

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON, D.C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE

Instructions Regarding Revision No. 6

Submitted herewith is Revision No. 6 of the Manual of Patent Examining Procedure, Third Edition.

The revised pages are to be substituted for those in the Manual having corresponding page numbers.

This revision incorporates certain revised practices embodied in Change Notices 5-3 and 6-1 through 6-5, as well as certain changes in the Rules of Practice and changes in the Statutes. Note should be made of pages which reproduce or refer to the new Rules and Statutes, for the pages superseded thereby may still be pertinent to applications filed before October 25, 1965.

For the guidance of all users of the Manual the changes are recapitulated as follows:

The term "final fee" has been changed to -- issue fee -- on those pages where other changes have been made. See 203.04 (page 19) and 307 (page 22). These are exemplary only. A new page has not been reproduced where this changed term would constitute the only change to be made. The words "examining divisions," "supervisory examiner" and "principal examiner" have been changed to -- examining groups --, -- Group Manager -- and -- Supervisory Primary Examiner --, respectively, on those pages where other changes have been incorporated. See 203.08 (page 20), 707.02 (page 77) and 707.02 (a) (page 77), for example. See also 1005. A new page has not been reproduced where a single term or designation of this nature would constitute the only change to be made.

203.07 has been rewritten in line with the new issue fee provisions affecting allowed applications which became effective October 25, 1965. 203.08 has been revised to indicate the modified handling of "status letters" and to set forth in the last paragraph an additional type of inquiry relating to pending applications. 304 has been corrected to remove an obvious typographical error in the heading.

602.03 has been rewritten in its entirety to incorporate the substance of the Notice of July 22, 1965, (Series No. 6-1). 607 and 607.01 have been modified in accordance with the new law effective October 25, 1965. 608.02 (i), 608.02 (k) and 608.02 (l) have been modified to set forth the procedure for transferring drawings between applications, in accordance with the Notice of September 9, 1965. 706.03 (n) now includes a further instruction where "new matter" may be involved, as contained in the Notice of August 13, 1965. 706.07 (e) sets forth current practice following final rejections as contained in the Notice of August 11, 1965. 707.02 now specifies certain Examiner's Answers on appeal in the list of actions which require the attention of the Primary Examiner. 710.02 (b) lists the shortened periods for response to be set in different types of office actions in accordance with the current practice.

712 has been rewritten to set forth new Rules 316 and 317 and to explain further the status of an application which has become abandoned for failure to pay the issue fee. 713.01, 713.05 and 713.09 have been substantially expanded to reflect the present practice in the conduct of interviews in the general case, in special situations, after final rejection and after issue.

714.02 adds the substance of the Notice of August 13, 1965 and a further instruction in facilitating the prosecution. 714.10 states the effect of the new fee law in submitting excess claims. A new first paragraph has been added to 715.01 relating to the effective date of a U. S. patent, especially as applicable to a Rule 131 situation. 717.03 explains the advantage in maintaining certain pencil notes on the drawing and file wrapper. (Notice of July 22, 1965, Series No. 6-2).

903.07 adds the substance of the Notice of June 18, 1965, relating to the processing of applications being passed to issue. 1005 has been revised by eliminating one of the categories (old No. 2) and by adding a further explanatory paragraph. A revision has also been made in 1208.01 involving certain approval to be obtained in making a new rejection in the Examiner's Answer on appeal. 1302.04 adds the substance of the Notice of August 18, 1964, and also includes a change in the Examiner's Amendment practice. See also 1302.12. 1302.10 restates the portion relating to certain notations on drawings referred to in 717.03. The short

paragraph comprising 1302.13 has been revised. 1308 substitutes new Rule 313. 1308.02 has been eliminated and 1308.03 has been renumbered as 1308.02. The last paragraph of 1309.02 has been eliminated and the provision of the new fee law regarding issue fees for reissue applications is set forth. 1505 has been revised in accordance with new fee law.

Certain changes have also been made in the index pages, as well as in the "table of contents" pages at the beginning of certain chapters.

Within the size limitations of Revision No. 6, many pages have not been substituted which would contain solely changes of a minor nature or errors in typography which have come to the Editor's attention. It is anticipated that these will be embodied in subsequent revisions.

W. B. Penn, Editor
Manual of Patent Examining Procedure

List of Replacement Pages

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Errata Regarding Revision No. 6

A corrected page 78 is hereby submitted to replace the one erroneously inserted in Revision No. 6.

New pages 108.1 and 113 are hereby submitted to remove the obvious printer's defect of carrying out the last three lines of former page 108 onto page 113.

In 706.07(a), line 14, "six" should be ---- four ----.

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Foreword

This Manual is published to provide examiners in the Patent Office with a reference work on the practice and procedure within the Office as it relates to their duties and operations. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and generally outlines the current procedure which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications.

Examiners will continue to be governed as in the past by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner, the Director, Patent Examining Operation, or the Supervisory Examiners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated and identified as such. Orders and Notices, or portions thereof, relating to the examiners' duties and functions included in this Manual which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

DAVID L. LADD
Commissioner.

NOVEMBER 15, 1961.

Acknowledgments

Preparation of the text of the Third Edition was directed by Ernest A. Faller, Editor, under the supervision of Manuel C. Rosa, Director, Patent Examining Operation.

The Supervisory Examiners, Isaac G. Stone, Norman H. Evans, Burnham Yung Kwai, Sam Spintman, John S. Hull, Thomas F. Murphy, Harvey E. Kauffman and George A. Gorecki took an active part in this work, especially in rewriting Chapter 700.

Others who assisted were Pasquale J. Federico, Hyman B. Freehof, Examiners-in-Chief; Joseph Schimmel, Deputy Solicitor; Samuel Levin, LaVerne L. Williams, Interference Examiners; and Florence A. Hoffman, Division Clerk.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

Commissioner of Patents,
Washington, D.C. 20231

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Introduction

Constitutional Basis

The Constitution of the United States provides:

"ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U.S.C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes. The pamphlet also contains tables showing where subject matter comparable to present title 35 may be found in prior statutes, and where subject matter of prior statutes will be found in new title 35.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the Commissioner of Patents (1002) and

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from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on formal matters is final

but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.