

MANUAL OF  
**PATENT**  
**EXAMINING**  
**PROCEDURE**

3<sup>RD</sup> EDITION

Rev. 48



U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

REEL NUMBER 2

BOOK NUMBERS 57

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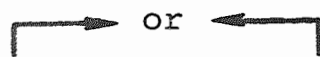
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MANUAL OF PATENT EXAMINING PROCEDURE  
Third Edition

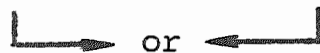
Instructions regarding Revision No. 48

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

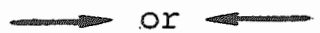
Arrows are printed in the margin of pages to indicate material changed, deleted, or added by this revision. Where insertion of new material results in shifting of unchanged material onto following pages, no arrows appear on such pages but the revision number is cited at the bottom of each page.



Line on which change begins.



Line on which change ends.



Line on which change both begins and ends.



Opposite a blank space, indicates deletion of material.

The notation "(R-48)" 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:

<u>Section</u>	<u>Change</u>
All	All rule citations are being changed to 37 Code of Federal Regulations designations.
102	New sub-section on status location information for Office personnel.
103	New sub-section on accessibility of non-final interference discovery opinions.
108 & 706.03(b)	Reference to ERDA added.
706.02 & 706.03(s)	35 U.S.C. 102(d) updated.
706.03(e)	Citation of In re Hughes added.
706.07(a)	Final rejection practice clarified.
707	Copies of revised forms PTOL-326 and PTO-1142 included.
707.05	Procedure added for citation of art from parent case where no art is cited in the continuing case. Revised form PTO-892 also includes revised procedure for citing a Defensive Publication and examples of citing a TVPP application and a Design Reissue.
1002.02(n)	New section relating to Board of Appeals clerk deciding petitions under 37 CFR 1.304.
1003	Item 15 amended to require director stamping of all copies of examiner's answers with new grounds. Item 19 added relating to withdrawal of appeal in a remanded case.
1004	A new item added requiring a primary examiner to sign a second action involving a previous restriction in a Markush-type claim.
1101.01	Exception added to 6 month filing date difference for interference is where the junior party has an earlier foreign filing date.
1216	Change in 37 CFR 1.304 added.

<u>Section</u>	<u>Change</u>
1308.03	Procedure for reopening prosecution of an application as a result of the Quality Review Program added.
1401	Note added that filing fee for a design re-issue application is 65 dollars.
1401.06	Note added as to handling of a certificate of correction in a reissue application.
1401.11	Note added on not renumbering patent claims in a reissue application.

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\*Added page

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**E X A M I N I N G**  
**P R O C E D U R E**

Original Third Edition, dated November 1961

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U.S. DEPARTMENT OF COMMERCE • PATENT AND TRADEMARK OFFICE

Rev. 48, Apr. 1976

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**First Edition, November 1949**

Revision 1, November 1950  
Revision 2, December 1951  
Revision 3, May 1952

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Revision 2, June 1956  
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Revision 46, October 1975  
Revision 47, January 1976  
Revision 48, April 1976 ←



## Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark 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 a patent application.

A separate manual entitled "Trademark Manual of Examining Procedure" is published by the Patent and Trademark Office as a reference work for trademark cases.

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 and Trademarks,  
Editor, M.P.E.P.  
Washington, D.C. 20231

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# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

Pursuant to the 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 75 cents) reprints the patent code and some additional statutes.

**35 U.S.C. 1 Establishment.** The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

## 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 regula-

tions, not inconsistent with law, for the conduct of proceedings in the Patent Office.

**Rule 351. Amendments to rules will be published.** All amendments to these rules will be published in the Official Gazette and in the Federal Register.

**Rule 352. Publication of notice of proposed amendments.** (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments to these rules will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

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. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules and forms, as well as trademark rules and forms and copyright rules. Persons desiring a copy of the patent rules should order a copy of "37 Code of Federal Regulations" from the Superintendent of Documents.

The primary 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 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.

### Publications Available from Superintendent of Documents

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*Patent Official Gazette.* The official journal of the Patent Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and an abstract of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification. Annual subscription \$211.00 (\$52.75 additional for foreign mailing). Single copy \$4.10.

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*Patents.* Copies of the specification and drawings of all patents are available at 50 cents each, except design patents. Design patents are 20 cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

*Classification Definitions.* Contain the changes in classification of patents as well as definitions of new and revised classes and sub-classes. Price is based upon size of publication, minimum price 10 cents.

*Weekly Class Sheets.* Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette*. Annual subscription, \$5.