

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

Supplemental Instructions Regarding Revision No. 1

The attached revised pages are to be substituted for those in the Manual having corresponding page numbers. The list of the attached Revision Notice No. 1 is to be checked to make certain that the set of pages received is complete.

Information and instructions published in Change Notices 1 - 1 through 1 - 19 have been included in these revised pages. Accordingly, these Change Notices should be removed and discarded. However, those of the 2-1, and 2-2 series should be retained.

Ernest A. Faller  
Editor, MPEP

Important changes in procedure appear in the following sections:

|            |   |
|------------|---|
| 604.01     | States not requiring Notary's Seal                                      |
| 608.02(a)  | New Drawing Requirements in Allowable Cases                             |
| 608.02(c)  | Drawing (or Print) Available for Interference Search                    |
| 707.05(e)  | Citation of Publications  |
| 707.07     | Specification Differs from Art Terminology                              |
| 708.01     | "Special" Cases   |
| 710.02(b)  | Shortened Period Situations   |
| 711.04(b)  | Ordering Abandoned Files  |
| 901.05(b)  | Citation of Foreign Patents   |
| 901.05(d)  | Translator's Services at Examiner's Desk                                |
| 901.06(a)  | Alternate Versions of Foreign Patent - Assistance by Library            |
| 903.03     | Classification of Foreign Patents                                       |
| 903.07(b)  | Issuing Patent in another Group - Prints Forwarded Promptly             |
| 903.08(a)  | Transferring New Applications   |
| 1002.02    | Handling of Petitions   |
| 1004       | Actions Submitted to Directors  |
| 1005       | Actions Submitted to Group Supervisory Examiners                        |
| 1101.01    | Defer Interference Until One Case Allowable                             |
| 1101.01(b) | Applicants of Commonly Assigned Cases Notified of Interference Election |
| 1101.02    | Interference with Patent - Broadest Claim to be a Count                 |

(over)

- 1101.02(a) Patent Claims Copied - More Complete Affidavit Required
- 1105.06 Decisions on Interference Motions - Use of Soft Copies
- 1112.08 Avoid Reference to Patent Claims in letter under Rule 237
- 1302.06 "None" entered on File Wrapper if No Foreign Priority
- 1302.09 "None" entered on File Wrapper if No Parent Case
- 1302.12 German Allowed Applications listed under "Other References"
- 1308.01 Action Following Quality Control Review

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**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  
Revision 1, January 1964

Rev. 1, Jan. 1964

## 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.