prior application must be in the application data sheet.</p> <p>Revised occurrence of 35 U.S.C. 112, by incorporating 35 U.S.C. 112(a) and specifying that 35 U.S.C. 112, first paragraph, is applicable for applications filed prior to September 16, 2012.</p> <p>Revised to replace form paragraph 15.75 with form paragraph 15.75.fti, Preface to Rejection in Alleged CIP based on pre-AIA 35 U.S.C. 102(d)/172.</p> <p>Revised to update form paragraph 15.75.01, C-I-P Caution, Claim to Foreign Priority in Earlier Filed Application.</p>
<u>1504.30</u>	<p>Revised subsection Expedited Examination Procedure, by deleting further explanation of examination and restriction requirements.</p>
<u>1509</u>	<p>Revised to provide for the submission of filing, search and examination fees for reissue applications. Updated the citation for the fee for issuing a reissue design patent.</p>
<u>1513</u>	<p>Revised to insert “Effective March 16, 2013, the provisions of 35 U.S.C. 157 were repealed.”</p>

CHAPTER 1600:

1601	Added Federal Circuit case (<i>In re Beineke</i>) explaining that the “invents or discovers” requirement of 35 U.S.C. 161 limits patent protection to newly found seedlings or plants that were created as a result of agricultural and horticultural efforts by the inventor.
1603	Updated section to refer to "inventor's" oath or declaration for consistency with the revision to 37 CFR 1.162.
1604	Added 37 CFR 1.162 (Applicant, oath or declaration) as it applies to applications filed on or after September 16, 2012. Also added form PTO/AIA/09 for submitting a declaration in a plant patent application filed on or after September 16, 2012. Deleted form PTO/SB/03. Added explanation that the inventor's oath or declaration must state, inter alia, that the inventor has asexually reproduced the plant, and where the plant is a newly found plant, that it was found in a cultivated area.
1605	Updated 35 U.S.C. 162 and 37 CFR 1.163(b). Revised form paragraphs 16.02 and 16.03 (objecting to the disclosure or rejecting a claim because of lack of a clear and complete disclosure with regard to colors) to add references to 35 U.S.C. 112(a).
1606	Updated 37 CFR 1.84(c) and 1.165(b). Deleted discussion of former 37 CFR 1.165(b). Revised form paragraph 16.06 such that it is limited to providing copies of color drawings in duplicate.
1608	Revised to limit subject matter discussed to statutory provisions that apply to the examination of plant patent applications. Deleted (and moved to MPEP § 1609) discussion of the authority of the Director to submit plant patent applications to the Department of Agriculture and request a report.
1609	Added discussion of the authority of the Director to submit plant patent applications to the Department of Agriculture and request a report.
1611	Revised to delete discussion relevant to processing of paper patent applications.
1612	Revised to update information on the International Convention for the Protection of New Varieties of Plants (UPOV) and to add table of UPOV member states and organizations. Added option to include the Latin name and the variety denomination for the plant claimed in an application data sheet as provided for in 37 CFR 1.76(b)(3).

CHAPTER 2100

<i>Passim</i>	Added text, where applicable, indicating sections not applicable to first inventor to file applications. Case citations were updated as necessary.
2106	In subsection II.B, deleted citation to <i>In re Grams</i> , 888 F.2d 835 (Fed. Cir. 1989) in discussing the extent to which the machine or apparatus imposes meaningful limits on claimed method steps.
2126	Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(a) and (b)” with “35 U.S.C. 102(a) or pre-AIA 35 U.S.C. 102(a) and (b)” and “35 U.S.C. 102(d)” with “pre-AIA 35 U.S.C. 102(d)”.
2126.01	Deleted reference to the Lutrelle F. Parker, Sr., Memorial Law Library.
2126.02	Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(a), (b) or (d)” with “35 U.S.C. 102(a) or pre-AIA 35 U.S.C. 102(a), (b) or (d)”; and “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b);” and “35 U.S.C. 102(d)” with “pre-AIA 35 U.S.C. 102(d)”.
2127	Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., certain references to “35 U.S.C. 102(e)” with “35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e)”; “35 U.S.C. 102(b)” with “35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102(b).” and “35 U.S.C. 102 (a) and (b)” with “35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102 (a) and (b)”.
	Added a reference to § 2154 for prior art under 35 U.S.C. 102(a). In subsection II, added text to indicate that canceled matter may be available as prior art under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(b). Also, added text to further clarify the teaching concerning the availability of cancelled subject matter as prior art in <i>Bruckelmyer v. Ground Heaters, Inc.</i> , 445 F.3d 1374, 78 USPQ2d 1684 (Fed. Cir. 2006).
2128	Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., reference to “35 U.S.C. 102 (a) and (b)” with “35 U.S.C. 102(a)(1) or pre-AIA 35 U.S.C. 102 (a) and (b)” and “35 U.S.C. 102 (a) or (b)” with “35 U.S.C. 102(a)(1) and pre-AIA 35 U.S.C. 102 (a) or (b)”.
2128.01	In subsections II and IV, added text to indicate that an oral presentation may be prior art under 35 U.S.C. 102(a)(1), including a citation to § 2152.02(e).
2131	Revised title to “Anticipation – Application of 35 U.S.C. 102”. Removed reproduction of pre-AIA 35 U.S.C. 102 and replaced with text indicating that a claim may be rejected under 35 U.S.C. 102 when it is anticipated by prior art that teaches every element of the claim.
2131.01	Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., certain references to “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b)”.
2131.02	Revised one subheading to “A Generic Disclosure Will Anticipate a Claimed Species Covered by That Disclosure When the Species Can Be ‘at Once Envisaged’ From the Disclosure”. In the same subsection, added a discussion of <i>Sanofi-Synthelabo v. Apotex, Inc.</i> , 550 F.3d 1075, 1083 (Fed. Cir. 2008) and <i>Osram Sylvania Inc., v. America Induction Tech.</i> , 701 F.3d 698, 705 (Fed. Cir. 2008).
2131.03	In subsection II, revised text to indicate that other facts must be considered when determining whether prior art with a broader range anticipates a claim with a narrow range. In support, added citation to and discussion of <i>ClearValue Inc. v. Pearl River Polymers</i>

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	<i>Inc.</i> , 668 F.3d 1340 (Fed. Cir. 2012). Also, further clarified the teaching of <i>Atofina v. Great Lakes Chem. Corp.</i>
2132	Revised title to “Pre-AIA 35 U.S.C. 102(a)” and added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(a)” with “pre-AIA 35 U.S.C. 102(a)”.
2132.01	Revised title to “Publications as pre-AIA 35 U.S.C. 102(a) Prior Art” and added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(a)” with “pre-AIA 35 U.S.C. 102(a)” and “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)”.
2133	Revised title to “Pre-AIA 35 U.S.C. 102(b)” and added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b)”.
2133.01-2133.02	Added an Editor Note that states these sections are not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b)”.
2133.03 <i>et seq.</i>	Added an Editor Note that states the sections are either not applicable or have limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b)”.
2134	Revised title to “Pre-AIA 35 USC 102(c)” and added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(c)” with “pre-AIA 35 U.S.C. 102(c)” and “35 U.S.C. 102(g)” with “pre-AIA 35 U.S.C. 102(g)”.
2135 <i>et seq.</i>	Revised title to “Pre-AIA 35 USC 102(d)” for § 2135. Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(d)” with “pre-AIA 35 U.S.C. 102(d)” and “35 U.S.C. 102(g)” with “pre-AIA 35 U.S.C. 102(g)”.
2136	Revised title to “Pre-AIA 35 U.S.C. 102(e)” and added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Removed text directed to prior amendments of pre-AIA 35 U.S.C. 102. Moved text pertaining to the prior art date of international applications published by WIPO under pre-AIA 102(e) and replaced reference to “the former (pre-AIPA) version of 35

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	<p>U.S.C. 102(e)” with “the pre-AIPA version of 35 U.S.C. 102(e) (i.e., the version in force on November 28, 2000)”.</p> <p>Removed the reproduction of 35 U.S.C. 102(e) in force on November 28, 2000.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)”.</p>
<u>2136.01</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and 103 and the references to pre-AIA 35 U.S.C. 102 and 103 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)” and “35 U.S.C. 103” with “pre-AIA 35 U.S.C. 103”.</p>
<u>2136.02</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)”.</p>
<u>2136.03</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)”.</p> <p>In subsection II, added subheadings for “A. International Application filed On or After November 29, 2000” and “B. International Application Filed Before November 29, 2000”.</p> <p>In subsection II.B, replaced references to “the former (pre-AIPA) version of 35 U.S.C. 102(e)” with “the pre-AIPA version of 35 U.S.C. 102(e) (i.e., the version in force on November 28, 2000)”. Added the text of 35 U.S.C. 102(e) in force on November 28, 2000.</p> <p>In addition, revised text to indicate that a reference that does not qualify as prior art under the version of 35 U.S.C. 102(e) in force on November 28, 2000 or pre-AIA 35 U.S.C. 102(e) may qualify under pre-AIA 102(a) or (b).</p>
<u>2136.04</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)”.</p>
<u>2136.05</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and 103 and the references to pre-AIA 35 U.S.C. 102 and 103 by replacing, e.g., references to “35 U.S.C. 102(e)” with “pre-AIA 35 U.S.C. 102(e)” and “35 U.S.C. 103” with “pre-AIA 35 U.S.C. 103”.</p> <p>Revised text to clarify that for applications subject to pre-AIA 35 U.S.C. 102, an applicant’s own work may not be used under pre-AIA 35 U.S.C. 102(e).</p>
<u>2137</u>	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and the references to pre-AIA 35 U.S.C. 102 by replacing, e.g., references to “35 U.S.C. 102(f)” with “pre-AIA 35 U.S.C. 102(f)” and references to “35 U.S.C. 102(b)” with “pre-AIA 35 U.S.C. 102(b)”.</p> <p>Revised text to clarify that <i>In re Costello</i> applies to applications subject to pre-AIA 35 U.S.C. 102.</p>

2137.01	<p>Revised text to discuss the different requirements for naming inventorship for applications filed before, or on or after September 16, 2012, and to clarify that 35 U.S.C. 119 requires the same inventor or at least one common joint inventor between a U.S. application and a foreign application in order to claim priority.</p> <p>Replaced references to “37 CFR 1.48(a)” with “37 CFR 1.48” and “MPEP § 201.13” with MPEP § 213.02”.</p> <p>In subsection I, revised subheading to “Naming Inventorship”. Added text to clarify that each inventor must execute an oath or declaration except as provided in 37 CFR 1.64 and to reference § 602.01(a) or (b) for oath or declaration requirements.</p> <p>Removed subsection VI. Some of the text was moved to § 2137.02</p>
2137.02	<p>Added an Editor Note that states this section is not applicable to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Added text discussing <i>Ex parte DesOrmeaux</i>, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992), which was formerly located in § 2137.01 and clarified that inventorship is generally by another when there are different inventive entities.</p>
2138 <i>et seq.</i>	<p>Revised title to “Pre-AIA 35 U.S.C. 102(g)” for § 2138.</p> <p>Added Editor Note that states these sections have limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA.</p> <p>Revised text to distinguish between current 35 U.S.C. 102 and 103 and the references to pre-AIA 35 U.S.C. 102 and 103 by replacing, e.g., references to “35 U.S.C. 102(g)” with “pre-AIA 35 U.S.C. 102(g)” and “35 U.S.C. 103” with “pre-AIA 35 U.S.C. 103”.</p>
2138.01	<p>In subsection I, revised to add a reference to 35 U.S.C. 116 regarding the definition of applicants.</p> <p>In subsection III, revised to indicate that if a reference or activity applied under pre-AIA 35 U.S.C. 102 or 103(a) is not a statutory bar or patent application publication claiming the same invention, an applicant can establish a prior date of invention under 37 CFR 1.131. Also, revised to clarify that subject matter which is prior art under pre-AIA 35 U.S.C. 102(g) and is subject to an interference is not open to further inquiry under 37 CFR 1.131 during the interference proceeding.</p>
2138.02	<p>Revised text to distinguish between current 35 U.S.C. 104, 135, and 291 and the references to pre-AIA 35 U.S.C. 104, 135, and 291 by replacing, e.g., reference to “35 U.S.C. 104” with “pre-AIA 35 U.S.C. 104”.</p>
2141	<p>Added reproduction of 35 U.S.C. 103 and deleted reproduction of pre-AIA 35 U.S.C. 103(b) and (c).</p> <p>Revised text to distinguish between current 35 U.S.C. 103 and the references to pre-AIA 35 U.S.C. 103 by replacing, e.g., references to “35 U.S.C. 103(a)” with “pre-AIA 35 U.S.C. 103(a)”.</p> <p>In subsection II.A, added a reference to § 2141.01 regarding analogous art.</p>
2141.01	<p>Revised text to distinguish between current 35 U.S.C. 102 and 103 and the references to pre-AIA 35 U.S.C. 102 and 103 by replacing, e.g., references to “35 U.S.C. 102(a), 102(b), 102(e)” with “35 U.S.C. 102(a)(1) or (a)(2) or pre-AIA 35 U.S.C. 102(a), 102(b), 102(e)”;</p> <p>“35 U.S.C. 102” to “pre-AIA 35 U.S.C. 102”; and “35 U.S.C. 103” with “pre-AIA 35 U.S.C. 103”.</p>
2142	<p>Added text to state that the decision to file evidence of secondary considerations should be influenced by the goals of compact prosecution and that evidence filed after a final rejection may not be entered into the record.</p>
2143.01	<p>Moved and modified the title for subsection I by deleting “the desirability of” and adding “not necessarily negated by desirable alternatives” at the end. Also, added a sentence to</p>

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	clarify that disclosing desirable alternatives does not necessary negate a reason to modify the prior art.
2144.04	In subsection VII, deleted citation to and discussion of <i>Ex parte Gray</i> , 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989).
2144.08	Modified the title for subsection I to delete “OF CHEMICAL COMPOSITIONS.” In subsection II, deleted the citation to <i>In re Deuel</i> , 51 F.3d, 1552 (Fed. Cir. 1995). In subsection II.A.4(a), added citation to pre-AIA 35 U.S.C. 102(b) in the discussion of <i>In re Schaumann</i> , 572 F.2d 312 (CCPA 1978).
2146	Added an Editor Note that states this section has limited applicability to applications subject to examination under the first inventor to file (FITF) provisions of the AIA. Revised text to distinguish between current 35 U.S.C. 102 and 103 and the references to pre-AIA 35 U.S.C. 102 and 103 by replacing, e.g., references to “35 U.S.C. 102” with “pre-AIA 35 U.S.C. 102” and “35 U.S.C. 103(c)” with “pre-AIA 35 U.S.C. 103(c)”.
2150	Added a new section entitled “Examination Guidelines for 35 U.S.C. 102 and 103 as Amended by the First Inventor To File Provisions of the Leahy-Smith America Invents Act”. Gives a brief explanation of the continued applicability of pre-AIA 35 U.S.C. 102 and 103. For example, all applications filed prior to March 16, 2013 are subject to pre-AIA 35 U.S.C. 102 and 103 and not the current version of the statutes.
2151	Added a new section entitled “Overview of the Changes to 35 U.S.C. 102 and 103 in the AIA”. Provides a brief discussion of the AIA changes regarding the definition of prior art and its application under anticipation and obviousness. Prior art is defined in 35 U.S.C. 102(a)(1) and (2). Exceptions, such as a grace period, are set forth in 35 U.S.C. 102(b). The common ownership or joint research agreement exceptions are provided in 35 U.S.C. 102(c). Definitions of certain terms, such as “claimed invention,” “effective filing date,” “the inventor,” and “joint inventor” are briefly discussed. States that the date of invention, whether an international application was published in English (pre-AIA 35 U.S.C. 102(e)), abandonment of invention (pre-AIA 35 U.S.C. 102(c)), premature foreign patenting (pre-AIA 35 U.S.C. 102(d)), derivation (pre-AIA 35 U.S.C. 102(f)) and prior invention (pre-AIA 35 U.S.C. 102(g)) are not relevant to, or contained in, the current version of 35 U.S.C. 102. The AIA changes took effect on March 16, 2013 and are generally applicable to any application that contains a claim that has an effective filing date on or after March 16, 2013.
2152	Added a new section entitled “Detailed Discussion of AIA 35 U.S.C. 102(a) and (b)”. Recites the current version of 35 U.S.C. 102(a) and (b). Explains that 35 U.S.C. 102(a)(1) defines activities (e.g., public use or sale) and prior art documents (patents, published applications, and non-patent publications) that may be prior art and 35 U.S.C. 102(a)(2) also defines that certain patent documents may be prior art. Discusses the 35 U.S.C. 102(b) exceptions to prior art defined under 35 U.S.C. 102(a).
2152.01	Added a new section entitled “Effective Filing Date of the Claimed Invention”. Explains that the effective filing date is the earliest of the actual filing date of the application or the filing date of the earliest application for which the application is entitled to a right of priority or benefit under 35 U.S.C. 119, 120, 121, or 365. Further explains that although effective filing date is determined on a claim-by-claim basis, the application of which prior art regime (pre-AIA or the current regime) is determined on an application-by-application basis.

