

# Chapter 700 Examination of Applications

- 701 Statutory Authority for Examination
- 702 Requisites of the Application
- 702.01 Obviously Informal Cases
- 703 "General Information Concerning Patents" Sent Instead of "Rules of Practice"
- 704 Search
- 705 Patentability Reports
- 705.01 Instructions re Patentability Reports.
- 705.01 (a) Nature of P. R., Its Use and Disposal
- 705.01 (b) Sequence of Examination
- 705.01 (c) Counting and Recording P. R.'s
- 705.01 (d) Duplicate Prints of Drawings
- 705.01 (e) Limitation as to Use
- 705.01 (f) Interviews With Applicants
- 706 Rejection of Claims
- 706.01 Contrasted With Objections
- 706.02 On Prior Art
- 706.02 (a) Establishing "Well Known" Prior Art
- 706.03 Not based on Prior Art
- 706.03 (a) Nonstatutory Subject Matter
- 706.03 (b) Barred by Atomic Energy Act
- 706.03 (c) Functional
- 706.03 (d) Indefinite
- 706.03 (e) Product by Process
- 706.03 (f) Incomplete.
- 706.03 (g) Prolix
- 706.03 (h) Nonstatutory Claim
- 706.03 (i) Aggregation
- 706.03 (j) Old Combination
- 706.03 (k) Duplicate Claims; Double Patenting
- 706.03 (l) Multiplicity
- 706.03 (m) Non-elected Inventions
- 706.03 (n) Correspondence of Claims and Disclosure
- 706.03 (o) New Matter
- 706.03 (p) No Utility
- 706.03 (q) Obvious Method
- 706.03 (r) Mere Function of Machine
- 706.03 (s) Statutory Bar
- 706.03 (t) Earlier Assigned Case
- 706.03 (u) Disclaimer
- 706.03 (v) After Interference or Public Use Proceeding
- 706.03 (w) Res Judicata
- 706.03 (x) Defective Reissue Oath
- 706.04 Previously Allowed Claim
- 706.05 After Allowance of Application
- 706.06 Claims Copied from Patent
- 706.07 Final Rejection
- 706.07 (a) When Proper
- 706.07 (b) When Proper on First Action
- 706.07 (c) Premature
- 706.07 (d) Withdrawal of Premature
- 706.07 (e) Withdrawal, General
- 707 Examiner's Letter of Action
- 707.01 Primary Examiner Indicates Action for New Assistant
- 707.02 Actions which Require the Personal Attention of the Primary Examiner
- 707.02 (a) Cases Up for Third Action and Five-Year Cases
- 707.03 Sample of Conventional "First Action" Letter
- 707.04 Initial Sentence
- 707.05 Citation of References
- 707.05 (a) Grouped at Beginning of Letter
- 707.05 (b) "References Applied"
- 707.05 (c) References Pertinent
- 707.05 (d) References Cited in Subsequent Actions
- 707.05 (e) Data Used in Citing References
- 707.05 (f) Effective Dates of Declassified Printed Matter
- 707.05 (g) Incorrect Citation of References
- 707.06 Citation of Decisions, Orders and Notices
- 707.07 Completeness and Clarity
- 707.07 (a) Action on Formal Matters
- 707.07 (b) Requiring New Oath
- 707.07 (c) Draftsman's Requirement
- 707.07 (d) Language To Be Used in Rejections
- 707.07 (e) Note All Outstanding Requirements
- 707.07 (f) Answer All Material Traversed
- 707.07 (g) Piecemeal Prosecution
- 707.07 (h) Notify of Inaccuracies in Amendment
- 707.07 (i) Each Claim To Be Mentioned in Each Letter
- 707.07 (j) State When Claims Are Allowable Except as to Form
- 707.07 (k) Numbering Paragraphs
- 707.08 Review by Assistant Examiner
- 707.09 Signing by Primary or Acting Primary
- 707.10 Entry
- 707.11 Date
- 707.12 Mailing
- 707.13 Returned Office Action
- 707.14 Action Preceding Final
- 708 Order of Examination
- 708.01 List of Special Cases
- 708.02 Petition to Make Special
- 708.03 Examiner Tenders His Resignation
- 709 Suspension of Action
- 709.01 Overlapping Applications by Same Applicant or owned by Same Assignee
- 709.02 Actions Following Correspondence under Rule 202
- 710 Period for Response
- 710.01 Statutory
- 710.01 (a) How Computed
- 710.02 Shortened Statutory Period and Time Limit Actions
- 710.02 (a) Approval of Time Set in Case of Shortened Statutory Period

