

Chapter 700 Examination of Applications

- 701 Statutory Authority for Examination
- 702 Requisites of the Application
- 702.01 Obviously Informal Cases
- 703 "General Information Concerning Patents" Sent Instead of "Rules of Practice"
- 704 Search
- 705 Patentability Reports
- 705.01 Instructions re Patentability Reports
- 705.01(a) Nature of P. R., Its Use and Disposal
- 705.01(b) Sequence of Examination
- 705.01(c) Counting and Recording P. R.'s
- 705.01(d) Duplicate Prints of Drawings
- 705.01(e) Limitation as to Use
- 705.01(f) Interviews With Applicants
- 706 Rejection of Claims
- 706.01 Contrasted With Objections
- 706.02 On Prior Art
- 706.02(a) Establishing "Well Known" Prior Art
- 706.03 Not Based on Prior Art
- 706.03(a) Nonstatutory Subject Matter
- 706.03(b) Barred by Atomic Energy Act
- 706.03(c) Functional
- 706.03(d) Vague and Indefinite
- 706.03(e) Product by Process
- 706.03(f) Incomplete
- 706.03(g) Prolix
- 706.03(h) Nonstatutory Claim
- 706.03(i) Aggregation
- 706.03(j) Old Combination
- 706.03(k) Duplicate Claims; Double Patenting
- 706.03(l) Multiplicity
- 706.03(m) Nonelected Inventions
- 706.03(n) Correspondence of Claim and Disclosure
- 706.03(o) New Matter
- 706.03(p) No Utility
- 706.03(q) Obvious Method
- 706.03(s) Statutory Bar
- 706.03(t) Other Assigned Application
- 706.03(u) Disclaimer
- 706.03(v) After Interference or Public Use Proceeding
- 706.03(w) Res Judicata
- 706.03(x) Reissue
- 706.03(y) Improper Markush
- 706.03(z) Undue Breadth
- 706.04 Previously Allowed Claim
- 706.05 After Allowance of Application
- 706.06 Claims Copied from Patent
- 706.07 Final Rejection
- 706.07(a) When Proper
- 706.07(b) When Proper on First Action
- 706.07(c) Premature
- 706.07(d) Withdrawal of Premature
- 706.07(e) Withdrawal, General
- 707 Examiner's Letter or Action
- 707.01 Primary Examiner Indicates Action for New Assistant
- 707.02 Actions which Require the Personal Attention of the Primary Examiner
- 707.02(a) Cases Up for Third Action and Five-Year Cases
- 707.03 Sample of Conventional "First Action" Letter
- 707.04 Initial Sentence
- 707.05 Citation of References
- 707.05(a) Grouped at Beginning of Letter
- 707.05(d) Reference Cited in Subsequent Actions
- 707.05(e) Data Used in Citing References
- 707.05(f) Effective Dates of Declassified Printed Matter
- 707.05(g) Incorrect Citation of References
- 707.06 Citation of Decisions, Orders and Notices
- 707.07 Completeness and Clarity
- 707.07(a) Action on Formal Matters
- 707.07(b) Requiring New Oath
- 707.07(c) Draftsman's Requirement
- 707.07(d) Language To Be Used in Rejections
- 707.07(e) Note All Outstanding Requirements
- 707.07(f) Answer All Material Traversed
- 707.07(g) Piecemeal Examination
- 707.07(h) Notify of Inaccuracies in Amendment
- 707.07(i) Each Claim To Be Mentioned in Each Letter
- 707.07(j) State When Claims Are Allowable
- 707.07(k) Numbering Paragraphs
- 707.08 Review by Assistant Examiner
- 707.09 Signing by Primary or Acting Primary
- 707.10 Entry
- 707.11 Date
- 707.12 Mailing
- 707.13 Returned Office Action
- 708 Order of Examination
- 708.01 List of Special Cases
- 708.02 Petition to Make Special
- 708.03 Examiner Tenders His Resignation
- 709 Suspension of Action
- 709.01 Overlapping Applications by Same Applicant or owned by Same Assignee
- 709.02 Actions Following Correspondence under Rule 202
- 710 Period for Response
- 710.01 Statutory

MANUAL OF PATENT EXAMINING PROCEDURE

- 710.01(a) How Computed
- 710.02 Shortened Statutory Period and Time Limit Actions
 - 710.02(a) Approval of Time Set in Case of Shortened Statutory Period
 - 710.02(b) Situations in Which Used: Shortened Statutory Period
 - 710.02(c) Situations in Which Used: Nonstatutory Time Limit
 - 710.02(d) Differences Between Shortened Statutory and Time Limit Periods
 - 710.02(e) Extension of Time
- 710.04 Two Periods Running
 - 710.04(a) Copying Patent Claims
- 710.05 Period Ending on Saturday, Sunday or Holiday
- 710.06 Miscellaneous Factors Determining Date
- 711 Abandonment
 - 711.01 Express or Formal Abandonment
 - 711.02 Failure to Take Required Action During Time Period
 - 711.02(a) Insufficiency of Response
 - 711.02(b) Special Situations Involving Abandonment
 - 711.02(c) Termination of Proceedings
 - 711.03 Reconsideration of Holding of Abandonment: Revival
 - 711.03(a) Holding Based on Insufficiency of Response
 - 711.03(b) Holding Based on Failure to Respond Within Period
 - 711.03(c) Petitions Relating to Holding of Abandonment
 - 711.03(d) Examiner's Statement on Petition
 - 711.04 Disposition of Abandoned Applications
 - 711.04(a) Pulling and Forwarding
 - 711.04(b) Ordering Abandoned Files
 - 711.05 Letter of Abandonment Received After Application is Allowed
 - 711.06 Publication of Abstracts
 - 711.06(a) Use of Abstract as Reference
- 712 Forfeiture
- 713 Interviews
 - 713.01 General Policy, How Conducted
 - 713.02 Interviews Prior to First Official Action
 - 713.03 Interviews for "Sounding Out" Examiner Not Permitted
 - 713.04 Substance of Interview Must Be Made of Record
 - 713.05 Interviews Prohibited or Granted, Special Situations
 - 713.06 No Inter Partes Questions Discussed Ex Parte
 - 713.07 Exposure of Other Cases
 - 713.08 Demonstration, Exhibits, Models
 - 713.09 Finally Rejected Application
 - 713.10 Interview Preceding Filing Amendment Under Rule 312
- 714 Amendments, Applicant's Actions
 - 714.01 Signatures to Amendments
 - 714.01(a) Unsigned or Improperly Signed Amendment
 - 714.01(b) Disposal of
 - 714.01(c) Signed by Attorney Not of Record
 - 714.01(d) Amendment Signed by Applicant But Not by Attorney of Record
 - 714.01(e) Power of Attorney to a Firm
 - 714.02 Must Be Fully Responsive
 - 714.03 Amendments Not Fully Responsive, Action to Be Taken
 - 714.04 Claims Presented in Amendment with No Attempt to Point Out Patentable Novelty
 - 714.05 Examiner Should Immediately Inspect
 - 714.06 Amendments Sent to Wrong Division
 - 714.07 Amendments Not in Permanent Ink
 - 714.08 Telegraphic Amendment
 - 714.09 Amendments Before First Office Action
 - 714.10 Claims Added in Excess of Filing Fee
 - 714.11 Amendment Filed During Interference Proceedings
 - 714.12 Amendments After Final Rejection or Action
 - 714.13 Amendments After Final Rejection or Action, Procedure Followed
 - 714.14 Amendments After Allowance of All Claims
 - 714.15 Amendment Mailed Before, but Received in Examining Division After Allowance
 - 714.16 Amendment After Notice of Allowance, Rule 312
 - 714.16(a) Copied Patent Claims
 - 714.16(b) Filed with a Motion Under Rule 231
 - 714.16(c) Additional Claims
 - 714.16(d) Handling
 - 714.16(e) Entry in Part
 - 714.17 Amendment Filed After the Period for Response Has Expired
 - 714.18 Entry of Amendments
 - 714.19 List of Amendments, Entry Denied
 - 714.20 List of Amendments Entered in Part
 - 714.21 Amendments Inadvertently Entered, No Legal Effect
 - 714.22 Entry of Amendments, Directions for
 - 714.23 Entry of Amendments, Directions for, Defective
 - 714.24 Amendment of Amendment
 - 714.25 Discourtesy of Applicant or Attorney
- 715 Swearing Back of Reference—Affidavit Under Rule 131
 - 715.01 Reference Claims Foreign Filing Date
 - 715.01(a) Reference a Joint Patent to Applicant and Another
 - 715.01(b) Reference and Application have Common Assignee
 - 715.01(c) Reference is Publication of Applicant's Own Invention
 - 715.02 General Rule as to Generic Claims
 - 715.03 Exceptions and Practice Relative to Chemical Cases
 - 715.04 Who May Make Affidavit
 - 715.05 Patent Claiming Same Invention
 - 715.06 Affidavit Under Rule 131 Must Be Removed Before Interference
 - 715.07 Facts and Documentary Evidence

- 715.07(a) Diligence
- 715.07(b) Interference Testimony Sometimes Used
- 715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country
- 715.07(d) Disposition of Exhibits
- 715.08 Passed Upon By Primary Examiner
- 715.09 Seasonable Presentation
- 716 Affidavits Traversing Rejections
- 717 File Wrapper
- 717.01 Papers in File Wrapper
- 717.01(a) Arrangement
- 717.01(b) Prints
- 717.02 Date Entered on
- 717.02(a) Statutory Period Ends On Sunday or Holiday
- 717.02(b) Name or Residence of Inventor or Title Changed
- 717.03 Classification During Examination
- 717.04 Index of Claims
- 717.05 Field of Search
- 717.06 Foreign Filing Dates
- 717.07 Related 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) Deficiencies in the drawing should be pointed out; (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. (Basis: Notice of January 15, 1924.)

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. (Basis: Notice of November 10, 1948.)

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

705.01 to 705.01(f) are based on the Notices of November 12, 1948, and April 12, 1951.

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. (Basis: Notice of April 12, 1951.)

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

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. Div. -----" 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

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 assigned. The "Approved" stamp should be im-

pressed on the memorandum requesting the P.R. (Basis: Notice of October 8, 1956.)

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

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.

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 re-

quirements 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

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 neither novel under 35 U.S.C. 102 nor non-obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See 707.07(d).

A U.S. patent is a valid reference against an application even though the patent date is after the filing date of an 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 as both basic and auxiliary references. The doctrine of the *Alexander Milburn Co. v. Davis-Bournonville Co.* decision, 1926 C.D. 303; 344 O.G. 817, has been thus construed in *re Youker* (C.C.P.A.), 1935 C.D. 658; 461 O.G. 10, and in *Minn. Mining & Mfg. Co. v. Coe* (C.A.D.C.) 1938 C.D. 100; 497 O.G. 766. See also *Detrola Corp. v. Hazeltine* (U.S.S.C.) 1941 C.D. 811; 528 O.G. 245 and *In re Gregg* (C.C.P.A.), 1957 C.D. 284; 720 O.G. 227. The Milburn case doctrine has been restated and reaffirmed by the

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

If there are proper priority papers in the file of the reference patent, a still earlier date; i.e., that of the foreign filing may be the effective date. (Basis: Notice of May 27, 1964.)

For the proper way to cite a patent granted after the filing of an application, see 707.05(e) and the sample letter in 707.03. Rejections on "old combination" are treated in 706.03(j).

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

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. In too many instances this consideration is relegated to a secondary position, while undue emphasis is given to technical rejections. Where a major technical rejection is proper (e.g. aggregation, lack of proper disclosure, undue breadth) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

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.

Rejections not based on prior art are explained in 706.03(a) to 706.03(y). 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

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

Applications **MUST** be inspected promptly when received to determine those which appear to relate to atomic energy and those so related **MUST BE PROMPTLY FORWARDED** to the Patent Security Division for processing under Rule 14(c), in order for the Commissioner to fulfill his responsibilities under Section 151(d) of the Act.

All rejections based upon Sections 151(a) and 155 of the Atomic Energy Act **MUST** be made only by Divisions 10, 44 and 46.

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 permitted because they are definite and 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.

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 omission 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

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

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.

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).

706.03(k) Duplicate Claims; Double Patenting

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 cannot 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:

Conflicting subject matter in two applications of the same inventor, one of which is assigned, see Section 304.

Where there is a common assignee for two or more applications by different inventors, see Section 305.

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-