

MANUAL OF
PATENT
EXAMINING
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

U. S. DEPARTMENT OF COMMERCE
Patent Office
Washington

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Transmitted herewith is the Third Edition of the Manual of Patent Examining Procedure. This edition dated November 1961 completely supersedes the Second Edition of the Manual published November 1953 with subsequent revisions.

There are many changes in the text of the Manual since Revision 4 of the Second Edition. The sections listed below embody the more significant changes:

107.02	708.01
608.01	708.02
608.01 (m)	708.03
608.01 (v)	710.02 (b)
608.02 (l)	713.04
608.02 (s)	714.02
608.02 (x)	714.05
608.04 (a)	714.13
702.01	714.16
704	715.01 (a, b, c)
705.01 (c)	715.07 (a)
706	716
706.01	901.05 (b)
706.03 (i)	901.06 (a)
706.03 (k)	903.03
706.03 (l)	1005
706.03 (s)	1302.12
706.03 (x)	1401
706.03 (z)	1504
707.07 (d)	1701
707.07 (f)	

MANUAL OF
PATENT
EXAMINING
PROCEDURE

Third Edition, November 1961



U.S. DEPARTMENT OF COMMERCE • PATENT OFFICE

First Edition, November 1949
Revision 1, November 1950
Revision 2, December 1951
Revision 3, May 1952
Second Edition, November 1953
Revision 1, April 1955
Revision 2, June 1956
Revision 3, June 1957
Revision 4, July 1958
Third Edition, November 1961

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.

Examiners will continue to be governed as in the past by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner, the Director, Patent Examining Operation, or the Supervisory Examiners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated and identified as such. Orders and Notices, or portions thereof, relating to the examiners' duties and functions included in this Manual which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

DAVID L. LADD
Commissioner.

NOVEMBER 15, 1961.

Acknowledgments

Preparation of the text of the Third Edition was directed by Ernest A. Faller, Editor, under the supervision of Manuel C. Rosa, Director, Patent Examining Operation.

The Supervisory Examiners, Isaac G. Stone, Norman H. Evans, Burnham Yung Kwai, Sam Spintman, John S. Hull, Thomas F. Murphy, Harvey E. Kauffman and George A. Gorecki took an active part in this work, especially in rewriting Chapter 700.

Others who assisted were Pasquale J. Federico, Hyman B. Freehof, Examiners-in-Chief; Joseph Schimmel, Deputy Solicitor; Samuel Levin, LaVerne L. Williams, Interference Examiners; and Florence A. Hoffman, Division Clerk.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

Commissioner of Patents,
Washington 25, D.C.

Contents

	Page
Introduction.....	1
Chapter 100 Secrecy and Access.....	3
200 Types, Cross-Noting, and Status of Applications.....	7
300 Ownership and Assignment.....	21
400 Representative of Inventor or Owner.....	23
500 Receipt and Handling of Mail and Papers.....	31
600 Parts, Form and Content of Application.....	33
700 Examination of Applications.....	61
800 Restriction; Double Patenting.....	117
900 Prior Art, Classification, Search.....	137
1000 Petitions; Cases Submitted to Commissioner and Super- visory Examiners.....	159
1100 Interference.....	163
1200 Appeal.....	209
1300 Allowance and Issue.....	221
1400 Correction of Patent.....	229
1500 Design Patents.....	235
1600 Plant Patents.....	239
1700 Miscellaneous.....	243
Appendix J Table of Orders and Notices.....	247
Appendix II List of Decisions Cited.....	253
Index.....	257

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. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U.S.C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes. The pamphlet also contains tables showing where subject matter comparable to present title 35 may be found in prior statutes, and where subject matter of prior statutes will be found in new title 35.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish 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 instruction, 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

MANUAL OF PATENT EXAMINING PROCEDURE

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.