

MANUAL OF
**PATENT
EXAMINING
PROCEDURE**

ORIGINAL EDITION



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MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions regarding Revision No. 28

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

Change Notice 17-2, relating to the Trial Multiple Dependent Claim Practice, should be retained until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969, 864 O.G. 323. All other Change Notices have been incorporated into the Manual.

The notation "A-28" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel
 Editor, Manual of Patent
 Examining Procedure

Particular attention is called to the following sections:

- 101 Incorporates memorandum to Patent Office Personnel dated December 10, 1970, relating to confidentiality and accessibility of patent application papers.
- 502 Incorporates notice of March 5, 1971, relating to identification of application correspondence (855 O.G. 2).
- 503 Incorporates notice of March 10, 1971 relating to early notification of serial number (884 O.G. 970).

(Over)

- 901.06 Revised form 2010 "Science Abstracts" handling.
- 1112.05 Revised form FO-880.
- Chapter 1200 Revised in view of amended Rule 192 and new clerical procedures.
- 1208 Times for furnishing examiners' answers.
- 1208.01

List of replacement pages, all bearing Rev. No. 28:

3-4	201-202
4.1-4.2	209-210
5-6	211-212
31-32	213-214
32.1-32.2	214.1-blank
43-44	215-216
44.1-blank	216.1-blank
73-74	217-218
74.1-blank	218.1-blank
79-80	219-220
139-140	220.1-220.2
140.1-140.2	220.3-220.4
167-168	220.5-220.6
177-178	220.7-blank
179-180	253-254
	255-blank

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The notation "R-27" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

- | | |
|------------------|---|
| 606.01 | Revised to indicate practice of marking box on Notice of Allowance form for a title change. |
| 903.07 | Revised to include instructions on designating unofficial subclasses on issue slips. |
| 1001.01,
1002 | Revised to correspond with current rule language. |
| Index | Completely revised. |

(Over)

List of replacement pages for Revision 27:

<u>Page</u>	<u>Rev. No.</u>	<u>Page</u>	<u>Rev. No.</u>
Title Page	27-27	263-264	27-27
III-blank	27	265-266	27-27
21-22	27-27	267-268	27-27
27-28	27-27	269-270	27-27
41-42	27-27	271-272	27-27
69-70	27-27	273-274	27-27
70.1-blank	27	275-276	27-27
83-84	27-27	277-278	27-27
151-152	27-27	279-280	27-27
*152.1-blank	27	281-282	27-27
157-blank	27	283-284	27-27
159-160	27-27	285-286	27-27
161-blank	27	287-288	27-27
165-166	23-27	289-290	27-27
257-258	27-27	291-292	27-27
259-260	27-27	293-blank	27
261-262	27-27		

* Added page

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.

Change Notice

Reference: MPEP 608.01(n)

SERIES NO. 17-2
(Follows Change 17-1)

June 4, 1968

TRIAL MULTIPLE DEPENDENT CLAIM PRACTICE

For the trial period running from July 1, 1968 through December 31, 1968, all applications and amendments to applications filed in the Patent Office will be permitted to include multiple dependent claims which refer back to any of the preceding claims in the alternative whether independent or dependent. In this manner a claim may have a single number but would effectively be considered and treated as a plurality of claims. Entry into this program will require (1) the filing of a written request in which the applicant agrees to abide by the conditions of the program, and (2) the filing of appropriate fees and a showing of the fee calculation. Although the trial period terminates December 31, 1968, the prosecution of all applications placed in this program will continue under the program guidelines.

A claim dependent upon any of a plurality of preceding claims will be considered in acceptable form and entered provided it is otherwise acceptable and does not (1) cross statutory classes with any of its parent claims, or (2) depend from any other multiple dependent claim, or (3) refer back to preceding claims in the conjunctive rather than the disjunctive form (e.g., "The tool as defined in any one of claims 1, 2, and 4 . . ." is acceptable, but "The tool as defined in claims 1 and 2 . . ." is not acceptable. Likewise, "The tool as defined in claims 1, 2, or 4 . . ." is acceptable, whereas "The tool as defined in claims 1, 2 and/or 4 . . ." is not acceptable). Should any dependent claim include a claim association that violates any of the above prohibitions the claim will be rejected as indefinite for failure to comply with 35 U.S.C. 112 and will not be further treated with regard to any other claim association. Also, multiple dependent claims will not be considered for entry after final rejection. Further, during this trial period, for the applications involved in this program the total numbered claims may not exceed ten. Non-compliance with this condition will result in applicant being given one month to reduce the total numbered claims to ten. In newly filed cases, the failure to comply within the one month period will result in loss of filing date. In all other cases the entire amendment will not be entered in the absence of compliance with this requirement.

