

MANUAL OF
**PATENT
EXAMINING
PROCEDURE**

ORIGINAL EDITION



U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

REEL NUMBER 2

BOOK NUMBERS 16

**MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice**

Reference: **MPEP 201.11**

SERIES NO. 12 - 8

March 7, 1967

CHAINS OF CONTINUING APPLICATIONS

In view of a recent decision of an enlarged panel of the Board of Appeals the practice involving applications which claim the benefit of earlier filing dates, under 35 U.S.C. 120, shall be as follows:

When an applicant has filed a plurality of applications disclosing common subject matter, a later filed application can only obtain the benefit of the filing date of an earlier filed copending application or of one copending with the earlier filed application. For example, in a chain of four successively file applications wherein no more than two were copending at any one time, the last filed application is not entitled to the benefit of the date of the first filed application.

The Group Manager should be informed and keep a record of situations wherein an applicant is refused the benefit of an earlier filing date in accordance with this notice.

**Richard A. Wahl
Assistant Commissioner**

MANUAL OF FEDERAL EMPLOYING PRACTICES

Instructions Regarding Revision No. 16

The attached revised pages are replacements for those in the Manual having corresponding numbers, or additional pages to be placed in appropriate numerical sequence.

Change Notices 12-3 and those subsequent to 16-6 are the only ones which need be retained.

All MPEP holders, whether employees of the Patent Office or members of the general public, are referred to the back of the MPEP title page for information on how to obtain manuals, replacement pages, notices and revisions.

F. Barry Suss
Acting Editor, MPEP

In the attached pages the notation "(R-16)" appears either at the title or at the end of sections that have been in any way altered. (Except the instances where neither the beginning nor the end of the amended section appears in the revised pages. In these instances the customary notation at the bottom of the page is the only notation of revision). Particular attention is called to the following alterations:

- 201.07 - Second paragraph rewritten (change 16-6)
- 201.11 - Last two sentences canceled (change 16-6)
- 608.01(b) - Fourth and fifth paragraphs new; item 3 expanded (changes 16-2, 3)
- 608.01(g) - Third paragraph new (change 16-2)
- 608.01(o) - Last paragraph new (change 16-2)
- 608.01(v) - Sentence preceding TM list broadened
- 706 - Fourth paragraph new
- 706.02 - Second paragraph new; third rewritten
- 706.03(j) - Second and last two paragraphs new
- 706.03(q) - Second paragraph new
- 706.03(r) - Whole section new

- 708.02 - Second and third paragraphs rewritten to correct
- 711 - Item 1(b) supplied
- 711.01 - Third sentence canceled and replaced by two new paragraphs at end (to correct)
- 711.05 - All after first sentence rewritten to correct
- 714.01(a) - Second and third paragraphs new matter from 714.01(b) incorporated
- 714.01(b) - Canceled part placed in 714.01(a)
- 714.01(c) - Rewritten to reflect changes
- 714.02 - Fourth, fifth and sixth paragraphs new (change 18-1)
- 714.22 - Last paragraph new (change 16-1)
- 804.02 - Last paragraph canceled (matter covered in 804.03)
- 804.03 - Second paragraph new (change 18-1)
- 804.03 - First sentence amended and third new (stems from change 12-1)
- 903.08(g) - Second paragraph new (change 16-5)
- 1201.02(g) - Second paragraph new
- 1103 - Third paragraph new
- 1111.05 - Third paragraph new
- 1205 - Last paragraph canceled and replaced by two new paragraphs
- 1208.02 - Last paragraph new
- 1210 - Section rewritten to correct and amplify
- 1302.04 - First paragraph of page 222.1 new (change 16-2)

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Washington, D.C. 20540

PATENT EXAMINING PROCEDURE

Third Edition, November 1961



U.S. DEPARTMENT OF COMMERCE • PATENT OFFICE

Rev. 16, Apr. 1968

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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.

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, D.C. 20231

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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. 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

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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.