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2152.02	<p>Added a new section entitled “Prior Art Under AIA 35 U.S.C. 102(a)(1) (Patented, Described in a Printed Publication, or in Public Use, on Sale, or Otherwise Available to the Public)”.</p> <p>Lists the types of documents and activities that may preclude patentability, such as prior patenting, descriptions in printed publications, public use, or sales activity.</p>
2152.02(a)	<p>Added a new section entitled “Patented”.</p> <p>Discusses that, under 35 U.S.C. 102(a)(1), a patent is prior art as of its grant date if it was made available to the public as of its grant date. The patent’s entire disclosure, even subject matter is not claimed, is available as prior art.</p>
2152.02(a)	<p>Added a new section entitled “Described in a Printed Publication”.</p> <p>Explains that the AIA changes to 35 U.S.C. 102 did not change the extent to which a claimed invention must be described in order to anticipate a claimed invention. Generally, prior art will anticipate a claimed invention if it discloses each and every element of the claimed invention either explicitly or inherently and the elements are arranged or combined in the same way as the claimed invention. Also briefly discusses the differences in requirements for written description and enablement under 35 U.S.C. 112(a) for prior art and the claimed invention.</p>
2152.02(c)	<p>Added a new section entitled “In Public Use”.</p> <p>Discusses that there is no geographical limitation of where the public use or availability occurs under 35 U.S.C. 102(a)(1). Briefly mentions the pre-AIA case law concerning public use and states that public use under current 35 U.S.C. 102(a)(1) has the same substantive scope with respect to uses by either the inventor or a third party as public use by unrelated third parties under pre-AIA 35 U.S.C. 102(b) or by others under pre-AIA 35 U.S.C. 102(b).</p>
2152.02(d)	<p>Added a new section entitled “On Sale”.</p> <p>Discusses that there is no geographical limitation of where the on sale activity occurs under 35 U.S.C. 102(a)(1). Briefly mentions the pre-AIA case law concerning on sale activities and states that on sale activities under current 35 U.S.C. 102(a)(1) have the same substantive scope under pre-AIA 35 U.S.C. 102(b), except for secret activities.</p>
2152.02(d)	<p>Added a new section entitled “Otherwise Available to the Public”.</p> <p>Discusses that 35 U.S.C. 102(a)(1) includes this “catch-all” provision that defines a new additional category of potential prior art. The inclusion of this provision allows the focus to be on whether the disclosure was available to the public and not on the means by which it was disclosed or published. Court decisions pertaining to pre-AIA 35 U.S.C. 102 concerning the availability to the public of certain disclosures (e.g., a student thesis, a poster display, a laid-open patent application) are mentioned.</p>
2152.02(f)	<p>Added a new section entitled “No Requirement of ‘By Others’”.</p> <p>Explains that a key difference between pre-AIA 35 U.S.C. 102(a) and current 35 U.S.C. 102(a)(1) is that the latter eliminated the “by others” requirement of the former.</p>
2152.03	<p>Added a new section entitled “Admissions”.</p> <p>Discusses that the Office will continue to treat admissions by the applicant as prior art.</p>
2152.04	<p>Added a new section entitled “The meaning of ‘Disclosure’”.</p> <p>Explains that the AIA did not define “disclosure” and that the Office defines “disclosure” as a generic expression that encompasses documents and activities enumerated in 35 U.S.C. 102(a).</p>
2153	<p>Added a new section entitled “Prior Art Exceptions Under 35 U.S.C. 102(b)(1) to AIA 35 U.S.C. 102(a)(1)”.</p>

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	States that § 2153.01 provides for prior art exceptions based on grace period disclosures and § 2153.02 provides for prior art exceptions based on inventor or inventor-originated prior public disclosures.
2153.01	Added a new section entitled “Prior Art Exception Under AIA 35 U.S.C. 102(b)(1)(A) To AIA 35 U.S.C. 102(a)(1) (Grace Period Inventor Or Inventor-Originated Disclosure Exception)”. Discusses that the exceptions in 35 U.S.C. 102(b)(1)(A) limit the use of the inventor’s own work as prior art under 35 U.S.C. 102(a)(1).
2153.01(a)	Added a new section entitled “Grace Period Inventor Disclosure Exception”. Explains that under 35 U.S.C. 102(b)(1)(A) a disclosure that would otherwise be prior art under 35 U.S.C. 102(a)(1) may be disqualified as prior art if the disclosure was made one year or less before the effective filing date of the claimed invention and by the inventor or joint inventor. The evidence necessary to disqualify a potential prior art disclosure will be treated on a case-by-case basis. Discusses when examiner should not apply such a grace period disclosure and statements an applicant can make that designates grace period disclosures in the application’s specification. Applicants can file an affidavit or declaration to disqualify a disclosure applied as prior art under 35 U.S.C. 102(a)(1).
2153.01(b)	Added a new section entitled “Grace Period Inventor-Originated Disclosure Exception”. Explains that under 35 U.S.C. 102(b)(1)(A) a disclosure that would otherwise be prior art under 35 U.S.C. 102(a)(1) may be disqualified as prior art if the disclosure was made one year or less before the effective filing date of the claimed invention and by another who obtained the subject matter from the inventor or joint inventor. Reference is made to §§ 718 and 2155.03 concerning use of an affidavit or declaration to disqualify a disclosure as prior art under 35 U.S.C. 102(a)(1).
2153.02	Added a new section entitled “Prior Art Exception Under AIA 35 U.S.C. 102(b)(1)(B) to AIA 35 U.S.C. 102(a)(1) (Inventor Or Inventor-Originated Prior Public Disclosure Exception)”. Discusses the additional exceptions under 35 U.S.C. 102(b)(1)(B) to prior art defined under 35 U.S.C. 102(a)(1), which includes disclosures of subject matter that occurred after the inventor, joint inventor, or another who obtained the subject matter from the inventor publicly disclosed the subject matter. States that if the previous disclosure of the subject matter by the inventor, joint inventor, or another who obtained the subject matter from the inventor is made outside the grace period, that previous disclosure may be prior art under 35 U.S.C. 102(a)(1). Explains that there is no requirement that the mode of disclosure by the inventor, joint inventor, or another who obtained the subject matter from the inventor be the same as the other disclosure or that the two disclosures must be verbatim. Also discusses how the exception might apply to genus-species disclosures.
2154	Added a new section entitled “Provisions Pertaining to Subject Matter in a U.S. Patent or Application Effectively Filed Before the Effective Filing Date of the Claimed Invention”. Briefly mentions that there are three types of U.S. patent documents that are potential prior art and references §§ 2151 and 2154 <i>et seq.</i> for more information.
2154.01	Added a new section entitled “Prior Art Under AIA 35 U.S.C. 102(a)(2) ‘US Patent Documents’”. Defines the three types of U.S. patent document as (1) U.S. patents; (2) U.S. patent application publications; and (3) certain WIPO published applications. Explains that a U.S. patent document is prior art under 35 U.S.C. 102(a)(1) if its issue or publication date is before the effective filing date of the claimed invention and under 35 U.S.C. 102(a)(2) if it was “effectively filed” before the effective filing date of the claimed invention.
2154.01(a)	Added a new section entitled “WIPO Published Applications”.

	Explains that a WIPO publication of a PCT international application that designated the U.S. is deemed a U.S. patent document in accordance with 35 U.S.C. 374. Unlike pre-AIA 102(e), there is no requirement for the international application to be filed on or after November 29, 2000 or published in the English language.
2154.01(b)	Added a new section entitled “Determining When Subject Matter Was Effectively Filed Under AIA 35 U.S.C. 102(d)”. Discusses the requirements in 35 U.S.C. 102(d) to determine when a U.S. patent document was effectively filed, which will either be its actual filing date or the filing date of a prior application to which it is entitled to claim a right of priority or benefit. States that the AIA eliminated the so-called “ <i>Hilmer doctrine</i> ,” which limited the effective filing date for U.S. patents and published applications to the earliest U.S. filing date.
2154.01(c)	Added section “Requirement Of ‘Names Another Inventor’”. Explains that prior art under 35 U.S.C. 102(a)(2) must name another inventor, which means there must be a difference in the inventive entity between the prior art U.S. patent document and the application/patent under examination.
2154.02	Added a new section entitled “Prior Art Exceptions Under 35 U.S.C. 102(b)(2) to AIA 35 U.S.C. 102(a)(2)”. Briefly mentions that there are three prior art exceptions under 35 U.S.C. 102(b)(2) and references §2154.02(a), (b), or (c) for more information.
2154.02(a)	Added a new section entitled “Prior art exception under AIA 35 U.S.C. 102(b)(2)(A) to AIA 35 U.S.C. 102(a)(2) (inventor-originated disclosure exception)”. Discusses that 35 U.S.C. 102(b)(2)(A) provides an exception to prior art under 35 U.S.C. 102(a)(2) that limits the use of an inventor’s own work as prior art when it is disclosed in a U.S. patent document by another who obtained the subject matter from the inventor or joint inventor. Reference is made to § 2155.03 concerning use of an affidavit or declaration to disqualify a disclosure as prior art under 35 U.S.C. 102(a)(2).
2154.02(b)	Added a new section entitled “Prior art exception under AIA 35 U.S.C. 102(b)(2)(B) to AIA 35 U.S.C. 102(a)(2) (inventor or inventor-originated prior public disclosure exception)”. Discusses the additional exceptions under 35 U.S.C. 102(b)(2)(B) to prior art defined under 35 U.S.C. 102(a)(2), which includes disclosures of subject matter in a U.S. patent document that occurred after the inventor, joint inventor, or another who obtained the subject matter from the inventor publicly disclosed the subject matter. States that if the previous disclosure of the subject matter by the inventor, joint inventor, or another who obtained the subject matter from the inventor is made outside the grace period, that previous disclosure may be prior art under 35 U.S.C. 102(a)(1). Reference is made to §§ 2155.02 and 2155.03 concerning use of an affidavit or declaration to disqualify a disclosure as prior art under 35 U.S.C. 102(a)(2). Explains that there is no requirement that mode of disclosure by the inventor, joint inventor, or another who obtained the subject matter from the inventor be the same as the other disclosure or that the two disclosures must be verbatim. Also discusses how the exception might apply to genus-species disclosures.
2154.02(c)	Added a new section entitled “Prior art exception under AIA 35 U.S.C. 102(b)(2)(C) to AIA 35 U.S.C. 102(a)(2) (common ownership or obligation of assignment)”. Explains that 35 U.S.C. 102(b)(2)(C) provides an additional exception to prior art under 35 U.S.C. 102(a)(2), which disqualifies subject matter disclosed in U.S. patent documents if the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person. If the requirements for this exception are met, the U.S. patent document cannot be applied in either an anticipation under 35 U.S.C. 102(a)(2) or

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	<p>obviousness rejection but may still be the basis for an obviousness-type double patenting rejection. Applicants must provide a clear and conspicuous statement that the claimed invention and the subject matter disclosed were commonly owned and refers to 37 CFR 1.104.</p>
<u>2155</u>	<p>Added a new section entitled “Use of Affidavits or Declarations Under 37 CFR 1.130 To Overcome Prior Art Rejections”.</p> <p>Recites 37 CFR 1.130 and explains that it provides a mechanism to filing an affidavit or declaration to disqualify a disclosure as prior art under 35 U.S.C. 102(a).</p>
<u>2155.01</u>	<p>Added a new section entitled “Showing That the Disclosure Was Made by the Inventor or a Joint Inventor”.</p> <p>Discusses the requirements for showing that the disclosure was made by the inventor or a joint inventor, e.g., an “unequivocal” statement to that effect from the inventor or joint inventor along with a reasonable explanation of the presence of additional authors may be sufficient in some circumstances.</p>
<u>2155.02</u>	<p>Added a new section entitled “Showing That the Disclosure was Made, or That Subject Matter had Been Previously Publicly Disclosed, by Another Who Obtained the Subject Matter Disclosed Directly or Indirectly From the Inventor or a Joint Inventor”.</p> <p>Explains the requirements for an affidavit or declaration to show that a disclosure of subject matter occurred after another who obtained the subject matter from the inventor publicly disclosed the subject matter. The affidavit or declaration should include any evidence that show communication of the subject matter by the inventor or joint inventor to the entity that made the disclosure.</p>
<u>2155.03</u>	<p>Added a new section entitled “Showing That the Disclosure was Made, or That Subject Matter had Been Previously Publicly Disclosed, by Another Who Obtained the Subject Matter Disclosed Directly or Indirectly From the Inventor or a Joint Inventor”.</p> <p>Explains the requirements for an affidavit or declaration to show that a disclosure of subject matter occurred after another who obtained the subject matter from the inventor publicly disclosed the subject matter. The affidavit or declaration should include any evidence that show communication of the subject matter by the inventor or joint inventor to the entity that made the disclosure.</p>
<u>2155.04</u>	<p>Added a new section entitled “Enablement”.</p> <p>Provides that an affidavit or declaration under 37 CFR 1.130(a) or (b) does not need to demonstrate that the disclosure by the inventor, joint inventor, or another who obtained the subject matter from the inventor was enabling.</p>
<u>2155.05</u>	<p>Added a new section entitled “Who May File an Affidavit or Declaration Under 37 CFR 1.130”.</p> <p>Explains that the applicant or patent owner may file an affidavit or declaration under 37 CFR 1.130(a) or (b). In certain circumstances, the inventor may sign the affidavit or declaration but cannot file it.</p>
<u>2155.05</u>	<p>Added a new section entitled “Situations in Which an Affidavit or Declaration Is Not Available”.</p> <p>Discusses that an affidavit or declaration under 37 CFR 1.130 cannot be filed if the rejection under 35 U.S.C. 102(a)(1) is based upon a disclosure made more than one year before the effective filing date of the claimed invention and in some circumstances, if the rejection is based on a U.S. patent or patent application claiming the same invention.</p>
<u>2156</u>	<p>Added a new section entitled “Joint Research Agreements”.</p> <p>Recites 35 U.S.C. 102(c) and explains that there are three conditions that must be met to disqualify subject matter as prior art under this provision. It explains that the provisions of 35 U.S.C. 102(c) are generally the same as those provided in the CREATE Act of 2004</p>

	<p>except 35 U.S.C. 102(c) is keyed to the effective filing date instead of the date the invention was made and that 35 U.S.C. 102(c) applies to disclosures applied in both anticipation and obviousness rejections. States that in order to invoke a joint research agreement (JRA) to disqualify a disclosure as prior art, the applicant must provide a statement that the disclosure and the claimed invention were made by or on behalf of parties to a JRA that was in effect on or before the effective filing date of the claimed invention and that the claimed invention was made as a result of activities undertaken within the scope of the JRA. Applicant may, but is not required, to submit supporting evidence. This exception does not apply to disclosures that are prior art under 35 U.S.C. 102(a)(1).</p>
<u>2157</u>	<p>Added a new section entitled “Improper Naming of Inventors”. Explains that although pre-AIA 35 U.S.C. 102(f) was eliminated by the AIA, patent laws still require the correct naming of the actual inventor(s) and refers to 35 U.S.C. 101 and 115.</p>
<u>2158</u>	<p>Added a new section entitled “AIA 35 U.S.C. 103”. Discusses some differences between current 35 U.S.C. 103 and pre-AIA 35 U.S.C. 103(a), such as obviousness is determined as of the effective filing date for the former instead of at the time the invention was made. Explains that the provisions of pre-AIA 35 U.S.C. 103(b) and (c) have been eliminated.</p>
<u>2159</u>	<p>Added a new section entitled “Applicability Date Provisions and Determining Whether an Application Is Subject to the First Inventor To File Provisions of the AIA”. States that the effective filing date of the claimed invention must be determined to know whether to apply pre-AIA 35 U.S.C. 102/103 or current 35 U.S.C. 102/103.</p>
<u>2159.01</u>	<p>Added a new section entitled “Applications Filed Before March 16, 2013”. Explains that for applications filed before March 16, 2013, pre-AIA 35 U.S.C. 102/103 applies even if a request for continued examination is filed after March 16, 2013. Similarly, pre-AIA 35 U.S.C. 102/103 applies to a PCT international application filed before March 16, 2013 even if it enters the national stage after March 16, 2013.</p>
<u>2159.02</u>	<p>Added a new section entitled “Applications Filed on or After March 16, 2013”. Discusses when 35 U.S.C. 102/103, as changed by the AIA, are applicable to applications filed on or after March 16, 2013. For example, if such an application contains, at any time, a claim that has an effective filing date after March 16, 2013, it is subject to AIA 35 U.S.C. 102/103. Provides an explanation for how claims that contain new matter are treated for purposes of determining whether the claims have an effective filing date on or after March 16, 2013.</p>
<u>2159.03</u>	<p>Added a new section entitled “Applications Subject to the AIA but Also Containing a Claimed Invention Having an Effective Filing Date Before March 16, 2013”. Explains that even if AIA 35 U.S.C. 102 and 103 apply to an application, pre-AIA 35 U.S.C. 102(g) may also apply if the application contains, at any time, a claimed invention having an effective filing date before March 16, 2013 or is designated as a continuing application of an application that contains such a claim.</p>
<u>2159.04</u>	<p>Added a new section entitled “Applicant Statement in Transition Applications Containing a Claimed Invention Having an Effective Filing Date On or After March 16, 2013”. States that if an application is filed on or after March 16, 2013, claims the benefit of, or priority to, an application filed before March 16, 2013, and also contains a claim having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect.</p>
<u>2161</u>	<p>Modified the title to “Three Separate Requirements for Specification Under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph”. Added recitation of 35 U.S.C. 112(a).</p>

