Chapter 700 Examination of Applications

701 Statutory Authority for Examination

35 U.S.C. 131. The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102, 103.

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

When an application is reached for its first action and it is then discovered to be impractical to give a complete action on the merits because of the paucity of disclosure, the following procedure may be followed: (1) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention and claims and any apparently pertinent art cited; (2) Informalities noted by Application Branch and deficiencies in the drawing should be pointed out by means of attachments to the Examiner's letter (see 707.07(a)); (3) A requirement should be made that the specification be revised to conform to idiomatic English and United States practice; (4) The claims should be rejected as failing to define the invention in the manner required by 35 U.S.C. 112 if they are informal. A blanket rejection is usually sufficient.

The Examiner should not attempt to point out the specific points of informality in the specification and claims. The burden is on the applicant to revise the application to render it in proper form for a complete examination.

Applicants should make every effort to follow U.S. practices and terminology when preparing a case for filing. If this has not been done, a prompt amendment should be made, avoiding the introduction of new matter, but putting the case in proper form.

For the procedure to be followed when only the drawing is informal, see 608.02(a) and 608.02(b).

703 "General Information Concerning Patents" Sent Instead of "Rules of Practice"

The pamphlet "General Information Concerning Patents" may be sent to an applicant handling his own case when the Examiner deems it advisable.

704 Search

After reading the specification and claims, the Examiner searches the prior art.

The subject of searching is more fully treated in Chapter 900. See 904 through 904.02. 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.

Previous Examiner's Search

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second Examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous Examiner, or make a new search in the mere hope of finding something. See 717.05.

705 Patentability Reports

Where an application, properly assigned to one examining group, is found to contain one or more claims *per se* classifiable in one or more other groups, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups 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 in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is suspended, except in extraordinary circumstances. See 705.01(e).

705.01 Instructions re Patentability Reports

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 group with a memorandum attached, for instance, For Patentability Report from Group _____ as to Claims _____.

705.01(a) Nature of P.R., Its Use and Disposal

The Primary Examiner in the group 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 written or typed on a memorandum form 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 in the reporting group will be returned to the group 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 in a reporting group is of the opinion that a Patentability Report is not in order, he should so advise the Primary Examiner in the forwarding group.

Disagreement as to Classification

Conflict of opinion as to classification may be referred to an Examiner of Classification for decision.

If the Primary Examiner in the group 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.

Disagreement on Patentability Report

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.

Appeal Taken

When an appeal is taken from the rejection of claims, all of which are examinable in the group preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the case to said group should be made for the purpose of appeal only. The receiving group will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said group with its classification determined by the controlling claims remaining in the case.

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 groups, 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 group for report. The group to which the case is referred will be advised of the results of this search.

If the Supervisory 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 [R–16]

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding group. When the P.R. is completed and the application is ready for return to the forwarding group, it is not counted either as a receipt or action by transfer. Credit, however, is given for the time spent. See 1705.

A box is provided on each file wrapper headed "P.R. Group ------" and the number of the group making the P.R. is entered in pencil.

The date status of the application in the reporting group will be determined on the basis of the dates in the group of original jurisdiction. To insure orderly progress in the reported dates, a timely reminder should be furnished to the group making the P.R.

705.01(d) Duplicate Prints of Drawings

In Patentability Report cases having drawings, the examiner to whom the case is assigned will furnish to the group to which the case is referred, prints of such sheets of the drawings as are applicable, for interference search purposes. That this has been done may be indicated by a pencil notation on the file wrapper.

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 group having jurisdiction of the case to each group that submitted a P.R. The Examiner of each such reporting group 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 group, they may be destroyed.

705.01(e) Limitation as to Use [R–16]

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.

Because of the high percentage of new examiners, situations frequently arise where the Patentability Report would of necessity be made by an examiner who knows less about the art than the examiner seeking the Patentability Report. Then there are also situations where the examiner seeking the report is sufficiently qualified to search the art himself.

In view of these conditions which are expected to prevail for some time to come, it is felt to be in the best interests of the Office to suspend the present Patentability Report practice. Where it can be shown, however, that a Patentability Report will save total examiner time, exceptions may be permitted with the approval of the Group Manager of the group to which the application is as-

signed. The "Approved" stamp should be impressed on the memorandum requesting the P.R.

705.01(f) Interviews With Applicants

In situations where an interview is held on an application in which a Patentability Report has been adopted, the reporting group may be called on for assistance at the interview when it concerns claims treated by them. (Basis: Notice of November 12, 1948.) See 713 to 713.10 regarding interviews in general.

706 Rejection of Claims [R-16]

Although this part of the Manual explains the procedure in *rejecting* claims, the Examiner should never overlook the importance of his role in *allowing* claims which properly define the invention.

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

(b) 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.

The standards of patentability applied in the examination of claims must be the same throughout the Office. In every art, whether it be considered "complex," "newly developed," "crowded," or "competitive," all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and 103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture" claim) is never, in itself, justification for the allowance of such a claim.

When an application discloses patentable subject matter and it is apparent from the claims and the Applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the Examiner should not stop with a bare objection or rejection of the claims. The Examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction.

If the Examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

Rule 112. Reexamination and reconsideration. After response by applicant (rule 111) the application will be reexamined 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 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 dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See 608.01(n).

706.02 Rejection on Prior Art [R-16]

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 either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See 707.07(d).

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, e.g., (1) where the propriety of a 35 U.S.C. 102 rejection depends on a particular interpretation of a claim; (2)

where a claim is met only in terms by a reference which does not disclose the inventive concept involved; or (3) where the most pertinent reference seems likely to be antedated by a Rule 131 affidavit. Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections; i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

A U.S. patent may be a reference against an application even though the patent date is after the filing date of the application, provided that the filing date of the patent is prior to the filing date of the application. It is proper to use such a patent as a basic or an auxiliary reference and such patents may be used together as basic and auxiliary references. This doctrine arose in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 1926 C.D. 303; 344 O.G. 817; and was enacted into law by 35 U.S.C. 102(e). It was held applicable to rejections under 35 U.S.C. 103 by the

U.S. Supreme Court in Hazeltine Research, Inc. et al. v. Brenner, 147 U.S.P.Q. 429 (1965).

For the proper way to cite a patent granted after the filing of the application in which it is being cited, see 707.05(e). [R-18]

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 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; 500 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 [R-18]

The primary object of the examination of an application is to determine whether or not the claims define a patentable advance over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to non-prior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Generally speaking, the inclusion of (1) negative limitations and (2) alternative expressions, provided that the alternatively expressed elements are basically equivalents for the purpose of the invention, are permitted if no uncertainty or ambiguity with respect to the question of scope or breadth of the claim is presented.

The Examiner has the responsibility to make sure the wording of the claims is sufficiently definite to reasonably determine the scope. It is applicant's responsibility to select proper wording of the claim, except to the extent that the selection of words makes the claims indefinite. Under no circumstances should a claim be rejected merely because the Examiner prefers a different choice of wording.

Rejections not based on prior art are explained in 706.03(a) to 706.03(z). IF THE ITALICIZED LANGUAGE IN THESE SECTIONS IS INCORPORATED IN THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

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 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

The term "process" as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

Judicial decisions have determined the limits of the statutory classes. 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 a process 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.

This subject matter is further limited by the Atomic Energy Act explained in 706.03(b).

706.03(b) Barred by Atomic Energy Act [R-18]

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181a) thereof reads in part as follows:

> No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms "atomic energy" and "special nuclear material" are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181c and d) set up categories of pending applications relating to atomic energy that must be brought to the attention of the U.S. Atomic Energy Commission. Under 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 the Atomic Energy Act.

All applications received in the Patent Office are sent to Licensing and Review for screening by Group 220 personnel, under Rule 14(c), in order for the Commissioner to fulfill his responsibilities under Section 151(d) (42 U.S.C. 2181d) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the Examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review.

All rejections based upon Sections 151(a) (42 U.S.C. 2181a), 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by Group 220 personnel.

706.03(c) Functional

See Ex parte Ball et al., 1953 C.D. 4; 675 O.G. 5 In re Arbeit et al., 1953 C.D. 409; 677 O.G. 843 and Ex parte Stanley, 121 USPQ 621.

Section 112 of the Patent Act of 1952 consists of three paragraphs, which read as follows:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Paragraph 3 of section 112 has the effect of prohibiting the rejection of a claim for a combination of elements (or steps) on the ground that the claim distinguishes from the prior art solely in an element (or step) defined as a "means" (or "step") coupled with a statement of function. However this provision of paragraph 3 must always be considered as subordinate to the provision of paragraph 2 that the claim particularly point out and distinctly claim the subject matter. If a claim be found to contain language approved by paragraph 3 such claim should always be tested additionally for compliance with paragraph 2 and if it fails to comply with the requirements of paragraph 2, the claim should be so rejected and the reasons fully stated.

Paragraph 3 of section 112 makes no change in the established practice of rejecting claims as *functional* in situations such as the following:

1. A claim which contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of the functional language in the claim. An example of a claim of this character may be found in In re Fuller, 1929 C.D. 172; 388 O.G. 279. The claim reads:

A woolen cloth having a tendency to wear rough rather than smooth.

2. A claim which recites only a single means and thus encompasses all possible means for performing a desired function. For an example, see the following claim in Ex parte Bullock, 1907 C.D. 93; 127 O.G. 1580:

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

706.03(d) Vague and Indefinite

When the Examiner is satisfied that patentable novelty is disclosed and it is apparent to

the Examiner that the claims are directed to such patentable subject matter, he should allow claims which define the patentable novelty with a *reasonable* degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire.

The fact that a claim is broad does not necessarily justify a rejection on the ground that the claim is vague and indefinite or incomplete. In non-chemical cases, a claim may, in general, be drawn as broadly as permitted by the prior art.

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 guess 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. The Examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction. 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 allowed. They can be definite and are by far the least cumbersome way to express the limitation. The mere inclusion of reference numerals in a claim otherwise allowable is not a ground for rejection. But see Ex parte Osborne, 1900 C.D. 137; 92 O.G. 1797.

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 bars", 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. [R-16]

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. As a rule, the product-by-process claims should be limited to one, unless it appears that there are material differences between the products produced by the processes recited in the different claims. See also "Product by Process Claims" (Wolffe) 28 J.P.O.S. 852.

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 ommission amounting to a gap between the elements, steps or necessary structural connections. Greater latitude is permissible with respect to the definition in a claim of matters not essential to novelty or operability than with respect to matters essential thereto. See also 706.03(d).

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. See also In re Ludwick, 1925 C.D. 306; 339 O.G. 393.

706.03(h) Nonstatutory Claim [R-16]

Some applications when filed contain an omnibus claim such as "A device substantially as shown and described."
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 35 U.S.C. 112.

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. Many decisions and some legal writers extend the term to include old and exhausted combinations (706.03(j)). 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 associated 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. Neither is a claim necessarily aggregative merely because elements which do cooperate are set forth in specific detail.

706.03(j) Old Combination [R-16]

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 (not a combination of references, of course) is cited, not to anticipate the claim, but to anticipate the broad combination set forth in the claim. Moreover, the cooperation and result between the elements in the reference must be the same as it is in the claim.

A rejection on the ground of old combination should be made whenever proper. Whether subcombination claims have been presented or allowed in the same application, or whether other grounds for rejection of the combination claims exist, are not determinative of the propriety of this rejection. The rejection is proper when a single reference discloses broadly a combination of the same elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. *Ex parte* Silverstein, 125 U.S.P.Q. 238 (Bd. App.). The fact that an applicant has improved one element of a combination which may be *per se* patentable does not entitle him to a claim to the improved element in combination with old elements where the elements perform no new function in the claimed combination. In re Hall, 41 C.C.P.A. 759.

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 and engine is the same and the end result is the same. The claimed combination is an improvement over the prior art only because of the improved carburetor. The carburetor has separate status, since entire subclasses are devoted to carburetors, claimed as such. A reference is preferably cited to show the separate status and development. (See 904.01(d).)

Old combination rejections ordinarily are based on 35 U.S.C. 112 (failure to point out the invention). The rejection should make it clear exactly what the combination is and why it is thought that any improved element does not modify the action of the combination. A suggested form for use in making an old combination rejection is as follows:

"Claim 1 is rejected under 35 U.S.C. 112 as being drawn to the old combination of a bell, a battery and a switch connected in series by wire conductors. This combination is shown to be old by the patent to Jones which discloses broadly the same elements funtionally interrelated in the same manner to produce substantially the same results. The combination of claim 1 differs from that shown in Jones in setting forth a specific construction of the battery itself. Since the latter does not modify the action of the other elements recited in the claim in any material manner, no new combination is seen to exist. In re Hall, 100 U.S.P.Q. 46; 41 C.C.P.A. 759; 208 F. 2d 370; 680 O.G. 5."

706.03(k) Duplicate Claims; Double Patenting [R-16]

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) his invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. Also, it is possible to reject one claim on an allowed claim if they differ only by subject matter old in the art. The latter ground of rejection is set forth in the following paragraph quoted from Ex parte Whitelaw, 1915 C.D. 18; 219 O.G. 1237:

"Claim 54 is not patentable over claim 51 and claims 53, 55 and 56 are not patentable over claim 50 in view of Comstock, No. 590,657, which shows that it is old to employ an engine-casing in tools of this character. The claims held patentable are considered as fully covering applicant's invention, and applicant can-

not be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function."

This rejection (the ex parte Whitelaw doctrine) is usually not applied if there are only a few claims in the application.

Situations related to that given above are as follows:

Where there is a common assignee for two or more applications by different inventors, and the applications contain conflicting claims, see 305 and 804.03.

DOUBLE PATENTING

Where there are conflicting claims in different applications of the same inventor, one of which is assigned, see 304.

Where the same inventor has two or more applications for species or for related inventions, see Chapter 800, particularly Sections 804–804.02, 806.04(h), 822 and 822.01 for double patenting rejections of inventions not patentable over each other.

APPLICATION FILED UNDER 35 U.S.C. 121

The Commissioner has determined that under 35 U.S.C. 121, the Patent Office cannot reject a divisional application on the parent patent if the divisional application is filed as a result of a requirement for restriction made by the Office even though the requirement for restriction relates to species. In re Joyce, 1958 C.D. 2; 727 O.G. 4. See also In re Herrick et al., 1958 C.D. 1; 727 O.G. 4 where the Com-

missioner ruled that a requirement for restriction should not be made in an application claiming more than five species if the Examiner is of the opinion that the various species are obviously unpatentable over one another. [R-20]

706.03(l) Multiplicity [R-20]

Rule 75(b). **More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.**

An unreasonable number of claims; that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, affords a basis for a rejection on the ground of *multiplicity.* A rejection on this ground should include all the claims in the case inasmuch as it relates to confusion of the issue.

To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Appeals prior to an examination on the merits of at least some of the claims presented, the Examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits. The Examiner should be reasonable in setting the number to afford the applicant some latitude in claiming his invention.

If a rejection on multiplicity is in order the Examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. He should request selection of a specified number of claims for purposes of examination.

If time for consideration is requested arrangements should be made for a second telephone call, preferably within three working days.

When claims are selected, a formal multiplicity rejection is made, including a complete record of the telephone interview, followed by an action on the selected claims.

When applicant refuses to comply with the telephone request, a formal multiplicity rejection is made. No reference should be made to the unsuccessful telephone call.

The applicant's response to a formal multiplicity rejection of the Examiner, to be complete, must either:

1. Reduce the number of claims presented to those selected previously by telephone, or if no previous selection has been made to a number not exceeding the number specified by the Examiner in the Office action, thus overcoming the rejection based upon the ground of multiplicity. or

2. In the event of a traverse of said rejection, applicant, besides specifically pointing out the supposed errors of the multiplicity rejection is required to confirm his selection previously made by telephone, or if no previous selection has been made, select certain claims for purpose of examination, the number of which is not greater than the number specified by the Examiner.

If the rejection on multiplicity is adhered to, all claims retained will be included in such rejection and the selected claims only will be additionally examined on their merits. This procedure preserves applicant's right to have the rejection on multiplicity reviewed by the Board of Appeals.

See also section 706.03(k).

706.03(m) Nonelected Inventions [R-20]

See sections 821 to 821.03. See particularly the last paragraph of section 821 for the necessity of rejecting claims, which stand withdrawn because they are not readable on the elected species, where applicant has traversed the Examiner's holding.

706.03(n) Correspondence of Claim and Disclosure [R-20]

Rule 117. Amendment and revision required. **The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.**

Another category of rejections not based on the prior art is based upon the relation of the rejected claim to the disclosure. In chemical cases, a claim may be so broad as to not be supported by disclosure, in which case it is rejected as unwarranted by the disclosure. If averments in a claim do not correspond to the averments or disclosure in the specification, a rejection on the ground of inaccuracy may be in order. It must be kept in mind that an original claim is part of the disclosure and might adequately set forth subject matter which is completely absent from the specification. Applicant is required in such an instance to add the subject matter to the specification. Whenever an objection or rejection is made based on incomplete disclosure, the Examiner should in the interest of expeditious prosecution call attention to Rule 118. If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required

329-817 O - 69 - 2

to add it to the drawing. See section 608.01(l).

See section 706.03(z) for rejections on undue breadth.

706.03(o) New Matter [R-20]

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 sections 608.04 to 608.04(c).

In the examination of an application following amendment thereof, the Examiner must be on the alert to detect new matter. The prohibition against new matter has been incorporated into the patent statute. These rejections are based on 35 U.S.C. 132.

706.03((p) No Utility [R-20]

A rejection on the ground of *lack of utility* includes the more specific grounds of *inoperativeness, involving perpetual motion, frivolous, fraudulent, against public policy*. The statutory basis for this rejection is 35 U.S.C. 101. See section 608.01(p).

706.03(q) Obvious Method [R-16]

A process which amounts to nothing more than an obvious manner of producing an article or product is not patentable. 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 an *obvious method of making the article*.

While a rejection on this ground does not require the citation of art or the allowance of any claim, it must be apparent to a person ordinarily skilled in the art, without reference to any method disclosure contained in the application, how the claimed article was made. It other words, the rejection is proper if such a person would be able, upon the basis of his own knowledge, to perform the claimed method merely from having the claimed article shown to him or by being told what ingredients it contained. *Note in re* Larsen, 49 C.C.P.A. 711; 130 U.S.P.Q. 209; 292 F. 2d 531.

706.03(r) Mere Function of Machine [R-20]

In view of the decision of the Court of Customs and Patent Appeals in In re Tarczy-Hornoch appearing at 158 USPQ 141, process or method claims are not subject to rejection by Patent Office Examiners solely on the ground that they define the inherent function of a disclosed machine or apparatus.

706.03(s) Statutory Bar [R-20]

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.