MANUAL OF PATENT EXAMINING PROCEDURE

- 710.01 (b) Situations in Which Used: Shortened Statutory Period
- 710.02 (c) Situations in Which Used: Nonstatutory Time Limit
- 710.02 (d) Differences Between Shortened Statutory and Time Limit Periods
- 710.02 (e) Extension of Time
- 710.03 Three Year Period, Government-owned Cases
- 710.04 Two Periods Running
- 710.04 (a) Copying Patent Claims
- 710.05 Period Ending on Sunday or Holiday
- 710.06 Miscellaneous Factors Determining Date
- 711 Abandonment
- 711.01 Express or Formal Abandonment
- 711.02 Failure to Take Required Action During Time Period
- 711.02 (a) Insufficiency of Response
- 711.02 (b) Special Cases Involving Abandonment
- 711.03 Reconsideration of Holding of Abandonment: Revival
- 711.03 (a) Holding Based on Insufficiency of Response
- 711.03 (b) Holding Based on Failure to Respond Within Period
- 711.03 (c) Petitions Relating to Holding of Abandonment
- 711.03 (d) Examiner's Statement on Petition
- 711.04 Disposal of Abandoned Files
- 711.04 (a) Pulling, Counting, Listing
- 711.04 (b) Ordering Abandoned Files
- 711.05 Letter of Abandonment Received After Application is Allowed
- 711.06 Publication of Abstracts
- 711.06 (a) Requirements of the Request
- 711.06 (b) Handling of Papers by Examiner
- 711.06 (c) Handling of Papers by Supervisory Examiners
- 711.06 (d) Request Does Not Serve as a Response to Office Action
- 711.06 (e) If the Request Indicates That the Application Will Be Abandoned Only If No Interfering Application Is Found
- 711.06 (f) Use as Reference
- 712 Forfeiture
- 713 Interviews
- 713.01 General Policy, How Conducted
- 713.02 Interviews Prior to First Official Action
- 713.03 Interviews for "Sounding Out" Examiner Not Permitted
- 713.04 Substance of Interview Must Be Made of Record
- 713.05 Interviews Prohibited or Granted, Special Cases
- 713.06 No Inter Partes Questions Discussed Ex Parte
- 713.07 Exposure of Other Cases
- 713.08 Demonstration, Exhibits, Models
- 713.09 Finally Rejected Application
- 713.10 Interview Preceding Filing Amendment Under Rule 312
- 714 Amendments, Applicant's Actions
- 714.01 Signatures to Amendments
- 714.01 (a) Unsigned or Improperly Signed Amendment
- 714.01 (b) Disposal of
- 714.01 (c) Signed by Attorney Not of Record
- 714.01 (d) Amendment Signed by Applicant But Not by Attorney of Record
- 714.01 (e) Power of Attorney to a Firm
- 714.02 Must Be Fully Responsive
- 714.03 Amendments Not Fully Responsive, Action to Be Taken
- 714.04 Claims Presented in Amendment with No Attempt to Point Out Patentable Novelty
- 714.05 Examiner Should Immediately Inspect
- 714.06 Amendments Sent to Wrong Division
- 714.07 Amendments Not in Permanent Ink
- 714.08 Telegraphic Amendment
- 714.09 Amendments Before First Office Action
- 714.10 Claims Added in Excess of Filing Fee
- 714.11 Amendment Filed During Interference Proceedings
- 714.12 Amendments After Final Rejection or Action
- 714.13 Amendments After Final Rejection or Action, Letter Written
- 714.14 Amendments After Allowance of All Claims
- 714.15 Amendment Mailed Before, but Received in Examining Division After Allowance
- 714.16 Amendment After Notice of Allowance, Rule 312
- 714.16 (a) Copied Patent Claims
- 714.16 (b) Filed with a Motion Under Rule 234
- 714.16 (c) Excess Number of Claims
- 714.16 (d) Handling
- 714.16 (e) Entry in Part
- 714.17 Amendment Filed After the Period for Response Has Expired
- 714.18 Entry of Amendments
- 714.19 List of Amendments, Entry Denied
- 714.20 List of Amendments Entered in Part
- 714.21 Amendments Inadvertently Entered, No Legal Effect
- 714.22 Entry of Amendments, Directions for
- 714.23 Entry of Amendments, Directions for, Defective
- 714.24 Amendment of Amendment
- 714.25 Discourtesy of Applicant or Attorney
- 715 Swearing Back of Reference—Affidavit Under Rule 131
- 715.01 Reference Patent Entitled to Foreign Filing Date
- 715.02 General Rule as to Generic Claims
- 715.03 Exceptions and Practice Relative to Chemical Cases
- 715.04 Who May Make Affidavit
- 715.05 Patent Claiming Same Invention
- 715.06 Affidavit Under Rule 131 Must Be Removed Before Interference
- 715.07 Facts and Documentary Evidence
- 715.07 (a) Diligence