It is suggested that the claims be arranged in order of narrowing scope whereby the first claim presented is the broadest. Claims dependent upon the broad claim should come next, followed by claims which are dependent upon any of the plurality of preceding claims.

Practice and Rejections

When acting on a multiple dependent claim, the examiner will consider the patentability of the various claim associations encompassed by said claim and apply any pertinent prior art in the usual manner. Each of these associations should be compared with the prior art, exactly as if it were presented as an independent claim. If a claim having multiple dependency should include both patentable and unpatentable claim associations, the Examiner will identify each of the patentable claim associations and identify and specifically reject each of the unpatentable claim associations. However, mere failure to reject a claim association does not give rise to a presumption of allowability.

For fee purposes every claim which refers to any of the preceding claims will be considered effectively as a dependent claim for each association of claims that it represents, thereby effectively increasing the number of claims in the case. Therefore, in these cases the additional fees required for claims in excess of ten will be two dollars (\$2.00) times the total effective number of claims in excess of ten. This fee is based on the fact that such a claim is, in substance and so far as the work of examination is concerned, equivalent to a number of dependent claims each based on a single preceding claim.

(over)

In applications not under this program but having multiple dependent claims, it will be assumed that applicant intends these claims as effectively only a single claim. Accordingly, such claims will be considered alternative and therefore indefinite under 35 U.S.C. 112.

Rule 75(c) is hereby suspended for the duration of the trial period in those cases presenting multiple dependent claims under this program insofar as conflict exists between the requisites of the rule and the proposed practice.

Richard A. Wahl
Assistant Commissioner

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MANUAL OF
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The Patent Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

Correspondence relating to any of the above items should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents
Mail List Section
P.O. Box 1533
Washington, D.C. 20013

Orders for individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

Commissioner of Patents
Washington, D.C. 20231
Attn: Document Services Branch

The cost per page will be 30¢ (see rules 13(a), 21(b), and 21(t) Rules of Practice).

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Employees of the Patent Office should direct their order for the Manual, replacement pages, notices, and revisions to the Scientific Library.

First Edition, November 1949
Revision 1, November 1950
Revision 2, December 1951
Revision 3, May 1952
Second Edition, November 1953
Revision 1, April 1955
Revision 2, June 1956
Revision 3, June 1957
Revision 4, July 1958
Third Edition, November 1961
Revision 1, January 1964
Revision 2, November 1964
Revision 3, January 1965
Revision 4, April 1965
Revision 5, July 1965
Revision 6, October 1965
Revision 7, January 1966
Revision 8, April 1966
Revision 9, July 1966
Revision 10, October 1966
Revision 11, January 1967
Revision 12, April 1967
Revision 13, July 1967
Revision 14, October 1967
Revision 15, January 1968
Revision 16, April 1968
Revision 17, July 1968
Revision 18, October 1968
Revision 19, January 1969
Revision 20, April 1969
Revision 21, July 1969
Revision 22, October 1969
Revision 23, January 1970
Revision 24, April 1970
Revision 25, July 1970
Revision 26, October 1970
Revision 27, January 1971
Revision 28, April 1971

Foreword

This Manual is published to provide Patent Office examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of applications before the Patent Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of application.

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

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

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

Commissioner of Patents,
Washington, D.C. 20231

WILLIAM E. SCHUYLER, JR.,
Commissioner.

Contents

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

**Checklist of Pages Needed To Form a Complete Set of the Third Edition as of
Revision 26.**

DATES OF REVISIONS 16-26

All pages issued in earlier revisions have been revised.

<i>Rev. No.</i>	<i>Date</i>	<i>Rev. No.</i>	<i>Date</i>
16	Apr. 1968	22	Oct. 1969
17	July 1968	23	Jan. 1970
18	Oct. 1968	24	Apr. 1970
19	Jan. 1969	25	July 1970
20	Apr. 1969	26	Oct. 1970
21	July 1969		