Abandonment of Invention

Under 35 U.S.C. 102(c), abandonment of the "invention" (as distinguished from abandonment of an application) results in loss of right to a patent.

Own Prior Foreign Patent

Extract from 35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless—

* * * * *

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

The statute above quoted establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country:

(1) The foreign application must be filed more than one year before the filing in the United States.

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

(3) The foreign patent must be actually granted (e.g., by sealing of the papers in Great Britain) before the filing in the United States or, since foreign procedures differ, the act from which it can be said that the invention was patented, has occurred. It need not be published. *Ex parte* Gruschwitz et al., 138 U.S.P.Q. 505 discusses the meaning of "patented" as applied to German procedures.

(4) The same invention must be involved.

If such a foreign patent is discovered by the Examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of *statutory bar*.

The new law only applies to applications filed after January 1, 1953.

SUBMISSION TO LIBRARY UNNECESSARY

Applications should not be submitted as a routine matter to the Library to ascertain if the foreign application has become a patent. Since the foreign patent to be a bar under 35 U.S.C. 102(d) must have been granted before the filing date in this country, the probability of the foreign patent having issued after the date of execution of the original oath and before the U.S. filing date is so slight as to make such a search ordinarily unproductive.

FOREIGN FILING WITHOUT LICENSE

35 U.S.C. 184. Filing of application in foreign country. Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

35 U.S.C. 185. Patent barred for filing without license. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

If, upon examining an application, the Examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for six months, and if the invention apparently was made in this country, he shall refer the application to Licensing and Review Section of Group 220, calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the Examining Group for prosecution on the merits. When it is otherwise in condition for allowance, the application will be again submitted to Licensing and Review Section of Group 220 unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under 35 U.S.C. 185, Licensing and Review Section of Group 220 will request transfer of the application to it.

OTHER STATUTORY BARS

Further, claims to an invention in public use or on sale in the United States more than twelve months before the effective U.S. filing date are also rejected. 35 U.S.C. 102(b).

706.03(t) Other Assigned Application [R-19]

As pointed out in section 304, assignment of one of several overlapping applications of the same inventor may give rise to a ground of rejection. See also sections 305 and 706.03(k).

706.03(u) Disclaimer [R-19]

Claims may be rejected on the ground that applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant's failure:

(a) to make claims suggested for interference with another application under Rule 203, section (1101.01(m)),

(b) to copy a claim from a patent when suggested by the Examiner, section (1101.02(f)), or

(c) to respond or appeal, within the time limit fixed, to the Examiner's rejection of claims copied from a patent (see Rule 206(b) and section 1101.02(f)).

The rejection on disclaimer applies to all claims not patentably distinct from the disclaimed subject matter as well as to the claims directly involved.

706.03(v) After Interference or Public Use Proceeding [R-20]

For rejections following an interference, see sections 1109 to 1110.

The outcome of public use proceedings may also be the basis of a rejection. (See Rule 292.)

Upon termination of a public use proceedings including a case also involved in interference, in order for a prompt resumption of the interference proceedings, a notice should be sent to the Board of Patent Interferences notifying them of the disposition of the public use proceedings.

706.03(w) Res Judicata [R-16]

A prior adjudication against the inventor on the same or similar claims constitutes a proper ground of rejection as *res judicata*. See Ex parte Budde, 150 U.S.P.Q. 469; 828 O.G. 409. The rejection should be used only when the earlier decision was a decision of the Board of Appeals or any of the reviewing courts and when the time for further court review has expired and no such review has been sought, or, if filed, the review action is terminated. The timely filing of a second application copending with an earlier application does not preclude the use of *res judicata* as a ground of rejection for the second application claims.

When making a rejection on *res judicata*, action should ordinarily be made also on the basis of prior art.

706.03(x) Reissue

35 U.S.C. 251 forbids the granting of a reissue "enlarging the scope of the claims of the original patent" unless the reissue is applied for within two years from the grant of the original patent. This is an absolute bar and cannot be excused. This prohibition has been interpreted to apply to any claim which is broader in any respect than the claims of the original patent. Such claims may be rejected as being barred by 35 U.S.C. 251. However, when the reissue is applied for within two years, the Examiner does not go into the question of undue delay.

The same section permits the filing of a reissue application by the assignee of the entire interest only in cases where it does not "enlarge the scope of the claims of the original patent". Such claims which do enlarge the scope may also be rejected as barred by the statute.

A *defective reissue* oath affords a ground for rejecting all the claims in the reissue application. See 1401.08.

Note that a reissue application is "special" and remains so even if applicant does not make a prompt response.

706.03(y) Improper Markush Group [R-17]

Ex parte Markush, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology, may be claimed under the Markush formula but it has consistently been held to be improper to extend it to purely mechanical features or process steps. It is improper to use the term "comprising" instead of "consisting of". Ex parte Dotter, 12 U.S.P.Q. 382. Regarding the normally prohibited inclusion of Markush claims of varying scope (generic and subgeneric for example) in the same case, see Ex parte Burke, 1934 C.D. 5; 441 O.G. 509.

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made. This practice with respect to Markush claims of diminishing scope is being continued.

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. The test should be applied as liberally as possible. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation then "wherein R is A, B, C or D" shall also be considered proper.

A rejection of a Markush type claim based on any of the grounds pointed out above relates to the merits and is appealable.

Subgenus Claim

A situation may occur in which a patentee has presented a number of examples which, in the examiner's opinion, are sufficiently representative to support a generic claim and yet a court may subsequently hold the claim invalid on the ground of undue breadth. Where this happens the patentee is often limited to species claims which may not provide him with suitable protection.

The allowance of a Markush type claim under a true genus claim would appear to be beneficial to the applicant without imposing any undue burden on the Patent Office or in any way detracting from the rights of the public. Such a subgenus claim would enable the applicant to claim all the disclosed operative embodiments and afford him an intermediate level of protection in the event the true genus claims should be subsequently held invalid.

The examiners are therefore instructed not to reject a Markush type claim merely because of the presence of a true genus claim embracive thereof.

See also 608.01(p) and 715.03.

706.03(z) Undue Breadth

In mechanical cases, broad claims may properly be supported by a single form of an ap-

313-834 O - 68 - 3

paratus or structure. In re Vickers et al., 1944 C.D. 324; 564 O.G. 174.

In chemical cases, however, the disclosure of a single species usually does not provide an adequate basis to support generic claims. In re Sol, 1938 C.D. 723; 497 O.G. 546. This is because in chemistry it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 1940 C.D. 351; 518 O.G. 255 gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases", 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail.

706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the Primary Examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See Ex parte Grier, 1923 C.D. 27; 309 O.G. 223; Ex parte Hay, 1909 C.D. 18; 139 O.G. 197.

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.

Because it is unusual to reject a previously allowed claim, the Examiner should point out in his letter that the claim now being rejected was previously allowed.

706.05 Rejection After Allowance of Application

See 1308.01 for a rejection based on a reference.

For rejection of claims in an allowed case which has failed to make the date of a senior application in correspondence under Rule 202, see 1101.01(i).

706.06 Rejection of Claims Copied From Patent

See 1101.02(f).

706.07 Final Rejection

Rule 113. Final rejection or action. (a) On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim (rule 191) or to amendment as specified in rule 116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (rule 181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Before final rejection is in order a clear issue should be developed between the Examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the Examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination; i.e., either an allowance of the case or a final rejection.

While the Rules no longer give to an applicant the right to "amend as often as the Examiner presents new references or reasons for rejection", present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the

prosecution of his case. But the applicant who dallies in the prosecution of his case, resorting to technical or other obvious subterfuges in order to keep the application pending before the Primary Examiner, can no longer find a refuge in the Rules to ward off a final rejection.

The Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and Examiner should be developed, if possible, before appeal is prosecuted. However, it is to the interest of the applicants as a class as well as to that of the

public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution. Ex parte Hoogendam, 1939 C.D. 3; 499 O.G. 3.

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a previous (single) Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's response. If appeal is taken in such a case, the Examiner's Answer should contain a complete statement of the Examiner's position.

A summary indicating the final disposition of each claim is desirable and also a statement that:

"The above rejection is made FINAL", or "This is a FINAL rejection".

The Office action first page form POL–326 should be used in all Office actions up to and including final rejections.

For amendments filed after final rejection, see sections 714.12 and 714.13. [R–20]

706.07(a) Final Rejection, When Proper on Second Action [R–20]

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. Under present practice, second actions on the merits shall be final, except where the Examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, e.g., a rejection of any claim not amended by applicant where that rejection relies on newly cited art.

See section 809.02(a) for actions which indicate generic claims not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the Examiner should be on guard not to allow such claims. See section 714.04. The claims, however, may be finally rejected if, in the opinion of the Examiner, they are clearly open to rejection on grounds of record.

706.07(b) Final Rejection, When Proper on First Action [R–20]

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the art of record in the next Office action if they had been entered in the earlier application. A first action final rejection in a continuation-in-part application is not proper where any claim includes subject matter not present in the parent case.

706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the case is still pending before the Primary Examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Appeals. It is reviewable by petition.

706.07(d) Final Rejection, Withdrawal of, Premature

If, on request by applicant for reconsideration, the Examiner finds the final rejection to have been premature, he should withdraw the finality of the rejection.

706.07(e) Withdrawal of Final Rejection, General [R–20]

See sections 714.12 and 714.13, Amendments after final rejection.

Once a final rejection that is not premature has been entered in a case, however, it should not be withdrawn at the applicant's request except on the showing of Rule 116. This does not mean that no further amendment or argument will be considered. An amendment that will place the case either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with Rule 116(a). While the Office will continue rigorous enforcement of Rule 116, citation of new art by the Examiner in a final rejection

will obviate further showing under Rule 116(b) for any amendment necessitated by the new art.

The Examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the Examiner that the previously rejected claims are in fact allowable, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record. Furthermore, the practice should not be used for entering new non-reference or so-called "formal" grounds of rejection such as those under 35 U.S.C. 112.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

707 Examiner's Letter or Action

Extract from Rule 104. (b) The applicant will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant to judge of the propriety of continuing the prosecution of his application.

707.01 Primary Examiner Indicates Action for New Assistant [R-20]

After the search has been completed, action is taken in the light of the references found. Where the Assistant Examiner has been in the Office but a short time, it is the duty of the Primary Examiner to go into the case thoroughly. The usual procedure is for the Assistant Examiner to explain the invention and discuss the references which he regards as most pertinent. The Primary Examiner may indicate the action to be taken, whether restriction or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, he may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

707.01(a) Partial Signatory Authority [R-20]

Examiners who are delegated partial signatory authority are expected to sign their own actions with the exception of the following actions which require the signature of the Primary Examiner:

Allowances
Quayle actions
Final rejections
Actions on amendments submitted after final rejection
Examiners' answers on appeal
Interference declarations or modifications
Decisions on interference motions
Actions suggesting claims for interference purposes
Actions involving copied patent claims (section 1101.02(f))
Requests for jurisdiction for interference purposes
Actions reopening prosecution
Requests for withdrawal from issue
Rule 312 amendments
Rejection of previously allowed claim
Final holding of abandonment for insufficient response
Actions based on affidavit evidence (Rules 131 and 132)
Suspension of Examiner's action
Reissue cases (decision on reissue oath)
Requests for an extension of time
Examiner's amendments
Restriction requirements

707.02 Actions Which Require the Attention of the Primary Examiner [R-20]

There are some questions which existing practice requires the Primary Examiner to be personally responsible for. The following actions fall in this category:

Third action on any case (section 707.02(a)).

Action on a case pending 5 or more years (section 707.02(a)).

Final rejection.

Initiating an interference (section 1101.01(c)).

First request for extension of time (section 710.02(e)).

Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (section 1111.05).

Decisions on interference motions under Rule 231; also, actions taken under Rule 237 (1105.02 to 1105.05).

Rejection of a previously allowed claim (706.04).

Proposed rejection of a copied patent claim. (If applicable to a patentee, see 1101.02(f).)

Classification of allowed cases (903.07).

Holding of abandonment for insufficient response.

Suspension of Examiner's action (Rule 103).

Treatment of newly filed application which obviously fails to comply with 35 U.S.C. 112 (702.01).

Consideration of the advisability of a patentability report (705.01).

Requirements for restriction (803.01).

Withdrawal of final rejection (706.07(d) and 706.07(e)).

All Examiner's Answers on appeal (Rule 193). Note also 1208.01 where a new ground of rejection or objection is raised, or a new reference is cited, in the Answer.

Decision on reissue oath.

Decision on affidavits under Rule 131 (715.08) and under Rule 132(716).

Initial review of streamlined continuation cases (201.07).

For a list of actions that are to be submitted to the Group Directors, see 1003, 1004, and 1005. [R-17]

707.02(a) Cases Up for Third Action and Five-Year Cases

The Supervisory Primary Examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The Supervisory Primary Examiners are expected to personally consider every application which is up for the third official action with a view to finally concluding its prosecution.

Any case that has been pending five years should be carefully studied by the Supervisory Primary Examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered "special" by the Examiner.

707.04 Initial Sentence

The initial sentence of each letter should indicate the status of that action, as, "This application has been examined" if it is the first action in the case, or, "This is in response to amendment filed * * *" if such is the case. Other papers received, such as supplemental amendments, affidavits, new drawings, etc., should be separately mentioned.

Preliminary amendment in a new case should be acknowledged by adding some sentence such as "Amendment filed (date) has been received" following the initial sentence. It should be noted, however, that in cases filed before October 25, 1965 in which claims in excess

of the number supported by the filing fee are presented before the first official action in the case, action is given only on the claims originally presented and applicant advised accordingly.

707.05 Citation of References [R–17]

During the examination of an application the Examiner cites appropriate prior art which is nearest to the subject matter defined in the claims.

All allowed applications should contain a citation of the prior art for printing in the patent. Only in rare instances involving pioneer inventions, such as new chemical compounds, would it be appropriate to send a case to issue with no art cited. On the allowance of a continuation application where references have been cited during the prosecution of the parent application, no additional citation of the prior art is necessary. See 1302.12.

Rule 107. Citation of references. If domestic patents be cited, their numbers and dates, the names of the patentees, and the classes of inventions must be stated. If foreign patents be cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents, the number of pages of specification and sheets of drawing must be specified, and in case part only of the patent be involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications be cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given. When a rejection is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

707.05(a) Copies of Cited References Provided by Reference Order Center

Copies of cited references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the Examiner during the prosecution.

Copies of references which are cited at the time of allowance, in Ex parte Quayle actions, and by applicant in accordance with 707.05(b) and 708.02 are *not* furnished to applicant with the Office action. Additionally, the practice of furnishing, automatically and without charge, copies of references cited in continuation applications if they had been previously cited in the parent application has been discontinued. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. Other continuing applications, including continuation-in-part and divisional applications, are not affected by this change.

This service is furnished by the Reference Order Center (R.O.C.) which is in charge of (1) ordering copies of the cited U.S. patents; (2) microfilming foreign and other references supplied by the examiner; (3) mailing the action with one copy of each cited reference; and (4) promptly returning to the appropriate Group the foreign and "other references", and (5) after mailing, returning to the Group the ribbon copy of the mailed action together with a copy of each reference to be placed in the application file.

To assist in providing this service, the Examiner should:

(a) Write the citation of the references on 3-part form PO–892, "Notice of References Cited". (The rest of the action is written as heretofore.)

(b) Place the original copy of PO–892 in the file wrapper and give to the clerk with the completed office action for counting and typing as usual.

(c) Write the application serial number on the plastic index tab of a special folder. Insert into the folder the two carbon copies of PO–892 together with any Foreign and Other References cited in the action. (Do not enclose any U.S. patents.)

(d) Place the folder in the "Out Box for R.O.C."

Form PO–892 is completed, and the folder prepared and forwarded to R.O.C. in all cases in which a reference is to be provided, regardless of the type reference cited.

Foreign and Other References are copied and returned to the Art Unit within 48 hours. If it is not feasible to release such a reference from the Art Unit, the Examiner should have two copies made. These copies must be clearly marked as such. Both copies are inserted into the folder for forwarding to R.O.C.

If one copy of a reference is to be used for two or more actions simultaneously, the folders involved must be fastened together with an explanatory note on top.

If Special Handling is desired, a "special" sticker should be attached to the top of the folder.

Jumbo U.S. Patents will be furnished to the applicant, but will not be placed in the appli-

cation file. A tab card stamped "Jumbo Patent" will be inserted in the file to account for the missing reference.

Detailed instructions regarding the above outlined procedure, and the procedure to be followed in correcting an Office action prior to mailing are found in Chapter 400 (Rev.) of the Manual of Clerical Procedures, and the Memorandums of May 31, 1966, and March 29, 1967, distributed to all Examiners.

707.05(b) References Cited By Applicant

Applicants, attorneys and agents are hereby advised that it is considered to be not only proper but highly desirable that they inform the Patent Office, in a separate paper either within thirty days of the filing of an application, or prior to the first Office action, whichever is later, of any prior patent or printed publication which, in their opinion, may be helpful to the Office in its examination of the application. It is not the intention of the Patent Office to rely on such citations as a substitute for all or any part of the official search, nor as an admission by the applicant or attorney that the cited art is anticipatory of any claim or should form a basis for a rejection thereof. The object in requesting a citation by the applicant or attorney of prior art known to him is to provide a check on the official search and also to facilitate such search in that an examiner who is advised of prior art of a given degree of pertinence before beginning his search does not need to spend time in considering art which is obviously less pertinent, but which he would have been required to consider if he were starting without such advice. The Patent Office, if it uses such art, will not rely in any way on the fact that it was cited by the applicant or attorney, but will treat it in exactly the same manner as art discovered in the official search. It is definitely to the applicant's advantage to have all pertinent art of record. Any citation should be selective and should avoid unnecessary duplication or the inclusion of art of comparatively little relevance.

Prior art cited by applicants, attorneys, or agents within thirty days of the filing of an application, or prior to the first Office action, whichever is later, will be fully considered by the Examiner, will be part of the official record, and will be included in the list of references cited in the patented file and in the printed patent provided:

(a) the number of references cited is limited to not more than five separate items, unless a satisfactory explanation is given as to why more than five citations are necessary;

(b) one copy of each of the cited references is submitted;

(c) a detailed discussion of the references, pointing out with the particularity required by Rule 111 (b) and (c), the manner in which the claimed subject matter distinguishes over the references, is submitted.

Where applicant's citations of prior art are submitted in accordance with the above procedures, they will be incorporated in the Examiner's list of reference citations and will not be listed under a separate heading as heretofore. The Examiner when preparing the action, will fill out form PO–892 as usual with the following exceptions. The Examiner will enter the submitted citations in the appropriate columns, *omitting* the class and subclass. For references other than patents, the Examiner will apply a heading entitled "Applicant's Non-Pat. Citations" on form PO–892 ahead of the citation data of the publication. In actions where no references are to be provided (Allowance, Ex parte Quayle, only applicant submitted references relied upon), the Examiner will list the submitted citations as usual with class and subclass on form PO–892. Since the file record will indicate the presence of the submitted citations, the Examiner does not have to point out in the action the reasons for the citation of those references not relied upon.

