

Chapter 600 Parts, Form and Content of Application

601	Petition	607.02	Returnability
601.01	Amendment of	608	Disclosure
601.02	Power of Attorney or Authorization of Agent	608.01	Specification
602	Original Oath	608.01 (a)	Parts
602.01	Cannot Be Amended	608.01 (b)	Preamble
602.02	New Oath or Substitute for Original	608.01 (c)	May Be Omitted
602.03	Defective Oath Must Not Be Waived by the Examiner	608.01 (d)	General Statement of invention and Object
602.04	Foreign	608.01 (e)	Coextensive with Claims
602.04 (a)	Ribboned to Other Application Papers	608.01 (f)	Brief Description of Drawings
602.05	Too Old at Time of Filing	608.01 (g)	Detailed Description of Invention
602.05 (a)	In Division and Continuation Cases	608.01 (h)	Mode of Operation
603	Supplemental Oath	608.01 (i)	Claims
603.01	After Allowance	608.01 (j)	Numbering
604	Administration or Execution of Oaths	608.01 (k)	Statutory Requirement
604.01	Seal	608.01 (l)	Original
604.01 (a)	When Not Required	608.01 (m)	Form
604.02	Venue	608.01 (n)	Dependent Claims
604.03	Notaries and Extent of Jurisdiction	608.01 (o)	Basis for Terminology in Description
604.03 (a)	Notarial Powers of Some Military Officers	608.01 (p)	Completeness
604.04	Consul	608.01 (q)	Substitute or Rewritten
604.04 (a)	Omission of Certificate	608.01 (r)	Derogatory Remarks About Prior Art
604.05	Consular Fee Stamp	608.01 (s)	Restoration of Canceled Matter
604.05 (a)	Omission	608.01 (t)	Use in Subsequent Application
604.05 (b)	Embassies and Legations—Fee Stamp Not Required	608.01 (u)	Of Formerly Filed Incomplete Application
604.06	By Attorney in Case, Invalid	608.01 (v)	Trade-Marks and Trade Names
605	Applicant	608.02	Drawing
605.01	Citizenship	608.02 (a)	When New Drawing Is Required
605.02	Residence	608.02 (b)	Informal
605.03	Post Office Address	608.02 (c)	Or Print Always Kept in Examining Division
605.04	Signature and Name	608.02 (d)	Complete Illustration
605.04 (a)	Single Signature Form	608.02 (e)	Examiner Determines
605.04 (b)	Full First Name Required	608.02 (f)	Modification
605.04 (c)	Change of Name	608.02 (g)	Illustration of Prior Art
605.04 (d)	Unable To Write	608.02 (h)	Additional, Duplicate, or Substitute
605.04 (e)	Use of Title	608.02 (i)	Transfer From Prior Application
605.04 (f)	Joint	608.02 (j)	Canceled Sheets to Divisional
605.04 (g)	Correction of Name, Send File to Application Branch	608.02 (k)	Patented, to Reissue
605.04 (h)	Unsigned Specification and Signed Duplicate	608.02 (l)	To Continuation
605.04 (i)	On Drawings	608.02 (m)	Prints
605.05	Administrator or Executor	608.02 (n)	Patentability Report Cases
605.05 (a)	Signature	608.02 (o)	Data Entered on
606	Title of Invention	608.02 (p)	Dates Entered on
606.01	Examiner May Require Change in Title	608.02 (q)	Correction of
607	Filing Fee	608.02 (r)	Conditions Precedent to Amendment of Drawings
607.01	Fee Exempt	608.02 (s)	Separate Letter to Draftsman
607.01 (a)	Inventor Leaves Service of United States	608.02 (t)	Estimating Cost of Correcting Drawings
607.01 (b)	Fee Exempt Changed to Fee Filed	602.02 (u)	Cancellation of Figures
607.01 (c)	Fee Filed Changed to Fee Exempt	608.02 (v)	Changing Name of Attorney on Drawing Forbidden

- 608.02 (w) Changes Which May Require Sketches
- 608.02 (x) Changes Which May be Made by Examiner's Amendment Without a Sketch
- 608.02 (y) Disposition of Orders for Amendments of Drawing
- 608.02 (z) Return of Drawing
- 608.03 Models, Exhibits, Specimens
- 608.03 (a) Handling of
- 608.04 New Matter
- 608.04 (a) Matter Not in Original Specification, Claims or Drawings
- 608.04 (b) By Preliminary Amendment
- 608.04 (c) Review of Examiner's Holding

Rule 51 General requisites of an application. Applications for patents must be made to the Commissioner of Patents. A complete application comprises:

- (a) A petition or request for a patent, see rule 61.
- (b) A specification, including a claim or claims, see rules 71 to 77.
- (c) An oath, see rule 65.
- (d) Drawings, when necessary, see rules 81 to 88.
- (e) The prescribed filing fee. (See rule 21 for filing fees.)