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	Added citation to <i>Ariad Pharm., Inc. v. Eli Lilly and Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010) (<i>en banc</i>) to support the statement that the written description requirement is separate and distinct from the enablement requirement.
2161	Revised title to “Computer Programming and 35 USC 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph”.
2162	Revised title to “Policy Underlying 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, First Paragraph”.
2163	Revised title to “Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112(a) or pre-AIA 35 USC 112, para. 1, ‘Written Description’ Requirement”.
2163.06	Clarified text regarding the two statutory provisions that prohibit the introduction of new matter. In subsection II, changed “Board of Patent Appeals and Interferences” to “Patent Trial and Appeal Board”.
2164	Revised text regarding claim limitations not found in the specification to clarify when there is not an enablement problem.
2164.06(c)	Added a reference to § 2161.01 where a computer invention is claimed using functional language that is not limited to a specific structure. In subsection I, deleted text that discussed complex systems and the need for disclosure of timing between various system elements. In subsection III, changed “routinier” to “person of ordinary skill”.
2164.07	In subsection I.B., added a citation to <i>In re Fischer</i> , 421 F.3d 1365 (Fed. Cir. 2005) to support the statement that burden shifts to applicant to provide rebuttal evidence once the examiner has provided evidence of a lack of utility.
2165	Revised text indicating the best mode requirements for (1) applications filed before September 16, 2012 and (2) applications filed on or after September 16, 2012. In subsection I, deleted the quote from <i>Eli Lilly & Co. v. Barr Laboratories</i> , 251 F.3d 955 (Fed. Cir. 2001). In subsection II, added text to indicate that 35 U.S.C. 119(e) and 120 refer to 35 U.S.C. 112(a) rather than pre-AIA 35 U.S.C. 112, first paragraph.
2165	Revised text to clarify that during <i>inter partes</i> proceedings, information necessary for making a best mode rejection may be uncovered.
2171	Added recitation of 35 U.S.C. 112(b). Changed “applicants” to “inventor or joint inventor” or “applicant” to “inventor” and added text to clarify that pre-AIA 35 U.S.C. 112, second paragraph, uses the phrase “which applicant regards as his invention” and pre-AIA 37 CFR 1.41(a) provides that a patent is applied for in the name or names of the actual inventor or inventors.
2172	Changed “applicants” to “inventor or joint inventor” or “applicant” to “inventor”.
2173.02	In subsection II, deleted language that stated the examiner should suggest improved claim language in place of making an indefiniteness rejection and deleted the example of use of the phrase “such as”.
2173.04	Added text to clarify that a claim is indefinite when the boundaries of the protected subject matter are not clearly delineated and the scope is unclear and provided an example.
2173.05	Revised title to “Specific Topics Related to Issues Under 35 U.S.C. 112(b) or Pre-AIA 35 U.S.C. 112, Second Paragraph”.
2173.05(a)	In subsection III, deleted the citation to <i>Tex. Digital Sys., Inc. v. Telegenix, Inc.</i> , 308 F.3d 1193 (Fed. Cir. 2002).
2173.05(b)	In subsection I, added text to clarify that applicant may provide evidence to overcome an indefiniteness rejection.

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	In subsection II, added text to further discuss <i>Ex parte Miyazaki</i> and <i>Ex parte Brummer</i> .
2173.05(c)	In subsection II, added a quote from <i>In re Kirsch</i> (CCPA 1974) in the discussion of claims directed to a chemical reaction process.
2173.05(d)	Added text to clarify that mere use of the phrases “such as” or “for example” does not by itself render a claim indefinite.
2173.05(f)	Added text that examiners should determine compliance with 35 U.S.C. 112(d) or pre-AIA 35 U.S.C. 112, fourth paragraph, for dependent claims.
2173.05(g)	Rearranged text to group examples together.
2173.05(u)	Deleted reference to a list of trademarks found in Appendix I.
2174	Revised title to “Relationship Between the Requirements of 35 U.S.C. 112(a) and (b) or Pre-AIA 35 U.S.C. 112, first and second paragraphs”.
2181	<p>Revised title to “Identifying and Interpreting a 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, Sixth Paragraph Limitation”.</p> <p>Removed text discussing the treatment of a means-or-step-plus-function limitation before the decision of <i>In re Donaldson Co.</i> and added text discussing the broadest reasonable interpretation of such a limitation.</p> <p>In subsection I, revised text to reflect that a “means-or-step-plus-function” limitation may be invoked by using the term “means”, “step” or the negative presumption that a claim without either terms may be overcome by the use of a generic placeholder. Added text defining a generic placeholder that is used as a substitute for the term “means”.</p> <p>In subsection II.B, added text discussing computer-implemented means-plus-function limitations, which includes citations to <i>In re Aoyama</i>, 656 F.3d 1293 (Fed. Cir. 2011); <i>In re Alappat</i>, 33 F.3d 1526 (Fed. Cir. 1994); <i>Noah Systems Inc. v. Intuit Inc.</i>, 675 F.3d 1302, 1312 (Fed. Cir. 2012); <i>Aristocrat</i>, 521 F.3d at 1333. Revised text regarding special purpose computers and algorithms. For example, added text that discussed two distinct groups, one in which there is no algorithm in the specification and a second in which there is an algorithm but there is an issue as to whether it is adequate to perform the entire claimed function. Deleted text discussing the situation where one of ordinary skill in the art may be capable of writing software to convert a general purpose computer to a special purpose computer.</p> <p>In subsection IV, added text that addresses whether a rejection under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph, is appropriate for the same reason as the indefiniteness rejection and adds a quotation from <i>Ariad Pharm. Inc. v. Eli Lilly Co.</i>, 598 F.3d 1336 (Fed. Cir. 2010) (en banc). Also added text to explain that merely restating a function associated with a means-plus-function limitation is not sufficient, including citations to <i>Noah</i>, 675 F.3d at 1317, 102 USPQ2d at 1419; <i>Blackboard</i>, 574 F.3d at 1384; <i>Aristocrat</i>, 521 F.3d at 1334, 86 USPQ2d at 1239.</p> <p>In subsection V, revised text to provide a definition of a single means claim and to provide a further explanation as to why a single means claim does not comply with 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.</p> <p>In subsection VI, added text to clarify that the two rebuttable presumptions regarding the application of 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph, should be established in the prosecution record. If rebutted, the record should reflect an explanation as to why the presumption was rebutted. The two rebuttable presumptions are explicitly defined.</p>
2182	<p>Modified title to delete “Scope of the.”</p> <p>Revised text to delete reference to and discussion of <i>In re Donaldson</i>, 16 F.3d 1189 (Fed. Cir. 1994).</p>

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<u>2201</u>	<p>Revised to delete reference to and text discussing Public Law 106-113 and the implementing final rules.</p> <p>Added text describing changes, affected by the Leahy-Smith America Invents Act (AIA), which expand the scope of information that any party may cite in a patent file to include written statements by a patent owner made in a proceeding before a Federal court or the USPTO regarding the scope of any claim of the patent.</p> <p>Revised to mention the AIA provision for first-to-file prior art regime to replace the first-to-invent prior art regime and its possible applications during a reexamination proceeding. Added text to state that all citations to 35 U.S.C. discussing the first-to-invent prior art regime (as opposed to the first-inventor-to-file prior art regime) are to the provisions in effect prior to March 16, 2013.</p> <p>Added a discussion about the new supplemental examination proceedings, which may lead to <i>ex parte</i> reexamination if a substantial new question of patentability (SNQ) is raised.</p> <p>Revised to indicate that the <i>inter partes</i> reexamination proceedings were replaced with an <i>inter partes</i> review process by the AIA. Reference to MPEP 2600 for guidance on <i>inter partes</i> reexamination proceedings was inserted.</p>
<u>2202</u>	<p>Title revised to add “and Written Statements.”</p> <p>Revised to recite 35 U.S.C. 301, 37 CFR 1.501, 1.502, and 1.902 as revised by the AIA or the implementing regulatory changes.</p> <p>Added text explaining that any party may cite, in a patent file, written statements by a patent owner made in a proceeding before a Federal court or the USPTO regarding the scope of any claim of the patent.</p>
<u>2203</u>	<p>Title revised to add “or Written Statements.”</p> <p>Revised to reflect changes made to 35 U.S.C. 301, which now permits any person to file statements of the patent owner made in proceedings before a Federal court or the Office in which the patent owner took a position on claim scope of a particular patent. Further revised to state that the filer can keep their identity confidential but any filing still must be served under 37 CFR 1.248(b).</p> <p>Patent examiners are cautioned not to prepare or file such statements.</p>
<u>2204</u>	<p>Title revised to add “or Section 301 Written Statements.”</p> <p>Revised to replace “citation” with “submission”; amended to reference 37 CFR 1.501(c) instead of 37 CFR 1.501(a) regarding submissions filed after the date of any order of reexamination; and revised to delete text stating that an <i>inter partes</i> reexamination requester who also submits the fee and other documents required under 37 CFR 1.915 may file a submission after the date of an order to reexamine.</p>
<u>2205</u>	<p>Title revised to add “or Section 301 Written Statements.”</p> <p>Added text explaining that any party may cite, in a patent file, written statements by a patent owner made in a proceeding before a Federal court or the USPTO regarding the scope of any claim of the patent. Text is added to discuss the content of any submission citing a patent owner’s written statement. Revised to replace “citation” with “submission” in order to apply requirements to both prior art citations and written statement filings. Further revised to require copies of written statements and any necessary English translations.</p> <p>Revised to indicate that a submission that includes a written statement must also include any other additional information, e.g. documents, pleadings, or evidence, in which the statement was made.</p> <p>Revised to discuss that a submission that includes written statements must, pursuant to 37 CFR 1.501(a)(3), further include the identification of: (1) The forum and proceeding in which patent owner filed each statement; (2) The specific papers and portions of the papers submitted that contain the statements; and (3) How each statement submitted is a statement in which patent</p>

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	<p>owner took a position on the scope of any claim in the patent. Other identifying information may be filed.</p> <p>Revised to indicate that all submissions must be served on the patent owner as required by 37 CFR 1.248(b).</p> <p>Revised examples to include a citation to particular portions of the prior art references cited. Deleted text regarding the explanation of the pertinence and manner of applying the prior art would be met by a statement that the art was made of record in a foreign or domestic application have the same or related invention; the statement that a duplicate copy of the submission may be filed if service on the patent owner is not possible; and the statement that the most recent address of the attorney or agent of record may be obtained from the Office’s register of registered patent attorneys and agents maintained by the Office of Enrollment and Discipline.</p>
2206	<p>Title revised to add “or Section 301 Written Statements.”</p> <p>Revised to replace “citation” with “submission” in order to apply requirements to both prior art citations and written statement filings. Text is added to discuss the handling of any submission citing a patent owner’s written statement.</p> <p>In subsection I.A.1, deleted text regarding treatment if no reexamination is pending and regarding service or the filing of duplicate copies of the citation, including the Office’s treatment of such. In subsection I.A.2, changed “sender” to “third party submitter” or “submitter” and modified example to replace “prior art citation” with “submission” or the like.</p> <p>In subsections I.B. and II.B, deleted the diagrams showing various situations of handling prior art citations.</p> <p>In subsection II.A, is revised to clarify that if a 37 CFR 1.501 submission is not proper it will not be entered into the file. The patent owner and the submitter (if known) will be notified that the submission is improper. Also revised to clarify that the submission must include an indication of service or a satisfactory showing that service under 37 CFR 1.248(a) was not practicable. Deleted text pertaining to the filing of duplication copies of the citation.</p>
2207	<p>No substantive changes – minor corrections/clarifications.</p>
2208	<p>Title revised to “Service of Prior Art or Written Statements on Patent Owner.”</p> <p>Revised to include the filing of “written statements and additional Information” in the service requirements.</p> <p>Added text to state that the submission must include an indication of service or a satisfactory showing that service under 37 CFR 1.248(a) was not practicable.</p>
2209	<p>Changed citation to 37 CFR 10.18(b) to 37 CFR 11.18(b) regarding certificates for correspondence filed in the Office.</p>
2210	<p>Modified to recite 35 U.S.C. 302 and 37 CFR 1.510 as revised by the AIA or the implementing regulatory changes.</p> <p>Revised to discuss the estoppel provisions of 35 U.S.C. 315(e)(1) and 35 U.S.C. 325(e)(1) with regard to <i>ex parte</i> reexamination.</p>
2211	<p>Added text to clarify that the period of enforceability is “generally” six years after the patent expires but may be extended if there is pending litigation.</p>
2212	<p>Modified to recite 37 CFR 1.510(a) as revised by the AIA implementing regulatory changes. Revised to reflect AIA changes to 35 U.S.C. 315 and 35 U.S.C. 325, that the only person barred from filing <i>ex parte</i> reexamination request is one who is barred by the estoppel provisions of 35 U.S.C. 315(e)(1) and 35 U.S.C. 325(e)(1).</p> <p>Deleted text stating that Director’s ordered reexamination will be initiated on a very limited basis.</p>
2212.01	<p>Revised to replace “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.”</p> <p>Changed citation to 37 CFR 10.23 to 37 CFR 11.804 regarding misconduct.</p>

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2213	Changed “an attorney or other person” to “any person” pertaining to who cannot represent a patent owner in a reexamination proceeding.
2214	Modified to recite 37 CFR 1.510 as revised by the AIA implementing regulatory changes. Revised to discuss new requirements of 37 CFR 1.501(a)(2) and 37 CFR 1.510(b)(2) for the <i>ex parte</i> reexamination requester to explain how a statement of the patent owner is being used to determine the proper meaning of a patent claim in connection with prior art applied to that claim. Revised to explain new requirements of 37 CFR 1.510(b)(6) that the request contain a certification by the third party requester that the statutory estoppel provisions of <i>inter partes</i> review and post grant review do not bar the third party from requesting <i>ex parte</i> reexamination. Replaced an older version of form PTO/SB/57 with the latest version.
2215	Revised by discussing 37 CFR 1.20(c)(1) and explaining that there are different <i>ex parte</i> reexamination filing fees for a large entity, a small entity and a micro entity.
2216	Corrected the citation to <i>KSR International Co. v. Teleflex Inc.</i> (KSR), 550 U.S. 398, 82 USPQ2d 1385 (2007). Deleted “concluded” modifying the earlier reexamination in the discussion of old art being the basis for a SNQ.
2217	Revised to reflect AIA provision concerning the first-to-file prior art regime. Added a discussion pertaining to which prior art regime will be applied and how to analyze the SNQ determination. Generally, the prior art regime under which the application for the patent was examined (the first-to-file prior art regime, or the first-to-invent prior art regime) will be applied in reexamination of the patent. Revised to delete reference to MPEP § 706.02(1)(1) for information pertaining to references which qualify as prior art under 35 U.S.C. 102(e)/103. Changed the citation to MPEP § 201.11 to § 211.05 regarding intervening art. In subsection I, revised to clarify that a request for reexamination must not include citations to background references which are not used to support a SNQ or proposed rejection of the claims. The examples of inappropriate language were revised by replacing the recitation of “35 U.S.C. 102(b)” with “35 U.S.C. 102.”
2219	Deleted the statement that the U.S. Patent and Trademark Office will prepare a separate file for each reexamination request.
2222	Changed the citation to 37 CFR 10.23(c)(8) to 37 CFR 11.104 and clarified text regarding termination of the attorney-client relationship. Also, added a citation to 37 CFR 1.116(d). Deleted text that discussed former 37 CFR 10.23(c)(8). Changed the citation and copy of form PTO/SB/82 to form PTO/SB/81 for changing correspondence address or power of attorney.
2223	Revised to discuss the new requirements for withdrawal of attorney or agent, pursuant to 37 CFR 11.116. The Office no longer requires that there be at least 30 days remaining in any running period for response between the approval of a request to withdraw from representation and the expiration date of any running period for response.
2226	Modified statement that all initial clerical processing is performed by staff in the Office of Patent Legal Administration to the Office of Patent Application Processing (OPAP).
2227	In subsection B, replaced “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.”
2233	Revised by replacing “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).” Revised to indicate the working groups in the Central Reexamination Unit or Technology Centers have designated the legal instrument examiners and paralegals to act as reexamination clerks.