Reference Order Center (R.O.C.) will not furnish copies of any patent for which the class and subclass have been omitted on form PO–892, or of any publication cited under the heading "Applicant's Non-Pat. Citations."

References cited by applicants, attorneys, or agents under the "special" examining procedure for certain new applications (Section 708.02) will be included in the list of references cited in the patented file and printed patent.

Where applicant's submitted citations do not comply with the above procedures, the paper containing the citations will not be entered in the file. The Examiner will *not* notify applicant of non-compliance. The references will be cited only if relied upon by the Examiner in his action. Applicant will *not* be permitted to withdraw the paper containing the improperly submitted citations from the application file.

All references appearing in Office actions will be listed in the patent under a single heading entitled "References Cited".

See 1302.12.

707.05(c) Grouped at Beginning of Letter

In citing references for the first time, the identifying data of the citation should be placed on form PO–892 "Notice of References

287-499 O - 68 - 3

Cited", a copy of which will be attached to the typed action. No distinction is to be made between references on which a claim is rejected and those formerly referred to as "pertinent". With the exception of applicant submitted citations (705.05(b), 708.02), the pertinent features of references which are not used as a basis for rejection, shall be pointed out briefly.

All U.S. patents (including reissues, designs, etc.) are to be listed in strict numerical order.

Foreign patents are then to be listed, alphabetically arranged by country, with those from each country in numerical order.

Other references are then listed, alphabetically arranged by author (by title, if no author is given). Included in this category are German allowed applications, Belgian and Netherlands printed specifications, abstracts, abbreviatures and other publications. See 707.05(e).

707.05(d) Reference Cited in Subsequent Actions

Where an applicant in an amendatory paper refers to a reference which is subsequently relied upon by the Examiner, such reference shall be cited by the Examiner in the usual manner.

707.05(e) Data Used in Citing References

Rule 107 (707.05 and 901.05(a)) requires the Examiner to give certain data when citing references. The patent number, patent date, name of the patentee, class and subclass (except applicant submitted citations), and the filing date, if appropriate, must be given in the citation of U.S. patents. See 901.04 for details concerning the various series of U.S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U.S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

If the patent date of a U.S. patent is after and the effective filing date of the patent is before the effective U.S. filing date of the application, the filing date of the patent must be set forth along with the citation of the patent. This calls attention to the fact that the particular patent relied on is a reference because of its filing date and not its patent date. Similarly, when the reference is a continuation-in-part of an earlier-filed application which discloses the anticipatory matter and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated.

In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See 707.05(a).

Cross-References

Official cross-references should be marked "X" and unofficial cross-references "uxr."

In citing U.S. patents an unofficial classification is enclosed in parentheses, for example "(96–24 F uxr)". Where only a portion of the classification is unofficial, it alone is enclosed, as in the citation 266–41(A) X. At the time of allowance, when preparing the list of references cited by the Examiner, the typist omits all parenthetically designated classification data.

Foreign Patents and Published Applications

In citing foreign patents, the patent number, citation date, name of the country, name of the patentee, and class and subclass (except applicant submitted citations), must be given.

In actions where references are furnished, and (1) less than the entire disclosure is relied upon, the sheet and page numbers specifically relied upon and the total number of sheets of drawing and pages of specification must be included (except applicant submitted citations); (2) the entire disclosure is relied upon, the total number of sheets and pages are not included, and the appropriate columns on PO–892 are left blank.

In actions where no references are furnished, the total number of sheets and pages should be included except for applicant submitted citations.

Publications such as German allowed applications and Belgian and Netherlands printed specifications should be similarly handled. If the total number of sheets and pages in any publication *to be furnished* (other than U.S. patents) exceeds 15, the authorizing signature of the Group Manager on PO–892 is required. If the total number exceeds 30, the signature of the Operation Director is required. Applicants who desire a copy of the complete foreign patent or of the portion not "relied on" must order it in the usual manner.

See 901.05(a) for a chart in which foreign language terms indicative of foreign patent and publication dates to be cited are listed. Foreign language terms indicating printed applications, which are to be cited as publications, are keyed to footnote (3) of said chart.

Publications

See 711.06(a) for citation of abstracts and abbreviatures. See 901.06(c) for citation of Alien Property Custodian publications.

In citing a publication, sufficient information should be given to determine the identity and facilitate the location of the publication. The data required by Rule 107 (Sec. 707.05) with the specific pages relied on identified together with the SCIENTIFIC LIBRARY call number will suffice. The call number appears on the "spine" of the book if the book is thick enough and, in any event, on the back of the title page. Books on interlibrary loan will be marked with the call number of the other library, of course. THIS NUMBER SHOULD NOT BE CITED. If the copy relied upon is located only in the Group making the action (there may be no call number), the additional information, "Copy in Group ——" should be given.

Examples of nonpatent bibliographical citations:

Winslow, C. E. A. Fresh Air and Ventilation. N.Y., E. P. Dutton, 1926. p. 97–112. TH7653.W5.

Singer, T. E. R. Information and Communication Practice in Industry. N.Y., Reinhold, 1958. Chapter 8, p. 157–165, by J. F. Smith, Patent Searching. T175.S5.

Machinery's Handbook, 16th ed. N.Y., Industrial Press, 1959. p. 1526–1527. TJ151.M3 1959.

Calvert, R. Patents (Patent Law). In Encyclopedia of Chemical Technology, ed. by R. E. Kirk and D. F. Othmer. N.Y., Interscience Encyclopedia. Vol. 9, 1952, p. 868–890. TP9. E68.

Hine, J. S. Physical Organic Chemistry. N.Y., McGraw-Hill, 1956, p. 81. QD476.H5.

Noyes, W. A., Jr. A Climate for Basic Chemical Research. In Chem. & Eng. News. 38(42): p. 91–95. Oct. 17, 1960. TP1.I418.

NOTE: In this citation, 38 is the volume number, 42 the issue number, and 91–95 the page numbers.

If the original publication is located outside the Office, the Examiner should immediately order a photocopy of at least the portion relied upon and indicate the class and subclass in which it will be filed. The Office action MUST designate this class and subclass.

Whenever, in citing references anywhere in the application file the titles of periodicals are abbreviated, the abbreviations of titles used in Chemical Abstracts and printed in the list of periodicals abstracted by Chemical Abstracts should be adopted with the following exceptions: (1) the abbreviation for the Berichte der deutschen chemischen Gesellschaft should be Ber. Deut. Chem. rather than Ber., and (2) where a country or city of origin is a necessary part of a complete identification, the country or city of origin should be added in parentheses; e.g., J. Soc. Chem. Ind. (London).

707.05(f) Effective Dates of Declassified Printed Matter [R-16]

In using declassified material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public.* If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Commerce Department.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit under Rule 131.

*See Ex parte Harris et al., 79 U.S.P.Q. 439.

707.05(g) Incorrect Citation of References

Where an error in citation of a reference is brought to the attention of the Office by applicant, a letter correcting the error and restarting the previous period for response, together with a correct copy of the reference, is sent to applicant. Where the error is discovered by the Examiner, applicant is also notified and the period for response restarted. In either case, the Examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given. See 710.06.

Form POL–316 is used to correct an erroneous citation or an erroneously furnished reference. Clerical instructions are outlined in the Manual of Clerical Procedures, Sec. 410.C (2) (3).

In any case otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the Examiner is directed to correct the citation on an Examiner's Amendment form POL–37.

If a FOREIGN patent is incorrectly cited; for example, the wrong country is indicated or the country omitted from the citation, the General Reference Branch of the Scientific Library may be helpful. The date and number of the patent are often sufficient to determine the correct country which granted the patent.

To correct a citation prior to mailing, either before or after sending the typed action to Reference Order Center (R.O.C.), see the Memorandum of March 29, 1967, distributed to

all Examiners, or the Manual of Clerical Procedures, Sec. 410.C(1).

707.06 Citation of Decisions, Orders, Memorandums and Notices [R–16]

In citing published decisions, both the C.D. and the O.G. citation should be given if the case is reported in these publications. The U.S., C.C.P.A., Federal Reporter or U.S.P.Q. citation should also be given when it is convenient to do so.

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Appeals which has not been published but which is available to the public in the patented file should be cited, as "Ex parte ----, decision of the Board of Appeals, Patent No. ------, paper No. ----, ------ pages."

Decisions found only in patented files should be cited only when there is no published decision on the same point. Any such decision which is frequently cited should be called to the attention of the appropriate Director to determine if it would be advisable to have it published.

The citation of manuscript decisions which are not available to the public should be avoided. If an Examiner believes that a particular manuscript decision not open to public inspection would be useful, he may, call it to the attention of the appropriate Director who will determine whether steps should be taken to release it for publication.

When a Commissioner's Order, Notice or Memorandum not yet incorporated into this manual is cited in any official action, the date of the order, notice or memorandum should be given. Where appropriate other data, such as a specific issue of the *Journal of the Patent Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

707.07 Completeness and Clarity

Rule 105. Completeness of examiner's action. **The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.**

Whenever, upon examination, it is found that the terms or phrases of modes of characterization used to describe the invention are not sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected, to enable the Examiner to make the examination specified in Rule 104, the Examiner should make a reasonable search of the invention so far as it can be understood from the disclosure. The action of the Examiner may be limited to a citation of what appears to be the most pertinent prior art found and a request that applicant correlate the terminology of his specification with art-accepted terminology before further action is made.

A suitable form for this action is as follows:

"A preliminary examination of this application indicates that the following terminology (or properties or units of test data, etc) . . . which appear(s) at page(s) . . . of the specification is (are) so different from those generally accepted in the art to which this invention pertains that it is difficult or impossible to make a reliable search.

Applicant is therefore requested to provide a sufficient elucidation of these terms (or properties or test data) or correlation thereof with art-accepted terminology so that a proper comparison with the prior art can be made.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE (date)."

707.07(a) Complete Action on Formal Matters [R–16]

Forms are placed in informal applications listing informalities noted by the Draftsman (Form PO–948) and the Head of the Application Branch (Form PO–152). Each of these forms comprises an original for the file record and two copies to be mailed to applicant as a part of the Examiner's action. They are specifically referred to as attachments to the letter and are marked with its paper number. In every instance where these forms are to be used they should be mailed with the Examiner's *first* letter, and any additional formal requirements which the Examiner desires to make should be included in the *first* letter.

When any formal requirement is made in an Examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to Rule 111(b) and state that a complete response must either comply with all formal requirements or specifically traverse each requirement not complied with.

707.07(b) Requiring New Oath

See 602.02.

707.07(c) Draftsman's Requirement [R–16]

See 707.07(a); also 606.02 (a), (e), (s).

707.07(d) Language To Be Used In Rejecting Claims [R–16]

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The Examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the Examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

In general, the most usual ground of rejection is based on prior art under either 35 U.S.C. 102 or 35 U.S.C. 103.

35 U.S.C. 102 (Anticipation or Lack of Novelty)

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. It may be advisable to identify a particular part of the reference to support the rejection. If not, the expression "rejected under 35 U.S.C. 102 as clearly anticipated by" is appropriate.

35 U.S.C. 103 (Obviousness)

In contrast, 35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more others. After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious.

Everything of a personal nature must be avoided. Whatever may be the Examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

The Examiner should, as a part of the first Office action on the merits, identify any claims which he judges, as presently advised, to be allowable and/or should suggest any way in which he considers that rejected claims may be amended to make them allowable. If the Examiner does not do this, then by implication it will be understood by the applicant or his attorney or agent that in the Examiner's opinion, as presently advised, there appears to be no allowable claim nor anything patentable in the subject matter to which the claims are directed.

Improperly Expressed Rejections

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

707.07(e) Note All Outstanding Requirements

In taking up an amended case for action the Examiner should note in every letter all the requirements outstanding against the case. Every point in the prior action of an Examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the requirement.

As soon as allowable subject matter is found, correction of all informalities then present should be *required*.

707.07(f) Answer All Material Traversed

Where the requirements are traversed, or suspension thereof requested, the Examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the Examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office action, the response (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the Examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the Examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he should state the reasons for his position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the Applicant will know that the asserted advantages have actually been considered by the Examiner and, if appeal is taken, the Board of Appeals will also be advised.

The importance of answering such arguments is illustrated by In re Herrmann et al., 1959 C.D. 159; 739 O.G. 549 where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since Applicants' statement of advantages was not questioned by the Examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

707.07(g) Piecemeal Examination [R-16]

Piecemeal examination should be avoided as much as possible. The Examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See 904.02.) Major technical rejections on grounds such as aggregation, lack of proper disclosure, undue breadth, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claims thereof to a particular issue. These situations include the following:

(1) Where an application is too informal for a complete action on the merits; see 702.01;

(2) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination; see 706.03(1);

(3) Where there is a misjoinder of inventions and there has been no successful telephone request for election; see 803, 806.02, 812.01;

(4) Where the disclosure is directed to perpetual motion; note *ex parte* Payne, 1904 C.D. 42; 108 O.G. 1049.

However, in such cases, the best prior art readily available should be cited and its pertinancy pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of *res judicata*, no *prima facie* showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accomplished by rejection on all other available grounds.

707.07(h) Notify of Inaccuracies in Amendment

See 714.23.

707.07(i) Each Claim To Be Mentioned in Each Letter [R-16]

In every letter each claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the case, its history through successive actions is thus easily traceable. Each action should conclude with a summary of rejected, allowed and cancelled claims.

Claims retained under Rule 142 and claims retained under Rule 146 should be treated as set out in 821 to 821.03 and 809.02(c).

See 1109.02 for treatment of claims in the application of losing party in interference.

The Index of Claims should be kept up to date as set forth in 717.04.

707.07(j) State When Claims Are Allowable [R-20]

INVENTOR FILED APPLICATIONS

When, during the examination of a pro se case, it becomes apparent to the Examiner that there is patentable subject matter disclosed in the application, he shall draft one or more claims for the applicant and indicate in his action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent.

Although this practice may be desirable and is permissible in any case where deemed appropriate by the Examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the Examiner should not stop with a bare objection or rejection of the claims. The Examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction. Further, an Examiner's suggestion of allowable subject matter may justify his indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the Examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a cancelled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

EARLY ALLOWANCE OF CLAIMS

Where the Examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, he should not delay the allowance of such claims.

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the letter consecutively. This facilitates their identification in the future prosecution of the case.

707.08 Reviewing and Initialing by Assistant Examiner

The full surname of the Examiner who prepares the Office action will, in all cases, be typed below the action on the left side. The telephone number below this should be called if the case is to be discussed or an interview arranged.

After the action is typed, the Examiner who prepared the action reviews it for correctness. If this Examiner does not have the authority to sign the action, he should initial the action above the typed name, and forward to the authorized signatory Examiner for signing.

707.09 Signing by Primary or Other Authorized Examiner

Although only the original is signed, the word "Examiner" and the stamped name of the signer should appear on the original and copies.

707.10 Entry [R-16]

The original, signed by the authorized Examiner, is the copy which is placed in the file wrapper. The character of the action, its paper number and the date of mailing are entered in black ink on the outside of the file wrapper under "Contents".

707.11 Date

The date should not be typed when the letter is written, but should be stamped on all copies of the letter after it has been signed by the authorized signatory Examiner and the copies are about to be mailed.

707.12 Mailing [R-20]

In cases where no references are to be provided by Reference Order Section (R.O.S.), the copies are mailed by the Group after the original, initialed by the Assistant Examiner and signed by the authorized signatory Examiner, has been placed in the file.

In cases where cited references are to be provided, the original and copies after signing are forwarded by the clerk to Reference Order Section (R.O.S.) for mailing. The file with a copy of the action is retained in the Group. After the copies are mailed by R.O.S., the original is returned for placement in the file.

707.13 Returned Office Action

Letters are sometimes returned to the Office because the Post Office has not been able to deliver them. The Examiner should use every reasonable means to ascertain the correct address and forward the letter again, after stamping it "remailed" with the date thereof and redirecting it if there be any reason to believe that the letter would reach applicant at such new address. If the Office letter was addressed to an attorney, a letter may be written to the inventor or assignee informing him of the returned letter. The period running against the application begins with the date of remailing. (Ex parte Gourtoff, 1924 C.D. 153; 329 O.G. 536.)

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. If the period dating from the remailing elapses with no communication from applicant, the case is forwarded to the Abandoned Files Unit.

708 Order of Examination [R-20]

Rule 101. Order of examination. (a) Applications filed in the Patent Office and accepted as complete applications (rules 53 and 55) are assigned for examination to the respective examining divisions having the classes of inventions to which the applications relate. Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which the Office has accepted a request under Rule 139.

(b) Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended applications) shall be taken up for action in such order as shall be determined by the Commissioner.

Each Examiner will give priority to that application in his docket, whether amended or new, which has the oldest effective U.S. filing date. Except as rare circumstances may justify Group Directors in granting individual exceptions, this basic policy applies to all applications.

Whether a given application has an effective U.S. filing date earlier than its actual filing date is determined by whether the disclosure of a parent case adequately supports any claim or claims of the later case. Examiners are responsible for making this determination. If at any time an Examiner determines that the "effective filing date" status of any application differs from what the records show, he should so inform the Clerk of Group, who should promptly amend the records to show the correct status, with the date of correction.

The new order of examination for each Examiner will continue top priority for those special cases having a fixed 30 or 60-day due date, such as Examiner's Answers and Decisions on Motions. Most other cases still remaining in the "special" category (for example, reissues, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U.S. filing date among them normally controlling priority.

Action on those applications in which the Office has accepted a request under Rule 139 is suspended for the entire pendency, except for purposes relating to interference proceedings under Rule 201(b) initiated within (5) five years of the earliest effective U.S. filing date.

708.01 List of Special Cases [R-16]

Rule 102. Advancement of examination. (a) Applications will not be advanced out of turn for examination or for further action except as provided by these rules, or upon order of the Commissioner to expedite the business of the Office, or upon a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

Certain procedures by the Examiners take precedence over actions even on special cases.

For example, all papers typed and ready for signature should be completed and mailed.

All issue cases returned with a "Printer Waiting" slip must be processed and returned within the period indicated.

Cases in which practice requires that the Examiner act within 60 days, such as decisions on motion (1105.06) and Examiner's answers (1208), necessarily take priority over special cases without specific time limits. Such cases should be taken up for action at least 30 days before the 60-day period expires, to guarantee completion within the 60-day limit.