<i>Page</i>	<i>Revision No.</i>	<i>Page</i>	<i>Revision No.</i>
Title Page (2 sides)	26-26	57-58	23-23
III-IV	17-17	59-60	23-23
V-VI	22-26	Chapter 700	
VII	26	61-62	25-25
Introduction		63-64	25-25
1-2	22-22	65-66	23-23
Chapter 100		66.1	23
3-4	24-24	67-68	18-18
4.1	24	69-70	16-16
5-6	18-18	70.1	16
Chapter 200		71-72	20-20
7-8	26-26	72.1-72.2	20-16
8.1	26	73-74	17-17
9-10	22-22	74.1	17
10.1-10.2	25-25	75-76	22-22
11-12	24-24	77-78	25-25
13-14	24-24	79-80	21-21
14.1	24	80.1	21
15-16	20-21	81-82	21-21
16.1	25	83-84	16-16
17-18	24-24	85-86	24-24
19-20	22-23	87-88	26-26
20.1	23	88.1	26
Chapter 300		89-90	24-24
21-22	24-24	90.1-90.2	24-26
22.1	24	91-92	26-26
Chapter 400		93-94	24-24
23-24	24-24	95-96	24-24
25-26	24-24	96.1-96.2	24-24
27-28	24-24	97-98	24-26
29-30	24-22	98.1	26
Chapter 500		99-100	26-26
31-32	24-24	101-102	25-25
32.1	26	102.1-102.2	25-25
Chapter 600		102.3	25
33-34	22-22	103-104	21-21
34.1-34.2	25-25	105-106	21-21
35-36	25-25	106.1	21
37-38	21-21	107-108	25-25
38.1	21	108.1	25
39-40	24-24	109-110	22-22
41-42	24-24	111-112	25-25
43-44	24-24	113-114	25-25
44.1	24	115-116	18-18
45-46	22-22	Chapter 800	
46.1	22	117-118	18-18
47-48	22-22	119-120	20-20
48.1-48.2	22-22	120.1-120.2	20-20
48.3-48.4	26-26	121-122	18-18
49-50	26-21	123-124	25-25
51-52	21-21	125-126	25-25
53-54	25-25	127-128	18-18
54.1	25	129-130	18-18
55-56	23-23	131	18
		133-134	18-18
		135-136	26-26
		Chapter 900	
		137-138	18-17
		138.1-138.2	17-17
		139-140	17-17

Page	Revision No.	Page	Revision No.
140.1	17	220.5-220.6	25-25
141-142	25-25	220.7	25
143-144	23-23	Chapter 1300	
145-146	23-23	221-222	24-24
147-148	26-26	223-224	24-24
149	26	225-226	24-24
151-152	23-26	227-228	24-24
153-154	26-26	228.1	26
154.1-154.2	26-26	Chapter 1400	
154.3	26	229-230	25-25
155-156	24-24	231-232	25-25
157	24	233-234	22-22
Chapter 1000		234.1-234.2	22-22
159-160	21-21	Chapter 1500	
161	21	235-236	20-20
Chapter 1100		237-238	20-20
163-164	23-23	Chapter 1600	
165-166	23-23	239-240	25-25
166.1	23	241-242	23-23
167-168	23-23	Chapter 1700	
169-170	20-20	243-244	24-24
171-172	25-25	245-246	26-26
172.1	22	246.1-246.2	26-26
173-174	22-22	246.3	26
174.1	22	Appendix I	
175-176	22-22	247-248	26-26
176.1	22	249-250	26-26
177-178	22-22	251	26
179-180	25-25	Appendix II	
181-182	25-25	253-254	26-26
183-184	25-25	255	26
185-186	25-25	Index	
186.1	26	257-258	19-19
187-188	23-23	259-260	19-19
189	23	261-262	19-19
191-192	omitted	263-264	19-19
193-194	25-25	265-266	19-19
194.1	25	267-268	19-19
195-196	26-26	269-270	19-19
197-198	26-26	271-272	19-19
199-200	23-23	273-274	19-19
201-202	23-23	275-276	19-19
203	25	277-278	19-19
205	23	279-280	19-19
207-208	omitted	281-282	19-19
Chapter 1200		283-284	19-19
209-210	23-23	285-286	19-19
211-212	23-23	287-288	19-19
213-214	23-23	289-290	19-19
214.1	21	291-292	19-19
215-216	26-26		
216.1	26		
217-218	21-21		
218.1	21		
219-220	25-25		
220.1-220.2	25-25		
220.3-220.4	25-25		

Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 96 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents for 35 cents) reprints the patent code and some additional statutes.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

These rules are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases" (available from the Superintendent of Documents for 55 cents). These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. The Rules of Practice govern the Examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

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

Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an Examiner's action may have it reviewed. In general, that portion of the Examiner's action pertaining to

MANUAL OF PATENT EXAMINING PROCEDURE

objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the Examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board

of Appeals (see § 1201). The distinction is set forth in Rules 181 and 191. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in § 707.06.