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	In subsection I, deleted the reference to 37 CFR 1.550(c) for extension of time fees; changed “brief” to “appeal forwarding fee”; deleted the reference to 37 CFR 1.137, 1.182, or 1.183 regarding petitions; and changed reference to 37 CFR 1.17(f), (l), and (m) to 37 CFR 1.17(m) and 37 CFR 1.20(a)(6) and (a)(7) for petition fees. Revised to indicate that small entity and micro entity reductions are available for the patent owner for fees for the request, petition fees, excess claims fees, appeal fees, appeal forwarding fee, and oral hearing fees. Small entity reduction is available for third party requesters for request filing fee and petition fees.
2235	In subsection (D), replaced “reexamination clerk” with “Central Reexamination Unit” in the discussion of who reports events in the proceedings. In subsection (E), deleted “tickler” in modifying reports for events.
2236	Revised by replacing “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.” In Subsection II, inserted “(notifying)” after “alerting” and modified the statement in regards to any “request challenging the assignment of an ‘examiner to the case’ must be made” to any “paper altering (notifying) the Office to the assignment to an ‘original examiner’ must be filed” within two months of the first Office action or other Office communication.
2237	Revised by replacing “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.”
2238	Deleted the statement that reexamination fees are based on full cost recovery.
2240	Revised to recite 35 U.S.C. 303, 37 CFR 1.501, and 37 CFR 1.515 as revised by the AIA or the implementing regulatory changes. Clarified that the litigation search report can come from Technical Support Staff (TSS) of the CRU and changed “STIC” search to “litigation” search. Revised by replacing “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).” Added text to discuss that a patent owner claim scope statement and any accompanying information submitted pursuant to 37 CFR 1.501(a)(2) will not be considered by the examiner when making the determination of whether to order <i>ex parte</i> reexamination but will be considered during examination if reexamination is ordered.
2242	In subsection I, deleted citation to <i>In re Etter</i> , 756 F.2d 852 (Fed. Cir. 1985) and <i>Heinl v. Godici</i> , 143 F. Supp.2d 593 (E.D. Va. 2001) and related text. Revised to state that an examiner makes the determination and the examiner’s determination may be reconsidered as follows: if reexamination is denied – as set forth in MPEP § 2248; and if reexamination is granted – as set forth in MPEP § 2246, part II. In subsection I, revised to clarify that if a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability, it can be re-presented in a new reexamination request. In subsection I, corrected the citation to <i>KSR International Co. v. Teleflex Inc.</i> (KSR), 550 U.S. 398, 82 USPQ2d 1385 (2007). In subsection II.A, clarified that material new argument or interpretation may be based solely on the scope of claims and deleted “concluded” modifying earlier reexamination in form paragraph 22.01.01. In subsection II.C, replaced “Board of Patent Appeals and Interferences” with “Board” or “Patent Trial and Appeal Board or Board of Patent Appeals and Interferences (Board).” In subsection III.A, revised to insert reference to <i>In re Swanson</i> , 540 F.3d 1368, 1378 (Fed. Cir. 2008) and <i>In re Baxter International Inc.</i> , 678 F.3d 1357, 102 USPQ2d 1925 (Fed. Cir. 2012) regarding the impact of prior court decisions on SNQ determinations.
2246	Revised to recite 35 U.S.C. 304 as revised by the AIA. Revised by replacing “SPE” with “SPRS.”

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	<p>Modified to limit the possible application of 35 U.S.C. 102(c) “for reexamination proceedings examined under the first-to-invent prior art regime.”</p> <p>The recitation of form paragraph 22.73 was revised to include updated correspondence information.</p> <p>Revised subsection I to clarify the process of preparing a decision on the request. Specifically, after an examiner is assigned to the proceeding, the examiner may prepare for a panel review conference by drafting a decision on the reexamination request and if applicable, a first Office action. After the conference is conducted and the decision and if applicable, the first Office action, are confirmed, the decision and action are prepared for mailing.</p> <p>In subsection II, the title was revised to “SEEKING REVIEW OF A FINDING OF A SUBSTANTIAL NEW QUESTION OF PATENTABILITY IN <i>EX PARTE</i> REEXAMINATION PROCEEDINGS.”</p> <p>Revised subsection II to delete the statement that neither the patent owner nor the requestor has a right to petition, or request reconsideration of, a finding that prior art patents or printed publications raise a substantial new question after a request for reexamination is granted. In the deleted text’s place, revised to discuss that a patent owner may challenge the correctness of the decision to grant an order for <i>ex parte</i> reexamination on the basis that there is no SNQ by requesting reconsideration of the examiner’s SNQ determination in a patent owner’s statement under 37 CFR 1.530. If the examiner maintains their determination, then further review can be sought via appeal to the Board. In order to preserve the appeal right, a patent owner must have first requested reconsideration of the SNQ issue by the examiner. In addition, a patent owner may file a petition under 37 CFR 1.181(a)(3) to vacate an <i>ex parte</i> reexamination order as “<i>ultra vires</i>.”</p> <p>In subsection II, in the listing of “Appropriate circumstance” for filing a petition under 37 CFR 1.181(a)(3), item (A) is revised to clarify that it is only when reexamination is ordered that is facially not based on prior art patents or printed publications; item (B) was amended to clarify that it is the claims of the patent “for which reexamination was ordered” that is being discussed; and item (E) was deleted. Revised to clarify there is no right to petition, as an “<i>ultra vires</i>” action by the Office, if the finding of a SNQ is based on reasons other than advanced by the requester (or based on less than all the grounds urged by the requester).</p>
<p>2247</p>	<p>Deleted “concluded” modifying the earlier reexamination in item (A) in the listing of reasons for denying a reexamination request.</p> <p>Modified to limit the possible application of 35 U.S.C. 102(c) “for reexamination proceedings examined under the first-to-invent prior art regime.”</p> <p>Clarified the process of preparing a denial of the request. Specifically, after an examiner is assigned to the proceeding, the examiner may prepare for a panel review conference by drafting a decision on the reexamination request. After the conference is conducted and the decision is confirmed, the decision is prepared for mailing.</p>
<p>2247.01</p>	<p>The recitation of form paragraph 22.73 was revised to include updated correspondence information.</p>
<p>2248</p>	<p>Revised to indicate that after a request for reexamination has been denied, the CRU will allow time for a petition seeking review of the examiner’s determination.</p> <p>Revised by replacing “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).”</p> <p>Revised to clarify that 37 CFR 1.515(c) applies only to challenging a basis for denying reexamination; it does not apply to challenging a basis for granting reexamination.</p> <p>Revised to indicate that a petition under 37 CFR 1.515(c) may be filed if an order granting reexamination includes a determination there is no SNQ for one claim, even if a SNQ is raised for at least one other claim. Also revised to explain that a petition may be filed requesting review</p>

	of a decision granting a request for reexamination if not granted based on all the grounds advanced in the request.
2249	<p>Revised to indicate that a statement filed by patent owner subsequent to the filing of the request but prior to the order for reexamination, will be expunged if inadvertently entered into the record. Deleted text that stated a one-month extension of time may be granted based upon good and sufficient reasons and relocated text that any extension of time would be granted only in the most extraordinary situations.</p> <p>Changed “Reexamination Clerk” to “Central Reexamination Unit.”</p> <p>Added text to describe the waiver of statement program in which the examiner would be permitted to provide a first Office action with or shortly after the order if patent owner agrees to waive their right to file a patent owner’s statement.</p>
2249	Modified to recite a revised version of 37 CFR 1.52.
2250.01	Amended to clarify the procedures for submitting new or amended drawings in that changes must be submitted as a separate paper labeled an “Annotated Sheet” and each figure on a single drawing sheet must be marked as “amended” or “new,” as appropriate.
2250.03	<p>Revised title to add “and for Filing a Petition.”</p> <p>Deleted the recitation of 37 CFR 1.20.</p> <p>Divided into two subsections: I. Fees for adding claims and II. Fees for filing a petition in reexamination. Subsection I contains the original text. The text in subsection II is newly added to explain petition fees required by 37 CFR 1.550(i).</p>
2252	Replaced “reexamination clerk” with “Central Reexamination Unit.”
2254	Modified to recite 35 U.S.C. 305 as revised by the AIA and 37 CFR 1.550 as revised by implementing regulations. 37 CFR 1.550(i) was newly added to provide for a petition fee in <i>ex parte</i> reexaminations.
2258	<p>Revised to recite amended 37 CFR 1.552, which added part (d) concerning a statement of the patent owner.</p> <p>Subsection I is revised to discuss which prior art regime will be applied in reexamination. Generally, the prior art regime under which the application for the patent was examined (the first-to-file prior art regime, or the first-to-invent prior art regime) will be applied in reexamination. Revised to note that that all citations to 35 U.S.C. discussing the first-to-invent prior art regime are to the relevant statute in effect on March 15, 2013.</p> <p>In subsection I.D, deleted subheading “1. General Considerations”; and the entirety of the text under sub-section 2 (Where Double Patenting May Be Present) and sub-section 3 (Joint Research Agreement).</p> <p>In subsection I.F.1, added text to state that a written statement of the patent owner under 37 CFR 1.501(a)(2) and accompanying 37 CFR 1.510(b)(2) explanation cannot be considered in making the initial reexamination determination.</p> <p>In subsection I.F.2, added text to explain the requirements that must be met in the request if a written statement of the patent owner under 37 CFR 1.501(a)(2) is filed with the request and that the examiner will consider the explanation during the examination stage if reexamination is ordered. Changed “Board of Appeals” to “Board” when discussing decisions on use of an admission.</p> <p>In subsection I.G, added text to discuss a written statement of the patent owner under 37 CFR 1.501(a)(2) and accompanying 37 CFR 1.510(b)(2) explanation can be filed but will not be considered until the examination stage if reexamination is ordered. Revised to insert reference to <i>Ex parte Papst-Motoren</i>, 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986) to support the statement that claims of an expired patent are construed pursuant to the principles set forth by the court in <i>Phillips</i>.</p>

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	<p>In subsection IV.G, changed the citation of 37 CFR 1.131 to 37 CFR 1.131(a) and 37 CFR 1.130 to 37 CFR 1.131(c) and “swear back of” to “swear behind.”</p> <p>In subsection IV.H, added text to clarify that “abandonment under 35 U.S.C. 102(c)” refers to patents that were examined, or reexamination proceedings examined, under the first-to-invent prior art regime.</p> <p>Added new subsection IV. J to explain that no preissuance submissions are permitted in <i>ex parte</i> reexamination proceedings.</p>
2258.01	<p>Updated the recitation of form paragraph ¶ 22.01.01 to the current version, which deletes the term “concluded” from “earlier concluded examination.”</p> <p>Changed the citation of 37 CFR 1.131 to 37 CFR 1.131(a).</p>
2260	<p>Deleted the recitation of 37 CFR 1.104 and added text to state that 37 CFR 1.104 applies to examination in reexamination proceedings.</p>
2261	<p>Modified to provide a recitation 35 U.S.C. 305, as revised by the AIA.</p>
2262	<p>Deleted the sentence “All Office actions are to be typed.” Changed “... cut and paste the claim chart (or other material) to incorporate it within the Office action” to “... bodily incorporate the claim chart (or other material) within the Office action.”</p> <p>Added text to explain if a written statement of the patent owner under 37 CFR 1.501(a)(2) is relied upon, the requester must have provided the required explanation and that the examiner will consider the explanation when drafting the Office action.</p> <p>In subsection I, the title was revised to “PROCESS OF PREPARING THE ACTION” and the text was revised to indicate that the examiner will prepare for and set up a panel review conference as per MPEP § 2271.01. After the conference is conducted and the Office action is confirmed, the action is prepared for mailing.</p> <p>In subsection II, the sample Office action was updated to provide clarifications, such as stating that the quoted 35 U.S.C. 103 is the version in effect on March 15, 2013, and current correspondence information.</p>
2265	<p>Changed “Board of Patent Appeals and Interferences” to “Board.”</p>
2266	<p>Updated recitation of 37 CFR 1.550, which includes new provision (i) that requires a fee for filing petitions in reexaminations.</p>
2266.02	<p>Revised example (C) of defects to change “person” to “non-practitioner.”</p>
2266.03	<p>Replaced “reexamination clerk” with “Central Reexamination Unit.”</p>
2267	<p>Subsection I is revised to state that inappropriate papers may be returned or discarded at the Office’s option and to delete the statement regarding the reexamination clerk.</p> <p>In subsection III, the title was revised to change “LOCATED” to “RETAINED.”</p>
2270	<p>Revised to state that legal instrument examiners and paralegals will handle most initial clerical processing of the reexamination file.</p> <p>Revised to replace “Central Reexamination (CRU) Supervisory Patent Examiner (SPE)” with “Central Reexamination Unit (CRU) Supervisory Patent Reexamination Specialist (SPRS).”</p>
2271	<p>Changed the citation of 37 CFR 1.131 to 37 CFR 1.131(a).</p> <p>In subsection I, changed the title to “PROCESS OF PREPARING THE ACTION” and revised the text to indicate that after the examiner has determined that a final Office action is appropriate, the examiner will set up a panel review conference as per MPEP § 2271.01.</p>
2271.01	<p>In subsection I, revised to indicate that a conference have be three “or more” members.</p> <p>In subsection II, revised to indicate that a conference have be three “or more” members and that all conferees will initial the action.</p> <p>Revised subsection III to indicate that the conference members can be two “or more” other members.</p>
2272	<p>Changed the citation of 37 CFR 1.131 to 37 CFR 1.131(a).</p>

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2273	<p>Modified to provide a recitation 35 U.S.C. 306, as revised by the AIA. Changed “Board of Patent Appeals and Interferences” to “Board.” Deleted the phrase “by the patent owner or his or her attorney or agent” regarding no requirement to sign the notice of appeal.</p>
2274	<p>In subsection V, changed “Board of Patent Appeals and Interferences” to “Board.” In subsection VI, changed the title to “SEEKING REVIEW OF A FINDING OF A SUBSTANTIAL NEW QUESTION OF PATENTABILITY” and revised the text to indicate that the patent owner may seek review on the examiner's SNQ determination before the Board along with any appeal, and how to obtain such a review. The text of former subsection VI was moved to new subsection VII. The text was revised to explain that the Board has the sole responsibility for determining whether appeal briefs filed in <i>ex parte</i> reexamination proceedings comply with 37 CFR 41.37 and will complete the determination before the appeal brief is forwarded to the examiner for consideration. Deleted the statement that the examiner will notify the patent owner that the brief is defective.</p>
2275	<p>Modified to recite a revised version of 37 CFR 41.39. Changed “Board of Patent Appeals and Interferences” to “Board.”</p>
2277-2279	<p>Changed “Board of Patent Appeals and Interferences” to “Board.”</p>
2281	<p>Revised to clarify that in person interviews between examiner and the patent owners undergoing <i>ex parte</i> reexamination or their attorneys or agents must be had in the Office at its Alexandria location or one of the Office’s satellite locations at such times and within Office hours when building security permits public admission. Changed “Supervisory Patent Examiner (SPE)” to “Supervisory Reexamination Specialist (SPRS).” Revised to indicate that a showing of good cause to conduct a second interview will explain why the information to be presented could not have been presented sooner; and that a party requesting a second interview after final rejection must provide an advance showing that it will expedite the issues for appeal or disposal of the application, citing MPEP § 713.09.</p>
2282	<p>Revised to clarify that a submission that is not limited to bare notice of the prior or concurrent proceedings will be returned, “expunged or discarded” by the Office. Modified the example regarding a proper submission under 37 CFR 1.565(a) by referring to an “enterable paper” or “paper” instead of an Information Disclosure Statement or IDS.</p>
2283	<p>Replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS)” and “CRU SPE” with “CRU SPRS.” In subsection III, revised the last paragraph by adding “(or is present in one proceeding but not present in the other(s))” after “merged proceedings.” In subsection IV, revised to clarify that a NIRC will be printed and scanned into the files of the merged proceeding. Subsection VII is modified to delete text that the requester who is not the patent owner can file a petition to merge. Revised to state that a third party requester does not have a right to file a petition under 37 CFR 1.182 to merge or stay and to explain why. The added text explains that third party requester may alternatively file a notification of concurrent proceedings.</p>
2284	<p>In subsection II and III, changed “Board of Patent Appeals and Interferences” to “Board.”</p>
2285	<p>In subsection I, replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).” In subsection II.B, changed “Board of Patent Appeals and Interferences” to “Board.” In subsection IV, replaced “CRU SPE” with “CRU SPRS” and clarified that if a compliant response is not received to an Office action or if a RCE is filed in a reissue application, the merger will be automatically dissolved (severed).</p>