If an Examiner has a case which he is satisfied is in condition for allowance, or which he is satisfied will have to be finally rejected, he should give such action forthwith instead of making the case await its turn.

The following is a list of special cases (those which are advanced out of turn for examination):

(a) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders (Rule 102).

(b) Cases made special as a result of a petition. (See 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the Commissioner or an Assistant Commissioner) will continue to be special throughout its entire course of prosecution in the Patent Office, including appeal, if any, to the Board of Appeals; and any interference in which such an application becomes involved shall, in like measure, be considered special by all Patent Office officials concerned.

(c) Applications for reissues (Rule 176).

(d) Cases remanded by an appellate tribunal for further action.

(e) A case, once taken up for action by an Examiner according to its effective filing date, should be treated as special by any Examiner, Art Unit or Group to which it may subsequently be transferred; exemplary situations include new cases transferred as the result of a telephone election and cases transferred as the result of a timely response to any official action.

(f) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents (Rule 201).

(g) Cases ready for allowance, or ready for allowance except as to formal matters.

(h) Cases which are in condition for final rejection.

(i) Cases pending more than five years, including those which, by relation to a prior United States application, have an effective pendency of more than five years. See 707.02(a)

See also 714.13 and 1207.

708.02 Petition to Make Special [R-18]

As noted in 708.01, certain cases may be advanced for examination out of turn as a result of a petition to make special. The categories of such special cases are noted below.

Manufacture or Infringement

Petitions to make special may be based on actual infringement or on prospective manufacture which is being delayed for lack of some assurance of patent protection. Showings supporting specific facts must be made. For details see the Patent Office publication dated July, 1968, entitled "Petitions To Make Applications Special." Copies of this publication are available in the office of the First Assistant Commissioner.

Age or Ill Health

Petitions to make special may be based on a showing that applicant is 65 or more years of age or that his state of health is such that he might not be available to assist in the prosecution of the application if it were to run its normal course.

Continuing Application

Petitions to make special a continuing application may be based on an allegation that the application contains only claims which have been held allowable in an earlier case or claims differing therefrom only in matters of form or by immaterial terminology. The Examiner is requested to make a report stating whether the allegation in the petition is correct and including a list of the references over which the claims were allowed, unless such references have been listed in the petition. If, in the opinion of the Examiner, the claims in the application do not qualify it for special status as above noted, but he is able to determine from inspection that the application is allowable in matters of substance or that the claims are otherwise such as would, by reason of the previous prosecution, be clearly subject to immediate final action, he should report the fact.

Special Examining Procedure for Certain New Applications—Accelerated Examination

A new application may be granted special status provided that applicant (and this term includes applicant's attorney or agent) concur-

rently submits a written petition to make special wherein he:

(a) Presents all claims directed to a single invention or if the Office determines that all the claims presented are not obviously directed to a single invention will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent case. Each such application must meet on its own all requirements for the new special status.

(b) Submits a statement that a pre-examination search was made, and specifying whether by the inventor, attorney, professional searchers, etc., and listing the field of search by class and subclass, publication, chemical abstracts, foreign patents, etc.

(c) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims.

(d) Submits a detailed discussion of the references, which discussion points out, with the particularity required by Rule 111 (b) and (c), how the claimed subject matter is distinguishable over the references. Where applicant indicates an intention of overcoming one of the references by affidavit under Rule 131, the affidavit must be submitted before the application is taken up for action, but in no event later than one month after request for special status.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request. If perfected, the request will then be granted.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

Following is the special examining procedure:

1. The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the Examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as Examiner's Answers, Decisions on Motions, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The Examiner's search will be restricted to the *subject matter encompassed by the claims.* A first action rejection will set a three-month shortened period for response.

2. During the three-month period for response, applicant is encouraged to arrange for an interview with the Examiner in order to resolve, with finality, as many issues as possible. In order to afford the Examiner time for reflective consideration before the interview, applicant or his representative should cause to be placed in the hands of the Examiner at least one working day prior to the interview, a copy (clearly denoted as such) of the amendment that he proposes to file in response to the Examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

3. Subsequent to the interview, or responsive to the Examiner's first action if no interview was had, applicant will file his "record" response. The response at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as not a proper response.

4. The Examiner will, within one month from the date of receipt of applicant's formal response, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a three-month period for response, or a notice of allowance. The Examiner's response to any amendment submitted after final rejection should be prompt and by way of forms 327, 303 or 309, by passing the case to issue, or by an Examiner's Answer should applicant choose to file an appeal brief at this time. Of course, where relatively minor issues or deficiencies might be easily resolved, the Examiner may use the telephone to inform the applicant of such.

5. A personal interview after final Office action will not be permitted unless requested by the Examiner. However, telephonic interviews will be permitted where appropriate for the

purpose of correcting any minor matters which remain outstanding.

HANDLING OF PETITIONS TO MAKE SPECIAL

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is placed of record in the application file, together with the decision thereon. The Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the "Contents" of the file. The decision will be accorded a separate paper number and similarly entered. To insure entries in the "Contents" in proper order, the Clerk in the Examining Group will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. [R–20]

708.03 Examiner Tenders His Resignation

Whenever an Examiner tenders his resignation, the Supervisory Primary Examiner should see that he spends his remaining time as far as possible in winding up the old complicated cases or those with involved records and getting as many of his amended cases as possible ready for final disposition.

If the Examiner has considerable experience in his particular art, it is also advantageous to the Office if he indicates (in pencil) in the file wrappers of cases in his docket, the field of search or other pertinent data that he considers appropriate.

709 Suspension of Action [R–20]

Rule 103. Suspension of action. (a) Suspension of action by the Office will be granted at the request of the applicant for good and sufficient cause and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner.

(b) If action on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

(c) Action by the examiner may be suspended by order of the Commissioner in the case of applications owned by the United States whenever publication of the invention by the granting of a patent thereon might be detrimental to the public safety or defense, at the request of the appropriate department or agency.

(d) Action on applications in which the Office has accepted a request filed under Rule 139 will be suspended for the entire pendency of these applications except for purposes relating to proceedings under Rule 201(b).

Suspension of action (Rule 103) should not be confused with extension of time for reply (Rule 136). It is to be noted that a suspension of action applies to an impending Office action by the Examiner whereas an extension of time for reply applies to action by the applicant.

Paragraph (b) of the Rule provides for a suspension of Office action by the Examiner on his own initiative, as in sections 709.01 and 1101.01 (i). Paragraph (d) is used in the Defensive Publication Program described in section 711.06.

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee [R–20]

Examiners should not consider ex parte, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party of interest. (See ex parte Jones, 1924 C.D. 59; 327 O.G. 681.)

Because of this where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the applications not in the interference in accordance with Ex parte McCormick, 1904 C.D. 575; 113 O.G. 2508.

Now, partly in view of In re Seebach, 1937 C.D. 495; 484 O.G. 503 the prosecution of all the cases not in the interference is required to be carried as far as possible, by treating as prior art the counts of the interference and by rejections forcing the drawing of proper lines of division. See section 1111.03.

709.02 Actions Following Correspondence Under Rule 202 [R–20]

See section 1101.01(i).

710 Period for Response [R–20]

35 U.S.C. 133. Time for prosecuting application. Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commisioner that such delay was unavoidable.

See Chapter 1200 for period for response when appeal is taken or court review sought.

710.01 Statutory Period [R–20]

Extract from Rule 135. **(a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.**

The maximum statutory period for response to an Office action is six months, 35 U.S.C. 133. Shortened periods are currently used in practically all cases, see section 710.02(b).

710.01(a) Statutory Period, How Computed [R–17]

The actual time taken for response is computed from the day of the mailing of the Office action to the date of receipt by the Office of applicant's response. No cognizance is taken of fractions of a day and applicant's response is due on the corresponding day of the month six months or any lesser number of months specified after the Office action.

Response to an Office action dated August 30 is due on the following February 28 (or 29 if it is a leap year), while a response to an Office action dated February 28 is due on August 28 and not on the last day of August. Ex parte Messick, 1930 C.D. 6; 400 O.G. 3. The same reasoning would apply for any period less than six months.

The date of receipt of a response to an Office action is given by the "Office date" stamp which appears on the responding paper.

In some cases the Examiner's letter does not determine the beginning of a statutory response period. For example, the Examiner may write a letter adhering to a final rejection, in which case the statutory response period running from the date of the final rejection is not disturbed. In all cases where the statutory response period runs from the date of a previous action, a statement to that effect should be included.

710.02 Shortened Statutory Period and Time Limit Actions [R–20]

Extract from Rule 136. Time less than six months. **(a) An applicant may be required to prosecute his application in a shorter time than six months, but not less than thirty days, whenever such shorter time is deemed necessary or expedient. Unless the applicant is notified in writing that response is required in less than six months, the maximum period of six months is allowed.**

Under Rule 136 (35 U.S.C. 133) an applicant may be required to respond in a shorter period than six months, not less than 30 days, whenever it is deemed "necessary or expedient". Some conditions deemed "necessary or expedient" are listed in section 710.02(b).

In other situations, for example, the rejection of a copied patent claim, the Examiner may require applicant to respond on or before a specified date. These are known as time limit actions and are established under authority of 35 U.S.C. 6. Some situations in which time limits are set are noted in section 710.02(c). The time limit requirement should be typed in capital letters where required.

An indication of a shortened time for reply should appear prominently on the first page of all copies of actions in which a shortened time for reply has been set so that a person merely scanning the action can easily see it.

710.02(b) Shortened Statutory Period: Situations in Which Used [R–20]

Under the authority given him by 35 U.S.C. 133 the Commissioner has directed the Examiners to set a shortened period for response to every action. The length of the shortened statutory period to be used depends on the type of response required. Some specific cases of shortened statutory period for response to be given are:

THIRTY DAYS

	Sec.
Requirement for restriction or election of species—no claim rejected	814
To file express abandonment—drawings transferred	608.02(l)

TWO MONTHS

	Sec.
Winning party in terminated interference to reply to unanswered Office action	1109.01

Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered Office action, final rejection or any other action, the Primary Examiner notifies the applicant of this fact. In this case response to the Office action is required within a shortened statutory period running from the date of such notice. See Ex parte Peterson, 1941 C.D. 8; 525 O.G. 3.

Ex parte Quayle

When an application is in condition for allowance, except as to matters of form, such as correction of drawings or specification, a new oath, etc., the case will be considered

special and prompt action taken to require correction of formal matters. Such action should include an indication on first page form letter POL–326 that prosecution on the merits is closed in accordance with the decision in *Ex parte* Quayle, 1935 C.D. 11; 453 O.G. 213. A two month shortened statutory period for response should be set.

	Sec.
Multiplicity rejection—no other rejection	706.03(l)

THREE MONTHS

To respond to any Office action on the merits.

PERIOD FOR RESPONSE RESTARTED	Sec.
Incorrect citation by Examiner—regardless of time remaining in original period	710.06

The above periods may be changed under special, rarely occurring circumstances.

There are other periods for response set forth in the Rules of Practice. For example, applicant will still have 60 days (not two months) to respond to a new ground of rejection in the Examiner's Answer (Rule 193).

A shortened statutory period may not be less than 30 days.

710.02(c) Time-Limit Actions: Situations in Which Used [R–20]

As stated in section 710.02, 35 U.S.C. 6 provides authority for the Commissioner to establish rules and regulations for the conduct of proceedings in the Patent Office. Among the Rules are certain situations in which the Examiner sets a time limit within which some specified action should be taken by applicant. Some situations in which a time limit is set are:

(a) A portion of Rule 203(b) provides that in suggesting claims for interference:

> The parties to whom the claims are suggested will be required to make those claims (i. e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared.

See sections 1101.01 (j), and 1101.01(m).

(b) Rule 206(b) provides:

> *Rule 206(b).* Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

See section 1101.02(f).

(c) When applicant's action is not fully responsive to the Office action, the Examiner may give applicant one month or the remainder of the set statutory period, whichever is longer, to complete his response. See Rule 135(c) which reads as follows:

> *Rule 135(c).* When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

See section 714.03.

(d) In applications filed on or after October 25, 1965, applicant is given one month or the remainder of the set statutory period, whichever is longer, to remit any additional fees required for the submission of an amendment in response to an Office action.

See sections 607 and 714.03.

(e) To ratify or otherwise correct an unsigned amendment, applicant is given one month or the remainder of the set statutory period, whichever is longer.

See section 714.01(b).

(f) Where application is otherwise allowable but contains a traverse of a requirement to restrict, one month is given to cancel claims to nonelected invention or species or take other appropriate action. See Rules 141, 144, and sections 809.02(c) and 821.01.

(g) If there is a defect in the format of a streamlined continuation application which can be corrected, applicant is given one month to correct the defect.

See section 201.07.

710.02(d) Difference Between Shortened Statutory and Time-Limit Periods [R–20]

The distinction between a limited time for reply and a shortened statutory period under Rule 136 should not be lost sight of. The penalty attaching to failure to reply within the time limit (from the suggestion of claims or the rejection of copied patent claims) is loss of the subject matter involved on the doctrine of disclaimer. A rejection on the ground of disclaimer is appealable. On the other hand, a complete failure to respond within the set statutory period results in abandonment of the entire application. This is not appealable, but a petition to revive may be granted if the delay

was unavoidable. Further, where applicant responds a day or two after the time limit, this may be excused by the Examiner if satisfactorily explained; but a response one day late in a case carrying a shortened statutory period under Rule 136, no matter what the excuse, results in abandonment; however, if asked for in advance extension of the period may be granted by the Examiner, provided the extension does not go beyond the six months' period from the date of the Office action. See also section 1101.02(f).

710.02(e) Extension of Time [R-29]

Extract from Rule 136. (b) The time for reply, when a time less than six months has been set, will be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. Only one extension may be granted by the primary examiner in his discretion; any further extension must be approved by the Commissioner. In no case can any extension carry the date on which response to an action is due beyond six months from the date of the action.

It should be very carefully noted that neither the Primary Examiner nor the Commissioner has authority to extend the shortened statutory period unless request for the extension is filed on or before the day on which applicant's action is due. While the shortened period may be extended within the limits of the statutory six months' period, no extension can operate to extend the time beyond the six months.

Compare, however, Rule 135(c) and section 714.03.

Any request under Rule 136(b) for extension of time must state a reason in support thereof; under the present policy the application of the Rule will entail only a limited evaluation of the stated reason.

This liberality will not apply to

(1) any requests for more than one-month extension, and

(2) second and subsequent requests for extension of time.

All first requests for extension of time regardless of the number of months involved will be decided by the Primary Examiner. All requests subsequent to the first request for extension of time to respond to an office action will be forwarded to the Group Director for action.

If a request for extension of time is filed in duplicate and accompanied by a stamped return-addressed envelope, the Office will indicate the action taken on the duplicate and return it promptly in the envelope. Utilization of this procedure is optional on the part of applicant.

In implementing this procedure, the action taken on the request should be noted on the original and on the copy which is to be returned. The notation on the original, which becomes a part of the file record, should be signed by the person granting or denying the extension, and the name and title of that person should also appear in the notation on the copy which is returned to the person requesting the extension.

When the request is granted, no further action is necessary; when it is denied, a formal letter of denial, giving the reason for denial, should be forwarded promptly after the mailing of the duplicate.

Request for extension of time may be made by hand delivery of a duplicate copy of a request which has been filed. Prompt consideration is given and the action taken communicated to applicant at the earliest practicable time; if an attorney's copy as well as the duplicate copy is submitted, it is sufficient to merely indicate on both copies that the extension will be granted if the request is timely filed.

If the request for extension is not presented in duplicate, the applicant should be advised promptly by way of form letter POL-327 regarding action taken on the request so that the file record will be complete.

The filing of a timely first response to a final rejection having a shortened statutory period for response will operate to extend the shortened statutory period an additional month even if previous extensions have been granted, but in no case to exceed six months from the date of the final action. (See section 714.13.)

710.04 Two Periods Running [R-20]

There sometimes arises a situation where two different periods for response are running against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception, involving suggested claims, see section 1101.01(n).

710.04(a) Copying Patent Claims [R-20]

Where, in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for response are running against the application. One period, the first,

is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for response to the rejection (either first or final), established under Rule 206. The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. (Ex parte Milton, 164 Ms. D. 1, 63 USPQ 132 and Ex parte Nelson, 164 Ms. D. 361, 26 J.P.O.S. 564.) See also section 1101.02(f).

710.05 Period Ending on Saturday, Sunday or Holiday [R–20]

35 U.S.C. 21. Day for taking action falling on Saturday, Sunday, or holiday. When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Rule 7. Times for taking action; expiration on Saturday, Sunday, or holiday. Whenever periods of time are specified in these rules in days, calendar days are intended. When the day, or the last day, fixed by statute or by or under these rules for taking any action or paying any fee in the Patent Office falls on Saturday, Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a holiday. See rule 304 for time for appeal or for commencing civil action.

The holidays in the District of Columbia are: New Year's Day, January 1; Washington's Birthday, February 22; Memorial Day, May 30; Independence Day, July 4; Labor Day (first Monday in September); Veterans' Day, November 11; Thanksgiving Day (fourth Thursday in November); Christmas Day, December 25; Inauguration Day (January 20, every four years). Whenever a holiday falls on a Sunday, the following day (Monday) is also a holiday. Ex. Order 10,358: 17 F.R. 5269.

When a holiday falls on a Saturday, the preceding day, Friday, is considered to be a holiday within the District of Columbia and the Patent Office will be closed for business on that day (5 U.S.C. 6103). Accordingly, any action or fee due on such a holiday Friday or Saturday is to be considered timely if the action is taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a holiday.

When an amendment is filed a day or two later than the expiration of the period fixed by statute, care should be taken to ascertain whether the last day of that period was Saturday, Sunday or a holiday in the District of Columbia, and if so, whether the amendment was filed or the fee paid on the next succeeding day which is not a Saturday, Sunday or a holiday.

An amendment received on such succeeding day which was due on Saturday, Sunday or a holiday is endorsed on the file wrapper with the date of receipt. The Saturday, Sunday and/or holiday is also indicated.

710.06 Miscellaneous Factors Determining Date [R–20]

Where the citation of a reference is incorrect and this error is called to the attention of the Office before the expiration of the period for response, a new period for response starts from the date of the Office letter giving the correct citation. The previous period is restarted regardless of the time remaining. See section 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to remail any action (section 707.13), the action should be correspondingly redated, as it is the re-mailing date that establishes the beginning of the period for response. *Ex parte* Gourtoff, 1924 C.D. 153; 329 O.G. 536.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If for any other reason an Office action is defective in some matter necessary for a proper response applicant's time to respond begins with the date of correction of such defect. An example is an action rejecting a claim on a reference which is not cited at all nor already of record.

711 Abandonment [R–20]

Rule 135. Abandonment for failure to respond within time limit. (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See rule 7.)