[Old Rule 30]

The petition, specification, and oath must be in the English language and must be legibly written or printed in permanent ink. See Rule 52 and 608.01.

The parts of the application may be included in a single document, if the approved single signature form is used (Rule 58, 605.04 (a)).

Determination of completeness of an application is covered in 506.

The petition, specification and oath are secured together in a file wrapper bearing appropriate identifying data including the serial number and filing date (717).

NOTE

- Reissue patents, 1401.
- Design patents, Chapter 1500.
- Plant patents, Chapter 1600.

A model, exhibit or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (Rules 91-93, 608.03).

Rule 59 Papers of complete application not to be returned. The papers in a complete application will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost. See rule 87 for return of drawing.

[Old Rule 72, par. 1]

601 Petition

Rule 61 Petition. The petition must be addressed to the Commissioner of Patents and must state the name, residence, and post office address of the petitioner

and request the grant of a patent; designate by title the invention sought to be patented; contain a reference to the specification for a full disclosure of such invention; and must be signed by the applicant in person.

The power of attorney or authorization of agent may be incorporated in the petition.

In the single signature form, the statements above required for a separate petition do not all appear in the petition paragraph and are differently arranged. (See rule 58.)

[Old Rule 33]

Petitioner's or applicant's post office address is discussed in 605.03.

The petition need not be dated.

601.01 Amendment of Petition

Those portions of the petition other than the post office address (see 605.03) may be amended by the attorney. (Extract from Order No. 1994.)

601.02 Power of Attorney or Authorization of Agent

Usually a power of attorney or authorization of agent is incorporated in either the petition or single signature form. See 402 and 605.04 (a).

The attorney's or agent's full post office address should be given in every power of attorney or authority of agent. The prompt delivery of communications will thereby be facilitated. (Extract from Notice of Oct. 8, 1946).

602 Original Oath

Rule 65 Oath of applicant. (a) The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state under oath that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States for more than one year prior to his application, or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country

or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

(b) If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the oath shall state the relationship of the affiant to the inventor and, upon information and belief, the facts which the inventor is required by this rule to make oath to.

(c) An additional oath may be required if the application has not been filed in the Patent Office within a reasonable time after the execution of the original oath.

(d) In the case of applications for patent for inventions to which section 3 of 61 Stat. 794; Public Law 380, August 6, 1947; 35 U. S. C., Supp., 101 note, applies, the oath should include a statement that the invention was not made before January 1, 1946, or was not made before January 1, 1946 in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. If not included in the oath, a separate affidavit will be required.

[Old Rule 46]

The single signature form mentioned in Rule 58 includes the oath.

An oath which refers to applicant as "the petitioner" need not contain applicant's name in the body thereof.

In the oath, the jurat must be filled out, and the word "sole" or "only" must appear if there is but one inventor, and "joint" if two or more inventors.

The oath usually bears an impressed seal of the administering official but such seal may not always be required. See Rule 66, and 604 to 604.01 (a).

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath is required. Rule 67, 603.

602.01 Oath Cannot Be Amended

The wording of an oath cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath must be required. However, in some cases a deficiency in the oath can be corrected by a supplemental paper and a new oath is not necessary.

For example, if the oath does not set forth evidence that the notary was acting within his jurisdiction at the time he administered the oath a certificate of the notary that the oath was taken within his jurisdiction will correct the deficiency. See 604.02.

Likewise, a consular certificate (604.04 (a)) or a consular fee stamp (604.05) can be added to correct a deficiency in the oath.

602.02 New Oath or Substitute for Original

In requiring a new oath, the Examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath, preferably by giving the serial number and the date of filing.

Where neither the original oath, nor the substitute oath is complete in itself, but the two taken together give all the required data, no further oath is needed.

602.03 Defective Oath Must Not Be Waived by the Examiner

The fact that the courts would probably not invalidate a patent because of a defective oath does not relieve the Examiner of the duty of requiring the appropriate remedy for any such defect.

602.04 Foreign Oath

An oath executed in a foreign country must be properly authenticated, 604, Rule 66.

602.04 (a) Foreign Oath Is Ribboned to Other Application Papers

Extract from Rule 66. (b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

[Old Rule 47]

602.05 Oath Too Old at Time of Filing

The time elapsed between the date of execution of oath and the filing date of the application should be checked for compliance with Rule 65 (c). If an unreasonable time has elapsed, the Examiner should call for a new oath. What constitutes a reasonable time is a question of judgment to be determined by all the circumstances in the particular case. (Five weeks plus time of transmission in the mails was consid-

ered reasonable under the circumstances of *ex parte* Heinze, 1919 C. D. 67; 265 O. G. 145). Note 602.05 (a).

602.05 (a) Oath in Division and Continuation Cases

Where the date of filing the application is not the date that determines the statutory twelve months' period, as in divisional and continuation cases, it is immaterial, so far as concerns the acceptability of the oath, how long a time intervenes between the execution of the oath and the filing of the application.

When a divisional application is identical with the original application as filed, signing and execution of the oath in the divisional case may be omitted. (See Rule 147, 201.06).

603 Supplemental Oath

Rule 67 Supplemental oath for matter not originally claimed. (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented in any foreign country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath here required may be made on information and belief by an executor or administrator of a deceased person or a guardian, conservator, or representative of an insane person.

[Old Rule 48]

Rule 67 requires in the supplemental oath substantially all the data called for in Rule 65 for the original oath. As to the purpose to be served by the supplemental oath, the Examiner should bear in mind that it cannot be availed of to introduce new matter into an application. It applies only to matter originally shown or described but not embraced in the statement of invention or claims as originally presented.

603.01 Supplemental Oath Filed After Allowance

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 Fed. 158, many supplemental

oaths covering the claims in the case have been filed after the case is allowed. Such oaths may be filed as a matter of right and when received they will be placed in the file by the Issue Branch, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under Rule 312, since they make no change in the wording of the papers on file. (Order No. 2798.) See 714.16.

604 Administration or Execution of Oath

Extract From Rule 66 Officers authorized to administer oaths. (a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made, except that no oath or affirmation may be administered by any attorney or agent appearing in the case. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by a competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

[Old Rule 47]

NOTE:

Seals, 604.01.

When unnecessary, 604.01 (a).

In foreign case, 602.04 (a).

604.01 Seal

An oath under Rule 65 administered by a civilian official must be attested to by a competent seal, as required by Rule 66.

The seal must be a physical impression such as produced with a die upon the paper or upon a substance adherent to the paper. See also 602.04 (a) on foreign executed oath and seal.

604.01 (a) Seal, When Not Required

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in 604.03 (a), in which situations no seal is necessary.

604.04 (a) Consul-Omission of Certificate

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad, the Examiner should require a consular certificate for the original oath.

604.05 Consular Fee Stamp

Sec. 10, Act approved April 5, 1906; "when-ever a consular officer is required or finds it necessary to perform any consular or notarial act he shall prepare and deliver to the party or parties at whose instance such act is performed a suitable and appropriate document as prescribed in the consular regulations and affix thereto and duly cancel an adhesive stamp in the denomination or denominations equivalent to the fee prescribed for such consular or notarial act, and no such act shall be legally valid within the jurisdiction of the Government of the United States unless such stamp or stamps is or are affixed and cancelled."

604.05 (a) Omission of Consular Fee Stamp

In all applications executed abroad before a consular officer, from which the required consular fee stamp has been omitted, the first action in the case will include the requirement that the necessary stamp be forwarded to the Patent Office to be affixed to the affidavit and canceled by the Head of the Application Branch. (Order No. 2032, Revised.)

604.05 (b) Embassies and Legations Stamp Not Required

Embassies and legations are not supplied with fee stamps, and are not required to attach any such stamps to papers executed by them. (Extract from Notice of Aug. 4, 1914.)

604.06 Oath by Attorney in Case, Invalid

The oath may not be executed before a notary who has power of attorney in the case. If such an oath is offered as one of the original papers, the application is not accepted as "complete," since an oath so executed is invalid and without legal effect. (Riegger v. Beierl, 1910 C. D. 12; 150 O. G. 826.) Rule 66, 604.

605 Applicant

Rule 41 Only inventor may apply for patent. Only the actual inventor may apply for a patent and the application papers must be signed and the necessary oath executed by the inventor, unless the inventor is dead or insane. See rule 147.

Extract from Rule 45. Joint inventors. (a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly.

For convertibility from a joint to sole application see 201.03.

Rule 46 Assigned inventions and patents. In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made by the inventor as indicated in rules 41 and 45, or by one of the persons mentioned in rules 42 and 43. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in rule 334.

[Old Rule 26]

Rule 47 Applicant. Unless the contrary is indicated, the word "applicant" when used in these rules refers to the inventor (rule 41), joint inventors who have applied for a patent (rule 45), or to the person mentioned in rule 42 or 43 who has applied for a patent in place of the inventor.

NOTE

Disposition of application by inventor, 301.

Inventor dead or insane, 409.

Nationals of Germany or Japan may not apply for or obtain patents for any invention made, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. Public Law 380, Sec. 3, 602 O. G. 675-6.

605.01 Applicant's Citizenship

The statute (Sec. 4892, R. S.; 35 U. S. C. 35) requires an applicant to state his citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement; but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

605.02 Applicant's Residence

The rules of practice require that the applicant state his place of residence. In the case of an applicant who is in the U. S. Army or U. S. Navy, a statement to that effect is sufficient as to residence. For change of residence see 717.02 (b).

605.03 Applicant's Post Office Address

Applicant's post office address means under Rule 61 that address at which he customarily receives his mail.