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	<p>Subsection V is revised to explain that a third party requester does not have a right to file a petition under 37 CFR 1.182 to merge or to stay a reexamination proceeding and a reissue application examination. The added text explains that third party requester may alternatively file a notification of concurrent proceedings.</p>
2286	<p>In subsection II, inserted a reference to <i>In re Swanson</i> et al, 540 F.3d 1368, 1378 (Fed. Cir. 2008) to state that the Federal Circuit approved of the Office’s interpretation in MPEP § 2242 and a reference to <i>In re Baxter International Inc.</i>, 678 F.3d 1357, 102 USPQ2d 1925 (Fed. Cir. 2012) to show that the Federal Circuit affirmed Office rejections even though it found the patent not invalid in parallel district court proceedings. Further revised to add a discussion that a prior court judgment upholding validity over a reference did not preclude the Office from finding a SNQ based on the same reference and cited to <i>Baxter</i> and <i>Abbott Labs. v. Syntron Bioresearch, Inc.</i>, 334 F.3d 1343 (Fed. Cir. 2003) as support. Also replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).”</p> <p>In subsection IV, revised to state that if no SNQ is present after a final federal court decision, the reexamination is terminated. Specifically, the text was revised to clarify that if all claims being examined in a reexamination proceeding are finally held invalid or unenforceable, the reexamination will be vacated by the CRU or TC Director if the decision was rendered prior to the order, or terminated as no longer containing a SNQ if the decision was rendered subsequent to the order.</p> <p>In subsection V, replaced “CRU SPE” with “CRU SPRS.”</p>
2286.01	<p>Newly added section that discusses the potential impacts of other post patent proceedings, such as <i>inter partes</i> review, post grant review and covered business method review, on a reexamination proceeding.</p>
2287	<p>Revised by replacing “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.”</p> <p>Revised to indicate that the conference members can be two “or more” other members and that all conferees will initial the NIRC.</p> <p>Changed “Board of Patent Appeals and Interferences” to “Board.”</p> <p>In subsections I and IV, replaced “reexamination clerk” with “CRU support staff.”</p> <p>In subsection IV(K), revised text regarding drawing changes to state that “amended” or “new” figures must be labeled in compliance with 37 CFR 1.84 and added a citation to 37 CFR 1.530(d)(3).</p>
2289	<p>Revised by replacing “Supervisory Patent Examiner” with “Supervisory Patent Reexamination Specialist (SPRS);” or “SPE” with “SPRS.”</p>
2290	<p>Deleted text that discussed listing references on the reexamination certificate and revised to state that a notice is provided on the certificate which states the list of cited documents is available via PAIR.</p>
2294	<p>Replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).”</p>
2295	<p>Revised by replacing “reexamination clerk” with “CRU support staff” and deleting reference to the Technology Center (TC).</p> <p>In subsection III, replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Reexamination Specialist (SPRS).”</p>

CHAPTER 2600:

<p>2601</p>	<p>Revised to reduce the discussion of <i>inter partes</i> reexamination as it was created by Public Law 106-113 or “the American Inventors Protection Act of 1999” (the AIPA). Added a discussion of the changes made by the Leahy-Smith America Invents Act (the AIA), Public Law 112-29, 125 Stat. 284 that replaced <i>inter partes</i> reexamination with a new procedure called <i>inter partes</i> review, effective September 16, 2012. <i>Inter partes</i> reexaminations filed before September 16, 2012 will continue and are subject to 35 U.S.C. 311-318 in effect prior to September 16, 2012. The AIA created a transition period in that <i>inter partes</i> reexaminations filed on or after September 16, 2011 (and prior to September 16, 2012) were subject to the reasonable likelihood that the requester will prevail standard (which is the standard for the new <i>inter partes</i> review) instead of the previous standard of a substantial new question of patentability (SNQ). For requests filed prior to September 16, 2011, the SNQ standard was applied in determining whether the request would be granted. The Office no longer accepts any request for <i>inter partes</i> reexamination filed on or after September 16, 2012. Revised to delete the discussion regarding the final rules to implement <i>inter partes</i> reexamination published in the Federal Register on December 7, 2000 and the indication that both the statutory <i>inter partes</i> reexamination option and the <i>inter partes</i> reexamination rules apply to all reexamination proceedings of patents issuing from applications filed on or after November 29, 1999.</p>
<p>2602</p>	<p>Deleted recitations of 35 U.S.C. 301 and 37 CFR 1.501. Replaced “Public Law 106-113” with “American Inventors Protection Act of 1999 (the AIPA).” Revised to indicate that AIA provided, under 35 U.S.C. 301(a)(2), for submission of statements of the patent owner filed in a proceeding before a Federal Court or the Office in which the patent owner took a position on the scope of any claim of a particular patent; however, no provision of the statute applies to an ongoing <i>inter partes</i> reexamination.</p>
<p>2609</p>	<p>Revised to indicate that the <i>inter partes</i> reexamination statute and rules permit any third party requester, “prior to September 16, 2012,” to request <i>inter partes</i> reexamination of a patent issued from an original application filed on or after November 29, 1999. Revised to indicate that the Office initially determines whether the standard for granting reexamination is met instead of initially determining whether a “substantial new question of patentability” is present. Revised to clarify that the electronic copy of the reexamination file is the Official file of the proceeding; and to delete the statement that the paper file is not available to the public.</p>
<p>2610 - 2612</p>	<p>Deleted the previous text in its entirety. Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055 (September 23, 2011).</p>
<p>2614 - 2615</p>	<p>Deleted the previous text in its entirety. Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055 (September 23, 2011).</p>
<p>2616</p>	<p>Revised title to “Substantial New Question of Patentability/Reasonable Likelihood that Requester Will Prevail.” Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055 (September 23, 2011).</p>
<p>2617 - 2620</p>	<p>Deleted the previous text in its entirety.</p>

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	Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055 (September 23, 2011).
2622	Modified the citation to former 37 CFR 10.23(c)(8) to 37 CFR 11.104 in regards to a practitioner’s responsibility to timely and adequately inform a client or former client. Added a citation to 37 CFR 11.116(d) to support the statement that a practitioner’s responsibility to a former client is not removed even if the practitioner withdraws as an attorney or agent of record.
2623	Revised to indicate the Office no longer requires there to be at least 30 days remaining in any running period for response for a practitioner to request withdrawal from a patent. Revised to state the updated Office requirements, pursuant to 37 CFR 11.116, for a practitioner to withdraw from a patent; form PTO/SB/83 has been updated.
2626	Deleted the previous text in its entirety. Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055.
2627	Revised to be written in the past tense. Modified text stating 30 days were given to complete requirements for the request to now state a specific time to complete requirements was given until the AIA’s termination of <i>inter partes</i> reexamination took effect. Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS)””; and to replace “CRU SPE” with “CRU SPRS.”
2629	Deleted the previous text in its entirety. Revised to indicate that no requests for <i>inter partes</i> reexamination may be filed on or after September 16, 2012, and guidance on the former practice is available in revision 7 of the 8th edition of the MPEP and in the Federal Register, 76 Fed. Reg. 59055.
2633	Deleted the previous text in its entirety.
2634	Revised to indicate that all petitions relating to a reexamination proceeding require fees, citing 37 CFR 1.937(d). Revised to indicate that micro entity and small entity reductions under 35 U.S.C. 41(h)(1) are available to the patent owner for certain fees and small entity reduction is available to the third party requester for certain fees. The citations to 37 CFR 1.958, 1.182, and 1.183 were deleted.
2635	Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).”
2636	Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).” Clarified text regarding any challenges to whether the proceeding was properly assigned to an examiner by indicating that any paper should be alerting (notifying) the Office to the assignment to an “original” examiner. Deleted subsection II regarding the mechanics of assignment.
2637	Deleted the previous text in its entirety.
2638	Deleted text that stated reexamination fees are based on full cost recovery.
2640	Added text to clarify that the recitations of 35 U.S.C. 312 and 37 CFR 1.923 & 1.927 are to the provisions that applies to a request filed prior to September 16, 2011. Added recitations for 35 U.S.C. 312 and 37 CFR 1.923 & 1.927 that applies to a request filed between September 16, 2011 and September 15, 2012. These provisions replace the “substantial new question of patentability” language with the “reasonable likelihood that the requester will prevail” language created by the amendment in the AIA.

	<p>Revised text to indicate that an examiner can request a litigation search from the Technical Support Staff of the CRU or from STIC.</p> <p>Revised to indicate that 35 U.S.C. 312 requires the Director to determine whether or not a “substantial new question of patentability” is raised in <i>inter partes</i> reexamination requests filed prior to September 16, 2011 or if there is a reasonable likelihood that the requester will prevail for <i>inter partes</i> reexamination requests filed on or after September 16, 2011.</p> <p>Moved the text regarding the prohibition provision of 37 CFR 1.907(a) from subsection II.A. to the second paragraph of subsection II.</p> <p>Deleted text permitting a patent owner to petition under 37 CFR 1.182 for suspension of a second or subsequent request filed by a third party.</p>
2641	<p>Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS)” and to replace “CRU SPE” with “CRU SPRS.”</p>
2642	<p>Maintains text pertaining to the criteria for deciding whether a SNQ is raised by a request in subsection I.A. Added that the meaning and scope of SNQ is developed using legislative history, as well as case law. Deleted citation to <i>Heinl v. Godici</i>, 143 F. Supp.2d 593 (E.D. Va. 2001) and related text and revised to state that a determination granting reexamination is final and non-appealable under 35 U.S.C. 312(c). Revised to clarify that if a request is denied, requester may obtain reconsideration only pursuant to MPEP § 2648; and if a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability, it can be re-presented in a new reexamination request. Deleted the discussion of a second or subsequent reexamination request.</p> <p>Revised to add text pertaining to the criteria for deciding whether a request shows a reasonable likelihood that a request will prevail (RLP) in a new subsection I.B. This standard is applied to requests filed on/after September 16, 2011 and prior to September 16, 2012. States that the meaning and scope of the RLP standard is not defined in the statute and cites to a House Report that discussed the RLP standard. Indicates if a reexamination proceeding is terminated/vacated without resolving the “reasonable likelihood” question, it can be re-presented in a new request. Revised subsection II to be limited to SNQ determinations in specific situations.</p> <p>Revised subsection III to be applicable to both SNQ and RLP determinations. Added citation to <i>In re Swanson</i>, 540 F.3d 1368, 1378 (Fed. Cir. 2008) which held that SNQ determinations are made independently from validity determinations in court.</p> <p>Revised to replace “Board of Patent Appeals and Interferences” with “Board” or “Patent Trial and Appeal Board or Board of Patent Appeals and Interferences (Board).”</p>
2643	<p>Revised to be applicable to both SNQ and RLP determinations.</p>
2644	<p>Revised to be applicable to both SNQ and RLP determinations.</p>
2646	<p>Clarified that current recitations of 35 U.S.C. 313 and 37 CFR 1.931 are in effect prior to September 16, 2011. Added recitations of 35 U.S.C. 313 and 37 CFR 1.931 that are in effect from September 16, 2011 to September 15, 2012.</p> <p>Revised to be applicable to both SNQ and RLP determinations by replacing SNQ with SNQ/RLP. Replaced list (A)-(F) itemizing what a decision on each substantial new question of patentability should point out with a list (A)-(C) itemizing the components of a decision on the request should contain for both SNQ and RLP determinations.</p> <p>Revised to indicate that, for a request filed prior to September 16, 2011 former form paragraph 26.01 was to be used for a substantial new question of patentability; and for a request filed September 16, 2011 and ending September 15, 2012, revised form paragraph 26.01 is used for a reasonable likelihood established.</p> <p>Updated form paragraph 26.73 to provide current correspondence and inquiry information.</p> <p>Revised subsection I to clarify that after the request is reviewed for compliance with requirements, it is then assigned to an examiner and that an examiner may follow the procedures in MPEP</p>

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	<p>2637 if he/she feels the reexamination belongs to another art unit within the CRU. Also revised to clarify that an examiner may prepare for a panel review conference by drafting a decision on the reexamination request and if applicable, a first Office action. After the conference is conducted and the decision, and if applicable, the first Office action, are confirmed, the decision and action are prepared for mailing.</p> <p>Revised subsection II by clarifying that court decisions regarding the ordering of reexamination under the SNQ standard are applicable to RLP determinations. Also revised to delete example (F) of appropriate circumstances under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination. Further revised to state that a petition under 37 CFR 1.181(a)(3) to vacate a reexamination order as “ultra vires” should be rare and are decided by the Director of the CRU.</p>
2647	<p>Revised to be applicable to both SNQ and RLP determinations by replacing SNQ with SNQ/RLP. Revised to indicate that for a request filed prior to September 16, 2011, the “Former” form paragraph 26.02 No New Question of Patentability was to be used; and for a request filed beginning September 16, 2011 and ending September 15, 2012, a revised version, form paragraph 26.02 No reasonable likelihood established is used.</p> <p>Revised to delete reasons (A)-(D) for the decision denying the request.</p> <p>Revised to clarify that the example in MPEP § 2647.01 is for decisions denying a request under the SNQ standard.</p> <p>Revised to clarify that an examiner may prepare for a panel review conference by drafting a decision denying the reexamination request and if confirmed in the conference, the decision is prepared for mailing.</p>
2647.01	<p>Clarified that the examples are for decisions on a request under the SNQ standard.</p> <p>Revised the examples to include current correspondence information.</p>
2647.02	<p>Deleted text that discussed discontinued paper processing.</p>
2648	<p>Clarified that current recitation of 37 CFR 1.927 is in effect prior to September 16, 2011. Added recitation of 37 CFR 1.927 that is in effect from September 16, 2011 to September 15, 2012.</p> <p>Revised to be applicable to both SNQ and RLP determinations.</p> <p>Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).”</p> <p>Revised to clarify that a petition under 37 CFR 1.927 only applies to review of bases that were denied and not to basis for which reexamination was granted.</p>
2654	<p>Revised the recitations of 35 U.S.C. 314 and 37 CFR 1.937 to be the provision in effect from September 16, 2011 to September 15, 2012. 37 CFR 1.937 is revised in part (a) to replace “Board of Patent Appeals and Interferences” with “Patent Trial and Appeal Board”; and to add part (d) which indicates a petition in an <i>inter partes</i> reexamination proceeding must be accompanied by the fee set forth in § 1.20(c)(6).</p>
2655	<p>Revised to clarify that granting a petition under 37 CFR 1.927 is overturning a refusal to order reexamination.</p>
2656	<p>No substantive changes – minor correction(s).</p>
2658	<p>Revised subsection I to clarify that decisions cited in MPEP §§ 2258 and 2258.01 regarding <i>ex parte</i> reexamination proceedings apply analogously to <i>inter partes</i> reexamination proceedings. Added in subsection II a citation to <i>In re NTP</i>, 654 F.3d 1268 (Fed. Cir. 2011), which held that the USPTO is not prohibited from performing a 35 U.S.C. 112 written description priority analysis during reexamination.</p> <p>Revised subsection IV.B to be applicable to both SNQ and RLP determinations.</p> <p>Clarified in subsection IV.C that restrictions are prohibited during reexamination.</p> <p>Added in subsection IV.H a reference to MPEP 2666.05 for requester comments that are not limited to addressing issues in Office actions or the patent owner’s response.</p>
2659	<p>No substantive changes – minor correction(s).</p>

<u>2660</u>	<p>Clarified that the recitation of 37 CFR 1.104 is the provision in effect prior to March 16, 2013. Revised subsection III to be applicable to actions in reexaminations using both the SNQ and RLP standards.</p> <p>Updated form paragraph 26.73 to provide current correspondence and inquiry information.</p> <p>Revised subsection IV to clarify that an examiner may prepare for a panel review conference by drafting an action in response to patent owner's response and requester's comments (if applicable) and if confirmed in the conference, the action is prepared for mailing.</p> <p>Revised subsection V to clarify that the sample action is for reexaminations under the SNQ standard.</p> <p>Deleted subsection VI which discussed former paper processing of actions.</p>
<u>2662</u>	<p>Replaced "Board of Patent Appeals and Interferences" with "Board."</p>
<u>2664</u>	<p>Revised to replace "Supervisory Patent Examiner (SPE)" with "Supervisory Patent Reexamination Specialist (SPRS)" and to delete references to "Reexamination Legal Advisor (RLA)" and "CRU support staff."</p>
<u>2666</u>	<p>Revised citation to 37 CFR 1.131 to 37 CFR 1.131(a) and 37 CFR 1.130 to 37 CFR 1.131(c).</p>
<u>2666.02</u>	<p>Amended to clarify the procedures for submitted new or amended drawings in that changes must be submitted as a separate paper labeled an "Annotated Sheet" and each figure on a single drawing sheet must be marked as "amended" or "new" as appropriate.</p>
<u>2666.04</u>	<p>Updated the recitation of 37 CFR 1.20 as revised.</p>
<u>2666.05</u>	<p>Revised subsection I to state that requester can file a petition under 37 CFR 1.181 (instead of previously-stated 37 CFR 1.182) to request expungement of the patent owner's response if patent owner's response exceeds the page length requirement and did not file a petition requesting waiver of the page length requirement.</p> <p>Added text to subsection II to clarify that requester is not permitted under 37 CFR 1.948(a)(2) to proposed new rejections for unamended claims and is not permitted under 37 CFR 1.948(a)(3) to proposed new rejections as the discussion of the pertinency of the newly cited references.</p>
<u>2666.10</u>	<p>Revised subsection III(B) to delete the reference to 37 CFR 1.957(b) in regard to terminating the proceeding if no appeal is filed by requester and at least one claim is indicated as allowable.</p>
<u>2666.20</u>	<p>Revised subsection III(B) to delete the reference to 37 CFR 1.957(b) in regard to terminating the proceeding if no appeal is filed by requester and at least one claim is indicated as allowable.</p>
<u>2667</u>	<p>Revised subsection I.A.2.(B) to indicate that sections of the appellant and respondent briefs required under 37 CFR 41.67(c)(1)(i)-(iv) and (ix)-(xi) and 37 CFR 41.68(b)(1)(i)-(iv) and (viii)-(x), respectively, are excluded from the page limits that are set forth by 37 CFR 1.943(c) only if those sections are limited to information required by those sections. Also revised to clarify that declarations or affidavits that are limited to establishing facts are excluded from the page limit requirements.</p> <p>Added new subsection I.A.4 to discuss when a patent owner's petition may be deemed improper. It states that the patent owner is not permitted to file an opposition/rebuttal/response to a requester's opposition paper and is not permitted to file oppositions to requester's petitions regarding discretionary procedural processes, such as accepting late papers.</p> <p>Clarified subsection I.B.2 by replacing "response" with "submission."</p> <p>Revised subsection I.B.4 regarding improper petitions to be limited to requester's petitions because patent owner's petitions are now discussed in new subsection I.A.4. Also revised to state that requester is permitted to file an opposition to patent owner's petition to reopen prosecution or to find an Action Closing Prosecution to be premature.</p> <p>Revised subsection II.A.3 regarding late papers to state that where there is a right to file an opposition to a petition, the opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party. Any opposition filed outside the two week period will remain of record but may not be considered.</p>