Rule 138. Express abandonment. An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment, signed by the applicant himself and the assignee of record, if any, and identifying the application. Except as provided in Rule 262 an application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record.

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application, in accordance with Rules 135 and 138, is one which is removed from the Office docket of pending cases through:

1. formal abandonment
   a. by the applicant, himself (acquiesced in by the assignee if there be one), or
   b. by the attorney or agent of record (including an associate attorney or agent appointed by the principal attorney or agent and whose power is of record); or
2. failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the case.

Where an applicant, himself, formally abandons an application and there is a corporate assignee, the acquiescence must be made through an officer whose official position is indicated.

See section 608.02(l).

See section 712 for abandonment for failure to pay issue fee.

711.01 Express or Formal Abandonment [R–20]

Applications may be expressly abandoned as provided for in Rule 138. When a letter expressly abandoning an application (not in issue) is received, the Examiner should acknowledge receipt thereof, indicate whether it does or does not comply with the requirements of Rule 138.

If it does comply, the Examiner should respond by using form POL–327 and by checking the appropriate boxes which indicate that the letter is in compliance with Rule 138 and that the application is being forwarded to the Abandoned Files Unit. The Examiner's signature may appear at the bottom of the form. If such a letter does not comply with the requirements of Rule 138, a fully explanatory letter should be sent.

In view of the doctrine set forth in Ex parte Lasscell, 1884 C.D. 66; 29 O.G. 861, an amendment canceling all of the claims, even though said amendment is signed by the applicant himself and the assignee, is not an express abandonment. Such an amendment is regarded as non-responsive and should not be entered, and applicant should be notified as explained in section 714.03, 714.05. But see section 608.02(l) for situation where application is abandoned along with transfer of drawings to a new application.

After Notice of Allowance

Letters of abandonment of allowed applications are acknowledged by the Issue and Gazette Branch.

Rule 313 provides that an allowed application will not be withdrawn from issue except by approval of the Commissioner, and that after the first portion of the issue fee has been paid and the patent to be issued has received its date and number, it will not be withdrawn for any reason except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. In cases where the second paragraph of Rule 313 precludes giving effect to an express abandonment, the appropriate remedy is a petition under Rule 183, showing an extraordinary situation where justice requires suspension of Rule 313.

The Defensive Publication Program is set forth in section 711.06.

711.02 Failure To Take Required Action During Statutory Period [R–20]

Rule 135 specifies that an application becomes abandoned if applicant "fails to prosecute" his application within the fixed statutory period. This failure may result either from

1. failure to respond within the statutory period, or
2. insufficiency of response, i.e., failure to take "complete and proper action, as the condition of the case may require" within the statutory period (Rule 135).

Abandonment by entire failure to respond presents no problems.

Nor is there ordinarily any particular difficulty when an amendment reaches the Office (not the Group) after the expiration of the statutory period. The case is abandoned and the remedy is to petition to revive it. The Examiner should notify the applicant or attorney at once that the application has been abandoned by using form letter POL–327. The proper boxes on the form should be checked

and the blanks for the dates of the proposed amendment and the Office action completed. The late amendment is endorsed on the file wrapper but not formally entered. (See section 714.17.)

To pass on questions of abandonment, it is essential that the Examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant's response must reach the Office within the set statutory period for reply dating from the mailing of the Office letter. See sections 710 to 710.06.)

711.02(a) Insufficiency of Response [R–20]

Abandonment may result in a situation where applicant's reply is within the statutory period but is not fully responsive to the Office action. But see section 710.02(c), par. (c). See also section 714.02 to 714.04.

711.02(b) Special Situations Involving Abandonment

The following situations involving questions of abandonment often arise, and should be specially noted:

1. Copying claims from a patent when not suggested by the Patent Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

2. A case may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Appeals. See 1215.01 to 1215.04.

3. Likewise it may become abandoned through dismissal of appeal to C.C.P.A. or civil action, where there was not filed prior to such dismissal an amendment putting the case in condition for issue or fully responsive to the Board's decision. Failure to perfect an appeal as required by CCPA Rule 25. See 1215.05 and 1216.01.

4. Where claims are suggested for interference near the end of the statutory period running against the case, see 1101.01(n).

5. When drawings are transferred under Rule 88. See 608.02(l).

711.02(c) Termination of Proceedings [R–16]

"Termination of proceedings" is an expression found in 35 U.S.C. 120. As there stated, a second application is considered to be copending with an earlier case if it is filed before (a) the patenting, (b) the abandonment of, or (c) other termination of proceedings in the earlier case. "Before" has consistently been interpreted, in this context, to mean "not later than".

In each of the following situations, proceedings are terminated:

1. When the issue fee is not paid and the application is abandoned for failure to pay the issue fee, proceedings are terminated as of the date the issue fee was due and the application is the same as if it were abandoned on that date (but if the issue fee is later accepted, on petition, the application is in a sense revived). See 712.

2. If an application is in interference involving all the claims present in the application as counts and the application loses the interference as to all the claims, then proceedings on that application are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

3. Proceedings are terminated in an application after decision by the Board of Appeals as explained in Section 1214.06.

4. Proceedings are terminated after a decision by the court as explained in Sections 1215.05 and 1216.01.

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his application, applicant may either ask for reconsideration of such holding, if he disagrees with it on the basis that there is no abandonment in fact; or petition for revival under Rule 137.

711.03(a) Holding Based on Insufficiency of Response

Applicant may deny that his response was incomplete.

While the Examiner has no authority to act upon an application in which no action by applicant was taken during the statutory period, he may reverse his holding as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. See also 714.03.

711.03(b) Holding Based on Failure To Respond Within Period

When an amendment reaches the Patent Office (not the Examining Group) after the expiration of the statutory period and there is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the Examiner and the applicant may disagree as to the date on which the statutory period commenced to run or ends. In this situation, as in the situation involving sufficiency of response, the applicant may take issue with the Examiner and point out to him that his holding was erroneous.

711.03(c) Petitions Relating to Abandonment

Rule 137. Revival of abandoned application. An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was

unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee.

A petition to revive an abandoned application should not be confused with a petition from an Examiner's holding of abandonment. Abandonment may result not only from insufficiency of response but also from entire failure to respond, within the statutory period following an office action.

Where the holding of abandonment is predicated on the insufficiency of the response, or disagreement as to controlling dates the petition from such holding comes under Rule 181 and does not require a fee.

Where the applicant acquiesces in the holding of abandonment, or where the petition from such holding is denied, applicant's only recourse, so far as concerns the particular case involved, is by petition to revive.

See 712 for a petition for late payment of the issue fee.

711.03(d) Examiner's Statement on Petition Relating to Abandonment

On Petition To Revive

When an application is received by the Examiner accompanied by both the petition to revive and the accompanying form (POL–269), the Examiner will complete the report form which will then be forwarded to the Commissioner. No communication will be sent to the applicant by the Examiner and no credit will be given for an action.

On Petition To Set Aside Examiner's Holding

Rule 181 states that the Examiner "may be directed by the Commissioner to furnish a written statement within a specified time setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner". Often, however, the question is passed upon without a statement being requested, if the issue raised is clear from the record. Unless requested, such a statement should not be prepared. See 1002.01.

711.04 Disposition of Abandoned Applications

Extract from Rule 14. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

As explained in 1302.07, a retention label is used to indicate applications not to be destroyed.

711.04(a) Pulling and Forwarding

The files and drawings of abandoned applications are pulled and forwarded to the Abandoned Files Unit on a bi-weekly basis in accordance with the chart in Section 505.E(1) of the Manual of Clerical Procedure.

They should be carefully scrutinized by the appropriate examiner to verify that they are actually abandoned. A check should be made of files containing a decision of the Board of Appeals for the presence of allowed claims to avoid their being erroneously sent to the Abandoned Files Unit.

711.04(b) Ordering Abandoned Files

Abandoned files may be ordered by Examiners by sending (through the Messenger Service) a completed Form PO–125 to the Abandoned Files Unit. The name and art unit of the individual Examiner ordering the file should appear on the form and the file will be sent to him through the Messenger Service.

Abandoned files more than ten years old which have not been marked for permanent retention are stored in a nearby Federal Records Center. Orders for files in this group require at least two days for processing. The file should be returned promptly when it is no longer needed.

Expedited Service

Examiners may expedite service by ordering abandoned files by telephone.

711.05 Letter of Abandonment Received After Application Is Allowed [R–16]

Receipt of a letter of abandonment while an application is allowed, is acknowledged by the Issue and Gazette Branch.

An express abandonment arriving after the issue fee has been paid and the patent to issue has received its date and number will not be accepted without a showing of one of the reasons indicated in the second paragraph of Rule 313, or else a showing under Rule 183 justifying suspension of Rule 313.

711.06 Abstracts, Abbreviatures and Defensive Publications [R-20]

Abstracts

Abstracts were prepared in accordance with the Notice of January 25, 1949, 619 O.G. 258. Each abstract includes a summary of the disclosure of the abandoned application, and in applications having drawings, a figure of the drawing. The publication of such abstracts was discontinued in 1953.

Abbreviatures

Abbreviatures were prepared in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviature contains a specific portion of the disclosure of the abandoned application, preferably a detailed representative claim, and, in applications having drawings, a figure of the drawing. The publication of such abbreviatures was discontinued in 1965.

Defensive Publications

Rule 139. Waiver of patent rights. An applicant may waive his rights to an enforceable patent based on a pending patent application by filing in the Patent Office a written waiver of patent rights, a consent to the publication of an abstract, an authorization to open the complete application to inspection by the general public, and a declaration of abandonment signed by the applicant and the assignee of record or by the attorney or agent of record.

A. Defensive Publication Program

An applicant may request to have an abstract of the technical disclosure of his application published as a defensive publication abstract under Rule 139. The request must be filed while the application awaits Office action and no later than 8 months from the earliest effective U.S. filing date of the application. However, any pending application awaiting the first Office action may be included in the program without regard to its filing date. The application is laid open for public inspection and the applicant provisionally abandons the application, retaining his rights to an interference for a limited period of five years from the earliest effective U.S. filing date.

The defensive publication of an application precludes a continuing application (divisional, continuation-in-part, or continuation) filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application unless the continuing application is filed within thirty (30) months after the earliest effective U.S. filing date. Where a similar application is filed after expiration of the thirty (30) month period, the application is examined, but it may not claim the benefit of the earlier filing date of the defensive publication application. The Examiner should require the cancellation of any claim or statement intended to obtain the benefit of the earlier filing date in such cases, objecting to its inclusion on the ground of estoppel.

The denial or approval of a request for defensive publication is made by the Supervisory Primary Examiner.

An application having therein a request for defensive publication is taken up special by the Examiner, and if acceptable, the application is processed promptly for publication of the abstract and opening of the application to the public. A request for defensive publication cannot be withdrawn after it has been accepted by the Office.

No fee is required for the defensive publication of an application.

The Defensive Publication Abstract and a selected figure of the drawing, if any, are published in the O.G. Defensive Publication Search Copies, containing the defensive publication abstract and suitable drawings, if any, are provided for the application file, the Public Search Room and the Examiner's search files.

The defensive publication application files are maintained in the Record Room after publication.

B. Requirements for a Statement Requesting Defensive Publication

An application may be considered for defensive publication provided applicant files a request under Rule 139 agreeing to the conditions for defensive publication. The statement requesting publication should: (1) be signed by the assignee of record, or by the attorney or agent of record, or by the applicant and the assignee of record, if any; (2) request the Commissioner to publish an abstract of the disclosure in the O.G.; (3) authorize the Commissioner to lay open to public inspection the complete application upon publication of the abstract in the O.G.; (4) expressly abandon the application to take effect 5 years from the earliest U.S. effective filing date of said application unless interference proceedings have been initiated within that period; and (5) waive all rights to an enforceable patent based on said application as well as on any continuing application filed more than 30 months after the earliest effective U.S. filing date of said application.

C. Requirements for Defensive Publication

The Examiner should scan the disclosure of the application to the extent necessary to deter-

mine whether it is suitable for publication and he also should ascertain that the abstract and the selected figure of the drawing, if any, adequately reflect the technical disclosure. The abstract should be entitled "Defensive Publication Abstract" and may contain up to 200 words and be an expanded version of the abstract required under Rule 72(b).

The request for defensive publication is disapproved by the Examiner if (1) there is some informality in the application or drawings, (2) the requirements of the statement requesting defensive publication as described in B above have not been met, or (3) the subject matter of the application is not considered suitable for publication because: (a) it involves national security; (b) it is considered advertising, frivolous, scandalous, lacking utility, or against public policy, etc., or (c) the disclosure is clearly anticipated by readily available art, and publication would not add anything to the fund of public knowledge (matters of patentability are generally not considered and no search is made).

If there are defects in the request for defensive publication which cannot be corrected by Examiners Amendment, the Examiner should notify applicant in writing, usually giving the reasons for disapproval and indicating how corrections may be made. Applicant is given a period of one (1) month within which to make the necessary corrections. Failure to correct a defect as required results in nonacceptance for defensive publication, and in resumption of the prosecution of the application by the Office in its regular turn.

In those instances, however, where the subject matter is not suitable for publication, the request may be disapproved by the Examiner without explanation. Under these circumstances, the Examiner's letter is first submitted to the Group Director for approval.

Petition may be taken to the Commissioner from the disapproval of a request for defensive publication.

Where the request is apparently fatally defective and involves subject matter not considered suitable for publication, for example, advertising, frivolous, lacking utility, etc., or is clearly anticipated by readily available art, the Examiner should generally examine the application and prepare a complete Office action when notifying applicant.

D. Formal Requirements of a Defensive Publication Application

Correction is required by the Examiner of informalities listed by the Application Branch and by the Draftsman before approval of the request for defensive publication. Informalities of the drawing are listed on the Notice of Informal Patent Drawings and defects of the application are noted on the Notice of Informal Patent Application. A letter notifying an applicant of the informalities in a request for defensive publication should end with the following paragraphs:

"The request for defensive publication has not been approved in view of the noted informalities. APPLICANT IS GIVEN ONE (1) MONTH WITHIN WHICH TO MAKE THE CORRECTIONS NECESSARY FOR PUBLICATION.

Failure to respond within the set period will result in resumption of the prosecution of the application in the normal manner."

Where the heading "Defensive Publication Abstract" has been omitted, it is inserted by Examiner's Amendment, as are other corrections to the abstract. The Examiner has the authority to add to the abstract reference numerals of the figure selected for the O.G., and to designate a figure of the drawing for printing in the O.G., or to change the selection made by applicant by Examiner's Amendment.

Informalities noted by the Draftsman on the Notice of Informal Patent Drawings should be corrected where appropriate and should be handled as follows: The Examiner notes in pencil in the left margin of the drawing the number of the figure selected for defensive publication in the O.G. and returns the drawing with the file to the Draftsman for further consideration in view of the request under Rule 139. Although the selected figure itself must meet all the drawing standards, the Draftsman may waive requirements as to the remaining figures which need be formal only to the extent of being sufficiently clear for reproduction. The Draftsman will note on the drawing and all copies of the Notice of Informal Patent Drawings "Approved for Defensive Publication Only". (If the application is later passed to issue, *all* drawing informalities must be corrected). If the drawing correction requires authority from the applicant, the Examiner notifies him in writing that the request under Rule 139 is disapproved until authorization for correction is received.

E. Preparation of an Application for Defensive Publication

After determining that the application is acceptable for defensive publication the Examiner indicates which papers, if any, are to be entered. Amendments accompanying the request are not entered until approved by the Examiner. If filed after receipt of the request, amendments will be placed in the file, but will not be

entered unless the subject matter of the amendment is in response to a requirement by the Examiner.

The designated spaces on the face of the file jacket for class, subclass, claim for foreign priority and prior United States application data are appropriately completed.

The Defensive Publication Retention Label identifies Defensive Publication Applications only and is affixed by the Examiner in the space on the file jacket reserved for the retention label. Issue and Gazette Branch complete the date of publishing and O.G. citation of the Defensive Publication Retention Label.

In the spaces titled "Prep. for Issue" and "Examined and Passed for Issue" the word "Issue" is changed to—Def. Publ.—by the Examiner before signing. (The clerk's signature is not necessary).

The "blue issue" slip is used on defensive publication applications and is completed in the usual manner except that in the space designated for the Patent Number the Examiner writes "Defensive Publication". Cross references are designated only in those subclasses where the Examiner believes the subject matter will be of significant interest to warrant it.

With respect to the drawings the procedure is the same as for allowance and the Examiner fills in the appropriate spaces on the left margin, in the Draftsman's "Approved" stamp area.

F. Citation of Prior Art in a Defensive Publication Application

Since the defensive publication procedure makes the disclosure of an application available to the public, usually before it or any continuing application is patented, citation of prior art under Rule 291 by any person or party is accepted for consideration in the event examination is subsequently conducted. Such citation is endorsed on the file jacket "Contents" by the Record Room, for the convenience of the Examiner when preparing the application or a continuing application of such an application for allowance.

G. Defensive Publication Application Interferences

During the five year period from its earliest U.S. effective filing date, interferences may be declared between defensive publication applications and other applications and/or patents in accordance with existing interference rules and procedures.

When making the interference search, the Examiner inspects the prints or brief cards of those defensive publication applications which have not become abandoned. Where the claims of a defensive publication application recite substantially the same subject matter as the allowed claims, the allowed claims should be suggested for interference purposes to the defensive publication application if these claims would be allowable therein.

Abandonment of a defensive publication application will be stayed during the period beginning with the suggestion of claims or the filing of claims copied from a patent and ending with the termination of the interference proceedings or the mailing of a decision refusing the interference.

Termination of the interference in favor of the defensive publication application would render the express abandonment ineffective but would not result in the issuance of an enforceable patent. The Examiner cancels by Examiner's Amendment all the claims in the case except those awarded to applicant and sends the case to issue. The Notice of Allowance in these cases will be accompanied by a statement informing the applicant that when the issue fee is remitted, a disclaimer of the entire term of the patent to be granted, must be included in accordance with 35 U.S.C. 253.

711.06(a) Citation and Use of Abstracts, Abbreviatures and Defensive Publications as References [R–17]

It is important that abstracts, abbreviatures and defensive publications (O.G. Defensive Publication and Defensive Publication Search Copy) be referred to as publications and not as patents or applications. These printed publications are cited as prior art under 35 U.S.C. 102(a) or 102(b) effective from the date of publication in the Official Gazette.

An application or portion thereof from which an abstract, abbreviature or defensive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 U.S.C. 102(a), effective from the actual date of filing in the United States.

These publications may be used alone or in combination with other prior art in rejecting claims under 35 U.S.C. 102 and 103.

