

# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the U.S. Patent and Trademark Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the U.S. Patent and Trademark Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into substantially its present form. The patent law is Title 35 of the United States Code which governs all cases in the U.S. Patent and Trademark Office. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. Title 35 of the United States Code is reproduced in Appendix L of the Manual of Patent Examining Procedure (MPEP).

### 35 U.S.C. 1. Establishment.

(a) ESTABLISHMENT.— The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

(b) OFFICES.— The United States Patent and Trademark Office shall maintain its principal office in the metropolitan Washington, D.C., area, for the service of process and papers and for the purpose of carrying out its functions. The United States Patent and Trademark Office shall be deemed, for purposes of venue in civil actions, to be a resident of the district in which its principal office is located, except where jurisdiction is otherwise provided by law. The United States Patent and Trademark Office may

establish satellite offices in such other places in the United States as it considers necessary and appropriate in the conduct of its business.

(c) REFERENCE.— For purposes of this title, the United States Patent and Trademark Office shall also be referred to as the “Office” and the “Patent and Trademark Office”.

## Rules

One of the sections of the patent statute, namely, 35 U.S.C. 2, authorizes the Commissioner of Patents and Trademarks, subject to the policy direction of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the U.S. Patent and Trademark Office.

These regulations or rules and amendments thereto are published in the *Federal Register* and in the *Official Gazette*. In the *Federal Register* and in the Code of Federal Regulations the rules pertaining to patents are in Parts 1, 3, 4, 5, and 10 of Title 37, Patents, Trademarks, and Copyrights. In referring to a particular section of the rules the citation is given, for example, as 37 CFR 1.31. A booklet entitled “Code of Federal Regulations, Title 37, Patents, Trademarks, and Copyrights,” published by the Office of the Federal Register, contains all of the patent rules as well as trademark rules and copyright rules. Persons desiring a copy of this booklet should order a copy from the Superintendent of Documents.

The primary function of the rules is to advise the public of the rules which have been established in accordance with the statutes and which must be followed before the Office. The rules govern the examiners, as well as applicants and their attorneys and agents. The rules pertaining to patent practice appear in the MPEP as Appendix R.

## Commissioner’s Orders and Notices

From time to time, the Commissioner of Patents and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the U.S. Patent and Trademark Office. Notices and circulars of information or instructions have also been issued by other Office officials under authority of the Commissioner. Orders and Notices have served various purposes including giving examiners instruction, information, interpretations, and the like. Others have been for the information of the public, advising what the Office will do under specified circumstances.

## Decisions

In addition to the statutes and rules, the actions taken by the examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see MPEP § 1002), and that portion of the examiner's action pertaining to the rejection of claims on the merits may be reviewed by appeal to the Board of Patent Appeals and Interferences (see MPEP § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his or her actions, the examiner should cite the decision in the manner set forth in MPEP § 707.06.

## Publications Available from Superintendent of Documents

The following is a partial list of patent related publications available from the Superintendent of Documents. Orders should be addressed and remittances made payable to Superintendent of Documents, U. S. Government Printing Office, Washington, DC 20402.

*Official Gazette of the United States Patent and Trademark Office-Patents.* The official journal of the Patent and Trademark Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and a claim of each patent granted, indexes of patents, lists of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification.

*Annual Indexes.* An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

*Guide for the Preparation of Patent Drawings.* Contains selected rules of practice relating to patent draw-

ings and interpretations of those rules, including examples of patent drawings.

*Manual of Classification.* A looseleaf volume listing the numbers and descriptive titles of the more than 300 classes and 95,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time.

*General Information Concerning Patents.* Contains a vast amount of general information concerning the application for and granting of patents, expressed in nontechnical language for the layman. Multiple copies available from Superintendent of Documents.

*Manual of Patent Examining Procedure.* A looseleaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the U.S. Patent and Trademark Office's Examining Corps including statutes, rules, treaties, etc. Subscription service includes basic manual, revisions, and change notices.

*Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office.* An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U. S. Patent and Trademark Office.

*Code of Federal Regulations, Title 37, Patents, Trademarks, and Copyrights.* Compilation including the rules of practice of the U. S. Patent and Trademark Office.

## Publications Available From the U.S. Patent and Trademark Office

Orders should be addressed to Commissioner of Patents and Trademarks, Washington, DC 20231. Remittances should be made payable to Commissioner of Patents and Trademarks. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of U.S. Patent and Trademark Office fees.

*Basic Facts About Patents.* Brief nontechnical answers to questions most frequently asked about Patents.

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

*Patents.* Copies of the specification and drawings of all patents are available at three dollars each. When ordering, identify the patent by the patent number, or

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give full name of the inventor and approximate date of issuance of the patent.

*Classification Definitions.* Contain the changes in classification of patents as well as definitions of new and revised classes and subclasses. Price is based upon size of publication.

For a current list of U.S. Patent and Trademark Office (USPTO) publications and the sources from which these publications are available, contact the USPTO General Information Services Division at 1-800-786-9199 or 703-308-4357.

See MPEP § 1730 for additional information sources.

## MANUAL OF PATENT EXAMINING PROCEDURE