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<u>2668</u>	Revised the recitation of 35 U.S.C. 41(a)(7) to the revised provision by changing the fee amounts.
<u>2670</u>	Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS)” and to delete text stating that amendments that comply with 37 CFR 1.941 are entered by the CRU clerical staff.
<u>2671</u>	Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS)” and to replace “CRU SPE” with “CRU SPRS.”
<u>2671.01</u>	Revised subsection I.(A) to state the examiner will not “normally” close prosecution where a new ground of rejection not caused by an amendment is made; and to add a reference to MPEP § 2671.02 for an exception when the patent owner submits an IDS. In subsection VIII, updated form paragraph 26.73 to provide current correspondence and inquiry information. Revised subsection IX to clarify that an examiner may prepare for a panel review conference by drafting an action in response to patent owner’s response and requester’s comments (if applicable) and if confirmed in the conference, the action is prepared for mailing.
<u>2671.02</u>	In subsection VII, updated form paragraph 26.73 to provide current correspondence and inquiry information. Revised subsection VIII to clarify that an examiner may prepare for a panel review conference by drafting an action in response to patent owner’s response and requester’s comments (if applicable) and if confirmed in the conference, the action is prepared for mailing. New subsection X added, entitled, “ART CITED BY PATENT OWNER DURING PROSECUTION,” which states that where art is submitted in a patent owner’s prior art citation under 37 CFR 1.501 and/or 37 CFR 1.555 and the submission is not accompanied by a statement similar to that of 37 CFR 1.97(e), the examiner may use the art and make the next Office action an ACP action.
<u>2672</u>	In subsection II, revised citation to 37 CFR 1.131 to 37 CFR 1.131(a). Deleted text in subsection VI regarding requester’s opposition to patent owner’s petition under 37 CFR 1.181. This procedure is now covered in MPEP 2667 I.B.4.
<u>2673</u>	In subsection III, deleted text stating that the patent owner cannot file a request for <i>inter partes</i> reexamination.
<u>2673.02</u>	Replaced “Board of Patent Appeals and Interferences” with “Board.” Updated form paragraph 26.73 to provide current correspondence and inquiry information. Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS)” and to replace “CRU SPE” with “CRU SPRS”; and to indicate that two “or more” conferees initial the RAN action.
<u>2674</u>	Replaced “Board of Patent Appeals and Interferences” with “Board.” Revised to indicate that the Board has the sole responsibility for determining whether briefs in <i>inter partes</i> reexamination proceedings comply with 37 CFR 1.943(c) and 37 CFR 41.67, 41.68, or 41.71. The Board will complete its determination before the examiner acts on the briefs. If the Board finds that the brief needs to be corrected, the Board will provide a notice to the party that filed the defective brief and require correction within a set time period. The added text states that jurisdiction of the proceeding does not transfer to the Board until a docketing notice is entered by the Board after all the briefing is completed.
<u>2674.01</u>	No substantive changes – minor correction(s).
<u>2675</u>	Modified the recitation of 37 CFR 41.67 to a revised provision. Revised to clarify that an appellant brief is due by the latter of (1) no later than two months from the last-filed notice of appeal or cross appeal; or (2) no later than two months from the expiration of the time to file a notice of appeal or cross appeal, as appropriate. Replaced “Board of Patent Appeals and Interferences” with “Board.”

2675.01	<p>Revised the recitation of 37 CFR 41.68 to the provision in effect for <i>inter partes</i> reexamination proceedings. Replaced “Board of Patent Appeals and Interferences” with “Board.”</p>
2675.02	<p>Revised to indicate that where an appellant or respondent brief does not comply with 37 CFR 41.67(a) and (c) or 37 CFR 41.68(a) and (b), the Board will notify the appropriate party. Revised to indicate that after a party has filed an amended appellant brief correcting the defect(s), the other party is not permitted to file a responsive amended respondent brief, if the amended brief does not go to the merits of the case. Deleted the recitation of form paragraphs 26.09 and 26.10, which an examiner used to notify a party of a noncompliant brief.</p>
2676	<p>Revised to indicate all appellant and respondent briefs will be processed by the Board and then forwarded to the CRU. Deleted references to “Reexamination Legal Advisor (RLA).” Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS);” and to replace “CRU SPE” with “CRU SPRS.” The reference to MPEP 1208 was changed to MPEP 1207.01, in relation to procedures for conducting the appeal conference.</p>
2677	<p>Revised to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS);” and to replace “CRU SPE” with “CRU SPRS.” Replaced “Board of Patent Appeals and Interferences” with “Board.” Revised citation to 37 CFR 1.131 to 37 CFR 1.131(a). Deleted text that examiner’s answer should not refer to more than one prior Office action. Deleted text that discussed an examiner’s review of briefs for compliancy and now indicates that examiners should no longer hold any appeal brief defective. Added text that examiners may use form PTOL-2291 for the examiner’s answer if at least two adverse parties filed appeal briefs. In this situation, examiners may only provide additional explanation if approved by the CRU director. Deleted references to “Reexamination Legal Advisor (RLA)” in subsection II. Deleted subsection III, which recited form paragraphs and examples of portions of examiner’s answers.</p>
2679	<p>Replaced “Board of Patent Appeals and Interferences” with “Board.”</p>
2679	<p>Revised to indicate the rebuttal brief is reviewed by the Board and forwarded to the CRU examiner. The examiner will acknowledge the rebuttal brief by using form PTOL-90. Examples of acknowledgment of the rebuttal brief are provided. Deleted the recitations of form paragraphs 26.65, 26.65.01, 26.66, 26.66.01, and 26.66.02.</p>
2681	<p>Updated the recitation of 37 CFR 41.77 to the revised version reciting “Patent Trial and Appeal Board.”</p>
2682	<p>Revised subsection I to clarify that the two month time period set in 37 CFR 1.304 for filing a notice of appeal to the CAFC starts on: (1) the mailing date of the Board decision if mailed or (2) the date electronic mail notification is sent to the appellant under the e-Office Action program, as indicated on the form PTOL-90 attached to the decision. Deleted text in subsection I.A. that the examiner should draw a red line through any refused claim and note “Board Decision” in the margin. Replaced “Board of Patent Appeals and Interferences” with “Board.” In subsection II.B, revised citation to 37 CFR 1.131 to 37 CFR 1.131(a).</p>
2683	<p>Inserted editor’s note that 35 U.S.C. 141 as reproduced is not applicable to proceedings commenced on or after September 16, 2012. Revised by inserting “PART 90-JUDICIAL REVIEW OF PATENT TRIAL AND APPEAL BOARD”; includes 37 CFR 90.1, 90.2, and 90.3.</p>

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	<p>Updated recitation of 37 CFR 1.983 to its revised version. Replaced “Board of Patent Appeals and Interferences” with “Board.” Added text that any notice of appeal or cross appeal should provide sufficient information to allow the Director to determine whether to exercise the right to intervene.</p>
<u>2686</u>	<p>Updated recitation of 37 CFR 1.985 to its revised version. Revised to indicate that where a submission is not limited to bare notice of the prior or concurrent proceedings, it will be returned, expunged or discarded by the Office. Revised to indicate any proper submission pursuant to 37 CFR 1.985 will be considered by the examiner as to its content when the proceeding comes up for action on the merits.</p>
<u>2686.01</u>	<p>Revised to delete the discussion regarding who can file a second or subsequent request for reexamination while a first reexamination is pending. Revised to delete the reference to 37 CFR 1.923 and replaced “substantial new question of patentability” with “question of patentability.” Revised subsection III to delete any reference to the “Reexamination Legal Advisor (RLA)” and to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).” Revised subsection III to indicate that if the claims are not the same in both files at the time the merger decision is drafted, the Office action will contain a rejection of claims under 35 U.S.C. 112(b) as being indefinite. Also revised to state requirements of responses/comments by the patent owner and third party requester(s) in reference to the decision to merge reexamination proceedings. Revised subsection IV to delete text that indicated that a requester of any multiple reexamination proceedings may also petition to merge the proceedings at any time after the order to reexamine the second request. Inserted text to explain that the third party requester of a reexamination proceeding does not have a right to file a petition under 37 CFR 1.182 to merge that reexamination proceeding with another reexamination proceeding because the requester does not have standing to request relief with respect to the other proceeding.</p>
<u>2686.02</u>	<p>Updated recitation of 37 CFR 1.993 to its revised version.</p>
<u>2686.03</u>	<p>Updated recitation of 37 CFR 1.937 to its revised version. Revised subsection I to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).” Revised subsection II.B to replace “Board of Patent Appeals and Interferences” with “Board.” Revised subsection III to delete “housekeeping” in modifying amendment. Revised subsection V to replace “OPLA” with “CRU” in regard to who returns an improper petition to merge; and to indicate that the third party requester does not have a right to file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination or a petition to stay proceedings. Revised title for subsection VIII to add “IN MERGED REISSUE/ <i>INTER PARTES</i> REEXAMINATION” at the end.</p>
<u>2686.04</u>	<p>Inserted editor’s note that 35 U.S.C. 314, 317, and 318 as reproduced is in effect prior to September 16, 2012. Revised subsection II.(A) to replaced “substantial new question of patentability” with “question of patentability” or “basis for reexamination.” Also revised to add a citation to <i>In re Swanson</i> et al, 540 F.3d 1368, 1378 (Fed. Cir. 2008) to support the existing statement that determination of the basis for reexamination is made independently of a court’s decision on validity. Further revised to make the text applicable to both SNQ and RLP determinations. Revised subsection II.(B) and IV to include a citation to 35 USC 317(b) in discussing the impact of the final holding of validity by a court. Further revised to make the text applicable to both SNQ and RLP determinations and to change “vacated” to “vacated/terminated.”</p>

	<p>Revised subsection II.(C) to include a discussion of <i>In re Swanson et al</i>, 540 F.3d 1368, 88 USPQ2d 1196 (Fed. Cir. 2008) and <i>In re Baxter International Inc.</i>, 678 F.3d 1357, 102 USPQ2d 1925 (Fed. Cir. 2012). Both cases pertain to the impact of court decisions on the determination in reexamination proceedings.</p> <p>Revised subsection III to indicate that 35 U.S.C. 314 provides a good cause qualification as to conducting reexamination with special dispatch. Also revised to delete text that indicated that a petition under 37 CFR 1.182 must be filed by patent owner to ensure consideration on the merits of a petition to suspend where there is an outstanding Office action.</p> <p>Revised subsection IV to clarify that if the reexamination cannot be maintained due to the provisions of 37 CFR 1.907(b), the proceeding is vacated if made prior to the order and terminated if made after the order is mailed.</p> <p>Revised subsection IV to delete text pertaining to bringing litigation to the attention of the “Reexamination Legal Advisor (RLA).”</p>
<u>2686.05</u>	<p>Newly added to discuss that the Office has discretion to determine the manner in which a post grant review proceeding and another matter or proceeding proceed including, whether to stay, transfer, consolidate or terminate any such matter or proceeding. Examiners should inform their supervisor if they are aware of any other pending post-grant proceedings for the same patent.</p>
<u>2687</u>	<p>Revised subsection I.(D) to replace “Board of Patent Appeals and Interferences” with “Board.”</p> <p>Revised subsection II.(B) and VI to replace “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).”</p> <p>Deleted all text pertaining to review by a Reexamination Legal Advisor (RLA) in subsection V.</p> <p>Revised subsection VI to be applicable to reexamination subject to either the SNQ and RLP standards.</p> <p>Revised subsection VI.(K) to delete text about draftsman’s review and to now require amended or new figures must be appropriately marked and be presented on new sheets.</p>
<u>2687.01</u>	<p>Replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).”</p>
<u>2689</u>	<p>Replaced “Supervisory Patent Examiner (SPE)” with “Supervisory Patent Reexamination Specialist (SPRS).”</p> <p>Revised to delete text regarding hand carrying paper parts of the file to the Reexamination Legal Advisor (RLA) for review and the screening the file after a NIRC is issued.</p>
<u>2690</u>	<p>Revised Part (C) to indicate a notice will be present on the certificate to inform that the list of cited prior art documents will be available via PAIR. Text is deleted regarding the discontinued practice of listing the references on the reexamination certificate.</p>
<u>2696</u>	<p>Updated list of forms used in <i>inter partes</i> reexamination by adding form PTOL-2291 and deleting forms PTOL-2057, PTOL-2058, PTOL-2059, PTOL-2060, PTOL-2061, PTOL-2062, and PTOL-2063. Text regarding transmittal form PTO/SB/58 is deleted.</p>

CHAPTER 2700

2701	<p>Revised to update 35 U.S.C. 154, in view of the revisions from the AIA that deleted “of this title” after the citation to various sections of title 35.</p> <p>Revised to indicate that design patents issued from applications filed on or after the date of entry into force of the Hague Treaty will have a term of 15 years from the grant date of the design patent.</p>
2710	<p>Revised text to clarify that the citation to 35 U.S.C. 154(b) is to the statute in effect on May 29, 2000 and amended thereafter.</p> <p>Consistent with the existing guidance regarding which applications are eligible for patent term extension or adjustment, added a citation to <i>Thomas D. Sykes v. Jon W. Dudas</i>, 573 F.Supp2d 191, 89 USPQ2d 1423 (D.D.C. 2008). In this decision, the court held that amendments to 35 U.S.C. 154 by the 1999 American Inventors Protection Act (AIPA) do not apply to applications filed prior to May 29, 2000.</p>
2720	<p>Revised to update 37 CFR 1.701, as necessitated by the AIA revisions related to the new name of the patent appeal board and the addition of deviation proceedings, and the regulatory changes that moved appeal regulations to part 41 of title 37.</p> <p>Revised text as necessitated by the AIA revisions related to the new name of the patent appeal board and to clarify that the citation to 35 U.S.C. 154(b) is to the statute in effect on May 29, 2000 and amended thereafter.</p> <p>Revised to indicate that patent term extension (PTE) information under former 35 U.S.C. 154 will be printed on the front face of the patent. Text relating to publication of PTE on the Notice of Allowance and Fee(s) Due form and correction of such PTE determination was deleted.</p>
2730	<p>Revised to update 35 U.S.C. 154(b), as necessitated by the AIA revisions related to the new name of the patent appeal board, the change that patent term adjustment (PTA) will be printed no later than the issuance date of the patent (instead of on the notice of allowance), and the change that the exclusive remedy for an applicant dissatisfied with the Director’s determination on the request for reconsideration of the patent term adjustment is a civil action filed in the U.S. District Court for the Eastern District of Virginia.</p> <p>Revised to update 37 CFR 1.702, as necessitated by the AIA revisions related to the new name of the patent appeal board, the reference in subsection (a) to the date the national stage commenced under 35 U.S.C. 371(b) or (f) (instead of fulfilling the requirements of 35 U.S.C. 371) and the addition of deviation proceedings, and the changes to the subtitle in subsection (b).</p> <p>Revised to update 37 CFR 1.703, as necessitated by the AIA revisions related to the new name of the patent appeal board, the reference in subsection (a) to the date the national stage commenced under 35 U.S.C. 371(b) or (f) (instead of fulfilling the requirements of 35 U.S.C. 371) and the addition of deviation proceedings, and the regulatory changes that moved appeal regulations to part 41 of title 37 and altered the language in subsection (b) to better reflect the period of appeal is from the time jurisdiction begins and ends at the Patent Trial and Appeal Board.</p> <p>Revised to update 37 CFR 1.704, as necessitated by the AIA revisions related to the new name of the patent appeal board, and the regulatory changes that moved appeal regulations to part 41 of title 37 and altered the language in subsection (c) to avoid any PTA reduction if an IDS submission resulting from an Office communication is submitted within 30 days and if a compliant appeal brief is filed within 3 months from the notice of appeal.</p> <p>Revised to update 37 CFR 1.705, as necessitated by the AIA revisions that patent term adjustment will be printed on the patent (instead of the notice of allowance), and the regulatory changes that requires any request for reconsideration of the PTA determination</p>