Abstracts, Abbreviatures and Defensive Publications are listed with Other References in the citation thereof as follows:

(a) Abstracts and Abbreviatures

Brown, (abstract or abbreviature) of Serial No. _____, filed _____, published in _____ O.G. _____, on _____ (list classification).

(b) The O.G. defensive publication

Jones, Def. Pub. of Serial No. _____ filed _____, published in _____ O.G. _____, on _____ (list classification).

(c) Search Copy defensive publication; (where a disclosure relied on is in the Search Copy but not in the O.G. publication)

Jones, Def. Pub. Search Copy of Serial No. _____, filed _____, published in _____ O.G. _____, on _____ (list classification).

(d) Applications or designated portions thereof abstracts, abbreviatures and defensive publications

Jones, Application Serial No. _____, filed _____, laid open to public inspection on _____ as noted at _____, O.G. _____ (portion of application relied on) (list classification).

712 Abandonment for Failure To Pay Issue Fee [R–17]

Rule 316. Application abandoned for failure to pay issue fee. (a) If the fee specified in the notice of allowance is not paid within three months from the date of the notice the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent Office.

(b) If the issue fee or portion thereof specified in the notice of allowance is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing of sufficient cause for the late payment, it may be accepted by the Commissioner as though no abandonment had ever occurred.

Rule 317. Delayed payment of balance of the issue fee; lapsed patents. Any remaining balance of the issue fee is to be paid within three months from the date of notice thereof and, if not paid, the patent lapses at the termination of the three-month period. If this balance is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing of sufficient cause for the late payment, it may be accepted by the Commissioner as though no lapse had ever occurred.

An application abandoned by reason of failure to pay the issue fee was formerly referred to as a forfeited application.

When the three months' period within which the issue fee might have been paid has expired, the file is returned by the Issue and Gazette Branch to the Examining Group. Certain clerical operations are performed and the file and drawing are forwarded to the Abandoned Files Unit. When the issue fee is not paid and the application is abandoned, proceedings are terminated as of the date the issue fee was due. The application is abandoned on that date (but if the issue fee is later accepted, on petition, the application is in a sense revived). During the three month period following such abandonment, it is possible to petition the Commissioner to have the application issued as a patent. Such petition must be supported by a verified showing of sufficient cause for the late payment, and accompanied by the proper issue fee and the fee for late payment. If such a petition accompanied by the required fees is not filed within the three month period following the abandonment (six months after the date of the notice of allowance) and granted, such abandoned application cannot be revived. In this respect an abandoned application that has passed through the six months' period indicated in Rule 316 differs in status from an application that has become abandoned under the provisions of Rules 135 and 136 in that the latter may be revived under the provisions of Rule 137.

713 Interviews

The personal appearance of an applicant, attorney, or agent before the Examiner presenting matters for the latter's consideration is considered an interview.

713.01 General Policy, How Conducted [R–17]

Extract of rule 133. Interviews. (a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

Interviews are permissible on any working day except during periods of overtime work.

An interview should normally be arranged for in advance, as by letter, telegram or phone call, in order to insure that the Primary Examiner and/or the Examiner in charge of the application will be present in the Office. When a second Art Unit is involved (Patentability Report), the availability of the second Examiner should also be checked. (See 705.01(f).) An

appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be made. When a telephone call is made to an Examiner and it becomes evident that a lengthy discussion will ensue or that the Examiner needs time to restudy the situation, the call should be terminated with an agreement that the Examiner will call back at a specified time. Such a call and all other calls originated by the Examiner may be handled through the FTS (Federal Telecommunications System) even though a collect call had been authorized. It is helpful if amendments include the complete telephone number with area code and extension, preferably near the signature of the writer. The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the Examiner may well justify his refusal of the interview at that time, particularly in an involved case. An Examiner's suggestion of allowable subject matter may justify his indicating the possibility of an interview to accelerate early agreement on allowable claims.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the Examiner and the applicant, and thereby advance the prosecution of the application. Thus the attorney when presenting himself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted.

The Examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the Examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the Examiner.

It is the duty of the Primary Examiner to see that an interview is not extended beyond a reasonable period even when he does not personally participate in the interview.

During an interview with an applicant who is prosecuting his own case and is not familiar with Office procedure the Examiner may make suggestions that will advance the prosecution of this case; this lies wholly within his discretion. Too much time, however, should not be allowed for such interviews.

To offset any increased rigor of prosecution (under the procedure effective July 1, 1964), Examiners may grant one interview after final rejection. See 713.09.

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Consideration of a filed amendment may be had by hand delivery of a duplicate copy of said amendment.

Early communication of the results of the consideration should be made to applicant; if requested, indicate on attorney's copy any agreement; initial and date both copies.

Although entry of amendatory matter usually requires actual presence of the original paper, examiner and clerical processing should proceed as far as practicable based on the duplicate copy. The extent of processing will depend on each amendment.

Examination by Examiner Other Than The One Who Conducted The Interview

Sometimes the Examiner who conducted the interview is transferred to another group or resigns, and the examination is continued by another Examiner. If there is an indication that an interview had been held, the second Examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second Examiner should take a position consistent with the agreements previously reached. See 812.01 for a statement of telephone practice in restriction and election of species situations.

713.02 Interviews Prior to First Official Action

Prior to the first action and, obviously, prior to filing, no interview is permitted. However, in the Examiner's discretion, a limited amount of time may be spent in indicating the field of search to an attorney, searcher or inventor.

Searching in Group

Searching in the group should be permitted only with the consent of the Primary Examiner.

Expounding Patent Law

The Patent Office cannot act as an expounder of the patent law, nor as a counsellor for individuals.

713.03 Interview for "Sounding Out" Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the Examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

713.04 Substance of Interview Must Be Made of Record

The substance of an interview must always be made of record in the application, particularly where agreement between attorney and the Examiner is reached. Rule 133 (second paragraph) specifically requires that:

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in rules 111, 135.

This is further brought out by the following Rule:

Rule 2. Business to be transacted in writing. All business with the Patent Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent Office is unnecessary. The action of the Patent Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

To insure that any mutually acceptable conclusions reached at an interview are understood by both parties, a memorandum summarizing these conclusions and the significance of any exhibits considered or demonstrations made should be prepared in duplicate and signed by both parties to the interview, and a copy should be retained by each. The copy retained by the examiner will be kept in the application file until prosecution is completed. Such procedure will not, however, relieve applicant of his responsibility under the second paragraph of Rule 133.

In those cases where an interview is had but no agreement is reached, the examiner should place an informal memorandum in the file to this effect. The memorandum should be sufficiently complete to make clear to others the issues resolved and/or discussed in the interview.

Some Examiners prepare, for their own information, informal notes setting forth what occurred at the interview. These informal notes do not become an official part of the record. A convenient arrangement is to make the notes on 4 by 6 cards which may be retained with the file wrapper by means of the slits in the flap. All notes should be removed from the file at the time of allowance.

The memoranda discussed above are not an official part of the record, and should be removed from the file if and when the case is passed to issue.

Examiner to Check for Accuracy

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any statement attributed to the examiner during the interview. (a) If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the Examiner should withhold allowance by means of an Ex parte Quayle action until the record is clarified. (b) If the inaccuracy does not bear directly on the question of patentability, the case may be sent to issue, if allowable for reasons of record, but the Examiner should send a letter setting forth his version of the statement attributed to him.

An inaccuracy with respect to an argument presented at the interview; e.g., including in the summary of the interview an argument not then presented, should be treated as in (a) or (b) above.

713.05 Interviews Prohibited or Granted, Special Situations

Saturday interviews, see 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after a case has been passed to issue.

An interview may be appropriate before applicant's first response when the Examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Patent Office employees are forbidden to hold either oral or written communication with a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. See 105.

Interviews are frequently requested by persons whose credentials are of such informal character that there is serious question as to whether such persons are entitled to any infor-

mation under the provisions of Rule 14. In general, interviews are not granted to anyone who lacks proper authority from the applicant or attorney of record in the form of a paper on file in the case. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

However, interviews may be granted to persons who are known to be the local representatives of the attorney in the case, even though their power of attorney be not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. (See 408.)

If the person seeking the interview is unknown to the Examiner but has in his possession a copy of the application file, the Examiner may accept his statement that he is the person named as the attorney of record or an employee of such attorney.

Interviews normally should not be granted unless the requesting party has authority to bind the principal concerned.

The availability of personal interviews in the "Conference Period", which is the time between the filing of applicant's thorough first response and a concluding action by the examiner, for attorneys resident or frequently in Washington is obvious. For others more remote, telephone interviews may prove valuable. However, present Office policy places great emphasis on telephone interviews initiated by the Examiner. For this reason, it is no longer deemed necessary for an attorney to request a telephone interview as specified in the old Optimum Examining Procedure memos. See 408.

The Examiner, by making a telephone call, may be able to suggest minor, probably quickly acceptable changes which would result in allowance. If there are *major* questions or suggestions, the call might state them concisely, and suggest a further telephone or personal interview, at a prearranged later time, giving applicant more time for consideration before discussing the points raised.

For an interview with an examiner who does not have negotiation authority, arrangements should always include an examiner who does have such authority, and who has familiarized himself with the case, so that authoritative agreement may be reached at the time of the interview.

GROUPED INTERVIEWS

For attorneys remote from Washington who prefer personal interviews, the grouped interview practice is effective. The cases they wish to discuss may include some applications which will not be up for action for many months. If in any such case there is a prearranged interview, *with agreement to file a prompt supplemental amendment putting the case as nearly as may be in condition for concluding action*, prompt filing of the supplemental amendment gives the case special status, and brings it up for immediate special action.

713.06 No Inter Partes Questions Discussed Ex Parte

The Examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties. For this reason, the telephone number of the Examiner should not be typed on Decisions on Motions or any other interference papers. See 1111.01.

713.07 Exposure of Other Cases

Prior to an interview the Examiner should arrange his desk so that files, drawings and other papers, except those necessary in the interview, are placed out of view. See 101.

713.08 Demonstration, Exhibits, Models

The invention in question may be exhibited or demonstrated during the interview by a model thereof which may be sent to the Office prior to the interview where it is received in the model room and forwarded to the group. A model is not to be received by the Examiner directly from the applicant or his attorney. See 608.03 and 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the Examiner outside of the Office, (in Washington) with the approval of the Primary Examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application

Normally, one interview after final rejection is permitted. However, the intended purpose and content of the interview must be presented briefly, either orally or in writing. With the approval of the Primary Examiner, an interview may be granted if the Examiner is convinced that disposal or clarification for appeal

may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search should be denied. See 714.13.

713.10 Interview Preceding Filing Amendment Under Rule 312

After a case is sent to issue, it is technically no longer under the jurisdiction of the Primary Examiner, Rule 312. An interview with an Examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under Rule 312 cannot be demanded as a matter of right.

Requests for interviews on cases already passed to issue should be granted only with specific approval of the Group Manager upon a showing in writing of extraordinary circumstances.

714 Amendments, Applicant's Action

Rule 115. Amendment by applicant. The applicant may amend before or after the first examination and action, and also after the second or subsequent examination or reconsideration as specified in rule 112 or when and as specifically required by the examiner.

See also 714.12.

714.01 Signatures to Amendments

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature. Note 605.04 to 605.05(a) for a discussion of signatures to the application.

714.01(a) Unsigned or Improperly Signed Amendment [R-16]

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies, for instance, where the amendment is signed by one only of two applicants and the one signing has not been given a power of attorney by the other applicant.

When an unsigned or improperly signed amendment is received the amendment will be listed on the file wrapper, but not entered. The examiner will notify applicant of the status of the case, advising him to furnish a duplicate amendment properly signed or to ratify the amendment already filed. Applicant is given either the time remaining in the statutory period, or one month, whichever is longer, to file his supplemental response (Rule 135, 711).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney of record, since he may have the authority to sign said attorney's name to the amendment. Listings of local representatives of out-of-town attorneys are kept available in the various Directors' Offices.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of Rule 347 or Rule 348 is not entered. The file and unentered amendment are submitted to the Office of the Solicitor for appropriate action.

714.01(b) Unsigned or Improperly Signed Amendment, Disposal of [R-16]

See 714.01(a).

714.01(c) Signed by Attorney Not of Record [R-16]

Where an amendment is filed, signed by an attorney whose power is not of record, he should be notified that the amendment cannot be entered and similar notification sent to the attorney of record, if there be one, or to applicant.

If the amendment is signed by an attorney not of record and arrives after the death of the attorney of record, see 406.

714.01(d) Amendment Signed by Applicant But Not by Attorney of Record [R-16]

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to Rule 35. The customary two copies of the action should be prepared, one only being sent to the attorney and the other direct to Applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

714.01(e) Power of Attorney to a Firm

See 402.03, 402.04, 402.04(a).

714.02 Must Be Fully Responsive [R-16]

Rule 111. Reply by applicant. **(a) After the Office action, if adverse in any respect, the applicant, if he persist in his application for a patent, must reply thereto and may request re-examination or reconsideration, with or without amendment.**

(b) In order to be entitled to re-examination or reconsideration, the applicant must make request therefor in writing, and he must distinctly and specifically point out the supposed errors in the examiner's action; the applicant must respond to every ground of objection and rejection in the prior Office action (except that request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated), and the applicant's action must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define invention without specifically pointing out how the langauge of the claims patentably distinguishes them from the references does not comply with the requirements of this rule.

(c) In amending an application in response to a rejection, the applicant must clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections. (See rules 135 and 136 for time for reply.)

In all cases where response to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated, a complete response must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matters and those touching the merits is not sharp, and the determination of the merits of a case may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

Rule 119. Amendment of claims. **The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in Rule 121. The requirements of Rule 111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.**

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held nonresponsive for that reason alone. (See Rule 112, 706).

The prompt development of a clear issue requires that the responses of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See 706.03(n).

An amendment attempting to "rewrite" a claim in the manner set forth in Rule 121(b) may be held non-responsive if it uses parentheses, ( ), where brackets, [ ], are called for; see 714.22.

Responses to requirements to restrict are treated under 818.

714.03 Amendments Not Fully Responsive, Action To Be Taken

If there is sufficient time remaining in the six months' statutory period or set shortened period when applicant's amendment is found to be not fully responsive to the last Office action, a letter should at once be sent applicant pointing out wherein his amendment fails to fully respond coupled with a warning that the response must be completed within the time period in order to avoid the question of abandonment. See 714.05.

Where a bona fide response to an Examiner's action is filed before the expiration of a permissible period, but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted,—such as an amendment or argument as to one or two of several claims involved or signature to the amendment,—the Examiner, as soon as he notes the omission, should require the applicant to complete his response within a specified time limit (one month) if the period has already expired or not sufficient time is left to take action before the expiration of the period. If this is done the application should not be held abandoned even though the prescribed period has expired. See Rule 135(c). Similarly, where there is an informality as to the fee in connection with an amendment presenting additional claims in a case filed on or after October 25, 1965, the applicant is notified by the clerk on form POL 319. See 607 and 714.10.

The Examiner must exercise discretion in applying this practice to safeguard against abuses thereof.

The practice outlined above does not apply where there has been a deliberate omission of some necessary part of a complete response. For example, if an election of species has been required and applicant does not make election because he holds the requirement to be wrong, the amendment on its face is not a "bona fide attempt to advance the case to final action" (Rule 135), and the Examiner is without authority to postpone decision as to abandonment.

If there be ample time for applicant's reply to be filed within the time period, no reference is made to the time limit other than to note in the letter that the response must be completed within the statutory period dating from the last Office action.

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. (See Rule 111, 714.02.)

An amendment failing to point out the patentable novelty which the applicant believes to exist in his case may be held to be nonresponsive and a time limit set to furnish a proper response if the statutory period has expired or almost expired (714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

714.05 Examiner Should Immediately Inspect

Actions by Applicant, especially those filed near the end of the statutory period, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the response within the statutory period. See 714.03.

All amended cases when put on the Examiner's desk should be inspected by him at once to determine:

If the amendment is properly signed (714.01).

If the amendment has been filed within the statutory period, set shortened period or time limit (710).

If the amendment is fully responsive. See 714.03 and 714.04.

If the changes made by the amendment warrant transfer.

If the case is special. See 708.01.

If claims suggested to Applicant for interference purposes have been inserted.

If there is a traverse of a requirement for restriction. See 818.03(a).

If "easily erasable" paper has been used or other non-permanent method of preparation or reproduction. See 714.07.

If applicant has cited references. See 707.05(b) and 1302.12.

If a terminal disclaimer has been filed. See 508.01 and 1403.

Action Crosses Amendment

A supplemental action is usually necessary when an amendment is filed on or before the mailing date of the regular action but reaches the examining group later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for response runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)".

714.06 Amendments Sent to Wrong Group

See 508.01.

714.07 Amendments Not in Permanent Ink

Rule 52(a) requires "permanent ink" to be used on papers which will become part of the record and In re Benson, 1959 C.D. 5; 744 O.G. 353 holds that documents on so-called "easily erasable" paper violate the requirement. The fact that Rule 52(a) has not been complied with may be discovered as soon as the amendment reaches the examining group or, later, when the case is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered and is required to file a permanent copy within 1 month or to order a copy to be made by the Patent Office at his expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate response within the 1 month period, a copy is made by the

Patent Office, applicant being notified and required to remit the charges or authorize charging them to his deposit account.

In the second instance, when the non-permanence of the amendment is discovered only when the case is reached for action, similar steps are taken, but action on the case is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

Xeroprinting or good carbon copies on satisfactory paper are acceptable. But see In re Application Papers Filed Jan. 20, 1956, 706 O.G. 4. Although a good copy is acceptable, signatures must be applied after the copy is made.

See section 608.01 for more discussion on acceptable copies. [R-18]

714.08 Telegraphic Amendment

When a telegraphic amendment is received, the telegram is placed in the file but not entered. If confirmation of this amendment by a properly signed formal amendment does not follow in due time, the applicant is notified that proper confirmation is required; otherwise, the telegram will not be accepted as a response to the former Office action. If he does confirm promptly, the amendment is entered. (See Ex parte Wheary, 1913 C.D. 253; 197 O.G. 534.)

The same test as to completeness of response applies to an amendment sent by telegraph as to one sent by mail. See 714.02.

714.09 Amendments Before First Office Action

An amendment filed before the first Office action, even one filed along with the original application, does not enjoy the status of part of the original disclosure. See 608.04(b).

In the case of Rule 147 (unexecuted) applications, an amendment stating that, "This is a division of application Serial No. ---------, filed ----------," should accompany the application, but no other amendments to the specification or drawing should be requested until the application has received its serial number and filing date.

