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701 Statutory Authority for Examination

The authority for the examination of applications for patents is set forth in Sec. 4893 R. S.; 35 U. S. C. 36.

On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and, if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. (R. S. Sec. 4893.)

The examination, made under the provisions of Sec. 4893 is to ascertain two things:

1. Is the applicant the first inventor of a patentable invention?
2. Has he taken the necessary steps to obtain a patent?

The main conditions precedent to the grant of a patent to an applicant inventor are set forth in Sec. 4886, R. S.; 35 U. S. C. 31:

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law,

and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

The other Statutes, Rules of Practice and decisions of the Courts determine what "other due proceeding" must be had to obtain a patent.

702 Requisites of the Application

The Examiner should be careful to see that the application meets all the requisites set forth in Chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

702.01 Obviously Informal Cases

Whenever in the assignment of applications the Primary Examiner finds that a newly filed application obviously fails to disclose an invention with the clarity required by Sec. 4888 R. S., 35 U. S. C. 33, or whenever immediately after assignment his attention is directed to such an application, he should call attention to Rule 71 and require in the first Office action, which should be taken immediately, that the application be revised to conform with the practice prevailing before this Office. A shortened statutory period may be set for compliance with this requirement, the duration of such shortened period, if set, being determined by the Primary Examiner in accordance with the complexity of the case, the revision of the specification necessary, and time necessary for communication with the applicant. These actions, in all cases, regardless of whether a shortened statutory period is set, should be submitted to the Supervisory Examiners for approval. (Notice of Jan. 23, 1947.)

A suitable form for this action is as follows:

A preliminary examination of this application discloses that it fails to comply with Sec. 4888 R. S. in that the invention is not presented with sufficient clarity to make possible an intelligent examination on the merits in a reasonable time.

In accordance with Rule 71, it is required that this application be revised to conform with the practice before this Office within the shortened statutory period hereinafter set to avoid any question of abandonment.

THE SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE -----

For the procedure to be followed when the drawing is informal, see 608.02 (a) and 608.02 (b).

703 "General Information Concerning Patents" Sent Instead of "Rules of Practice"

Whenever in the examination of an application the Examiner deems it advisable to send information about patent matters to the applicant for his guidance, the small pamphlet entitled "General Information Concerning Patents" should be sent if suitable. (Notice of January 15, 1924, Revised.)

704 Search

After reading the specification and claims, the Examiner searches the prior art. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution. The search on an informal application should be as complete as can be made in view of the understanding of the invention to be had therefrom. See 904 through 904.02 and 717.05.

705 Patentability Reports

Where an application, properly assigned to one examining division, is found to contain one or more claims *per se* classifiable in one or more other divisions, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first division, the application may be referred to the other division or divisions concerned for a report as to the patentability of certain designated claims. This report will be known as a Patentability Report (P. R.) and will be signed by the Primary Examiner of the reporting division. Credit for an action will be given for each such report. (Extract from Notice of November 10, 1948.)

705.01 Instructions re Patentability Reports

705.01 to 705.01 (f) are quotations from the Notice of November 12, 1948.

In the prosecution of an application under conditions authorized in the Notice of November 10, 1948, relating to Patentability Reports, the following procedure should be observed.

When an application comes up for any action and the Primary Examiners involved agree that a Patentability Report is necessary, the application will be forwarded to the proper division with a memorandum attached, for instance, For Patentability Report from Division ----- as to Claims-----.

705.01 (a) Nature of P. R., Its Use and Disposal

The Primary Examiner of the division from which the Patentability Report is requested, if he approves

the request, will direct the preparation of the Patentability Report. This Patentability Report will be made on Memo Form #64 and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. When an examiner to whom a case has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he should so state. The Patentability Report when signed by the Primary Examiner of the reporting division will be returned to the division to which the application is regularly assigned.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the examiner to whom the case is assigned to avoid duplication of work. If the Primary Examiner of a reporting division is of the opinion that a Patentability Report is not in order, he should so advise the Primary Examiner of the forwarding division.

Conflict of opinion as to classification or joinder may be referred to an Examiner of Classification for decision.