	<p>be filed no later than two months from the issue date of the patent and that any requests for reinstatement of PTA reduction under 37 CFR 1.704(b) must be filed prior to issuance of the patent.</p> <p>Revised text to discuss the above-mentioned statutory & regulatory changes and the effective date of the changes.</p>
<p>2731</p>	<p>Revised to update 37 CFR 1.703, as necessitated by the AIA revisions related to the new name of the patent appeal board, the reference in subsection (a) to the date the national stage commenced under 35 U.S.C. 371(b) or (f) (instead of fulfilling the requirements of 35 U.S.C. 371) and the addition of deviation proceedings, and the regulatory changes that moved appeal regulations to part 41 of title 37 and altered the language in subsection (b) to better reflect the period of appeal is from the time jurisdiction begins and ends at the Patent Trial and Appeal Board.</p> <p>Revised text to discuss the above-mentioned statutory & regulatory changes and the effective date of the changes.</p> <p>Added text to discuss that written restriction requirements are notifications under 35 U.S.C. 132, and therefore, would toll any PTA time period running under 37 CFR 1.703(a).</p> <p>Added text to clarify that a reply that is not in compliance with 37 CFR 1.113(c) will not start the four month requirement under 37 CFR 1.703(a)(3) for the Office to act on the reply.</p> <p>Added text to discuss the regulatory change that no fee is required to file an appeal brief if it was filed on or after March 19, 2013 and that 37 CFR 1.703(a)(4) no longer requires payment of the appeal brief fee.</p> <p>Added text to discuss when a remand by the Patent Trial and Appeal Board (Board) is deemed to be a decision under 35 U.S.C. 134 or 135 as stated in 35 U.S.C. 154(b)(1)(A)(iii) or a final decision as stated in 37 CFR 1.703(a)(5). Specifically, the remand must include a decision on the patentability of the claims, derivation, or priority of invention in order to be deemed a decision by the Board. The text explains that if the remand is not deemed a final decision by the Board, then the filing of a request for continued examination may impact the amount of PTA for the patent.</p> <p>Added text to define a “final decision” by the Board or a Federal court as a last decision that does not require further action by the applicant to prevent termination of the proceedings. A decision containing a new ground of rejection is not a final decision. A final decision does not require that the decision is ready for judicial review.</p> <p>Added text to explain that if prosecution is reopened after a notice of allowance, the PTA determination under 37 CFR 1.703(a)(6) would be based on when all outstanding requirements in response to the latest notice of allowance were satisfied.</p> <p>Added text to discuss <i>Wyeth v. Kappos</i>, 591 F. 3d 1364, 93 USPQ2d 1257 (Fed. Cir. 2010), which found that different periods of delay overlap under 35 U.S.C. 154(b)(2)(A) only if the periods of PTA under 35 U.S.C. 154(b)(1) occur on the same calendar day.</p>
<p>2732</p>	<p>Revised to update 37 CFR 1.704, as necessitated by the AIA revisions related to the new name of the patent appeal board, and the regulatory changes that moved appeal regulations to part 41 of title 37 and altered the language in subsection (c) to avoid any patent term adjustment reduction if an IDS submission resulting from an Office communication is submitted within 30 days and if a compliant appeal brief is filed within 3 months from the notice of appeal.</p> <p>Revised text to discuss the above-mentioned statutory & regulatory changes and the effective date of the changes. For example, it is explained that the filing of a non-compliant appeal brief will not be treated as an omission under 37 CFR 1.704(c)(7) if the notice of appeal was filed on or after September 17, 2012 because it would be treated under 37 CFR 1.702(c)(11). Text is also added to explain that the filing of an appeal brief that fails to</p>

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	<p>meet the requirements of 37 CFR 41.37 more than three months from the notice of appeal will delay the appeal and may result in a reduction in any earned PTA.</p> <p>Text is added to fully explain that a submission of an information disclosure statement (IDS) within 30 days of receipt from a foreign counterpart office or the USPTO will not result in a reduction of any earned PTA. Three examples are added to demonstrate what individuals are included in 37 CFR 1.56(c) and how the 30 days may be calculated.</p> <p>Added text to clarify that the submission of an IDS or an amendment after a notice of appeal but prior to jurisdiction passing to the Board will be deemed applicant delay under 37 CFR 1.704(c)(8) because treatment of such papers may cause delays in the appeal process.</p> <p>Added text to explain that if the last day of the three month time period in 37 CFR 1.704(b) falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, then any reply can be filed on the next succeeding business day without any reduction to earned PTA. Added a citation to <i>ArQule v. Kappos</i>, 793 F. Supp. 2d 214 (D.D.C. 2011), which held that the 35 U.S.C. 21(b) (a.k.a. the holiday/weekend exception) applies to the determination of PTA reductions under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b).</p> <p>Added text to reflect the establishment of the new micro-entity status.</p> <p>Modified text to clarify that a submission of a request under 37 CFR 1.705(c) for reinstatement of reduced PTA will not be counted as a further reduction under 37 CFR 1.704(c)(10).</p>
<p>2733</p>	<p>Revised to update 37 CFR 1.705(a), as necessitated by the AIA Technical Corrections Act that patent term adjustment will be printed on the patent (instead of the notice of allowance).</p> <p>Revised text to discuss the above-mentioned statutory changes and the effective date of the changes. Specifically, the text explains that the official notification of PTA will be published on the patent but the Office will still provide a preliminary PTA calculation on the notice of allowance, although it is not required to do so by statute. Patentee should not request reconsideration of the preliminary PTA determination but should wait until receipt of the official PTA determination on the patent.</p> <p>Modified text to clarify existing policies that if the PTA determination on the patent is longer than expected, a registered practitioner may disclose the Office's error in a letter. The Office will place the letter in the patent file but will not otherwise act on the letter. If patentee wants the Office to reconsider the PTA determination, patentee must follow the procedures set forth in 37 CFR 1.705. Patentee can also file a terminal disclaimer to disclaim any portion of the PTA that is considered excessive.</p>
<p>2734</p>	<p>Revised to update 37 CFR 1.705(b) and (c), as necessitated by the regulatory changes that require any request for reconsideration of the PTA determination be filed no later than two months from the issue date of the patent and that any requests for reinstatement of PTA reduction under 37 CFR 1.704(b) be filed prior to issuance of the patent.</p> <p>Revised text to discuss the above-mentioned regulatory changes and the effective date of the changes.</p> <p>Modified text to now allow the two month time period of 37 CFR 1.705(b) to be extended up to 5 additional months. In other words, patentee may have up to 7 months to file a request for reconsideration of the PTA on the patent after the patent is granted.</p> <p>Added text to explain that if the Office agrees with patentee's request for reconsideration or finds that a correction to the PTA determination is needed, the Office will issue a certificate of correction to correct the PTA determination on the patent. If the Office denies patentee's request for reconsideration, patentee may appeal to the District Court for the Eastern District of Virginia within 180 days of the Office's decision on the reconsideration request. This is the exclusive remedy as provided in the amendments to 35 U.S.C. 154(b)(4)</p>

	<p>by AIA Technical Corrections Act, which is effective for any patent granted on or after January 14, 2013.</p> <p>Added text to discuss that 37 CFR 1.705(c) requires that any request for reinstatement of PTA reductions be filed prior to the issuance of the patent and the Office will not consider such a request if filed after the patent issues. Applicants do not need to know the PTA determination in order to make the due care showing under 37 CFR 1.705(b) so that there is no reason to delay filing a request for reinstatement. The Office will not delay issuance of the patent in order to address a request for reinstatement but instead will issue, as appropriate, a certificate of correction to change the PTA determination on the patent.</p> <p>Added text to explain that if the last day of the three month time period in 37 CFR 1.704(b) falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, then any reply can be filed on the next succeeding business day without any reduction to earned PTA.</p> <p>Added a citation to <i>ArQule v. Kappos</i>, 793 F. Supp. 2d 214 (D.D.C. 2011), which held that the 35 U.S.C. 21(b) (a.k.a. the holiday/weekend exception) applies to the determination of PTA reductions under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). It is further explained that a request for reinstatement is not necessary if applicant utilizes the holiday/weekend exception.</p>
2735	Entire subsection is deleted. The subject matter is now covered in MPEP 2734. Former 37 CFR 1.705(d) and (e) were removed in light of regulatory changes to 37 CFR 1.705(b).
2736	Revised to update 37 CFR 1.705, as necessitated by the regulatory changes that redesignated former 37 CFR 1.705(f) as 37 CFR 1.705(d).
2750	<p>Revised text to clarify that the rights from PTE under 35 U.S.C. 156 are not limited to a claim-by-claim basis but extend to the patent. However, if the patent claims other products in addition to the approved product, any PTE will not be applied to the claims covering the other products. Added a citation to <i>Genetics Institute LLC v. Novartis Vaccines and Diagnostics Inc.</i>, 655 F.3d 1291, 99 USPQ2d 1713 (Fed. Cir. 2011), which found that PTE under 35 U.S.C. 156 does not apply on a claim-by-claim basis.</p> <p>Modified text to clarify that the FDA will grant a marketing applicant 5 years of data exclusivity for any active ingredient or salt or ester of the active ingredient which has not been previously approved.</p> <p>Added text to explain that the AIA clarified that the sixty-day period of 35 U.S.C. 156 will not start until the next business day if the permission was transmitted after 4:30 pm on a business day or on a day that is not a business day.</p>
2751	<p>Consistent with the existing guidance that patents subject to a terminal disclaimer may receive PTE under 35 U.S.C. 156, added a citation to <i>Merck & Co., Inc. v. Hi-Tech Pharmacal, Co., Inc.</i>, 482 F.3d 1317, 82 USPQ2d 1203 (Fed. Cir. 2007). The court found that PTE under 35 U.S.C. 156 applies even if the patent is subject to a terminal disclaimer, which was filed to overcome an obviousness-type double patenting rejection.</p> <p>Modified text to clarify that eligibility for PTE for a product subject to regulatory review under 35 U.S.C. 156(g) depends on whether the active ingredient present in the final dosage form that was previously approved by the FDA. In support, added a citation to <i>PhotoCure ASA v. Kappos</i>, 603 F.3d 1372, 95 USPQ2d 1250 (Fed. Cir. 2010), which held that the reference in 35 U.S.C. 156(f) to active ingredient means the ingredient actually present in the approved drug and not merely an active moiety responsible for pharmacological properties.</p> <p>Added text to further discuss applying the active ingredient language from 35 U.S.C. 156 to an approved product having more than one active ingredient. Added a citation to <i>Arnold Partnership v. Dudas</i>, 362 F.3d 1338, 70 USPQ2d 1311 (Fed. Cir. 2004) to support the already stated policy that an approved product that has two active ingredients is not</p>

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	<p>considered to have a single active ingredient made of two active ingredients. In addition, added a citation to <i>Ortho-McNeil Pharmaceutical, Inc. v. Lupin Pharmaceuticals, Inc.</i>, 603 F.3d 1377, 95 USPQ2d 1246, (Fed. Cir. 2010), in which the court found an enantiomer is a different drug product from its racemate and is eligible for PTE under 35 U.S.C. 156(f) even if the racemate itself had been previously marketed.</p>
<u>2752</u>	<p>Added text to explain that the AIA clarified that the sixty-day period of 35 U.S.C. 156 will not start until the next business day if the permission for commercial marketing or use for a product was transmitted after 4:30 pm on a business day or on a day that is not a business day.</p>
<u>2753</u>	<p>Modify text to clarify that any PTE will be granted based upon review of the product as either a medical device or a drug product.</p> <p>Added text to explain that the AIA clarified that the sixty-day period of 35 U.S.C. 156 will not start until the next business day if the permission for commercial marketing or use for a product was transmitted after 4:30 pm on a business day or on a day that is not a business day.</p> <p>Added text to refer to 35 U.S.C. 112(f) for applications subject to the first inventor to file provisions of the AIA as an alternative to the citation to 35 U.S.C. 112, paragraph 6, when discussing means plus function claims.</p> <p>Modified the citation from 35 U.S.C. 156(g)(6)(C) to 35 U.S.C. 156(g)(6)(A) and changed “two or three” to “five-year” in discussing the limit under this subsection.</p> <p>Changed from Mail Stop “Patent Extension” to “Hatch-Waxman PTE.”</p> <p>Added text to state that the original copy and the patent file will be scanned into the Image File Wrapper (IFW) system so that all documents will be viewable in PUBLIC PAIR. One copy of the application is forwarded to the regulatory agency and a second copy is used by a legal advisor in the Office of Patent Legal Administration (OPLA).</p>
<u>2754</u>	<p>Changed from Mail Stop “Patent Extension” to “Hatch-Waxman PTE.”</p> <p>Added text to state that PTE applications must not be filed via the Office’s electronic filing system (EFS-Web).</p>
<u>2754.01</u> <u>2754.01</u>	<p>Added text to explain that the AIA clarified that the sixty-day period of 35 U.S.C. 156 will not start until the next business day if the permission for commercial marketing or use for a product was transmitted after 4:30 pm on a business day or on a day that is not a business day.</p>
<u>2755.01</u>	<p>Deleted text that stated that notification of the issuance of interim extension will be published in the Official Gazette.</p>
<u>2755.02</u>	<p>Deleted text in the header of the sample of an order granting interim extension.</p>
<u>2756</u>	<p>Deleted text that stated a certified copy of the application for PTE is sent to the regulatory agency along with a second letter.</p> <p>Clarified text by changing “restoration” to “extension” in reference to 35 U.S.C. 156.</p>
<u>2757</u>	<p>Added text that in the determination of the regulatory review period for an animal drug where components were submitted to the FDA in a phased review, the approval phase defined in 35 U.S.C. 156(g)(4)(B)(ii) begins on the date of the submission of the administrative New Animal Drug Application. To support the added text, a citation to <i>Wyeth Holdings Corp. v. Sebelius</i>, 603 F.3d 1291, 1299-1300, 95 USPQ2d 1233, 1240 (Fed. Cir. 2010) was added.</p>
<u>2757.01</u>	<p>No substantive changes – minor grammatical correction(s).</p>
<u>2758</u>	<p>Modified text to state that the determination which finds the patent ineligible for PTE “dismisses” (instead of denies) the application.</p> <p>Modified the text of the sample Notice of Final Determination. In particular, the presentation of the formula for PTE is changed.</p>

MANUAL OF PATENT EXAMINING PROCEDURE

	<p>Deleted text pertaining to the restoration extensions not being applicable to patents in force on June 8, 1996 only because of a Hatch Waxman extension.</p> <p>Clarified text that “original expiration date” in 35 U.S.C. 154 includes patent term extension under former 35 U.S.C. 154(b) for applications filed between June 8, 1995 and May 28, 2000 and PTA under current 35 U.S.C. 154(b) for applications filed on or after May 29, 2000.</p> <p>Corrected the volume citation in F.2d for <i>Hoechst Aktiengesellschaft v. Quigg</i>, 917 F.2d 522, 525, 16 USPQ2d 1549, 1551 (Fed. Cir. 1990)</p>
<p>2759</p>	<p>Clarified and updated the proper name and location of the electronic FOIA Reading Room on the USPTO website.</p> <p>Deleted text that stated that a public file is available at the Public Search Room and the Office of Patent Legal Administration.</p>

CHAPTER 2800

Chapter 2800 is newly added to the MPEP and provides guidance on Supplemental Examination, which was created by section 12 of Public Law 112-29, known as the Leahy-Smith America Invents Act (AIA) (effective September 16, 2012).

2801	Introduction - Supplemental examination provides a patent owner with a mechanism to request that the Office consider, reconsider, or correct information believed to be relevant to the patent. Supplemental examination became available on September 16, 2012 as a result of AIA. Information submitted in a supplemental examination is not limited to patents and printed publications like <i>ex parte</i> reexamination; request may involve any grounds of patentability. A flowchart shows the general procedure of a supplemental examination.
2802	Recites and discusses 35 U.S.C. 257 – Provides a short summary of each paragraph of 35 U.S.C. 257. Once supplemental examination is requested, the Office will decide, within three months, whether a substantial new question of patentability (SNQ) is raised and publish the determination by issuing a certificate. If a SNQ is raised, then the Office will order reexamination to answer the question(s). If no SNQ is raised, the reexamination fee is refunded and the patent is not reexamined. Supplemental examination may insulate the patent owner from inequitable conduct defenses under certain conditions, which are provided in 35 U.S.C. 257(c).
2803	Discusses who can file a request by referring to 37 CFR 1.601(a), which states that only a patent owner may file a request for supplemental examination. The request must be filed by the owner(s) of the entire right, title, and interest in the patent unless one of the described rare exceptions apply.
2803.01	Discusses inquiries from persons other than the patent owner by referring to 37 CFR 1.601(b), which prohibits third parties from filing papers or otherwise participating in a supplemental examination.
2803.02	Discusses public access for a supplemental examination. The public will not be provided access to a request for supplemental examination until a filing date is granted. After a filing date has been accorded to the request, the supplemental examination files, except for non-patent literature, are open to the general public via Public PAIR.
2804	Explains who can represent the patent owner. An attorney or agent, who files a request on behalf of a patent owner, may act under a power of attorney under 37 CFR 1.32 or under a representative capacity under 37 CFR 1.34. Correspondence from the Office will be directed to the patent owner at the address indicated in the patent file.
2804.01	Explains that a practitioner can withdraw from representation in a patent, supplemental examination proceeding, or a reexamination proceeding, pursuant to 37 CFR 11.116(d), by taking steps to the extent reasonably practicable to protect a client's interests.
2805	Explains that the correspondence address will be the address in the file of the patent for which supplemental examination is requested. If the patent owner desires the Office to send correspondence to a different address, then a new power of attorney must be filed in the patent for which supplemental examination is requested and in the supplemental examination proceeding, or in the resulting <i>ex parte</i> reexamination proceeding, if ordered. A copy of form PTO/SB/81B is provided.
2806	Discusses how to file papers in a supplemental examination and any resulting <i>ex parte</i> reexamination proceeding. Stresses that a request for supplemental examination should be deposited as a new, separate, and independent submission, and not in the file of the patent for which supplemental examination is requested, or any other application, patent, or proceeding. Clarifies that a supplemental examination proceeding is separate and distinct from any <i>ex parte</i> reexamination proceeding resulting from it; even though any resulting <i>ex parte</i> reexamination proceeding will retain the same control number.