714.10 Claims Added in Excess of Filing Fee

The new Fee Act, effective October 25, 1965, provides for the presentation of claims added in excess of filing fee. On payment of an additional fee (see 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action. This provision, it should be emphasized, does not apply in the case of applications filed before October 25, 1965. In the case of applications filed before October 25, 1965 an amendment presenting claims after filing but before the application is reached for action ordinarily will not be entered (in whole or in part) if the new total of claims would exceed the number covered by the filing fee. The fact of, and reasons for, nonentry shall be included in the first action.

714.11 Amendment Filed During Interference Proceedings

See 1111.05.

714.12 Amendments After Final Rejection or Action [R-18]

Rule 116. Amendments after final action. (a) After final rejection or action (rule 113) amendments may be made canceling claims or complying with any requirements of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment under rule 135.

(b) If amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in rule 198, or to carry into effect a recommendation under rule 196.

Once a final rejection that is not premature has been entered in a case, applicant no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with Rule 116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the Examiner. See 706.07(e), 714.13 and 1207.

714.13 Amendments After Final Rejection or Action, Procedure Followed [R-18]

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in

condition for allowance or in better form for appeal. Examiners are expected to turn in their response to an amendment after final rejection within five days from the time the amendment reaches their desks. In those situations where the amendment reaches the Examiner's desk after the expiration of the shortened statutory period, the Examiner is expected to return his action to the clerical force within three days. In *all* instances in which such an amendment places an application in condition for allowance, *before preparing it for allowance*, applicant, or his representative if one is currently of record in the application, should be notified promptly of this fact by means of form letter POL–327.

Such a letter is important because it may act as a safeguard against a holding of abandonment. It may avoid an unnecessary appeal. Every effort should be made to mail the letter before the statutory period expires.

Final Rejection—Time for Response

The filing of a timely response to a final rejection having a shortened statutory period for response will extend the shortened statutory period an additional month, but in no case to exceed six months from the date of the final action. The additional month may be used to place the application in condition for allowance, to appeal or to file a continuing application. Since a timely first response to a final rejection is construed as including a request for an extension of time, any subsequent request for an extension of time is considered to be a second request and must be submitted to the Group Director.

An object of this practice is to obviate the necessity for appeal or filing a continuing case merely to gain time to consider the examiner's position in reply to an amendment timely filed after final rejection.

Failure to file a response during the shortened statutory period will result in abandonment of the application.

In any case where this one-month extension applies and an amendment is officially received during this additional month, the amendment will not be entered unless it *prima facie* places the application in condition for allowance (e.g., cancels all rejected claims, fully complies with all examiner suggestions, requirements, etc.).

Also, during this additional month no applicant- or attorney-initiated interview will be permitted.

Entry Not a Matter of Right

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see Rule 116) or reinstate previously canceled claims. Except for the provisions of items 3 and 4 of section 714.20, applicant's failure to properly respond within the statutory period results in abandonment.

See also sections 1207 and 1211.

No Appeal Filed

In the event that the amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should, at least, be given sufficient consideration to determine whether it obviously places any of the claims in condition for allowance or would simplify the issues on appeal. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons should be concisely expressed. For example,

(1) the claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal,

(2) the claims, if amended as proposed, would avoid the rejection on indefiniteness but would not avoid the rejection on the references. The amendment will be entered upon the filing of an appeal,

(3) the claims as amended present new issues requiring further consideration or search,

(4) since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal; Ex parte Wirt, 1905 C.D. 247; 117 O.G. 599.

Applicant should be notified, if it is a fact, that certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or comply with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Form letter POL–303 should be used to acknowledge receipt of the first response only from applicant after final rejection where such response is also prior to filing of a notice of appeal. Form letter POL–309 should be used to notify applicant of non-entry or disposition of: (1) a second or subsequent response after

final rejection but before appeal and (2) any response with or after appeal. These forms have been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the applicantion in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

If no appeal has been filed within the statutory period for response and no amendment has been submitted to make the case allowable or which can be entered in part (see 714.20), the case stands abandoned.

Final Action and Pre-Appeal

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview and one written response by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal interview may be initiated by the *examiner* if in his judgment this would materially assist in placing the application in condition for *allowance*.

Any amendments submitted under Rule 116 (a) and Rule 116(b) *for purposes of appeal* should be presented in the first response after final action and will be considered; if any amendments are submitted after the examiner's reply to such first response, they should be refused entry as not warranted at this stage of prosecution, even though such amendments allegedly present rejected claims in better condition for appeal. (See 1207.) Similarly, no affidavit should be considered if presented later than with the first response after final unless a showing is made under Rule 116(b). However, if an affidavit is presented with or as a first response after final and prior to a Notice of Appeal it should be entered and considered without requiring a showing under Rule 116(b).

The practice will be continued of advising applicant by means of the recently introduced form letter (POL–303) as to the disposition of proposed amendments to the claims and as to the effect of any argument or affidavit submitted in the *first* response after final action.

If a response subsequent to the first response after final action is received before appeal and which *on its face* clearly places the application in condition for allowance, it should be entered and a notice of allowability (POL–327) promptly sent to applicant; if such subsequent response does not *on its face* place the application in condition for allowance, it should not be considered further (unless, in the examiner's judgment, there are only minor matters which could be readily cleared up in a telephone interview leading to a notice of allowance) and should be refused entry. A form letter (POL–309) will be used for notification that such subsequent responses do not place the application in condition for allowance.

The first request for extension of the shortened statutory period for reply after final action, under Rule 136(b), will be considered by the Primary Examiner; petitions for further extensions will be decided by the Group Director.

It should be noted that, under Rule 181(f), the filing of a Rule 181 petition will not stay the period for reply to an Examiner's action which may be running against an application. See section 1207 for appeal and post-appeal procedure.

NEW REFERENCE

In the consideration of any proposed amendment, a new reference may be discovered which is pertinent to the claims as amended. The practice set forth in 1207 should be followed.

714.14 Amendments After Allowance of All Claims

Under the decision in Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213, after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be outstanding formal objections which preclude making the action final.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See 714.12 and 714.13.

See 607 for additional fee requirements.

714.15 Amendment Mailed Before, But Received in Examining Division After Allowance

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under Rule 312. Its entry is a matter of grace. For discussion of amendments filed under Rule 312, see 714.16 to 714.16(e).

If, however, the amendment is filed in the Office, but is not received by the Examiner prior to the mailing out of the notice of allowance, it has the same standing in the case as though the notice had not been mailed. Where the case has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the Examiner would recommend for entry under Rule 312.

As above implied, the case will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the case is a matter of grace and not of right (Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213). To this extent the practice affecting the status of an amendment received in the Office on the date of mailing the notice of allowance, as set forth in Ex parte Miller, 1922 C.D. 36; 305 O.G. 419, is modified.

714.16 Amendment After Notice of Allowance, Rule 312

Rule 312. Amendments after allowance. Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the printing of the specification has not begun, on the recommendation of the Primary Examiner, approved by the Commissioner, without withdrawing the case from issue.

The Commissioner has delegated the approval of such recommendation to the Group Managers.

A supplemental oath is not treated as an amendment under Rule 312, see 603.01.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the Primary Examiner. He can however, make Examiner's Amendments (See 1302.04) and has authority to enter amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the Group Manager for approval. (Basis: Order 3311.)

Amendments other than these require approval by the Group Manager. He also establishes Group policy with respect to the treatment of Order 3311 amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent; namely, (1) that its disclosure be adequately clear, and (2) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under Rule 312 cannot be demanded as a matter of right. Prosecution of a case should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (1) to be needed for proper disclosure or protection of the invention, and (2) to require no

270-341 O - 67 - 4

substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the Primary Examiner.

The requirements of Rule 111(c) (714.02) with respect to pointing out the patentable novelty of any claim sought to be added or amended, apply in the case of an amendment under Rule 312, as in ordinary amendments. See 713.04 and 713.10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show: (1) why the amendment is needed; (2) why the proposed amended or new claims require no additional search or examination; (3) why the claims are patentable and, (4) why they were not earlier presented.

NOT TO BE USED FOR CONTINUED PROSECUTION

Rule 312 was never intended to provide a way for the continued prosecution of application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient: (1) an additional search is required, or (2) more than a cursory review of the record is necessary, or (3) the amendment would involve materially added work on the part of the Office, e.g. checking excessive editorial changes in the specification or claims.

Where claims added by amendment under Rule 312 are all of the form of dependent claims, some of the usual reasons for non-entry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See 607 and 714.16(c) for additional fee requirements.

714.16(a) Amendments Under Rule 312, Copied Patent Claims

See 1101.02(g) for the procedure to be followed when an amendment is received after notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See 714.19 item (4).

See 607 and 714.16(c) for additional fee requirements.

714.16(b) Amendment Under Rule 312 Filed With a Motion Under Rule 231

Where an amendment filed with a motion under Rule 231(a)(3) applies to a case in issue, the amendment is not entered unless and until the motion has been granted. See 1105.03.

714.16(c) Amendment Under Rule 312, Additional Claims

If the application was filed on or after October 25, 1965, and the amendment under Rule 312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the Examiner unless accompained by the full fee required. See 607 and 35 U.S.C. 41.

714.16(d) Amendments Under Rule 312, Handling

AMENDMENTS NOT UNDER ORDER 3311

Amendments under Rule 312 are sent by the Mail and Correspondence Branch to the Issue and Gazette Branch which, in turn, forwards the proposed amendment, file, and drawing (if any) to the group which allowed the application. In the event that the class and subclass in which the application is classified has been transferred to another group after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other group and the Issue and Gazette Branch notified. If the Assistant Examiner who allowed the application is still employed in the Patent Office but not in said other Group, he may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration.

The amendment is PROMPTLY considered by the Examiner who indicates thereon whether or not its entry is recommended. It should be kept in mind that the words "recommended" or "not recommended" are used instead of "entered" or "not entered".

If the amendment is favorably considered, it is entered and a notice of entry (POL–271) is prepared. An "Entry Recommended under Rule 312" stamp is then applied to the amendment and to the notice of entry (under the printed word "Report"). The Primary Examiner indicates his approval by signing under the recommendation on the amendment and by stamping and signing his name under the recommendation on the notice of entry.

If the Examiner's recommendation is completely adverse, a report giving the reasons for non-entry is typed on the notice of disapproval (POL–271) and signed by the Primary Examiner.

The file, drawing, and unmailed notices are forwarded to the Group Manager for consideration, approval, and mailing.

For entry-in-part, see 714.16(e).

The filling out of the appropriate form by the clerk does not signify that the amendment has been admitted; for, though actually entered it is not officially admitted unless and until approved.

See 607 and 714.16(c) for additional fee requirements.

AMENDMENTS UNDER ORDER 3311

Amendments concerning merely formal matters do not require submission to the Group Manager prior to entry. See 714.16. The notice of entry (POL–271) is date stamped and mailed by the examining group. If such amendments are disapproved either in whole or in part, they are handled like those not under Order 3311.

714.16(e) Amendments Under Rule 312, Entry in Part

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under Rule 312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the case. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment.

The Examiner should then submit a report (POL–271) recommending the entry of the acceptable portion of the amendment and the non-entry of the remaining portion together with his reasons therefore. The claims entered should be indicated by number in this report.

Handling is similar to complete entry of a Rule 312 amendment.

If the application was filed on or after October 25, 1965, entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See 607, 714.16(c).

714.17 Amendment Filed After the Period for Response Has Expired

When an application is not prosecuted within the period set for response and thereafter an amendment is filed, such amendment shall be endorsed on the file wrapper of the application, but not formally entered and the Examiner shall immediately notify the applicant that the amendment was not filed within the time period and therefore cannot be entered. The applicant should also be notified that the application is abandoned.

714.18 Entry of Amendments

Amendments are stamped with the date of their receipt in the group. It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the group ("Group Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his amendment.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action." It is placed on the Examiner's desk, and he is responsible for its proper disposal. The Examiner should immediately inspect the amendment as set forth in 714.05. After inspection if no immediate or special action is required, the application awaits re-examination in regular order.

Amendments or other papers filed in cases before the Law Examiner should be promptly forwarded to him.

714.19 List of Amendments, Entry Denied

The following types of amendments are ordinarily denied entry:

1. An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in a case whose prosecution before the Primary Examiner has been closed, as where

(a) All claims have been allowed,

(b) All claims have been finally rejected (for exceptions see 714.12, 714.13, and 714.20(4)),

(c) Some claims allowed and remainder finally rejected. See 714.12 to 714.14.

2. Substitute specification that has not been required and is not needed. See Rule 125, 608.01(q) and 714.20. If the Examiner approves, it may be entered.

3. A patent claim suggested by the Examiner and not presented within the time limit set or a reasonable extension thereof, unless entry is authorized by the Commissioner. See 1101.02(f).

4. While copied patent claims are generally admitted even though the case is under final rejection or on appeal, under certain conditions, the claims may be refused entry. See 1101.02(g).

5. An unsigned or improperly signed amendment or one signed by a disbarred attorney or any person having no authority.

6. An amendment filed in the Patent Office after the expiration of the statutory period or set time limit for response. See 714.17.

7. An amendment so worded that it cannot be entered with certain accuracy. See 714.23.

8. An amendment cancelling all of the claims and presenting no substitute claim or claims. (711.01.)

9. An amendment in a case no longer within the Examiner's jurisdiction with certain exceptions in applications in issue (714.16), except on approval of the Commissioner.

10. Amendments to the drawing held by the Examiner to contain new matter are not entered until the question of new matter is settled. This practice of non-entry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims.

11. An amendatory paper containing objectionable remarks that, in the opinion of the Examiner, brings it within the condemnation of Rule 3, will be submitted to the Commissioner with a view toward its being returned to applicant. See 714.25.

12. Amendments not in permanent ink. Amendments on so-called "easily erasable paper." See In re Benson, 1959 C.D. 5; 744 O.G. 353.

13. In an application filed before October 25, 1965, an amendment filed before the first action increasing the number of claims when the total of claims would be in excess of those supported by the filing fee. See 714.10.

14. In an application filed on or after October 25, 1965, an amendment presenting claims (total and independent) in excess of the number previously paid for, and

(a) not accompanied by *any portion* of the fee required, or

(b) prior to the first Office action or not in response to an Office action, and not accompained by the *full* fee required, or

(c) the authorization for a charge against a Deposit Account is not in the form of a separate paper (2 copies).

While amendments falling within any of the foregoing categories should not be entered by the Examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

714.20 List of Amendments Entered in Part

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the statutory period. Thus,

(1) An "amendment" presenting an uncalled-for and unnecessary substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry *in toto*. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The case as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been required and is not necessary and therefore has not been entered, and that any desired changes in the original specification must be made by specific amendments. See also Rule 125, 608.01(q).

It may be noted in this connection, however, that the fact that a substitute specification, in the opinion of the Examiner, contains new matter is not in itself a proper reason for refusing entry thereof.

(2) An amendment under Rule 312, which in part is approved and in other part disapproved, is entered only as to the approved part. See 714.16(c).

(3) In a case having some claims allowed and others finally rejected, where an amendment is received at or near the close of the statutory period cancelling the finally rejected claims and presenting one or more new ones which the Examiner cannot allow, the amendment, after the statutory period has ended, is entered to the extent only of cancelling the finally rejected claims. Of course, if any of the new claims were, in the Examiner's opin-

ion, patentable, they too would be entered. The applicant is notified that the new claims which are held unpatentable have not been admitted, and at the same time the case is passed for issue. This proceedure applies only where there has been no appeal.

(4) Where all of the claims are under final rejection and the amendment cancels these claims and presents new ones, only some of which are deemed allowable by the Examiner, the same practice is followed as indicated in (3), assuming no appeal has been taken.

(5) In a case having all claims allowed and some formal defect noted, where an amendment is presented at or near the close of the statutory period curing the defect and adding one or more claims some or all of which are in the opinion of the Examiner not patentable, or will require a further search, the procedure indicated in (3) is followed. After the statutory period has ended, the amendment in such a case will be entered only as to the formal matter and to any of the newly presented claims that may be deemed patentable.

(6) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted. See 1108.

NOTE: The Examiner writes "Enter" in ink and his initials in the left margin opposite the enterable portions. [R-16]

714.21 Amendments Inadvertently Entered, No Legal Effect [R-16]

If the clerk inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as "Not Officially Entered".

If it is to be retained in the file an amendatory paper, even though not entered, should be given a paper number and listed on the file wrapper with the notation "Not Entered". See Rule 3, 714.25, for an instance of a paper which may be returned.

714.22 Entry of Amendments, Directions for [R-16]

Rule 121. Manner of making amendments. (a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to Rule 52), directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in Rule 121(a) to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) may be considered non-responsive and treated accordingly.

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) above shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended as specified in paragraph (a) above.

The term "brackets" set forth in Rule 121 means angular brackets, thus: [ ]. It does not encompass and is to be distinguished from parentheses ( ). Any amendment using parentheses to indicate cancelled matter in a claim rewritten under Rule 121(b) may be held nonresponsive in accordance with Rule 121(c).

714.23 Entry of Amendments, Directions for, Defective

The directions for the entry of an amendment may be defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line. If it is clear from the context what is the correct place of entry, the amendatory paper will be properly amended in the examining group, and notation thereof, initialed in ink by the Examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action the applicant should be informed of this alteration in his amendatory paper and the entry of

the amendment as thus amended. He will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

714.24 Amendment of Amendment

Rule 124. Amendment of amendments. When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion cancelled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter cancelled by amendment can be reinstated only by a subsequent amendment presenting the cancelled matter as a new insertion.

However, where a relatively small amendment to a previous amendment can be made easily without causing the amendatory matter to be obscure or difficult to follow, such small amendment should be entered.

714.25 Discourtesy of Applicant or Attorney

Rule 3. Business to be conducted with decorum and courtesy. Applicants and their attorneys or agents are required to conduct their business with the Patent Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other employees must be made in communications separate from other papers.

If the attorney is discourteous in the remarks or arguments in his amendment, either the discourtesy should be entirely ignored or the paper submitted to the Supervisory Examiner with a view toward its being returned.

715 Swearing Back of Reference-Affidavit Under Rule 131 [R-16]

Rule 131. Affidavit of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained.

Any printed publication dated prior to an applicant's effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application.

Such a rejection may be overcome, in certain instances noted below, by applicant's filing of an affidavit under Rule 131, known as "swearing back" of the reference.

Affidavits under Rule 131 may be used:

(1) Where the date of the foreign patent or that of the publication is less than one year prior to applicant's effective filing date.

(2) Where the reference, a U.S. Patent, with a patent date less than one year prior to applicant's effective filing date, shows but does not claim the invention.

Affidavit under Rule 131 is not appropriate in the following situations:

(1) Where reference publication date is more than one year back of applicant's effective filing date. Such a reference is a "statutory bar".

(2) Where the reference U.S. patent claims the invention. See 1101.02(a).

(3) Where reference is a foreign patent for the same invention to applicant or his legal representatives or assigns issued prior to the filing date of the domestic application on an application filed more than twelve months prior to the filing date of the domestic application.