- 715.07 (b) Interference Testimony Sometimes Used
- 715.07 (c) Acts Relied Upon Must Have Been Carried Out in This Country
- 715.07 (d) Disposition of Exhibits
- 715.08 Passed Upon By Primary Examiner
- 715.09 Seasonable Presentation
- 716 Affidavits Traversing Rejections
- 717 File Wrapper
- 717.01 Papers in File Wrapper
- 717.01 (a) Arrangement
- 717.01 (b) Prints
- 717.02 Date Entered on
- 717.02 (a) Statutory Period Ends On Sunday or Holiday
- 717.02 (b) Name or Residence of Inventor or Title Changed
- 717.03 Classification During Examination
- 717.04 Index of Claims
- 717.05 Field of Search
- 717.06 Foreign Filing Dates
- 717.07 Related Applications

## 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.

### 705.01 (c) Counting and Recording P. R.'s

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding division. When the P. R. is completed and the application is ready for return to the forwarding division, the reporting division will simultaneously count the P. R. as a receipt and action by transfer and so enter it on the current Weekly Work Report.

The number of actions by Patentability Report will be recorded each week by a notation in the lower left-hand corner of the Weekly Work Report, for instance, "P. R. -----"

The file of an application in which a Patentability Report has been made will be distinguished by noting in pencil in the upper left-hand corner of the file directly below "Div. -----" the following: "P. R. Div. -----"

The date status of the application in the reporting division will be determined on the basis of the dates in the division of original jurisdiction.

### 705.01 (d) Duplicate Prints of Drawings

In Patentability Report cases having drawings, the examiner to whom the case is assigned will obtain a duplicate set of prints of the drawing for filing in the division to which the case is referred.

When a case that has had Patentability Report prosecution is passed for issue or becomes abandoned, notification of this fact will at once be given by the division having jurisdiction of the case to each division that submitted a P. R. The Examiner of each such reporting division will note the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting division, they may be destroyed.

### 705.01 (e) Limitation as to Use

The above outlined Patentability Report practice is not obligatory and should be resorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ in scope only, prosecution by Patentability Report is never proper.

Exemplary situations where Patentability Reports are ordinarily not proper are as follows:

(1) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(2) Where the claims are related as a product and a process which involves merely the fact that a product having certain characteristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(3) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination *per se*. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.

### 705.01 (f) Interviews With Applicants

In case of an interview on an application in which a Patentability Report has been adopted, the Primary Examiner of the division having jurisdiction of the case may call on the Primary Examiner of the reporting division for assistance at the interview when it concerns the claims treated by the reporting divisions. (Notice of November 12, 1948.) (See 713 to 713.10 regarding interviews in general.)

## 706 Rejection of Claims

*Rule 106 Rejection of claims.* If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

In rejecting claims for want of novelty or for want of invention, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not obvious, must be clearly explained and each rejected claim specified.

[Old Rule 66, par. 1]

*Rule 112 Re-examination and reconsideration.* After response by applicant (rule 111) the application will be re-examined and reconsidered, and the applicant will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant may respond to such Office action, in the same manner provided in rule 111, with or without amendment, but any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made, and the application will be again considered, and so

Nov. 1949

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:

## PRINTED MATTER

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as *not being within the statutory classes*.

## NATURALLY OCCURRING ARTICLE

Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture." A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413.

## METHOD OF DOING BUSINESS

Though seemingly within the category of an "art" or method, the law is settled that a method of doing business can be rejected as not being within the statutory classes. *Hotel Security Checking Co. v. Lorraine Co.*, 160 Fed. 467.

## SCIENTIFIC PRINCIPLE

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O'Reilly v. Morse*, 15 Howard 62.

**706.03 (b) Barred by Atomic Energy Act**

A limitation on what can be patented is imposed by the Atomic Energy Act, Public Law 585, 590 O. G. 195. Sec. 11 (a) of the Act contains the following provisions:

(1) No patent shall hereafter be granted for any invention or discovery which is useful solely in the production of fissionable material or in the utilization of fissionable material or atomic energy for a military weapon. Any patent granted for any such inventions or discovery is hereby revoked, and just compensation shall be made therefor.

Section 5 (a) (1) defines "Fissionable material" as follows:

As used in this act, the term "fissionable material" means plutonium, uranium, enriched in the isotope 235, any other material which the Commission determines to be capable of releasing substantial quantities of energy through nuclear chain reaction of the material, or any material artificially enriched by any of the foregoing; but does not include source materials, as defined in Section 5 (b) (1).

Section 11 (d) provides in part as follows:

The Commissioner of Patents shall notify the Commission of all applications for patents heretofore or hereafter filed which in his opinion disclose such inventions or discoveries and shall provide the Commission access to all such applications.

*Extract from Rule 14 (c)* Applications for patents which disclose or which appear to disclose, or which

purport to disclose, inventions or discoveries relating to atomic energy are reported to the Atomic Energy Commission and the Commission will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by sec. 11 (d) of the Atomic Energy Act of 1946, 60 Stat. 768, 42 U. S. C. 1811.

All applications relating to atomic energy should be submitted to Division 70 for consideration (Memorandum of February 1, 1949, 107).

**706.03 (c) Functional**

Claims which are rejected as *functional* are so broad in scope that it is considered to be against public policy to allow them, even though they do not read upon any prior art. A so-called "single means" claim, such as:

In a device of the class described, means for transferring clothes-carrying rods from one position and depositing them on a suitable support.

covers every possible means for accomplishing the desired result. *Ex parte Bullock*, 1907 C. D. 93; 127 O. G. 1580.

As is suggested in *Heidbrink v. McKesson*, 1924 C. D. 407; 320 O. G. 227, a claim which defines a method only by its result may be properly rejected as functional. *Holland v. Perkins Glue*, 1928 C. D. 266; 372 O. G. 517, applies the doctrine of functionality to product claims and holds them to be invalid if the product is defined only by its desirable properties. This rejection is not based on the prior art and is to be distinguished from a rejection as *differing from the prior art only by a functional statement*. *General Electric Co. v. Wabash*, 1938 C. D. 813; 491 O. G. 463. Obviously this last-mentioned rejection requires that the Examiner find in the prior art everything called for by the claim with the exception of a functional limitation. The rejection as functional should not be confused with a rejection of a claim as being the *mere function* of the machine. See 706.03 (r).

**706.03 (d) Indefinite**

The rejection of a claim as *indefinite* would appear to present no difficulties. On occasion, however, a great deal of effort is required to explain just what is wrong with the claim, when writing the Examiner's letter. Although cooperation with the attorney is to be commended, undue time should not be spent trying to figure out what the attorney was trying to say in the claim. Sometimes, a rejection as indefinite plus the statement that a certain line is meaningless is sufficient. Inclusion of a negative limitation, such as a "metal, excepting nickel", may make

a claim indefinite. Expressions such as: "anhydrous", "colorless" and "non-poisonous" have been permitted because they are definite and by far the least cumbersome way to express the limitation.

Alternative expressions such as "brake or locking device" may make a claim indefinite if the limitation covers two different elements. If two equivalent parts are referred to such as "rods or wires", the alternative expression may be considered proper.

Still another way in which a claim can be indefinite is where a *non sequitur* occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference or *no antecedent* in the claim to a lever. An *indirect limitation* also affords a ground of rejection as indefinite. If a "lever" is set forth and, later in the claim, "said aluminum lever" is recited, the claim is rejected as indefinite.

### 706.03 (e) Product by Process

An article which cannot be described in any other manner, may be claimed by a process of making it. In *re Moeller*, 1941 C. D. 316, 527 O. G. 559. Applicant must, however, make a showing that the product cannot be described except by reference to the process of making it. In *re Dreyfus and Whitehead*, 1935 C. D. 386, 457 O. G. 479. Accordingly both product claims described by characteristics and product by process claims concurrently presented are inconsistent.

### 706.03 (f) Incomplete

A claim can be rejected as *incomplete* if it omits essential elements, steps or necessary structural cooperative relationship of elements, such omission amounting to a gap between the elements, steps or necessary structural connections.

### 706.03 (g) Prolix

Claims are rejected as prolix when they contain long recitations of unimportant details which hide or obscure the invention. *Ex parte Iagan*, 1911 C. D. 10; 162 O. G. 538, expresses the thought that very long detailed claims setting forth so many elements that invention cannot possibly reside in the combination should be rejected as prolix.

### 706.03 (h) Nonstatutory Claim

Many applications when filed contain an omnibus claim such as "A device substantially as shown and described". Such a claim is often included in an application as filed because the application is to serve as a basis for a duplicate

foreign application in a country where this type of claim is permitted. This type of claim is not permitted in a United States patent because R. S. 4888, 35 U. S. C. 33, states that Applicant "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery". Such a claim can be rejected as follows:

Claim ----- is rejected for failing to "particularly point out and distinctly claim" the invention as required in R. S. Sec. 4888.

For cancellation of such a claim by Examiner's Amendment, see 1302.04 (b).

### 706.03 (i) Aggregation

Rejections on the ground of *aggregation* should be based upon a lack of cooperation between the elements of the claim. No prior art need be relied upon in this rejection. However, citation of art showing the various elements may be advisable to support this rejection. Many decisions and some legal writers extend the term to include old and exhausted combination (706.03 (j)). Rejections on the latter grounds, however, involve the state of the art, and cooperation *is* present. Confusion as to what is meant can be avoided by treating all claims which include more than one element as combinations (patentable or unpatentable) if there is actual cooperation between the elements, and as aggregations if there is no cooperation.

*Example of aggregation:* A washing machine combined with a dial telephone.

*Example of old combination:* An improved carburetor claimed in combination with a gasoline engine.

A claim is not necessarily aggregative because the various elements do not function simultaneously. A typewriter, for example, is a good combination.

### 706.03 (j) Old Combination

The rejection on the ground of *old combination* (synonymous with "exhausted combination") requires the citation of a reference, but is treated here because of its relation to aggregation. The reference is cited, not to anticipate the claim, but to anticipate the broad combination set forth in the claim. Moreover, the cooperation between the elements in the reference must be the same as it is in the claim.

*Example:* An improved (specifically recited) carburetor claimed in combination with a gasoline engine. A reference is cited which shows a carburetor combined with a gasoline engine. This shows the broad combination to be old. Both in the reference and in the claimed combination, the cooperation between the carburetor



shown in the drawing, applicant is required to add it to the drawing. (See 608.01 (1).)

### 706.03 (o) New Matter

In the examination of an application following amendment thereof, the Examiner must be on the alert to detect new matter.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it is *drawn to new matter*. New matter includes not only the addition of wholly unsupported subject matter, but also, adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See 608.04 to 608.04 (c) to 7-8-4 (c.).

### 706.03 (p) No Utility

A rejection on the ground of *lack of utility* includes the more specific grounds of *inoperativeness, involving perpetual motion, frivolous, fraudulent, against public policy, and insufficiently useful and important* under Sec. 4893 R. S., 35 U. S. C. 36. (See 608.01 (p).)

### 706.03 (q) Obvious Method

An applicant may invent a new and useful article of manufacture. Once the article is conceived, it often happens that anyone skilled in the art would at once be aware of a method of making it. In such a case, if applicant asserts both article and method claims, the article claims are allowed but the method claims may be rejected as being drawn to the *obvious method of making the article*. [According to the decision *In re Barnett*, 1946 C. D. 457, 590 O. G. 509 this rejection is applicable *only* when the method is not *only* obvious but the *only* method of making the article. Similarly, method claims to the *obvious method of using* a new device may be rejected.

### 706.03 (r) Mere Function of Machine

Judicial decisions on *mere function of the machine*, like those on aggregation, cannot be fitted into a single pattern. There is logic, as well as precedent, in limiting such rejections to the following cases: First, method claims only should be rejected on this ground. Compare 706.03 (c). Second, the method must be such that it cannot be carried out by hand, nor by a machine which differs materially from applicant's. This rejection, which is rarely availed of, appears to be based upon the theory

that, in such cases, claims to the machine alone suffice. Of course, if applicant's machine is not new, the method claims are more readily handled by rejecting them as being unpatentable in view of the ordinary operation of the prior machine.

### 706.03 (s) Statutory Bar

Another category of rejections not based on the prior art finds a basis in some prior act of applicant, as a result of which the claim is denied him.

Sec. 4887 R. S. (U. S. C. title 35, sec. 32). (First Paragraph).

No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

The first paragraph of R. S. 4887, above quoted, establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. These four conditions are as follows:

(1) The foreign application must be filed more than one year before the filing in the United States (Modified by Public Law 690, 201.16).

(2) It must be filed by the inventor, his legal representatives or assigns.

(3) The foreign patent must be actually granted (e. g., by sealing of the papers in Great Britain).

(4) The same invention must be involved.

If such a foreign patent is discovered by the Examiner, the rejection is made on the ground of statutory bar.

Further, claims to an invention in public use or on sale in the United States more than twelve months before his effective filing date are similarly rejected. (Sec. 4886 R. S.; 35 U. S. C. 31.)

### 706.03 (t) Assigned Application

Where there is a conflict in the ownership of two applications by the same inventor; see 304.

### 706.03 (u) Disclaimer

Claims may be rejected on the ground that applicant has disclaimed the subject matter in-