	<p>Subsection I explains that patent owners may submit papers in a supplemental examination proceeding via the Office's Web-based electronic filing system (EFS-Web) and how to electronically file a new request.</p> <p>Subsection II explains that the Office will accept a paper form request and any other paper(s) filed in the proceeding. Addresses are provided.</p> <p>Subsection III explains that requests for supplemental examination may not be facsimile-transmitted.</p>
2807	<p>Discusses the format for papers in supplemental examination by referring to 37 CFR 1.615. All papers must be formatted in accordance with 37 CFR 1.52. Court documents and non-patent literature may be redacted with certain discussed limitations.</p>
2808	<p>Explains the time for requesting supplemental examination by reciting to and discussing 37 CFR 1.601(c). A request for supplemental examination of a patent may be filed at any time during the period of enforceability of the patent.</p>
2809	<p>Discusses the definition of an item of information by referring to 37 CFR 1.605. An item of information is a document that contains information believed to be relevant to the patent.</p> <p>Subsection I explains that each request for supplemental examination may include no more than twelve items of information, but more than one request for supplemental examination may be filed.</p> <p>Subsection II states the requirements for an item of information.</p> <p>Subsection II.A explains that an item of information must be in writing.</p> <p>Any audio or video recording must be submitted in the form of a written transcript.</p> <p>Subsection II.B states that an item of information is usually a separate document from the request. Examples of different types of items of information are given.</p> <p>Subsection II.C explains that an item of information may be part of the request if the information to be considered is not contained within or based on a supporting document. In this case, the discussion within the body of the request relative to the information will be considered as the item of information.</p> <p>Subsection III discusses how items of information are counted. A single reference that raises multiple issues will be counted as a single item of information. Each of the references cited in a combination of references under 35 U.S.C. 103 will be separately counted as items of information. Cumulative items of information will be separately counted. A declaration or affidavit is usually counted as one item but if it presents two distinct items of information (such as information relating to 35 U.S.C. 101 issues and information related to 35 U.S.C. 103 issues), then each item of information will be counted separately. Patent owner cannot group multiple items of information together in a declaration or other document and have it counted as one item of information. Illustrative examples are provided. A non-English language document and its translation are counted as a single item of information.</p> <p>Subsection IV explains that certain papers should not be submitted with a request, such as petitions and amendments.</p>
2809.01	<p>Discusses information related to the correction of factual information. In a request for supplemental examination, the patent owner may inform the Office of factual information relevant to the patent which the patent owner wishes to correct. If the patent owner merely wishes to amend the patent file or correct inventorship, the owner should file a reissue application or a request for certificate of correction, where appropriate.</p> <p>Subsection I stresses that supplemental examination is limited to a determination of whether the request raises a SNQ. If the Office determines that no SNQ is raised by the request, the proceeding concludes with the issuance of a supplemental examination certificate indicating no SNQ is raised. In this case, there will be no opportunity to make changes (e.g., correct a priority or benefit claim) to the patent. If the Office determines that the request raises a SNQ, reexamination will be ordered and correction of factual information could be made during the reexamination. Emphasizes that</p>

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	<p>the Office will not initiate supplemental examination based on any item of information that was not requested by the patent owner to be considered, reconsidered or corrected.</p> <p>Subsection II explains that the Office recommends that any request that includes an item of information limited to the correction of factual information should also include one or more additional items of information that potentially provides evidence that the patentability of the claims depends upon the factual information to be corrected. The patent owner may include in the request one or more additional items of information, which are unrelated to the factual information to be corrected, and these unrelated items may raise a SNQ.</p> <p>Subsection III discusses that certain papers should not be submitted with the request, such as petitions and amendments.</p>
2810	<p>Explains the fees due by citing to 37 CFR 1.610(a) and (d). The filing fee, the <i>ex parte</i> reexamination fee, and any applicable document size fees must accompany the request for supplemental examination.</p>
2810.01	<p>Discusses document size fees, which are only applicable to non-patent documents having greater than 20 pages. Examples are provided.</p>
2811	<p>Explains the required content for a request for supplemental examination by reciting 37 CFR 1.610 and providing a summary of each provision of 37 CFR 1.610.</p> <p>Subsection I states that 37 CFR 1.610(b)(1) requires identification of the number of the patent for which supplemental examination is requested.</p> <p>Subsection II discusses 37 CFR 1.610(b)(2), which requires a list of each item of information that is requested to be considered, reconsidered, or corrected. Where appropriate, the list must meet the requirements of 37 CFR 1.98(b).</p> <p>Subsection III explains 37 CFR 1.610(b)(3), which requires a list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is requested.</p> <p>Subsection IV discusses 37 CFR 1.610(b)(4), which requires an identification of each claim for which supplemental examination is requested.</p> <p>Subsection V briefly discusses 37 CFR 1.610(b)(5), which requires that the request include a separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested. Reference is made to MPEP 2811.01 for a detailed discussion.</p> <p>Subsection VI explains 37 CFR 1.610(b)(6), which requires a copy of the patent for which supplemental examination is requested, including a copy of any disclaimer or certificate issued for the patent.</p> <p>Subsection VII discusses 37 CFR 1.610(b)(7), which requires a copy of each item of information listed in 37 CFR 1.610(b)(2), accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language document. No copy is required for U.S. patent documents or for items that form part of the discussion within the body of the request.</p> <p>Subsection VIII explains 37 CFR 1.610(b)(8), which requires a summary of the relevant portions of any submitted document (including patent documents), other than the request, that is over 50 pages long.</p> <p>Subsection IX discusses 37 CFR 1.610(b)(9), which requires an identification of the owner(s) of the entire right, title, and interest in the patent, and a submission by the patent owner in compliance with 37 CFR 3.73(c) establishing the entirety of the ownership in the patent.</p> <p>A copy of the transmittal form PTO/SB/59 is included.</p>
2811.01	<p>Provides a detailed discussion of the requirement for a separate, detailed explanation of the relevance and manner of applying each item of information to each claim, in accordance with 37 CFR 1.610(b)(5).</p> <p>Subsection I explains that a separate, detailed explanation must include, for each item of information listed pursuant to 37 CFR 1.610(b)(2), an explanation of how the item of information may be</p>

	<p>applied to the claims for which supplemental examination is requested. Explains that a separate, detailed explanation is also required for each dependent claim for which supplemental examination is requested. The use of chart claims to supply the explanation is encouraged. Illustrative examples are provided. Failure to provide the required explanation will result in the request not receiving a filing date. In that case, patent owner will be notified and be given a time period to correct the request.</p> <p>Subsection II discusses that the requirement for a detailed explanation may not be met by incorporating by reference a paper from another proceeding, or by relying on a paper of a third party.</p> <p>Subsection III explains that if the request includes an item of information limited to a correction of factual information, the request should also include one or more additional item(s) of information that potentially provide evidence that the patentability of the claims depends upon the factual information to be corrected. An example is given.</p>
<u>2811.02</u>	<p>Discusses optional content that may be included as part of the request by citing to 37 CFR 1.610(c). Subsection I states that a cover sheet may be included under 37 CFR 1.610(c)(1). The cover sheet should itemize each component submitted as part of the request.</p> <p>Subsection II explains that a table of contents may be submitted under 37 CFR 1.610(c)(2). Subsection III discusses that the request may include an explanation of how the claims patentably distinguish over the items of information in accordance with 37 CFR 1.610(c)(3). Patent owner is encouraged to provide this optional explanation separately from the required explanation under 37 CFR 1.610(b)(5).</p> <p>Subsection IV explains that 37 CFR 1.610(c)(4) permits inclusion an explanation why each item of information does or does not raise a SNQ. Patent owner is encouraged to provide this optional explanation separately from the required explanation under 37 CFR 1.610(b)(5).</p>
<u>2812</u>	<p>Explains that all processing for the supplemental examination and any resulting reexamination will be performed by the Central Reexamination Unit (CRU).</p>
<u>2812.01</u>	<p>Explains the requirements for receiving a filing date by reciting 37 CFR 1.610(d) and stating that the request must satisfy all the requirements of 37 CFR 1.605, 1.610 and 1.615. If a filing date is not granted, the Office will mail a Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d)), which will detail the defects in the request and set a time period to file a corrected request. A copy of the notice is provided.</p>
<u>2812.02</u>	<p>Further explains the procedure of mailing the Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d)). Recites 37 CFR 1.601(d).</p>
<u>2812.03</u>	<p>Describes the process of filing a corrected request. Explains that the patent owner has one opportunity to file a corrected request in response to a Notice of Noncompliant Supplemental Examination Request (37 CFR 1.610(d)). If the corrected request is compliant with filing date requirements, the Office will grant the corrected request a filing date as of its receipt date. If the correct fees were already paid, the fees do not have to be resubmitted with the corrected request. A corrected request may be filed via the Office’s electronic filing system or in paper by mail or hand-delivery.</p>
<u>2812.04</u>	<p>Explains that processing of a request will be terminated if a proper corrected request is not filed or is not timely received, or if the corrected request is defective/improper. In this case, the Office will mail a Notice of Termination and the reexamination fee will be refunded.</p>
<u>2813</u>	<p>Discusses the handling of papers, other than a request, in a supplemental examination proceeding and recites 37 CFR 1.620(b) and (c).</p> <p>Subsection I explains that 37 CFR 1.620(b) provides that the Office may hold in abeyance an action on any petition or other papers until after the proceeding is concluded.</p> <p>Subsection II states that if an unauthorized or otherwise improper paper is filed in a supplemental examination proceeding, it will not be entered into the official file or considered, or if inadvertently</p>

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	<p>entered, it will be expunged. After a request has received a filing date, no papers, except for a notice of prior or concurrent proceedings, should be filed in the supplemental examination. Subsection II.A explains that no third party papers are permitted because 35 U.S.C. 257(a) prohibits any party other than the patent owner from filing papers or participating in the supplemental examination proceeding.</p> <p>Subsection II.B states that where papers are defective, such papers will be expunged.</p> <p>Subsection II.C states that an application data sheet cannot be submitted in a supplemental examination proceeding.</p>
2813.01	Explains that no amendment may be filed in a supplemental examination proceeding and recites 37 CFR 1.620(f).
2814	States that interviews are prohibited in a supplemental examination proceeding and recites 37 CFR 1.620(e). A telephone call to confirm receipt or to ask purely procedural questions is not deemed an interview.
2815	Explains that, within 3 months of the filing date, the Office must issue a determination on whether a SNQ is raised by the request and recites 37 CFR 1.620(a).
2816	States that the standard used in evaluating the request is whether a SNQ is raised by any of the items of information properly presented in the request. The SNQ standard is the same as used in <i>ex parte</i> reexamination determinations. Recites 37 CFR 1.620(a).
2816.01	Explains that the claims of the patent in effect at the time of the determination will be the basis for deciding whether a SNQ is raised. Explains that if the patent owner fails to describe how any of the items of information may be applied to a patent claim, then the patent owner is not entitled to supplemental examination of that claim. Amendments and/or new claims presented in any copending post-patent Office proceeding will not be considered or commented upon in the determination on the request.
2816.02	<p>Explains the criteria for making a determination on a request.</p> <p>Subsection I discusses the SNQ standard. Explains that an item of information raises a SNQ where there is a substantial likelihood that a reasonable examiner would consider the item of information important in deciding whether or not the claim is patentable unless the same question was previously raised in another Office proceeding or has already been decided by a final holding of invalidity by a federal court. States that the meaning and scope of SNQ is not defined by statute and is determined on a case-by-case basis with reference to earlier court decisions involving <i>ex parte</i> reexaminations.</p> <p>Subsection II describes policies in specific situations concerning correction of factual information. Explains that an item of information limited to a correction of factual information, alone, may not raise a SNQ. Specifically, explains that for the correction of a foreign priority or domestic benefit claim to raise a SNQ, the request for supplemental examination should also include one or more additional item(s) of information. Examples are provided.</p>
2816.03	<p>Discusses content of the determination on a request for supplemental examination. The determination consists of the Supplemental Examination Certificate and the Reasons for Substantial New Question of Patentability Determination (the “reasons document”).</p> <p>Subsection I states that a supplemental examination certificate is prepared and lists all of the items of information properly submitted as part of the request and whether a substantial new question of patentability is raised. Samples of a certificate indicating that a SNQ is raised and a certificate in which no SNQ is raised are provided.</p> <p>Subsection II describes the reasons document, which explains why each item of information does or does not raise a SNQ.</p> <p>Subsection II.A indicates that the reasons document should include 1) a statement that the item of information raises a SNQ and identify the claims for which the SNQ is raised; 2) where appropriate, a statement that the item of information does not raise a SNQ and identify the claims for which a</p>

	<p>SNQ is not raised; and 3) a brief statement of the basis for the determination. Describes what the reasons document should point out if the examiner determines that a SNQ is raised, and if the examiner determines that a SNQ is not raised.</p> <p>Subsection II.B further describes the situation where the examiner determines that none of the items of information raise a SNQ. The reasons document should explain why each item did not raise a SNQ for each claim to which that item of information was applied in the request.</p> <p>Subsection II.C addresses the situation where the request includes an item of information limited to the correction of factual information. For example, the item may raise a SNQ depending upon whether the foreign priority or domestic benefit claim is or is not corrected. Examples are provided of what the examiner should provide in the reasons document.</p> <p>Subsection II.D explains that after an examiner has made a preliminary determination and formulated a draft certificate, the examiner will inform the CRU SPRS and a panel review conference will be convened. The conference members will review the preliminary determination. If confirmed, the certificate and reasons document are prepared for mailing.</p> <p>Subsection II.E provides form paragraphs that could be used in the reasons document.</p>
2816.04	Discusses the effect of the determination on the request. If the examiner determines that a SNQ is raised, <i>ex parte</i> reexamination of the patent will be ordered. If no SNQ is raised, reexamination will not be ordered and the reexamination fee will be refunded.
2817	States that a supplemental examination proceeding concludes with the issuance of the certificate indicating whether the request raised a SNQ. Recites 37 CFR 1.625(a).
2817.01	Discusses the processing and electronic issuance of the supplemental examination certificate. The certificate will be electronically issued and visible in Public PAIR within three months of the filing date. If reexamination is ordered, at the conclusion of the reexamination, the reexamination certificate will be published in accordance with established reexamination practice. If reexamination is not ordered, the supplemental examination certificate will be published in due course by the Office's patent publication process.
2818	Describes the procedure after conclusion of supplemental examination. The Office procedure after publication of the certificate depends on whether the Office determines that a SNQ affecting at least one claim of the patent is raised in the request. If a SNQ is found, reexamination is order. If a SNQ is not found, reexamination is not ordered and the reexamination fee is refunded. Recites 37 CFR 1.625(b) and (c).
2818.01	Explains the reexamination procedure after a determination finding a SNQ. The resulting reexamination generally follows the procedures for <i>ex parte</i> reexamination with a few described exceptions. A copy of form PTO-2302, Reexamination Ordered Pursuant to 35 U.S.C. 257, is provided.
2818.02	Explains that if the supplemental examination certificate indicates that no SNQ is raised in the request, the supplemental examination certificate will be published as an attachment to the patent. No reexamination is order and the reexamination fee will be refunded.
2819	Addresses discovery of possible material fraud on the Office in connection with the patent. Supplemental examination or any <i>ex parte</i> reexamination proceeding will continue and the matter will be referred to the U.S. Attorney General. Recites 37 CFR 1.620(g).
2820	States that the patent owner must, as soon as possible after discovery of any other prior or concurrent post-patent Office proceeding involving the patent, file a paper limited to notifying the Office of the post-patent Office proceeding. Recites 37 CFR 1.620(d).
2821	Discusses multiple post-patent Office proceedings. Generally, supplemental examination proceedings will not be merged, however, the Office reserves its option to merge proceedings as circumstances arise. If multiple post-patent proceedings are simultaneously filed, any determination of which proceedings to initiate, and when, will be made on a case-by-case basis.

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<u>2822</u>	Explains that supplemental examination requests will be assigned to the CRU in the same manner in which reexamination requests are assigned.
<u>2823</u>	Discusses differences between <i>ex parte</i> reexamination proceedings ordered pursuant to 35 U.S.C. 257 and <i>ex parte</i> reexamination proceedings ordered pursuant to 35 U.S.C. 302.