(4) Where the effective filing date of applicant's parent application or an International Convention proved filing date is prior to the effective date of the reference, affidavit under Rule 131 is unnecessary and the reference is not used. See 201.11 to 201.15.

(5) Where the reference is a prior U.S. patent to the same entity, claiming the same invention, the question involved is one of "double patenting."

(6) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending, the question is one of dedication to the public.

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit is the date of the amendment. In re Willien et al., 1935 C.D. 229; 454 O.G. 535.

It should be kept in mind that it is the *rejection* that is withdrawn and not the reference.

715.01 Reference Claims Foreign Filing Date

The effective date of a United States Patent for use as a prior art reference is not affected by the foreign filing date to which the patentee may be entitled under 35 U.S.C. 119. In re Hilmer, 833 O.G. 13, 149 USPQ 480 (CCPA 1966); Lily et al. v. Brenner, 153 USPQ 95 (C.A.D.C. 1967). The reference patent is effective as of the date the application for it was filed in the United States (35 U.S.C. 102(e) and 103). Hazeltine Research, Inc. et al. v. Brenner, 824 O.G. 8 (U.S. Supreme Court 1965).

715.01(a) Reference a Joint Patent to Applicant and Another

When subject matter disclosed but not claimed in a patent issued jointly to S and another is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit under Rule 131. In re Strain, 1951 C.D. 252; 648 O.G. 5. Disclaimer by the other patentee should not be required. But see 201.06.

715.01(b) Reference and Application Have Common Assignee

The mere fact that the reference patent which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit under Rule 131. The common assignee does not obtain any rights in this regard by virtue of common ownership which he would not have in the absence of common ownership. In re Beck et al., 1946 C.D. 398; 590 O.G. 357; Pierce v. Watson, 124 U.S.P.Q. 356.

715.01(c) Reference Is Publication of Applicant's Own Invention

Unless it is a statutory bar, a rejection on a publication may be overcome by a showing that it was published either by applicant himself or in his behalf Ex parte Lemieux, 1957 C.D. 47; 725 O.G. 4; Ex parte Powell et al., 1938 C.D. 15: 489 O.G. 231.

Co-authorship

Where the applicant is one of the co-authors of a publication, cited against his application, he is not required to file an affidavit under Rule 131. The publication may be removed as a reference by filing a disclaiming affidavit of the other authors. Ex parte Hirschler, 110 U.S.P.Q. 384.

715.02 General Rule as to Generic Claims

A reference applied against generic claims may (in most cases) be antedated as to such claims by an affidavit under Rule 131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference (assuming, of course, that the reference is not a statutory bar or a patent claiming the same invention). See, however, 715.03.

715.03 Practice Relative to Chemical Cases

In chemical cases, where generic claims have been rejected on a reference which discloses a species not antedated by the affidavit, the rejection will not ordinarily be withdrawn unless the applicant is able to establish that he was in possession of the generic invention prior to the effective date of the reference. In other words, the affidavit under Rule 131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

"The principle is well established in chemical cases, and in cases involving compositions of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claim." In re Steenbock, 1936 C.D. 594; 473 O.G. 495.

Where the only pertinent disclosure in the reference is a single species, which species is antedated by the affidavit, the reference is overcome. In re Stempel 1957 C.D. 200; 717 O.G. 886.

Markush Type Genus Claim

Where a claim reciting a Markush group is rejected on a reference disclosing but not claiming a specific member of the group, the reference cannot be avoided by an affidavit under Rule 131 showing different members of the group.

715.04 Who May Make Affidavit

A. The Inventor.

B. One of two joint inventors is accepted where suitable excuse is given for failure of the other applicant to sign. In re Carlson et al. 1936 C.D. 95; 462 O.G. 479.

C. The Assignee or other party in interest when it is not possible to produce the affidavit of the inventor. Ex parte Foster, 1903 C.D. 213; 105 O.G. 261.

715.05 Patent Claiming Same Invention

When the reference in question is a patent claiming the same invention as applicant and its issue date is less than one year prior to the filing date of the application being examined, applicant's remedy, if any, must be by way of Rule 204 instead of Rule 131. The Examiner should therefore take note whether the status of the patent as a reference is that of a PATENT or a PUBLICATION. If the patent is claiming the same invention as the application, this fact should be noted in the Office letter. The reference patent can then be overcome only by way of interference. Note, however, 35 U.S.C. 135, 1101.02(f).

715.06 Affidavit Under Rule 131 Must Be Removed Before Interference

Where an application in which an affidavit under Rule 131 has been filed is to be involved in an interference, the affidavit must be sealed

276-248 O - 87 - 8

in an envelope properly labeled before forwarding the application to the interference division.

The same practice obtains with respect to a Rule 131 affidavit in the file of an application made the subject of a motion under Rule 234 or 235.

Under the practice established in Ferris v. Tuttle, 1940 C.D. 5; 521 O.G. 523, the Rule 131 affidavit is thrown open to the opposing party or parties to the interference at the time the preliminary statements are opened. See 1101.03 and 1102.01.

715.07 Facts and Documentary Evidence

The essential thing to be shown under Rule 131 is priority of invention and this may be done by any satisfactory evidence of the fact. *FACTS*, not conclusions, must be shown by the evidence accompanying an affidavit under Rule 131. For example:

1. As shown in attached sketches.
2. As shown in attached blueprints.
3. As indicated by accompanying model.
4. As shown in attached photographs.
5. As shown in reproductions of notebook entries.
6. If verbal disclosures were made instead of the above, supporting statements by the witness will be acceptable.
7. If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath.

The dates in the oath may be the actual dates or, if the applicant does not desire to disclose his actual dates, he may merely allege that the acts referred to occurred prior to a specified date.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23; 23 O.G. 1224.

"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others." *Ex parte* Donovan, 1890 C.D. 109; 52 O.G. 309.

The affidavit must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention IN THIS COUNTRY, the conception at least being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant must show diligence in the completion of his invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing of his application, which constitutes a *constructive* reduction to practice. Rule 131. In this connection, note the following:

A conception of an invention, evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited, 1909 C.D. 498; 139 O.G. 991.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724; 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The facts to be established under Rule 131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his remedy is by appeal from the continued rejection.

715.07(a) Diligence

Where conception occurs prior to the date of the reference, but reduction to practice is afterward it is not enough merely to allege that applicant had been diligent. Ex parte Hunter, 1889 C.D. 218; 49 O.G. 733.

What is meant by diligence is brought out in Christie v. Seybold, 1893 C.D. 515; 64 O.G. 1650. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if his lack of activity is excused.

Note, however, that only diligence *before* reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" (Ex parte Merz, 75 U.S.P.Q. 296) is not relevant to a Rule 131 affidavit.

715.07(b) Interference Testimony Sometimes Used

In place of an affidavit the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of a Rule 131 affidavit.

The part of the testimony to form the basis of priority over the reference should be pointed out. Ex parte Bowyer, 1939 C.D. 5; 505 O.G. 759.

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country

The affidavit must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out *in this country*. See 35 U.S.C. 104.

715.07(d) Disposition of Exhibits Submitted as Evidence to Support Facts

Exhibits, such as those filed as part of an affidavit under Rule 131, that are too bulky to be placed in the application file are retained in the Examining Group until the case is finally disposed of. When the case goes to issue (or abandonment) the exhibits are sent to the Model and Receiving Room, notation to this effect being made on the margin of the affidavit. See 608.03(a).

715.08 Passed Upon by Primary Examiner [R–19]

The question of sufficiency of affidavits under Rule 131 should be reviewed and decided by a Primary Examiner.

715.09 Seasonable Presentation [R–19]

Affidavits under Rule 131 must be seasonably presented. Ex parte Berg, 1906 C.D. 36; 120 O.G. 903; Ex parte Romunder, 1910 C.D. 121; 157 O.G. 209; Ex parte Hale, 49 U.S.P.Q. 209; Ex parte Bowyer, 1939 C.D. 5; 505 O.G. 759.

For affidavits under Rule 131 filed after appeal see Rule 195 and section 1212.

716 Affidavits Traversing Rejections, Rule 132 [R–19]

Rule 132. Affidavits traversing grounds of rejection. When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits traversing these references or objections may be received.

NOTE THAT RULE 132 IS NOT APPLICABLE TO A REJECTION BASED ON A U.S. PATENT WHICH CLAIMS THE REJECTED INVENTION.

It is the responsibility of the Primary Examiner to personally review and decide whether affidavits submitted under Rule 132 for the purpose of traversing grounds of rejection, are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavits evidence traversing rejections or objections, Ex parte Gresselin, 1896 C.D. 39; 76 O.G. 1573. The enumeration of rejections in the rule is merely exemplary. All affidavits presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

Certain legal principles and standards have been established respecting affidavit evidence. Some are applicable to all affidavits, while others are applicable only to particular types of affidavits, as indicated below. The critical factors and standards are summarized as an aid or guide to the examiners in evaluating such affidavits. Affidavits timely filed (i.e. before final action or appeal) should be acknowledged and commented upon in the action following filing. See Sec. 707.02. If an affidavit is filed later and entered (See Rule 195) similar action should be taken.

The following criteria are applicable to all affidavits submitted under this rule:

(1) Affidavits must be timely or seasonably filed (i.e. before final rejection or appeal) to be entitled to consideration. In re Rothermel et al., 1960 C.D. 204; 755 O.G. 621. Affidavits not timely filed must meet the requirements of Rule 195.

(2) Affidavits must set forth facts, not merely conclusions. In re Pike et al., 1950 C.D. 105;

633 O.G. 680. The facts presented in the affidavits must be pertinent to the rejection. In re Renstrom 1949 C.D. 306; 624 O.G. 5. Otherwise, the affidavits have no probative value.

(3) Affidavits should be scrutinized closely and the facts presented weighed with care. The affiant's interest is a factor which may be considered, but the affidavit cannot be disregarded solely for that reason. In re McKenna et al., 1953 C.D. 251; 674 O.G. 9; Bullard & Co. v. Coe 1945 C.D. 13; 573 O.G. 547.

Rule 132 affidavits may be classified in five groups, and such affidavits must conform, in addition, to the established criteria and standards for the group into which they fall. These groups and the applicable standards are:

Comparative Tests or Results

Affidavits comparing applicant's results with those of the prior art must relate to the reference relied upon and not other prior art—Blanchard v. Ooms 1946 C.D. 22; 585 O.G. 175 —, and the comparison must be with disclosure identical (not similar) with that of the reference. In re Tatincloux 1956 C.D. 102; 702 O.G. 964. Otherwise, the affidavits have no probative value.

Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained—in re Finley, 1949 C.D. 284; 624 O.G .262—and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong 1960 C.D. 422; 759 O.G. 4. Otherwise, the affidavits may be entitled to little weight.

Where the comparison shows unexpected results or advantages, it should be compared with the application disclosure, since recitals of the specification are controlling. Abbott v. Coe, 1940 C.D. 13; 512 O.G. 3. In re Rossi 1957 C.D. 130; 717 O.G. 214. Advantages not disclosed carry little or no weight in establishing patentability.

Affidavits setting forth advantages and asserting that despite familiarity with the art, the claimed subject matter was not obvious to affiants, do not afford evidence of non-obviousness, where the advantages relied upon are merely those which would result from following the teaching of the prior art. In re Henrich 1959 C.D. 353; 747 O.G. 793.

Operability of Applicant's Disclosure

Since it is the Examiner's duty to pass upon the operativeness of any invention which he is called upon to examine he is free to express his opinion on that question so long as he gives reasons for his holding with clarity and completeness. Therefore, he need not support every rejection on inoperativeness with references or affidavits. In re Quattlebaum 84 U.S.P.Q. 383.

Affidavits attempting to show that the structure deemed inoperative was seen in operation by persons who vouch for its operability, are insufficient. In re Perrigo, 1931 C.D. 512, 411 O.G. 544.

Where the invention involved is of such a nature that it cannot be tested by known scientific principles, theoretical arguments in affidavit form are unacceptable, and the only satisfactory manner of overcoming the rejection is to demonstrate the operability by construction and operation of the invention. Buck v. Ooms 1947 C.D. 33; 602 O.G. 177. In re Chilowsky 1956 C.D. 155; 704 O.G. 213.

Inoperability of References

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability—Metropolitan Eng. Co. v. Coe 1935 C.D. 54; 455 O.G. 3—Examiners should not express any opinion on the operability of a patent. Therefore affidavits attacking the operability of a patent cited as a reference, though entitled to consideration, should be treated, not as conclusive of the factual matter presented, but rather as an expression of opinion by an expert in the art. In re Berry, 137 U.S.P.Q. 353. See also In re Lurelle Guild 1953 C.D. 310; 677 O.G. 5. Opinion affidavits need not be given any weight. In re Pierce 1930 C.D. 34; 390 O.G. 265; In re Reid 1950 C.D. 194; 635 O.G. 694.

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. Bullard v. Coe 1945 C.D. 13; 573 O.G. 547; In re Michalek 1947 C.D. 458; 604 O.G. 223; In re Reid 1950 C.D. 194; 635 O.G. 694.

Where the affidavit presented asserts inoperability in some features of the patent as to which it was not relied upon, the matter is of no concern. In re Wagner, 1939 C.D. 581; 497 O.G. 1041.

Where the affidavit asserts inoperability of the process disclosed in the reference for pro-

ducing the claimed product, which product is fully disclosed in the reference, the matter is of no concern. In re Attwood 1958 C.D. 204; 730 O.G. 790.

Where the affidavit presented asserts that the reference relied upon is inoperative, it is elementary that the claims presented by applicant must distinguish from the alleged inoperative reference disclosure; therefore the matter is of no concern. In re Crecelius 1937 C.D. 112; 474 O.G. 465. In re Perrine 1940 C.D. 465; 519 O.G. 520. In re Crosby 1947 C.D. 35; 595 O.G. 5.

Affidavit by patentee that he did not intend his device to be used as claimed by applicant is immaterial. In re Pio 1955 C.D. 59; 691 O.G. 454.

COMMERCIAL SUCCESS

Affidavits submitting evidence of commercial success can have no bearing in a case where the patentability over the prior art is not in doubt. In re Jewett et al 1957 C.D. 420; 724 O.G. 225. In re Troutman, 1960 C.D. 308; 757 O.G. 556.

Affidavits showing commercial success of a structure not related to the claimed subject matter has neither significance nor pertinence. In re Kulieke 1960 C.D. 281; 756 O.G. 288.

Affidavits which attribute commercial success to the invention "described and claimed" or other equivalent indefinite language have little or no evidenciary value. In re Troutman 1960 C.D. 308; 757 O.G. 556.

Where affidavits show commercial success it must appear that such success resulted from the invention as claimed. In re Hollingsworth 1958 C.D. 210; 730 O.G. 282. Otherwise the affidavit showing is non-pertinent.

SUFFICIENCY OF DISCLOSURE

Affidavits presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. In re Smyth 1951 C.D. 449; 651 O.G. 5.

Affidavits purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. In re Oppenauer 1944 C.D. 587; 568 O.G. 393.

717 File Wrapper

717.01 Papers in File Wrapper [R-19]

Full details for processing file wrapper papers are given in the Manual of Clerical Procedures.

Papers that do not become a permanent part of the record should not be entered on the "Contents" of the file wrapper (jacket). No paper legally entered on the "Contents" should ever be withdrawn or returned to applicant without special authority of the Commissioner. Certain oaths executed abroad are returned but a copy is retained in the file. See 604.04(a).

717.01(a) Arrangement of Papers in File Wrapper [R-19]

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order; that is, the communication with the latest "Mail Room" date is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the print is always kept on top for the convenience of the Examiner.

Where amendments are submitted in duplicate, the carbon copy is destroyed except where the duplicate is received within the time period for response and the original is late. In this latter situation both copies are placed in the file. The "original" (ribbon copy) is entered with reference made to the carbon copy.

If a receipt of any paper filed in the Patent Office is desired, it may be obtained by enclosing with the paper a self-addressed post card identifying the paper. The Patent Office will stamp the receipt date on the card and place it in the outgoing mail.

The identifying data on the card should be so complete as to match the paper with the application or other document to which it is to be associated. For example, the document should be identified by the applicant's name(s), Serial No., filing date, appeal number, interference number, etc., and the paper should be identified by specifying the type thereof, namely, affidavit, amendment, appeal, application papers, brief, drawings, fees, motions, supplemental oath or declaration, petition, etc.

When papers for more than one document are filed under a single cover a return addressed post card should be attached to the paper for *each* document for which a receipt is desired.

717.01(b) Prints [R-19]

The prints of the drawing are fastened inside the file wrapper by the Application Branch, and shall always be kept on top. A

paper number is assigned by the Clerk of the Group.

The prints shall always be kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the date of their receipt in the office and given their appropriate paper number.

717.02 Data Entered on File Wrapper [R-19]

See also sections 707.10, 717.01.

If the Examiner notices an error in any of the data originally entered on the file wrapper, he should have it corrected by the Application Branch.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Branch.

All of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the clerk of the group, the original entry being canceled but not erased.

717.02(a) Statutory Period Ends on Saturday, Sunday or Holiday

See 710.05.

717.02(b) Name or Residence of Inventor or Title Changed

The distinction between "residence" and Post Office address should not be lost sight of.

Sec. 605.04(c) explains the procedure to be followed concerning sending the application to the Assignment Branch and the Application Branch when Applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

717.03 Classification During Examination

When a new case is received in an Examining Group, the classification of the case and the initials or name of the Examiner who will examine it or other assigned docket designation are noted in pencil in the upper lefthand corner of the drawing (first sheet) and in the designated spaces on the file wrapper. These notations should be kept current. When the application is sent to issue, the notations then appearing on the drawing should not be erased. They may be useful in classifying an incoming continuing application to which drawings may have been transferred and in assigning it to an Examiner already familiar with the subject matter.

717.04 Index of Claims [R–18]

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date so as to be a reliable index of all claims standing in a case, and of the amendment in which the claims are to be found.

The preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented. Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under Rule 121(b), the original claim number should not be stricken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e. "Amend. 1"; if the claim is rewritten a second time, "Amend. 1" should be changed by striking out "1" and inserting "2" above it.

As any claim is canceled a line in red ink should be drawn through its number.

717.05 Field of Search [R–18]

In each action involving a search, the Examiner shall endorse, on the flap of the file wrapper, the classes and subclasses and publications searched, the date when the search was made or was brought up to date and the Examiner's initials, all entries being in BLACK INK. Great care should be taken, inasmuch as this record is important to the history of the application.

717.06 Foreign Filing Dates [R–18]

See 201.14(c) and 202.03.

717.07 Related Applications [R–18]

The file wrapper should identify earlier filed related applications. See 202.02 and 202.03.