If the Primary Examiner of the Division having jurisdiction of the case agrees with the patentability Report, he should incorporate the substance thereof in his action, which action will be complete as to *all* claims. The Patentability Report in such a case will *not* be given a paper number but will be allowed to remain in the file until the case is finally disposed of by allowance or abandonment, at which time it should be removed.

If the Primary Examiner does not agree with the Patentability Report or any portion thereof, he may consult with the Primary Examiner responsible for the report. If agreement as to the resulting action cannot be reached, the Primary Examiner having jurisdiction of the case need not rely on the Patentability Report but may make his own action on the referred claims, in which case the Patentability Report should be removed from the file.

705.01 (b) Sequence of Examination

In the event that the Primary Examiners concerned in a P. R. case cannot agree as to the order of examination by their divisions, the Primary Examiner having jurisdiction of the case will direct that a complete search be made of the art relevant to his claims prior to referring the case to another division for report. The division to which the case is referred will be advised of the results of this search.

If the Primary Examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

on repeatedly, unless the examiner has indicated that the action is final.

706.01 Contrasted With Objection

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the Examiner's letter. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Appeals, while an objection, if persisted in, may be reviewed only by way of petition to the Commissioner.

An example of a matter of form as to which objection is made is improper dependency of a claim. See 608.01 (n).

706.02 Rejection on Prior Art

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed matter is not "new" and patentable or does not involve invention. The reference relied upon is identified and the claim is accordingly rejected either because it is *fully met* therein, or if there is a difference between the requirements of the claim and the showing of this prior art, as unpatentable thereover.

In the event that there is no invention involved in combining several elements of two or more prior structures, the rejection is made on the combination of the several references. See 707.07 (d) for language to be used in rejecting claims.

A patent can be used as a reference against an application even though the patent date is after the filing date of an application provided that the filing date of the patent is prior to the filing date of the application. The fact that the second applicant had no way of knowing about the prior application that is now a patent does not matter. It is proper to use such a patent as a basic or an auxiliary reference and such patents may be used as both basic and auxiliary references. The doctrine of the *Milburn Co. v. Davis-Bournonville Co.* decision, 1926 C. D. 303; 344 O. G. 817, has been thus construed in *In re Youker (C. C. P. A.)*, 1935 C. D. 658; 461 O. G. 10, and in *Minn. Mining & Mfg. Co. v. Coe (C. A. D. C.)* 1938 C. D. 100; 497 O. G. 766.

For the proper way to cite a patent granted after the filing of an application, see 707.05 (e) and the sample letter in 707.03.

706.02 (a) Establishing "Well Known" Prior Art

Things believed to be known to those skilled in the art are often asserted by the Examiner to be "well known" or "matters of common knowledge". If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In *re Malcolm*, 1942 C. D. 589; 543 O. G. 440. If the applicant traverses such an assertion the Examiner should, if possible, cite a reference in support of his position.

Failure of the applicant to seasonably challenge such assertions establishes them as admitted prior art. See *In re Gunther*, 1942 C. D. 332; 538 O. G. 744; *In re Chevenard*, 1944 C. D. 141; 560 O. G. 196. This applies also to assertions of the Board. In *re Selmi*, 1946 C. D. 525; 591 O. G. 160; *In re Fischer*, 1942 C. D. 295; 538 O. G. 503.

706.03 Rejections Not Based on Prior Art

Although they constitute a relatively small percentage of all rejections made, there are a number of rejections which may be appropriate despite the fact that no pertinent prior art is discovered in the search. The Examiner's function is not to scrutinize each claim with the idea of rejecting it on some far-fetched technical ground. Nevertheless, claims which, for example, are drawn to nonstatutory subject matter, or are functional, or present new matter, or are barred by some prior act of the inventor should be recognized as such and rejected. These rejections are explained in the following sections.

706.03 (a) Nonstatutory Subject Matter

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by R. S. 4886; 35 U. S. C. 31 (701), which permits patents to be granted only for "any new and useful art, machine, manufacture, or composition of matter, or any new useful improvements thereof, or----- any distinct and new variety of plant other than a tuber-propagated plant."

This subject matter is further limited by the Atomic Energy Act explained in 706.03 (b). Judicial decisions, have determined the limits of the classes set forth in R. S. 4886. Examples of subject matter not patentable under the Statute follow: