

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

November 1, 1950

MANUAL OF PATENT EXAMINING PROCEDURE

Supplemental Instruction to Patent Office Personnel
Regarding Revision No. 1

Information and instructions published in Manual Change Notices 1-1 through 1-17 and 2-1 and 2-2 have been included in the attached revised pages. Consequently these change notices should be removed from your Manual.

Additional changes in procedure incorporated in this revision which have not been previously published as change notices appear in the following sections:

- 804.02 Double patenting rejection after election of species or division requirement.
- 903.03 Classifying foreign patents.
- 1004 List of Cases submitted to Supervisory Examiners.
- 1101.01(o) Suggestion of claims to an applicant in issue.
- 1207 New reference found after appeal but before brief.
- 1208 New form for Appeal Statement.
- 1704) Records kept in Examining Division (cards).
- 1705)

DEPARTMENT OF COMMERCE
U. S. Patent Office
Washington

November 1, 1950

MANUAL OF PATENT EXAMINING PROCEDURE

Revision Notice No. 1

Transmitted herewith is one set of revised pages for the Manual of Patent Examining Procedure incorporating changes prescribed in examining procedure through November 1, 1950. Substitute these pages for those now in your Manual having corresponding page numbers. In a few instances where revisions were extensive, an additional page was required. Each of these new pages has a compound page number to indicate its proper location in the Manual, (e.g., page 62-1 which will be inserted after page 62).

The following list of these replacement pages may be used as a check list for determining that your set is complete. The parallel listing, which is provided to facilitate identification of new matter on these pages, includes only those sections in which significant subject matter changes have been made.

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Appendices and Index

Revised pages 209, 210, and 211 for Appendix I and pages 213 and 214 for Appendix 2 and revised pages for the entire index (pages 217-248) have been provided to reflect changes in the main body of the Manual.

Date:
January 10, 1950

INSTRUCTIONS TO HOLDERS OF THE
MANUAL OF PATENT EXAMINING PROCEDURE

The Manual of Patent Examining Procedure was printed in loose-leaf style and issued in a carefully selected binder in order to facilitate the incorporation of changes in examining practice that are prescribed from time to time. Since the Manual must be maintained current at all times to be of maximum usefulness, provision has been made for printing all documents affecting patent examining procedure in a form suitable for insertion in the Manual. Each such change notice will be identified by a number indicating, first, the series of the change and, second, the succession of each change in such series. For example, the first change issued will be numbered 1-1 and will be followed by 1-2 and so on with series 1 continuing until a sufficient number of changes accumulate to warrant a revision of the Manual. As soon as replacement pages for the Manual are ordered which incorporate the changes in the current series, a new series of change notices will be started (e.g. 2-1, 2-2, etc.). These revisions will be scheduled so that ordinarily not more than two series of change notices will be in your binder at any one time.

Each of the change notices will carry a reference to the Manual section or sections, if any, to which it appertains. Immediately upon receipt of a change notice you should enter the number of the change (e.g. 1-4) in the margin beside each section referenced and then file the notice in the back of your Manual binder. A tab separator will be provided in a few weeks for insertion between the Manual and the change notices. The change notices will be retained in your Manual binder until the revised Manual pages incorporating that series of changes have been issued.

The copy of the Manual which you now have was issued on a personal custody basis and you are responsible for observing such requirements as may prevail concerning it. Retain this same copy as long as you remain an employee of the Patent Office in a capacity which requires its use. Upon separation from the Office, the copy assigned you should be turned in to the Administrative Management Division, Room 3086. Persons leaving the employ of the Patent Office desiring to have a copy of the Manual may purchase same from the Superintendent of Documents, Government Printing Office. These copies are punched to fit a three-ring binder and the sale price of \$2.00 includes revision service for a limited period.

It is suggested that this instruction sheet be filed in the back of your Manual immediately preceding the change notices.

C. E. Haglund
Executive Officer

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**MANUAL OF
PATENT
EXAMINING
PROCEDURE**



Approved

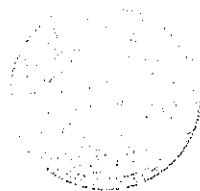
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Foreword

THIS MANUAL is published to provide examiners in the Patent Office with a reference work on the practice and procedure within the Office as it relates to their duties and operations. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and generally outlines the current procedure which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications. Substantive aspects of patent law are only referred to briefly.

Examiners will continue to be governed as in the past by the statutes, the rules of practice, applicable decisions, and orders and instructions issued by the Commissioner or by the Supervisory Examiners under his authority. Existing Orders and Notices relating to the subject matter included in this manual are incorporated and identified as such. Many Orders and Notices have been revised to coordinate them with the new rules of practice or to make other changes and are included in their revised form; these supersede the previous versions of the same Orders and Notices.

It is expected that subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the manual. Each examiner will be provided with a copy of the manual for his official use and will be expected to maintain it in current condition.

Lawrence B. Kingsland

JUNE 9, 1949

Commissioner.

Acknowledgments

This work is the result of the combined efforts of a large number of contributing editors including:

D. D. Andrews, C. G. Angel, D. Arnold, M. F. Bailey, W. Berlowitz, G. L. Brehm, J. L. Brewrink, W. W. Cochran, E. A. Faller, A. J. Goldberg, G. A. Gorecki, M. Hertz, A. M. Horton, W. J. Kanof, R. Leibowitz, L. J. Lenny, C. Levy, I. Lisann, J. C. MacNab, H. Magil, A. Margolis, N. Marmelstein, S. M. Newman, R. A. O'Leary, E. Paul, E. O. Retter, M. C. Rosa, J. Schimmel, A. Shapiro, and R. M. Wood.

In the preparation of this work, use was made of much of the material in the "Manual of Patent Office Procedure" published by the Patent Office Society, the last three editions of which were prepared by C. L. Wolcott. Permission to use this material has been given by the Patent Office Society. Many helpful suggestions by the members of the Patent Office personnel for improving the first draft have been incorporated in the present text.

Programing and organizing of the project was done by R. D. Lambert, of Wallace Clark & Co., consultants.

Numbering System

The system of numbering used in this Manual was selected to indicate to the reader topical indentations in the tables of contents. It may be understood by considering specific examples. Thus, the symbol "1100" refers to Chapter 1100 as a whole; the symbol "1101" refers to a subdivision indented under 1100; the symbol "1101.01" refers to a further subdivision indented under 1101; and "1101.01 (a)" refers to a still further indentation under 1101.01. Thus Chapter 1100 is numbered as follows:

Chapter 1100 Interference

- 1101 Preliminaries to an Interference
 - 1101.01 Between Applications
 - 1101.01 (a) In Different Divisions
 - 1101.01 (b) Common Ownership
 - 1101.01 (c) The Interference Search
 - 1101.01 (d) Correspondence Under Rule 202
 - 1101.01 (e) How Conducted

Indentations beyond the third indentation are ignored in the assignment of a symbol. Fourth and further indentations are given the same type of symbol as a third indentation. Thus in the above example the section entitled "How Conducted" has the same type of symbol as the section entitled "Correspondence Under Rule 202." Because a fourth indent in the table of contents does not show up in the numbering system, those sections which are a fourth indent in the table of contents are given a title in the text which includes the title of the section under which they are indented. Thus, in the text, the heading for Sec. 1101.01 (e) reads: "Correspondence Under Rule 202, How Conducted."

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Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. The present laws relating to patents are various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870, and numerous amendatory and additional acts which have been passed since that time. These have been compiled as Title 35 of the United States Code and are reprinted by the Patent Office in a pamphlet entitled "Patent Laws." In referring to a particular section of Patent Laws there should ordinarily be given both the Revised Statutes section number and the United States Code citation, thus "R. S. 4886; 35 U. S. C. 31".

Rules of Practice

One of the sections of the patent statutes, namely, R. S. 483; 35 U. S. C. 6, authorizes the Commissioner of Patents, subject to the approval of the Secretary of Commerce, to establish from time to time regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public, first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been

established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instructions, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the Commissioner of Patents (1002) and from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on formal matters is final but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.