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1301 Substantially Allowable Case, Special [R-30]

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action

taken to require correction of formal matters. See § 710.02(b).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure [R-46]

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole case meets all formal requirements and particularly that the brief summary of the invention and the descriptive matter are confined to the invention to which the allowed claims are directed and that the language of the claims finds clear support or antecedent basis in the specification. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the examiner should require the applicant to modify his brief summary of the invention and restrict his descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (rule 71.) Of course enough background should be included to make the invention clearly understandable. See §§ 608.01(d) and 608.01(e).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See § 601.01(o).

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or become abandoned and that fact or the patent number added to the specification.

The claims should be renumbered as required by rule 126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. An examiner's amendment should be prepared if the order of the claims is changed. See §§ 608.01(j), 608.01(n) and 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosure. See § 608.01(b).

The title should also be checked. It should be as short and specific as possible. If a satisfactory title is not supplied by the applicant, the examiner may change the title on or after allowance. See §§ 606 and 606.01.

All pencil notes made by the examiners must be erased when the case is passed to issue.

The Mail Room receipt date of all amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification [R-24]

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the case to issue. See rule 125 in § 608.01(q).

1302.03 Status Letter of Allowability, POL-327 [R-31]

Form POL-327 is used whenever an application has been placed in condition for allowance as a result of a communication from or an interview with applicant except where an examiner's amendment will be mailed promptly.

The date of the communication or interview which resulted in the allowance and the name of the person with whom the interview, if any, was held should be included in the letter.

Immediately after determining that a POL 327 letter or examiner's amendment is necessary, it should be prepared and mailed before preparing the application for allowance. See § 714.13.

1302.04 Examiner's Amendments and Changes [R-46]

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See rule 121.)

Correction of the following obvious errors and omissions only may be made with pen by the examiner of the case who will then initial the sheet margin and assume full responsibility for the change. When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.
5. Entry of "Patent No. ----" to identify a patent which has been granted on a U.S. application referred to by serial number in the specification.
6. Entry of "abandoned", if a U.S. patent application referred to by serial number in the specification has become abandoned.
7. Entry of "now Defensive Publication No. T ----" following the filing date if a patent application referred to in the specification by serial number has been published as a Defensive Publication.
8. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
9. Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

The fact that applicant is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Serial No. ----, filed ----" should appear as the first sentence after the abstract except in the case of design applications where it should appear as set forth in § 1503.01. Any such statements appearing elsewhere in the specification should be relocated. The clerk indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

Other obvious informalities in the application may be corrected by the examiner, but such corrections must be by a formal examiner's amendment, signed by the primary examiner, placed in the file, and a copy sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his attorney or agent) in a telephone or

personal interview. The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts

under special conditions. Such charges must not exceed \$50.00 for any one patent application.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to ex-

pedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (drawing correction, additional claims, etc.), and the deposit account number. Further identifying data, if deemed necessary and requested by the attorney, should also be included in the examiner's amendment.

A change in the abstract may be made by examiner's amendment.

Where a reference to the parent application in an otherwise allowable rule 60 case has inadvertently been omitted by the applicant, the examiner should insert the required reference by examiner's amendment (see § 201.11).

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PO-892, a copy of which will be attached to examiner's amendment form POL-37.

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will note in pencil on the drawing the addition or alteration to be made. He will also prepare an examiner's amendment indicating the changes made and send the drawing to the Draftsman for the required correction.

See also § 608.02(w).

→ No other changes may be made by any person in any record of the Patent and Trademark Office without the written approval of the Commissioner of Patents and Trademarks.

→ In reviewing the application all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time a case is being prepared for issue by the examiner. However, the need for such may not be noted until after the proof of the patent is read and the case is sent up to the examiner with a "printer waiting" slip (Form PO-97). A copy of any formal examiner's amendment is sent to applicant even if the application is already in the printer's hands. See § 1309.01.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed, *In re Willingham*, 127 USPQ 211, CCPA (1960).

In all instances, both before and after final

rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of form letter POL-327 or an examiner's amendment. [R-47]

1302.04(a) Title of Invention [R-24]

Where the title of the invention is not specific to the invention as claimed, see § 606.01.

1302.04(b) Cancellation of Non-Statutory Claim [R-17]

When a case is otherwise in condition for allowance the examiner may cancel an obviously non-statutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Non-Elected Invention [R-24]

See §§ 821.01 and 821.02.

1302.04(d) Cancellation of Claim Lost in Interference [R-24]

See § 1109.02.

1302.04(e) Cancellation of Rejected Claims Following Appeal [R-24]

See §§ 1214.06, 1215.03, and 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date [R-47]

Where a patent application which is ready for issue refers by serial number to a U.S. application which has matured into a patent, the examiner is authorized to enter the patent number without a formal examiner's amendment. This entry should be in the following form: "Patent No. ----." Where a referred to patent application has been published as a Defensive Publication, the examiner should enter "now Defensive Publication No. T—, —" following the filing date. They entry is to be initialed and dated in the margin by the examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the application referred to has become abandoned, the entry, "abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

1302.04(g) Identification of Claims [R-17]

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

1302.05 Correction of Drawing [R-24]

Where a case otherwise ready for issue requires correction of the drawing, the examiner, before sending the file to the Draftsman, should attach thereto a slip indicating that the case is ready for allowance. Slight defects may be corrected on the examiner's initiative as set forth in § 608.02(w) and a formal examiner's amendment prepared.

Correction of some slight defects may be obviated, see § 608.02—"Waiving of Corrections"

1302.06 Prior Foreign Application

See §§ 201.14(c) and 202.03.

1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications [R-47]

Related applications referred to in patent specifications are preserved from destruction by a retention label (Form PO-150) which is attached to the outside of the file wrapper. The final review clerk of the group prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath or declaration of the application ready for allowance (or in any Office letter therein).

If the case referred to is

Still pending:

Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

Abandoned for failure to pay issue fee:

If file has been forwarded to abandoned files, fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded, treat the same as pending case.

Abandoned:

If file has been forwarded fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded treat the same as pending case. Add "now abandoned" by red ink and initialing to the allowable application.

Already patented:

No label is required. Insert patent number in specification if not already present. Formal examiner's amendment not necessary if this is only change.

In issue:

Fill in label. Make no change in the specification of the allowable application. Clip the label to the serial register card of the case in issue. If case in issue is abandoned or is withdrawn from issue, it is returned to the group, where the serial register card is pulled. The label is attached at this time. If case in issue is patented, the label is destroyed when the card is pulled.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the serial number cited thereon.

1302.08 Interference Search [R-24]

Assuming that the case is found ready for issue, the examiner makes an "interference search" and notes the date and class and subclasses searched in the file wrapper. To do this, he inspects all the pending prints and drawings (or all the digests if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his group or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, he examines the corresponding file.

If the search does not disclose any interfering application, the examiner should prepare the case for issue.

1302.09 Notations on File Wrapper [R-41]

The examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid the Patent Issue Division and the printers, examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral