

U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**MANUAL OF PATENT EXAMINING PROCEDURE**  
**Eighth Edition**

**Instructions Regarding Revision No. 2**

This revision incorporates the changes necessitated by the following final rules:

- (1) "Correspondence With the United States Patent and Trademark Office," which became effective on May 1, 2003;
- (2) "Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications," which became effective on July 14, 2003;
- (3) "Changes To Implement Electronic Maintenance of Official Patent Application Records," which became effective on July 30, 2003;
- (4) "Reorganization of Correspondence and Other General Provisions," which became effective on September 12, 2003;
- (5) "Revision of Patent Fees for Fiscal Year 2004," which became effective on October 1, 2003;
- (6) "January 2004 Revision of Patent Cooperation Treaty Application Procedure," which became effective on January 1, 2004;
- (7) "Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute," which became effective on January 21, 2004; and
- (8) "Revision of Patent Term Extension and Patent Term Adjustment Provisions," which became effective on May 24, 2004.

It is noted that the discussion of 35 U.S.C. 102(e) in Chapters 800 and 900 has not yet been updated to incorporate revised 35 U.S.C. 102(e) (as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002). When using Chapters 800 and 900 where 35 U.S.C. 102(e) has not yet been updated, users of the Manual should refer to Chapters 700 and 2100 for the revised 35 U.S.C. 102(e) as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002.

This revision consists of replacement pages for the **Title Page, Foreword, Table of Contents, and Introduction** in the front of the Manual, **entire Chapters 100, 200, 500 - 700, 1000, 1100, 1300 - 1500, 1700, 1800, 2000 - 2200, 2500 and 2700, Appendices II – List of Decisions Cited, L – Patent Laws, R – Patent Rules, T – Patent Cooperation Treaty, and AI – Administrative Instructions Under the PCT, and entire Index**. A new **Chapter 2600** on *Inter Partes* Reexamination has been added.

Pages which have been printed in this revision are labeled as "**Rev. 2**" on the bottom. Sections of the Manual that have been changed by this revision are indicated by "[**R-2**]" after the section title. Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (\*) where a single word was deleted and by two asterisks (\*\*) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule that was not reproduced.

This revision of the Manual was prepared with the assistance of the Office of Patent Legal Administration. Their efforts are greatly appreciated.

Magdalen Y. C. Greenlief, Editor  
Manual of Patent Examining Procedure

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Particular attention is called to the changes in the following sections:

**CHAPTER 100:**

- 101 Revised to reflect amendments to 37 CFR 1.14. Added reference to Image File Wrapper (IFW) processing. References to particular PALM screens have been deleted.
- 102 Revised to reflect amendments to 37 CFR 1.14. Also revised to indicate that status information includes whether another application claims the benefit of the application for which status information is requested. Added reference to IFW processing.
- 103 Revised to reflect amendments to 37 CFR 1.11 and 1.14. The section has been rearranged to parallel 37 CFR 1.14 as amended and new subsection headings have been added. Added a subsection to discuss access to IFW applications. Revised to indicate that all reexamination files are available to the public in electronic format only. Regarding FOIA requests, 37 CFR 1.15, which was directed to requests for USPTO records, has been removed and supplanted by 37 CFR Part 102.
- 104 Revised to reflect amendments to 37 CFR 1.14. Revised to indicate that powers to inspect are not accepted in IFW applications. IFW applications are available through Private Patent Application Information Retrieval (PAIR) system.
- 110 Revised to reflect amendments to 37 CFR 1.14.
- 115 Added reference to IFW processing.
- 120 Revised to reflect amendments to 37 CFR 5.1, 5.2, and 5.3. Also revised to indicate that any petition for rescission or modification of a Secrecy Order or any appeal of a decision on petition should be addressed to Mail Stop L & R, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- 140 Revised to reflect amendments to 37 CFR 5.11, and 5.18.
- 150 Revised to reflect amendments to 37 CFR 1.14.

**CHAPTER 200:**

- 201 Revised to indicate that effective July 14, 2003, a continued prosecution application (CPA) filed under 37 CFR 1.53(d) is only available for design applications.

- 201.03 Form paragraphs have been revised. Added reference to IFW processing. Revised to indicate that effective July 14, 2003, a continued prosecution application (CPA) filed under 37 CFR 1.53(d) is only available for design applications and that the CPA practice has been eliminated as to utility and plant applications.
- 201.04(b) Revised to indicate that an application filed under 37 CFR 1.53(b) may be converted to a provisional application provided a “request” for conversion and the fee are filed rather than a “petition” for conversion and the fee. Form PTO/SB/16 has been updated to reflect the current form that is available on the USPTO web site.
- 201.06 Revised to indicate that a divisional application is often filed as a result of a restriction requirement made by the examiner. Also revised to indicate that effective July 14, 2003, continued prosecution application (CPA) practice has been eliminated as to utility and plant applications. The reference to the deletion of 37 CFR 1.60 and 1.62 as of December 1, 1997 has been deleted.
- 201.06(a) Information regarding practice and procedure under former 37 CFR 1.60 has been deleted. Such information is available in the 8<sup>th</sup> edition, revision 1 of the MPEP posted on the USPTO web site.
- 201.06(b) Information regarding practice and procedure under former 37 CFR 1.62 has been deleted. Such information is available in the 8<sup>th</sup> edition, revision 1 of the MPEP posted on the USPTO web site.
- 201.06(c) Revised to indicate that a proceeding is terminated when the mandate is issued by the court rather than the date of receipt of the court’s certified copy of the decision by the USPTO. This change is consistent with a 1998 amendment to Rule 41 of the Federal Rules of Appellate Procedure. The commentary to the amendment to Rule 41 of the Federal Rules of Appellate Procedure indicated that the change is to make clear that the court’s mandate is effective upon issuance, and that its effectiveness is not delayed until receipt of the mandate by the trial court or agency.
- 201.06(d) Revised to reflect amendments to 37 CFR 1.53(d). Effective July 14, 2003, continued prosecution application (CPA) practice has been eliminated as to utility and plant applications. CPA practice is only available for design applications. CPAs filed prior to July 14, 2003 will continue to be processed and examined under the procedures set forth in prior 37 CFR 1.53(d). The forms have been updated to reflect the current forms that are available on the USPTO web site.

- 201.07 Revised to indicate that effective July 14, 2003, a continued prosecution application (CPA) filed under 37 CFR 1.53(d) is only available for design applications.
- 201.08 Revised to indicate that notations are to be put in the “file history” rather than referring to the file wrapper so as to cover applications maintained in paper and those that are maintained in IFW.
- 201.09 Revised to indicate that notations are to be put in the “file history” rather than referring to the file wrapper so as to cover applications maintained in paper and those that are maintained in IFW.
- 201.10 Form paragraph has been revised.
- 201.11 Form paragraphs have been revised. Added discussion to a Federal Circuit decision. Revised to indicate that a proceeding is terminated when the mandate is issued by the court rather than the date of receipt of the court’s certified copy of the decision by the USPTO. Revised to indicate that when a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application unless an incorporation by reference statement of the prior application was presented at the time of filing of the application. Also revised to indicate that a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the benefit claim must be made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii), as appropriate.
- 201.11(a) Added a new subsection to discuss delayed submission of benefit claim in an international application.
- 201.13 The list of countries to which the right of priority referred to in 35 U.S.C. 119(a)-(d) has been recognized has been updated.
- 201.14(a) Revised to reflect amendments to 37 CFR 1.55. Form paragraph has been revised.
- 201.14(b) Form paragraph has been revised.
- 201.14(c) Added reference to IFW processing.
- 202.02 The title of this section has been changed to read “Notation in File History Regarding Prior U.S. Application, Including Provisional Applications.” Added reference to IFW processing.
- 202.03 Added reference to IFW processing.

- 202.04 Revised to include the requirements of 37 CFR 1.63(c)(2).
- 203.08 Revised to indicate that applicants are encouraged to check Patent Application Information Retrieval (PAIR) for status information of their own patent applications. Also revised to indicate that for amended applications, if applicant files a reply to an Office action and six months have elapsed since the filing of the reply and no response from the Office is received, applicant should inquire as to the status of the application to avoid potential abandonment.
- 203.08(a) Revised to reflect that the name of the Office of Legislative and International Affairs has been changed to the Office of International Relations.

#### **CHAPTER 500:**

- 501 The title of this section has been changed to read “Filing Papers With the U.S. Patent and Trademark Office.” Revised to reflect amendments to 37 CFR 1.1 and 1.4. Revised to set forth the mailing addresses for certain types of correspondence. Also revised to indicate that patent-related papers, other than those that require immediate Office attention may be delivered to the Office and if hand-delivered, the correspondence must be delivered to the Customer Window.
- 502 Revised to reflect amendments to 37 CFR 1.5 and 1.6. Revised to indicate that effective December 1, 2003, all official patent application related correspondence for organizations reporting to the Commissioner for Patents that is hand-delivered to the Office must be delivered to the Customer Window with a few exceptions.
- 502.01 Revised to reflect amendments to 37 CFR 1.6. Revised to indicate that effective July 14, 2003, continued prosecution application (CPA) procedures are only available to design applications. Revised to indicate that effective December 1, 2003, all patent application related correspondence transmitted by fax must be directed to the central fax number with a few exceptions. Also revised to indicate that the Office has waived the prohibition in 37 CFR 1.6(d)(4) against the submission of drawings by fax when the drawings are facsimile transmitted with the issue fee.
- 502.02 Revised to reflect amendments to 37 CFR 1.4.
- 502.04 Revised to reflect amendments to 37 CFR 1.4.

- 503 Added reference to the “10” series code for patent applications and the “95” series code for *inter partes* reexamination proceedings. Revised to indicate that any return receipt postcard containing a dated meter postmark may not be delivered by the USPS to the address provided on the postcard.
- 505 Revised to reflect amendments to 37 CFR 1.6.
- 506 Revised to reflect amendments to 37 CFR 1.53. Revised to indicate that any preliminary amendment, regardless of when it is filed, must comply with the requirements of 37 CFR 1.121.
- 507 Revised to indicate that replacement drawings for inclusion in a patent application publication must be addressed to Mail Stop PGPUB Drawings.
- 508 Revised to indicate that all applications filed on or after June 30, 2003 are electronically scanned and loaded into the IFW system.
- 508.03 Revised to indicate that effective December 1, 2003, no official paper that relates to a pending application may be personally delivered to a TC except for papers that are directed to an application subject to a secrecy order or are national security classified.
- 509 Revised to reflect amendments to 37 CFR 1.22 and 1.26. Revised to indicate that the credit card payment form, PTO-2038, may be downloaded from the USPTO web site.
- 509.01 Revised to reflect amendments to 37 CFR 1.25. Revised to add information regarding deposit account replenishment.
- 509.02 Revised to include reference to 35 U.S.C. 41(h)(1). Information regarding the Small Business Administration has been updated. Added recent Federal Circuit decision regarding a grant of a non-exclusive license to a large entity which resulted in applicant being disqualified from claiming small entity status.
- 509.03 Added form paragraph 5.05 which may be used to notify applicant that he or she may qualify for small entity status. Address for submitting requests for refunds along with assertions under 37 CFR 1.27(c) has been updated.
- 511 The title of this section has been changed to read “Postal Service Interruptions and Emergencies.” Revised to indicate that in the event of a postal interruption or emergency, an announcement will be posted on the USPTO web site providing instructions on the filing of patent applications and other papers related to patent applications and patents. Information regarding depositing papers with U.S. Department of Commerce District Offices is no longer necessary and has been deleted.

- 512 Revised to reflect amendments to 37 CFR 1.8. Form paragraph has been revised.
- 513 Revised to reflect amendments to 37 CFR 1.6 and 1.10. Revised to indicate that the Express Mail procedures set forth in 37 CFR 1.10 is limited to correspondence deposited in the “Express Mail Post Office to Addressee” service of the USPS and that no similar benefit can be obtained for correspondence deposited in International Express Mail.

**CHAPTER 600:**

- 601 Revised to reflect amendments to 37 CFR 1.51. Added information regarding what constitutes a complete application filed under 35 U.S.C. 111(a). Revised to include a reference to new MPEP Chapter 2600, which is directed to *inter partes* reexamination.
- 601.01 Revised to reflect amendments to 37 CFR 1.53. Also revised to indicate that effective July 14, 2003, continued prosecution application (CPA) practice under 37 CFR 1.53(d) is only available for design applications.
- 601.01(a) The discussion regarding applications filed under former 37 CFR 1.62 has been deleted since 37 CFR 1.62 has been deleted since December 1, 1997.
- 601.01(c) Revised to indicate that the conversion of a nonprovisional application to a provisional application would not avoid publication of the nonprovisional application unless the request to convert is recognized in sufficient time to permit the Office to remove the nonprovisional application from the publication process. Requests to convert should be addressed to “Mail Stop Conversion.”
- 601.01(d) Added reference to IFW processing.
- 601.01(e) Added discussion of recent Federal Circuit decision on preliminary amendments that cancels all claims without presenting new claims.
- 601.01(g) Revised to replace the requirement of a separate letter renumbering the drawing figures consecutively with replacement sheets of drawings in compliance with 37 CFR 1.121(d).
- 601.02 The title of this section has been changed to read “Power of Attorney.” Reference to authorization of agent has been deleted. Form PTO/SB/81 has been updated to reflect the current form that is available on the USPTO web site.
- 601.03 Revised to reflect amendments to 37 CFR 1.33.

- 601.05 Revised to include an example to illustrate the reasons why the Office would prefer applicants to use an application data sheet. Reference to authorization of agent has been deleted. Added discussion on supplemental ADS submissions. Revised to indicate that the Office strongly encourages the filing of an ADS or a supplemental ADS to correct a typographical or transliteration error in the spelling of an inventor's name.
- 602 Revised to indicate that documents with seals cannot be adequately scanned for retention in the IFW, therefore, the Office strongly encourages the use of declarations rather than oaths. Also revised to indicate that 37 CFR 1.63 no longer requires the oath or declaration to state that the inventor is a sole or joint inventor of the invention claimed. Form paragraph has been revised. Form PTO/SB/01 has been updated to reflect the current form that is available on the USPTO web site.
- 602.02 The cross-reference to the MPEP has been corrected.
- 602.03 Form paragraphs have been revised. Added reference to IFW processing.
- 604.01 Revised to indicate that documents with seals cannot be adequately scanned for retention in the IFW, therefore, the Office strongly encourages the use of declarations rather than oaths.
- 604.04(a) Revised to indicate that the Office no longer returns improperly authenticated oaths for proper authentication. Form paragraph has been revised.
- 605 Revised to reflect amendments to 37 CFR 1.41.
- 605.02 Form paragraph has been revised.
- 605.03 Form paragraph has been revised.
- 605.04(a) Revised to indicate that applications filed through the EFS must also contain an oath or declaration personally signed by the inventor. Also revised to indicate that in situations where an inventor's full given name is a singular letter or a plurality of singular letters, it is acceptable to identify the inventor by his or her family name and the singular letter(s). In order to avoid an objection under 37 CFR 1.63(a)(2), applicant should point out in the oath or declaration that the singular lettering set forth is the inventor's given name. Revised to indicate that when a typographical or transliteration error in the spelling of an inventor's name is discovered during the pendency of the application, applicants are strongly encouraged

to use an ADS to provide the corrected spelling to ensure that any patent to issue will reflect the correct spelling of the inventor's name.

- 605.04(c) Added reference to IFW processing.
- 605.04(f) Revised to indicate that applicants are strongly encouraged to submit an ADS showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue. Also revised to indicate that when the Office of Petitions grants a petition to change the order of the names of the inventors, the Office of Petitions will change the order of the names in the Office computer records unless the application is an 08/ or earlier series, in which case, OIPE will correct the file wrapper and the PALM database.
- 605.04(g) The discussion regarding a typographical or transliteration error in the spelling of an inventor's name has been moved to MPEP § 605.04(a). Added reference to IFW processing.
- 606.01 Added reference to IFW processing.
- 607.02 Revised to reflect amendments to 37 CFR 1.26.
- 608.01 Revised to reflect amendments to 37 CFR 1.52, and 1.71. Revised to indicate that the specification must commence on a separate sheet and the text must be written in a nonscript type font. Also revised to indicate that examiners should not object to the specification and/or claims merely because applicants are using British English spellings rather than American English spellings. Regarding "Easily Erasable" paper, since application papers are now maintained in an IFW, the type of paper is unlikely to be an issue so long as the Office was able to scan and reproduce the papers that are filed. Also revised to clarify that where the hyperlinks themselves, rather than the content of the site to which the hyperlinks are directed, are part of applicant's invention and it is necessary to have them included to comply with 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. Form paragraphs have been revised.
- 608.01(a) Form paragraphs have been revised.
- 608.01(b) Revised to reflect amendments to 37 CFR 1.72. Form paragraphs have been revised.
- 608.01(i) Revised to reflect amendments to 37 CFR 1.75.

- 608.01(m) Revised to indicate that the claim or claims must commence on a separate physical sheet or electronic page. Form paragraphs have been revised.
- 608.01(n) Added reference to forms PTO/SB/06 and PTO/SB/07. Revised to clarify the reason why a claim to a product set forth in claim 1 is an improper dependent claim where claim 1 recites a method of making a specified product.
- 608.01(o) Revised to indicate that if the examiner determines that the claims presented late in prosecution do not comply with the requirements of 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.
- 608.01(p) Added a reference to MPEP § 2181 regarding incorporation by reference, 35 U.S.C. 112, second paragraph, and 35 U.S.C. 112, sixth paragraph. Revised to indicate that as a safeguard against the omission of a portion of a prior application for which priority is claimed under 35 U.S.C. 119(a)-(d) or (f), or for which benefit is claimed under 35 U.S.C. 119(e) or 120, applicant may include a statement at the time of filing of the later application incorporating by reference the prior application. The inclusion of the incorporation by reference statement will permit applicant to include subject matter from the prior application into the later-filed application without the subject matter being considered as new matter.
- 608.01(q) Revised to reflect amendments to 37 CFR 1.125. Form paragraphs have been revised.
- 608.01(v) Revised to indicate that where a letter demonstrates a trademark misuse in a patent application publication, the Office should, where the application is still pending, ensure that the trademark is replaced by appropriate generic terminology.
- 608.02 Revised to indicate that facsimile copies of drawings are acceptable if included with application papers mailed or hand delivered to the Office or if submitted at the time of payment of the issue fee. Applicants should ensure that the facsimile transmission process does not unreasonably degrade the quality of the drawings. Also revised to indicate that the “Guide for the Preparation of Patent Drawings” is available on the USPTO web site. Also revised to indicate that photographs may be treated as artifacts when the patent application is an IFW application. Revised to add a reference to the American National Standards Institute (ANSI) publications that pertain to graphical symbols.

- 608.02(a) Deleted reference to “informal” drawings since the Office no longer considers drawings as formal or informal. Drawings are either acceptable or not acceptable.
- 608.02(b) Revised to indicate that drawings are now considered either acceptable or not acceptable rather than formal or informal. Form paragraphs have been revised.
- 608.02(c) Added reference to IFW processing.
- 608.02(d) Form paragraphs have been revised.
- 608.02(e) Form paragraphs have been revised.
- 608.02(f) Form paragraph has been revised.
- 608.02(g) Form paragraph has been revised.
- 608.02(h) The title of this section has been changed to read “Replacement Drawings.” The phrase “additional or substitute sheets of drawings” has been changed to “replacement sheets of drawings.” Form paragraph has been changed.
- 608.02(m) Added reference to IFW processing.
- 608.02(o) Revised to indicate that drawings are no longer endorsed with an application number or receipt date.
- 608.02(p) Revised to reflect amendments to 37 CFR 1.121(d). Form paragraphs have been revised.
- 608.02(r) This section on separate letter has been deleted.
- 608.02(t) Revised to indicate that if a drawing figure is canceled, a replacement sheet of drawing must be submitted with the figure. If the canceled figure was the only drawing on the sheet, then only a marked-up copy of the drawing including an annotation that the drawing has been canceled is required.
- 608.02(v) The title of this section has been changed to read “Drawing Changes Which Require Annotated Sheets.”
- 608.02(w) The title of this section has been changed to read “Drawing Changes Which May Be Made Without Applicant’s Annotated Sheets.”

- 608.02(x) The title of this section has been changed to read “Drawing Corrections or Changes Accepted Unless Notified Otherwise.” Revised to indicate that drawing corrections or changes will be entered at the time they are presented, unless applicant is notified to the contrary by the examiner in the action following the amended drawing submission.
- 608.02(z) Revised to indicate that if at allowance, the examiner determines that correction is required, the drawings requiring correction should be placed as the top papers in the center fold of the file wrapper if the application is maintained in paper.
- 608.03(a) Revised to reflect amendments to 37 CFR 1.94 and 1.95.
- 608.05 Added reference to IFW processing.
- 608.05(a) Form paragraphs have been revised. Revised to indicate that the Office provided for the continuation of prior microfiche appendix practice for computer listings until March 1, 2001. Added references to IFW processing.
- 608.05(b) Revised to indicate that if lengthy tables are submitted on a CD or in electronic format in response to a specific request from the Office of Publication, these lengthy tables will not be published as part of a patent document. The lengthy tables will be published separately on the sequence homepage of the USPTO Internet web site as an XML file and the patent document will include a standardized “Lengthy Table” statement. Form paragraph has been revised.
- 609 Revised to reflect amendments to 37 CFR 1.98. Revised to indicate that a third party, who is not covered by 37 CFR 1.56(c), cannot file an IDS under 37 CFR 1.97 and 1.98. Also revised to indicate that pursuant to 37 CFR 1.98(d), if the IDS submitted in the parent application complies with 37 CFR 1.98(a) to (c), applicant need not resubmit copies of the documents in the continuing application. Form paragraphs have been revised. Revised to include a discussion of e-IDS. Forms PTO/SB/08A and PTO/SB/08B have been updated to reflect the current forms that are available on the USPTO web site.
- 610 This section has been deleted and the subject matter has been moved to new MPEP § 1134.01.

## **CHAPTER 700:**

- 702 Added reference to IFW processing.
- 702.01 Form paragraph has been revised.

- 704.10 Added discussion of recent Federal Circuit decision.
- 704.12(a) Added discussion of recent Federal Circuit decision.
- 704.14(b) Added reference to IFW processing.
- 705.01 Added reference to IFW processing.
- 705.01(a) Added reference to IFW processing.
- 705.01(d) Added reference to IFW processing.
- 705.01(e) Added reference to IFW processing.
- 706.02 Added reference to MPEP § 2658, which is directed to *inter partes* reexamination.
- 706.02(b) Revised to indicate that where applicant is attempting to overcome a rejection under 35 U.S.C. 102(b) by perfecting priority claim under 35 U.S.C. 119(e), there has to be at least one intermediate application between the provisional application and the nonprovisional application under examination (chain of prior applications) since a provisional application could not have been filed more than one year prior to the filing of a nonprovisional application that claims benefit to the provisional application. In this situation, priority must be perfected for the chain of prior applications (35 U.S.C. 119(e) and 120 must be perfected).
- 706.02(f)(1) Revised to indicate that where the 35 U.S.C. 102(e) date of a reference is based on the filing date of an earlier-filed U.S. provisional or nonprovisional application or international application, the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e).
- 706.02(l)(1) Revised to indicate that the fact that the reference and the application have the same assignee is not, by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that the common ownership was “at the time the invention was made.”
- 706.02(l)(2) Added examples 7 and 8 to illustrated common ownership.
- 706.02(m) Form paragraphs have been revised.
- 706.03(a) Form paragraph has been revised.

- 706.03(c) Form paragraphs have been revised.
- 706.03(d) Form paragraph has been revised.
- 706.07 Revised to reflect amendments to 37 CFR 1.113.
- 706.07(f) Form paragraph has been revised.
- 706.07(h) Revised to indicate that applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered. Revised to add a chart to illustrate what the submission must include based on the status of the application. Also revised to indicate that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications. If an applicant files a transmittal letter that is ambiguous as to whether it is a CPA or an RCE in an application filed on or after June 8, 1995, the Office will treat the transmittal letter as an RCE. If the application is a design application, the Office will treat the transmittal letter as a request for a CPA since RCE practice does not apply to design applications. Revised to indicate that all amendments filed as of the date the RCE is filed are entered in the order in which they are filed in the absence of any specific instructions for entry. Also revised to indicate that if a reply to a final Office action is outstanding and the submission is not fully responsive and is not a *bona fide* attempt to provide a complete reply, the RCE will be treated as an improper RCE and the improper RCE will not toll the period for reply to the final Office action. Form paragraphs have been revised. Forms have been updated to reflect current forms.
- 707 Form paragraphs have been revised. Form PTOL-326 has been updated.
- 707.05 Added reference to IFW processing.
- 707.05(a) Added reference to IFW processing.
- 707.05(e) Added reference to IFW processing.
- 707.05(g) Form paragraph has been revised.
- 707.07(a) Form paragraph has been revised.
- 707.07(i) Added reference to IFW processing.
- 707.07(j) Form paragraphs have been revised.

- 707.08 Form paragraphs have been revised.
- 707.10 Added reference to IFW processing.
- 707.12 Added reference to IFW processing.
- 707.13 Added reference to IFW processing.
- 708 Added reference to *inter partes* reexamination.
- 708.01 Revised to reflect amendments to 37 CFR 1.102.
- 708.02 Revised to reflect amendments to 37 CFR 1.102. Subsection VIII. has been revised to clarify that the pre-examination search must be directed to the invention as claimed in the application for which special status is requested. Also revised to clarify that a search made by a foreign patent office satisfies the requirement of a pre-examination search if the claims in the corresponding foreign application are of the same or similar scope to the claims in the U.S. application for which special status is requested. Added reference to IFW processing.
- 708.03 Added reference to IFW processing.
- 709 Revised to reflect amendments to 37 CFR 1.103. Revised to indicate that effective July 14, 2003, CPA practice is only available for design applications. Form PTO/SB/37 has been updated to reflect the current form that is available on the USPTO web site.
- 710.02 Added reference to MPEP Chapter 2600 for *inter partes* reexamination.
- 710.02(b) The discussion under the heading “Period For Reply Restarted” has been revised.
- 710.02(e) Revised to indicate that hand-carried requests for extension of time will no longer be accepted in the TCs. They may only be delivered to the Customer Window.
- 710.06 Added reference to IFW processing.
- 711.01 Form paragraph has been revised. Added discussion of recent Federal Circuit decision. Revised to indicate that applicants are strongly encouraged to hand-carry a petition to withdraw an application from issue to the Office of Petitions to allow sufficient time to process the petition and if the petition is granted, withdraw the application from issue. Also revised to indicate that a petition under 37 CFR 1.138(c) for express

abandonment to avoid publication may be (1) mailed to Mail Stop Express Abandonment, (2) faxed to the Pre-Grant Publication Division, or (3) hand-carried to the Pre-Grant Publication Division. Form PTO/SB/24 has been updated to reflect the current form that is available on the USPTO web site.

- 711.02 Form paragraph has been revised.
- 711.02(b) The reference to FWC applications filed under former 37 CFR 1.62 has been deleted.
- 711.03(c) Revised to reflect amendments to 37 CFR 1.137. Former subsections I and II directed to petitions to withdraw a holding of abandonment have been combined as a single subsection I. Added discussion regarding untimely petition to withdraw holding of abandonment. The discussion regarding reply requirement under the subsection directed to petitions to revive an abandoned application or accept late payment of issue fee has been clarified to indicate that a petition for extension of time under 37 CFR 1.136 and a fee for such an extension are not required to be included with the reply. The forms have been updated to reflect the current forms that are available on the USPTO web site.
- 711.03(d) Revised to reflect amendments to 37 CFR 1.181.
- 711.04 Revised the discussion to reflect amendments to 37 CFR 1.14.
- 711.04(b) Added reference to IFW processing.
- 713.01 Revised to reflect amendments to 37 CFR 1.133. Revised to indicate that applicants are encouraged to use form PTOL-413A, "Applicant Initiated Interview Request," however, the fact that applicants do not submit this form is not, by itself, grounds for the examiner to deny a request for an interview. Added reference to IFW processing.
- 713.04 Added reference to IFW processing.
- 713.05 Revised to indicate that a practitioner cannot authorize other registered practitioners to conduct interviews without the consent of the client after full disclosure (37 CFR 10.57(c)) and furthermore, a practitioner cannot authorize a nonpractitioner to conduct interviews since this would be contrary to 37 CFR 10.47.
- 713.08 Added reference to IFW processing.
- 714 The revised manner of making amendments which became effective on July 30, 2003 has been added.

- 714.01(e) Subsections added. Revised to indicate that a preliminary amendment must comply with the requirements of 37 CFR 1.121.
- 714.02 Revised to reflect amendments to 37 CFR 1.111.
- 714.03 Revised to indicate that if an amendment submitted on or after July 30, 2003 fails to comply with 37 CFR 1.121, applicant will be notified by a Notice of Non-Compliant Amendment. Applicant's reply to the notice should consist of a corrected version of only that portion of the amendment that previously failed to comply with 37 CFR 1.121. It is not necessary to resubmit the entire amendment document. Added discussion of recent Federal Circuit decision.
- 714.03(a) Revised to reflect amendments to 37 CFR 1.115.
- 714.13 Revised to indicate that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications. Form paragraph has been revised. Also revised to indicate that hand-carried papers for the TCs may only be delivered to the Customer Window. Added reference to IFW processing.
- 714.16 Revised to reflect amendments to 37 CFR 1.312. Revised to indicate that an amendment under 37 CFR 1.312 must be filed on or after the date the issue fee is paid, except where the amendment is required by the Office of Patent Publication.
- 714.16(d) Revised to indicate that hand-carried amendments are no longer accepted in the TC. The amendments may only be delivered to the Customer Window. Added discussion regarding IFW processing. Added a subsection to address amendments required by the Office of Patent Publication.
- 714.16(e) Added reference to IFW processing.
- 714.17 Added reference to IFW processing.
- 714.18 Revised to indicate that evaluation of the amendment after final rejection for compliance with 37 CFR 1.121 should be left to the examiner and not treated by the technical support staff before forwarding the amendment to the examiner. If the examiner determines that the amendment does not comply with 37 CFR 1.121, a Notice of Non-Compliant Amendment should be attached to the Advisory Action.
- 714.22 Revised to reflect amendments to 37 CFR 1.121.

- 714.23 Added reference to IFW processing.
- 714.24 Added discussion regarding a marked-up version of the replacement paragraph or section of the specification.
- 714.25 Revised to reflect amendments to 37 CFR 1.3.
- 715 Form paragraph has been revised.
- 715.04 Revised to clarify that if a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the 37 CFR 1.131 affidavit may be signed by the 37 CFR 1.47 applicant or the legal representative of the deceased or incapacitated inventor, as appropriate.
- 715.05 Revised to indicate that if the reference is a U.S. application publication under 35 U.S.C. 122(b) which claims the same invention as the application being examined and its publication date is more than one year prior to the presentation of claims to that invention in the application under examination, a rejection of the claims in the application under examination under 35 U.S.C. 135(b)(2) should be made only if the application under examination was filed after the publication date of the reference.
- 719.01 Added reference to IFW processing.
- 719.01(a) Added reference to IFW processing.
- 719.01(b) Added reference to IFW processing.
- 719.02 Added reference to IFW processing.
- 719.02(b) Revised to indicate that for a patent application publication to be published with a new residence, the information must be entered into the Office electronic records at least nine weeks before the publication date of the application. For a patent to issue with the new residence, applicants are strongly encouraged to file an ADS showing the new residence information.
- 719.04 Added reference to IFW processing.
- 719.05 Added reference to IFW processing. Table 1 has been revised. The “Search Request Form” has been updated.
- 719.07 Added reference to IFW processing.

- 720 Revised to reflect amendments to 37 CFR 1.292. Added reference to IFW processing. Also revised to indicate that hand-carried petitions under 37 CFR 1.292 and replies may only be delivered to the Customer Window.
- 724.02 The examples of appropriate labels for envelope or container with trade secret, proprietary and/or protective order materials have been revised. Also revised to indicate that these envelope or container should be hand-carried to the Customer Window.
- 724.04 Revised to indicate that if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14, any material submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.
- 724.04(a) Revised to indicate that if the application file and contents are available to the public pursuant to 37 CFR 1.11 or 1.14, any material submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.
- 724.04(b) Revised to indicate that material submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.
- 724.04(c) Revised to indicate that material submitted under MPEP § 724.02 will only be released to the public with any other application papers if no petition to expunge was filed prior to the mailing of a notice of allowability or notice of abandonment, or if a petition to expunge was filed and the petition was denied.
- 724.05 Revised to indicate that a petition to expunge should accompany the submission of the information and in any event, must be submitted in sufficient time that it can be acted on prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to the mailing of a NIRC for reexamination proceedings.
- 724.06 Revised to reflect amendments to 37 CFR 1.59. Form paragraphs have been revised.

## **CHAPTER 1000:**

- 1001 The title of this section has been changed to read “Statutory Authority of Director of the USPTO.” Revised to reflect amendments to 35 U.S.C. 2 and 3.
- 1001.01 Revised to change “Commissioner” to “Director.”
- 1002 The title of this section has been changed to read “Petitions to the Director of the USPTO.” Revised to reflect amendments to 37 CFR 1.181.
- 1002.02 Revised to change “Commissioner” to “Director of the USPTO.”
- 1002.02(b) The address for sending petitions decided by the Office of the Deputy Commissioner for Patent Examination Policy has been changed. Revised to add petitions to withdraw patent applications from issue after payment of the issue fee (item 33) and petitions to expunge papers from patent application or patent files where the papers were not submitted under MPEP § 724.02 or as part of the IDS (item 34).
- 1002.02(c) Added items 20 to 22.
- 1002.02(d) Revised to delete “requests for second or subsequent change of inventorship in application under 37 CFR 1.48” since all requests for correction of inventorship are decided by primary examiners as noted in MPEP § 1002.02(e).
- 1002.02(i) The title of this section has been changed to read “Petitions Decided by the Commissioner for Trademarks.”
- 1002.02(k)(1) The title of this section has been changed to read “Petitions and Matters Decided by the General Counsel.” Items 2 to 4 have been added since these petitions and matters have been delegated to the General Counsel.
- 1002.02(o) The title of this section has been changed to read “Petitions and Matters Decided by the Deputy Director of the USPTO.” Items 3 and 4 have been moved to MPEP § 1002.02(k)(1) and items 5 and 6 have been combined and moved to MPEP § 1002.02(k)(1).
- 1002.02(p) Revised to change “Commissioner” to “Director of the USPTO.” Reference to 37 CFR 1.44 in item 10 has been deleted since this rule has been removed and reserved.
- 1002.02(r) Added item 4.
- 1003 Added item 19.

1005 Revised to indicate that withdrawal of final rejection requires the signature of a primary examiner.

**CHAPTER 1100:**

1101 Added reference to MPEP § 1120 *et seq.* for information pertaining to eighteen months publication of patent applications. Form PTO/SB/94 has been updated to reflect the current form that is available on the USPTO web site.

1103 Revised to reflect the current SIR forms.

1105 Revised to reflect amendments to 37 CFR 1.295.

1107 Added reference to IFW processing.

1109 Revised to reflect the current SIR forms.

1120 New section added to discuss eighteen-month publication of patent applications.

1121 New section added to discuss content of a patent application publication.

1122 New section added to discuss requests for nonpublication.

1123 New section added to discuss rescission of a nonpublication request.

1124 New section added to discuss notice of foreign filing.

1125 New section added to discuss express abandonment to avoid publication.

1126 New section added to discuss publication fees.

1127 New section added to discuss notice of publication.

1128 New section added to discuss availability of published applications.

1129 New section added to discuss request for early publication.

1130 New section added to discuss republication and correction of patent application publications.

1132 New section added to discuss requests for redacted publication.

1133 New section added to discuss requests for voluntary publication.

- 1134 New section added to discuss third party inquiries and correspondence in a published application.
- 1134.01 The subject matter in former MPEP § 610 has been moved to this section.
- 1135 New section added to include PGPUB forms.

**CHAPTER 1300:**

- 1302.01 Revised to indicate that if an application is an IFW application, any changes made by the examiner to the specification must be by way of a formal examiner's amendment. Added a reference to MPEP § 1302.04 for changes to the abstract by examiner's amendment.
- 1302.03 Form PTOL-37 has been updated.
- 1302.04 Revised to indicate that informal examiner's amendments are not permitted if the application is an IFW application. Form paragraphs have been revised. Also revised to indicate that substantive changes made by the examiner to the abstract must be done by a formal examiner's amendment after first obtaining approval from the applicant. Furthermore, no examiner's amendment, whether formal or informal, may make substantive changes to the written portions of the specification without first obtaining applicant's approval. Also revised to indicate that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications.
- 1302.04(f) Revised to indicate that any changes made by the examiner to an IFW application must be by way of a formal examiner's amendment.
- 1302.05 Revised to indicate that if the corrected drawings submitted by the applicant in response to a Notice of Allowability are still not acceptable, the Publishing Division will mail a notice giving applicant a non-extendable period to file the corrected drawings.
- 1302.05(a) Revised to indicate that where the original drawings cannot be located and the replacement drawings are not acceptable for publishing, an attachment to the Notice of Allowability should explain the problem and require the corrected drawings. If the attachment is not included with the Notice of Allowability, the Publishing Division will mail a notice giving applicant a non-extendable period to file the corrected drawings.
- 1302.09 The title of this section has been changed to read "Classification, Print Figure, and other Notations." Revised to indicate that for an IFW application, an Issue Classification sheet is to be completed.

- 1302.10 Revised to indicate that if the application is an IFW application, the issue classification information should be put on the Issue Classification sheet.
- 1302.12 Added reference to form PTO/SB/08. Revised to indicate that when preparing an application for allowance, the technical support staff will also verify that each reference on the IDS has either been initialed by the examiner or lined-through by the examiner.
- 1302.14 Revised to indicate that it is improper to use a statement of reasons for allowance to attempt to narrow a claim by providing a special definition to a claim limitation which is argued by the applicant, but not supported by a special definition in the description in cases where the ordinary meaning of the term in the prior art demonstrates that the claim remains unpatentable for the reasons of record, and where such claim narrowing is only tangential to patentability. Added example (I) to show that a statement of reasons for allowance should be added to the record in this situation. Form paragraph has been revised. Also revised to indicate that the examiner's statement of reasons for allowance should not create an *estoppel*, only applicant's statements should create an *estoppel*. The failure of applicant to comment on the examiner's statement of reasons for allowance should not be treated as acquiescence to the examiner's statement.
- 1303 Revised to reflect amendments to 37 CFR 1.311. Revised to indicate that the Notice of Allowance and Issue Fee Due form (PTOI-85) has been revised and the revised form is entitled "Notice of Allowance and Fee(s) Due."
- 1303.01 Revised to indicate that any paper filed after receiving the Issue Notification should include the indicated patent number, unless the application has been withdrawn from issue.
- 1303.02 Revised to add discussion of IFW processing.
- 1306 Revised to indicate that the issue fee and any required publication fee are due 3 months from the date of the notice of allowance.
- 1306.02 Revised to indicate that any request for simultaneous issuance of patents must be addressed to Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Attention: Office of Patent Publication.
- 1306.03 Revised to indicate that duplicate filing of papers is not recommended and may be treated as a failure to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704(c)(10).

1308 Revised to indicate that effective July 14, 2003, CPA practice is available only for design applications. Also revised to indicate that applicants are encouraged to hand-deliver a petition to withdraw an application from issue to the Office of Petitions to allow sufficient time to process the petition and if the petition can be granted, withdraw the application from issue. Form paragraph has been revised.

1308.01 Added reference to IFW processing.

1309 Revised to indicate that the Initial Data Capture (IDC) process takes approximately 5 weeks and during this time, the application (if in a paper file) is not available for purposes of making copies of the application. Also revised to indicate that recording of the assignment or submission of the assignment for recordation is required for a patent to issue to an assignee.

1309.02 Added reference to IFW processing.

#### **CHAPTER 1400:**

1400.01 Added reference to MPEP Chapter 2600 for *inter partes* reexamination.

1402 Revised to indicate that in the situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application and the patent to be reissued resulted from a utility or plant application that was filed on or after November 29, 2000, the reissue applicant must also file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. Also revised to indicate that a reissue may be based on a drawing correction that is substantive in nature.

1404 Added reference to IFW processing.

1405 New section added to discuss reissue and patent term.

1406 New section added to discuss citation and consideration of references cited in the original patent.

1410 Revised to indicate that for expedited processing, new and continuing reissue application filings may be addressed to Mail Stop REISSUE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Mail Stop REISSUE should only be used for the initial filing of reissue applications and should not be used for any subsequently filed correspondence in reissue applications.

- 1410.01 Revised to reflect amendments to 37 CFR 3.73. Revised to indicate who needs to sign a reissue oath or declaration where an inventor is to be added or where one or more inventors are being deleted. Also revised to indicate when a copy of the assignee consent from the parent reissue application should be accepted in a continuation reissue application. Form paragraphs have been revised.
- 1411 Revised to indicate that a full copy of the printed patent is used to provide the abstract, drawings, specification, and claims of the patent for the reissue application. Each page of the patent must appear on only one side of each individual page of the reissue application. A two-sided copy is improper.
- 1411.01 Revised to indicate that if the certificate of correction changes are too extensive, the examiner may request a clean copy of the specification. In order for the clean copy to be entered as a substitute specification, the reissue applicant must file a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.125(d) and 1.173(a)(1). The examiner's request for the clean copy will generally serve as sufficient basis for granting the petition.
- 1412.01 A new subsection has been added to discuss the failure to timely file a divisional application prior to the issuance of the original patent.
- 1412.02 Revised to reflect updated reissue recapture guidelines. A new flow chart has been added. Form paragraph has been revised.
- 1412.03 Revised to add an example to illustrate new category of invention added in a reissue application is generally not broadening.
- 1412.04 Revised to clarify that where a reissue application seeks to correct inventorship in the patent and the inventors are required to sign the reissue oath or declaration due to a broadening of any claims of the original patent, the correct inventive entity must sign the reissue oath or declaration.
- 1413 Revised to reflect amendments to 37 CFR 1.173.
- 1414 Revised to add a discussion regarding copy of the reissue oath or declaration from the parent reissue application being filed in a continuation reissue application. Forms PTO/SB/51 and PTO/SB/52 have been updated to reflect the current forms that are available on the USPTO web site.
- 1414.01 Revised to indicate that a supplemental reissue oath or declaration will not be effective for any errors which are corrected by a filing made after the

execution of the supplemental reissue oath or declaration, unless it is clear from the record that the parties executing the document were aware of the nature of the correction when they executed the document. Form PTO/SB/51S has been updated to reflect the current form that is available on the USPTO web site.

- 1415 Form PTO/SB/56 has been updated to reflect the current form that is available on the USPTO web site.
- 1415.01 Revised the instructions for obtaining the history of maintenance fees. Also revised to indicate that the issuance of one or more reissue patents does not alter the schedule of payments of maintenance fees on the original patent.
- 1417 Added reference to IFW processing. Revised to indicate that reissue is also available to correct the “error” in failing to take any steps to obtain the right of foreign priority before the original patent was granted.
- 1418 Revised to indicate that the Office imposes no responsibility on a reissue applicant to resubmit, in the reissue application, all the references cited in the patent for which reissue is sought. Rather, applicant has a continuing duty under 37 CFR 1.56 to timely apprise the Office of any information which is material to the patentability of the claims under consideration in the reissue application. The text has been rearranged.
- 1430 Added reference to IFW processing.
- 1431 This section on notice to be placed in the patented file identifying the reissue application has been deleted.
- 1441.01 Revised to indicate that since reissue applications are not published under 35 U.S.C. 122, pursuant to 37 CFR 1.291(a)(1), a protest may be filed throughout the pendency of the reissue application prior to the date of mailing of a notice of allowance subject to the timing constraints of the examination. Added reference to IFW processing.
- 1442.02 Added reference to MPEP § 2686 directed to *inter partes* reexamination.
- 1442.05 The title of this section has been changed to read “Court Ordered Filing of Reissue Application.” Added discussion of Federal Circuit decision which held that a district court in an infringement case could not compel a patentee to seek reissue by the USPTO.
- 1442.05(a) This section has been deleted.
- 1442.05(b) This section has been deleted.

- 1443 Added reference to IFW processing.
- 1448 Form paragraph has been revised.
- 1449 Revised to indicate that after the reissue application has been reviewed by the OPLA, the reissue application with the protest will be returned to the examiner.
- 1449.01 New subsection headings have been added. Added discussion on reissue application and a reexamination proceeding that are pending concurrently on a patent.
- 1450 The title of this section has been changed to read “Restriction and Election of Species Made in Reissue Application.” Revised to indicate that where a restriction requirement is made by the examiner in the reissue application, applicant will be informed in the Office action that if the original claims are found allowable, and a divisional reissue application has been filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional reissue application.
- 1451 Added reference to IFW processing. Revised to indicate that whenever a divisional reissue application is filed with a copy of the reissue oath or declaration and assignee consent from the parent reissue application, the copy of the assignee consent from the parent reissue application should not be accepted. Revised to add a discussion regarding copy of the reissue oath or declaration from the parent reissue application being filed in a continuation reissue application.
- 1453 Revised to reflect amendments to 37 CFR 1.121 and 1.173. Additional examples regarding amendments in reissue applications have been added.
- 1455 Added reference to IFW processing.
- 1456 Revised to indicate that TC SPREs monitor and review all reissue applications in the TC. TC QASs perform patentability review in a sample of reissue applications.
- 1457 New section added to discuss design reissue applications.
- 1460 Added a discussion regarding intervening rights.
- 1470 Added reference to IFW processing. Revised to indicate that requests for copies of papers in the reissue application file must be in writing and addressed to Mail Stop Document Services, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

- 1480 Revised to reflect amendments to 37 CFR 1.322. The address of the Certificate of Correction Branch has been updated.
- 1480.01 New section added to discuss expedited issuance of certificate of correction – error attributable to the Office.
- 1481 The title of this section has been changed to read “Certificates of Correction – Applicant’s Mistake.” Added discussion of recent Federal Circuit decision. Revised to reflect amendments to 37 CFR 1.324. Form paragraphs have been revised.
- 1485 The address of the Certificate of Correction Branch has been updated. Added reference to IFW processing. Form PTO/SB/44 has been updated to reflect the current form that is available on the USPTO web site.
- 1490 Added reference to IFW processing. Form paragraphs have been revised. Form PTO/SB/43 has been updated to reflect the current form that is available on the USPTO web site.

#### **CHAPTER 1500:**

- 1502 Form paragraph has been revised.
- 1502.01 Revised to clarify that articles of manufacture may possess both functional and ornamental characteristics. Also revised to indicate that effective July 14, 2003, continued prosecution application (CPA) practice is only available for design applications.
- 1503.01 Added discussion of the form and content of a design claim. Revised to indicate that statements which describe or suggest another embodiment of the claimed design having a shape and appearance that would be evident from the one shown are permitted in the specification of an issued design patent. Form paragraphs have been revised.
- 1503.02 Revised to indicate that certain deficiencies in the drawings may render the design nonenabling and indefinite under 35 U.S.C. 112, first and second paragraphs. Also revised to indicate that a grantable petition to accept color photographs or color drawings must explain that they are necessary because color is an integral part of the claimed design. Form paragraphs have been revised.
- 1504 Revised to clarify that ornamentality, novelty, nonobviousness, enablement and definiteness are necessary prerequisites to the grant of a design patent. Also revised to indicate that if a reply to an Office action

overcomes a rejection, the rejection must be indicated as withdrawn in the next Office action, unless such action is a notice of allowability.

- 1504.01(c) Revised to rewrite explanation of the proper evidentiary basis for a rejection under 35 U.S.C. 171 that a claim is lacking in ornamentality. Also revised to explain that attorney's arguments are not a substitute for evidence to rebut a *prima facie* case of lack of ornamentality. Revised to clarify that the requirements for visibility of the design and creation for the purpose of ornamenting must be met for a rejection under 35 U.S.C. 171 to be overcome if the design would be hidden during its end use. Form paragraphs have been revised.
- 1504.02 Form paragraphs have been revised.
- 1504.03 Form paragraphs have been revised.
- 1504.04 Revised to clarify that claims must be analyzed to determine whether they comply with the requirements of both the first and second paragraphs of 35 U.S.C. 112, and to provide further guidance with respect to these analyses. Also revised to clarify that an amendment that changes the scope of a design by either reducing certain portions of the drawing to broken lines or converting broken line structure to solid lines is not a change in configuration. Form paragraphs have been revised.
- 1504.05 Revised to indicate that a clear admission on the record that embodiments are not patentably distinct will not overcome a requirement for restriction if the embodiments do not have the same basic overall appearances. Also revised to clarify that examiners must include a brief explanation of the differences between the embodiments that render them patentably distinct. Added guidance with respect to determining whether embodiments of different scope can be retained in a single application. Added discussion of traversal of a restriction requirement. Form paragraphs have been revised.
- 1504.06 Revised to clarify that an obviousness-type double patenting rejection is appropriate where the conflicting designs have overall appearances that are basically the same, and the differences between them must either be minor and patentably indistinct or obvious to a designer of ordinary skill in the art. Form paragraphs have been revised.
- 1504.10 Revised to indicate that the United States will recognize claims for the right of priority under 35 U.S.C. 119(a)-(d) based on applications filed under the "European Community Design." Form paragraphs have been revised.

- 1504.20 Revised to indicate that a later filed application that changes the scope of a design claimed in an earlier application by reducing certain portions of drawings to broken lines is not a change in configuration. Form paragraphs have been revised.
- 1504.30 Revised to update delivery and mailing information pertaining to requests for expedited examination under 37 CFR 1.155.
- 1509 Added discussion of drawing views with respect to design reissue applications.
- 1512 Form paragraphs have been revised.

#### **CHAPTER 1700:**

- 1701.01 Revised to reflect issuance of 37 CFR Part 104, Subpart C, which sets forth policies and procedures regarding employee testimony and production of documents in legal proceedings. Also revised to indicate that a request by a third party to take deposition testimony of a patent examiner in a pending *ex parte* reexamination proceeding will generally be denied.
- 1703 Revised to indicate that the *Official Gazette – Patents* (eOG:P) and the *Official Gazette – Trademarks* are published electronically, and to explain how the information in the eOG:P can be browsed. Also revised to indicate that special and regular notices of the Office are published in the *Official Gazette Notices*, both as part of the eOG:P and as a separate publication.
- 1705 Revised to reflect differences in procedures for reporting an examiner's action in applications maintained in paper form and in IFW applications.
- 1706 Revised to add a brief description of provisional patent applications, and to encourage inventors to file a provisional patent application instead of a Disclosure Document. Also revised to update the mailing address of the USPTO and to update the Patent and Trademark Depository Libraries (PTDLs) that are authorized to accept documents under the Disclosure Document Program.
- 1730 Revised to include additional information pertaining to Patent Application Information Retrieval (PAIR) and the Electronic Filing System (EFS). Also revised to update USPTO facility and contact information.

## CHAPTER 1800:

- 1801 Revised to reflect amendments to PCT rules and CFR Title 37 that took effect on January 1, 2004.
- 1805 Revised to include new mailing address for international applications and related papers: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
- 1807 Revised to reflect amendments to PCT Rule 90 and 37 CFR 1.455, and to indicate that the USPTO, when acting in its capacity as a receiving Office, International Searching Authority, or International Preliminary Examining Authority, will in most cases waive the requirement for a separate power of attorney and copy of the general power of attorney in international applications having an international filing date on or after January 1, 2004.
- 1808 Revised to reflect amendments to PCT Rule 90 and 37 CFR 1.455.
- 1810 Revised to reflect amendments to 37 CFR 1.431 and to expand discussion of PCT Rule 19.4 to include discussion of international applications filed with the USPTO that are not in the English language.
- 1812 Revised to refer to WIPO's web site ([www.wipo.int/pct/en/index.html](http://www.wipo.int/pct/en/index.html)) as a source of the PCT request (Form PCT/RO/101) and to replace discussion of PCT-EASY with discussion of PCT-SAFE.
- 1817 Revised to update list of PCT Contracting States and to indicate that a current listing is maintained on WIPO's web site ([www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax\\_a.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax_a.pdf)).
- 1817.01 Revised to discuss international applications having an international filing date on or after January 1, 2004. Information regarding the designation of states and precautionary designations in applications filed before January 1, 2004 moved to newly added MPEP § 1817.01(a).
- 1817.01(a) Added new section. Includes the information formerly in MPEP § 1817.01.
- 1817.02 Revised to reflect treatment as a continuation or continuation-in-part now provided for in PCT Rule 4.11(a)(iv).
- 1819 Revised to reflect amendments to PCT Rule 4 and 37 CFR 1.445. Applicant is entitled to reduced search fee only if the prior nonprovisional application is identified as specified in 37 CFR 1.445(a)(2)(i).

- 1820 Revised to reflect amendments to PCT rules and CFR Title 37 regarding signature requirements on the international application and powers of attorney. Also revised to include the procedure for naming a legal representative of a deceased inventor as the applicant.
- 1821 Revised to reflect amendments to the PCT rules and CFR Title 37, to reflect the replacement of PCT-EASY with PCT-SAFE, to include WIPO's web site ([www.wipo.int/pct/en/forms/index.htm](http://www.wipo.int/pct/en/forms/index.htm)) as a source of the request form, and to include the date format now provided in Administrative Instructions Section 110.
- 1823 Revised to reflect amendments to Administrative Instructions Section 209.
- 1823.01 Revised to reflect amendments to Administrative Instructions Section 209.
- 1823.02 Revised to reflect amendments to Administrative Instructions Section 803 and to include Alexandria mailing address for submissions under PCT Administrative Instructions - Part 8.
- 1827 Revised to reflect amendments to the PCT rules eliminating designation fees for applications filed on or after January 1, 2004.
- 1830 Revised to update the list of submissions specifically covered by Form PTO-1382.
- 1840 Revised to reflect amendments to 37 CFR 1.413.
- 1840.01 Revised to reflect changes regarding when the EPO is a competent International Searching Authority for residents and nationals of the U.S.
- 1842 Revised to include time limits for applications filed on or after January 1, 2004.
- 1843 Revised to include a discussion of the written opinion of the International Searching Authority (PCT Rule 43*bis*).
- 1843.01 Material formerly in MPEP § 1843 moved to this added new section. Supplemented with information from the PCT Search and Examination Guidelines relating to conducting the international search, citing documents on the international search report, and establishing the written opinion of the International Searching Authority.
- 1843.02 Material formerly in MPEP § 1843 moved to this added new section.
- 1843.03 Material formerly in MPEP § 1843 moved to this added new section.

- 1843.04 Added new section to explain ISA procedure for claims not required to be searched and for claims that are unclear.
- 1843.05 Added new section. Includes subject matter formerly in MPEP § 1844.01.
- 1844 Revised for consistency with Form PCT/ISA/210 (January 2004).
- 1844.01 Revised to include information useful to the examiner preparing the international search report and to include a completed copy of updated Form PCT/ISA/210 (January 2004).
- 1845 Added new section explaining new PCT Rule 43*bis*, the written opinion of the International Searching Authority.
- 1845.01 Added new section useful to the examiner when preparing the written opinion of the International Searching Authority. Includes a completed copy of new Form PCT/ISA/237 (January 2004).
- 1845.02 Added new section useful to the examiner when preparing the Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority. Includes a completed copy of revised Form PCT/ISA/220 (January 2004).
- 1846 Revised to reflect the current status of PCT Rules and Administrative Instructions.
- 1847 Revised to reflect the revision of 37 CFR 1.446(c) to include “Director” and “Director’s” instead of the “Commissioner” and “Commissioner’s.”
- 1849 Section deleted. Subject matter moved to MPEP § 1843.02.
- 1850 Revised to include a more complete discussion of the requirement for unity of invention, the invitation to pay additional fees (PCT/ISA/206), and telephonic unity practice. Also revised to indicate that if a written invitation is required, the examiner should, if possible submit that written invitation to the TC for review and mailing within 7 days from the date the international application is charged to the examiner. Also revised to include the form paragraphs formerly reproduced in MPEP § 1875.01.
- 1851 Revised to cite documents using new date formats provided in Administrative Instructions Section 110 and to update information reproduced from WIPO Standard ST.16 and WIPO Standard ST.3.
- 1857 Updated to reference new rules and to include current information on electronic publication of international applications.

- 1859 Revised to include a more complete discussion of withdrawals under PCT Rule 90*bis*, with the exception of withdrawals under PCT Rule 90*bis*.4, which are discussed in MPEP § 1880.
- 1860 Revised to discuss international applications having an international filing date on or after January 1, 2004. Information regarding the international preliminary examination procedure applicable to applications filed before January 1, 2004 moved to newly added MPEP § 1860.01.
- 1861 Section deleted.
- 1860.01 Added new section. Includes the information formerly in MPEP § 1860.
- 1864 Revised to reflect amendments to 37 CFR 1.480.
- 1864.01 Revised to include an overview of amendments filed under PCT Article 34.
- 1864.03 Revised to indicate the filing of a demand after January 1, 2004 shall constitute the election of all Contracting States which are designated and bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).
- 1865 Addresses for use when filing a demand in the USPTO updated. Demand (Form PCT/IPEA/401) was replaced with January 2004 version.
- 1865.01 Revised to reflect changes regarding when the EPO is a competent International Examining Authority for residents and nationals of the U.S.
- 1866 Reference to “14 digit” PCT application number eliminated in view of amendments to Administrative Instructions Section 307.
- 1867 Revised to reflect amendments to 37 CFR 1.481. For demands filed on or after January 1, 2004, 37 CFR 1.481(a) provides that the preliminary examination fee or handling fee payable is the preliminary examination fee or handling fee in effect on the date of payment.
- 1868 Revised to reflect amendments to PCT Rule 60.1 and deletion of PCT Rule 60.2.
- 1871 Revised to discuss international applications having an international filing date on or after January 1, 2004. Information regarding the processing of amendments at the start of international preliminary examination for applications filed before January 1, 2004 was moved to newly added MPEP § 1871.01.

- 1871.01 Added new section. Includes the information formerly in MPEP § 1871.
- 1873 Section deleted.
- 1875 Revised to include a discussion of treatment (permitted by national stage offices under PCT Article 34(3)(c)) of parts of the international application which do not relate to the main invention.
- 1875.01 Revised to indicate that if a written invitation is required, the examiner should, if possible, submit that written invitation to the TC for review and mailing within 7 days from the date the international application is charged to the examiner. Form paragraphs formerly in this section were moved to MPEP § 1850.
- 1878 Revised to discuss written opinions of the IPEA in international applications having an international filing date on or after January 1, 2004. Information relating to preparing a written opinion in an application filed before January 1, 2004 was moved to newly added MPEP § 1878.01.
- 1878.01 Added new section. Includes the information formerly in MPEP § 1878.
- 1878.01(a) Revised to discuss the “relevant date” for prior art purposes when there is insufficient time for the examiner to make a proper determination as to whether a priority claim is valid. The “relevant date” for the purposes of the written opinion of the ISA will be based on the claimed priority date.
- 1879 Revised to include information relating to the preparation of an IPER in international applications filed on or after January 1, 2004. Also revised to include completed examples of Forms PCT/IPEA/416 (January 2004) and PCT/IPEA/409 (January 2004).
- 1879.01 Revised to discuss the time limit for preparing the IPER in an application having an international filing date on or after January 1, 2004. Subject matter formerly in MPEP § 1879.01 moved to newly added MPEP § 1879.01(a).
- 1879.01(a) Added new section. Includes the information formerly in MPEP § 1879.01.
- 1879.04 Revised to include PCT Rule 44*ter* relating to the confidential nature of the written opinion of the ISA. Also revised to reflect amendments to 37 CFR 1.14.
- 1880 Updated in view of new rules effective for applications filed on or after January 1, 2004, to indicate that pursuant to PCT Rules 90.4(e) and

90.5(d), the requirement for a separate power of attorney or a copy of the general power of attorney shall not be waived in cases of withdrawal.

- 1881 Revised to reflect amendments to PCT Rule 61.2(b) and 61.3.
- 1890 Section deleted.
- 1891 Section deleted.
- 1893.01(a) Revised to reflect amendments to 37 CFR 1.495(c) and (g).
- 1893.01(a)(2) Revised to indicate that if applicant has requested early processing of the national stage application under 35 U.S.C. 371(f), the amendment(s) under PCT Article 19 and the English translation of the amendment(s) must be filed by the time applicant has submitted the basic national fee, an oath or declaration in compliance with 37 CFR 1.497(a)-(b), and any required translation of the international application if such time is earlier than 30 months from the priority date. Otherwise, the amendment(s) will be considered to be canceled.
- 1893.01(a)(3) Revised to indicate that if an amendment introducing “new matter” was entered during the international phase, the U.S. national stage examiner should require removal of the new matter and make any necessary rejections to the claims.
- 1893.01(c) Revised to include discussion of calculation of national stage fees under 37 CFR 1.492 when a preliminary amendment accompanies the initial national stage submission under 35 U.S.C. 371.
- 1893.01(d) Revised to provide additional guidance relating to translations that will not be accepted because they are not translations of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91.
- 1893.03 Revised to indicate the International Publication Number and the Publication Date MUST be in the national stage application if the application is allowed. (This requirement was formerly in MPEP § 1895.01).
- 1893.03(a) Revised to indicate that national stage applications transmitted using a “Utility Patent Application Transmittal” (Form PTO/SB/05) and national stage applications that include a benefit claim under 35 U.S.C. 120 to the international application include conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371. Also revised to indicate that applications that have been processed under 35 U.S.C. 371 and later

found by the examiner to contain conflicting instructions should be forwarded to the Office of PCT Legal Administration for resolution.

- 1893.03(b) Revised to explain the relevance of the “Date of Completion of all 35 U.S.C. 371 Requirements” included on the Notification of Acceptance of Application under 35 U.S.C 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) and to explain how the “Date of Completion of all 35 U.S.C. 371 Requirements” is determined.
- 1893.03(c) Regarding a right of priority under 35 U.S.C. 119(a) and 365(b), revised to indicate that the priority must have been timely claimed in the international stage of the international application (37 CFR 1.55(a)(1)(ii)). Regarding a benefit claim under 35 U.S.C. 119(e) or 120 and 365(c), revised to indicate that if the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional, a petition under 37 CFR 1.78(a)(6) may be filed to accept the delayed claim.
- 1893.03(d) Revised to include the form paragraphs for restricting national stage applications where the claimed invention does not form a single general inventive concept under PCT Rule 13.1.
- 1893.03(e) Revised to indicate that applicants desiring to have the filing receipt reflect a title that is different than the English language title appearing on the cover page of the publication must submit either a preliminary amendment amending the title or an application data sheet (37 CFR 1.76) with the desired title. Also revised to include a discussion of how to use the IPER as a roadmap to determine which version of the application should be examined during its national stage.
- 1895.01 Revised to include a more complete discussion of continuations, divisions, and continuations-in-part of international applications designating the United States. Subsection I deleted as redundant to information provided in MPEP § 1896. Subject matter from subsection I, paragraph F moved to MPEP § 1893.03.
- 1896 Revised to indicate that if a copy of the foreign priority document is not in the national stage application file but applicant asserts that a certified copy of the priority document was timely furnished under PCT Rule 17 in the international phase, then the examiner should consult with a Special Program Examiner in his or her Technology Center.

#### **CHAPTER 2000:**

- 2001.04 Revised to indicate that materiality is not limited to prior art but embraces any information, including information pertaining to enablement, that a

reasonable examiner would likely consider important in making a patentability determination. Also revised to indicate that the Office may order or conduct reexamination proceedings based on prior art that was cited/considered in any prior related Office proceeding.

- 2001.06 Added discussion of recent Federal Circuit decision.
- 2001.06(a) Revised to clarify when there is a strong inference that prior art or other information in any related foreign application brought to the attention of individuals covered by 37 CFR 1.56 is material to patentability.
- 2001.06(b) Added discussion of recent Federal Circuit decision. Also revised to indicate that if the application under examination is identified as a continuation, divisional, or continuation-in-part of an earlier application, the examiner will consider the prior art cited in the earlier application.
- 2001.06(c) Added discussion of where litigation papers that are filed with the Office and relate to a pending reissue application should be forwarded for processing.
- 2001.06(d) Deleted discussion pertaining to issuance of a requirement for information.
- 2003.01 Added cross-references to information pertaining to *inter partes* reexamination.
- 2004 Added discussion of recent Federal Circuit decisions.
- 2005 Added discussion of recent district court decision.
- 2010 Added discussion of when the Board of Patent Appeals and Interferences will consider issues of fraud and/or inequitable conduct in an interference proceeding.
- 2013 Revised to clarify that protest information indicating the presence of fraud, inequitable conduct or violation of the duty of disclosure will be entered in the application file without comment other than a statement that such information will not be considered.
- 2014 Revised to add cross-references to *inter partes* reexamination proceeding information.

#### **CHAPTER 2100:**

- 2106 Added discussion of recent Federal Circuit decisions. Also revised to clarify that in the absence of an express intent to impart a different

meaning, claims terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

- 2111.01 Revised to add discussion of recent Federal Circuit decisions. Also revised to clarify that in the absence of an express intent to impart a different meaning, claims terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.
- 2111.02 Revised to add discussion of recent Federal Circuit decision.
- 2111.03 Revised to add discussion of recent Federal Circuit decisions.
- 2112 Revised to indicate that an inherent feature need not be recognized at the time of the invention. Also revised to add discussion of recent Federal Circuit decisions.
- 2112.01 Revised to indicate that where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art.
- 2116.01 Revised to add discussion of recent Federal Circuit decision.
- 2121.01 Revised to add discussion of recent Federal Circuit decision.
- 2128.01 Revised to indicate that while internal documents intended to be confidential are not “printed publications,” there must be an existing policy of confidentiality or agreement to remain confidential within the organization; mere intent to remain confidential is insufficient.
- 2129 Rewritten to clarify when admissions by applicant constitute prior art.
- 2131.03 Revised to indicate that prior art which teaches a value or range close to, but not overlapping or touching, a claimed range does not anticipate the claimed range.
- 2131.05 Revised to add discussion of recent Federal Circuit decision.
- 2133.03(b) Revised to add discussion of recent Federal Circuit decisions.
- 2133.03(c) Revised to indicate that the sale of a device embodying a claimed process may trigger the on-sale bar.
- 2133.03(e) Revised to add discussion of recent Federal Circuit decision.
- 2133.03(e)(3) Revised to add discussion of recent Federal Circuit decision.

- 2133.03(e)(6) Revised to add discussion of recent Federal Circuit decision.
- 2136.03 Revised to clarify that in order to give subject matter disclosed in a reference available under 35 U.S.C. 102(e) the benefit of an earlier filing date under 35 U.S.C. 119(e), 120, or 365(c), the subject matter must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph.
- 2137.01 Added discussion of recent Federal Circuit decision.
- 2141.01(a) Revised to add discussion of recent Federal Circuit decision and to clarify that the cross-references in the official search notes of the class definitions are some evidence of analogy.
- 2141.03 Revised to indicate that documents not available as prior art because they were not widely disseminated may be used to demonstrate the level of ordinary skill in the art.
- 2143.01 Added discussion of a recent Federal Circuit decision.
- 2145 Revised to indicate that there is no requirement for an express, written motivation to combine to appear in prior art references to support a finding of obviousness.
- 2163 Revised to add discussion of recent Federal Circuit decisions.
- 2163.05 Revised to add discussion of recent Federal Circuit decisions.
- 2164 Revised to indicate that to comply with 35 U.S.C. 112, first paragraph, it is not necessary to enable a skilled artisan to make and use a commercially viable embodiment in the absence of a limitation to that effect.
- 2164.03 Added discussion of recent Federal Circuit decision.
- 2164.05(a) Added discussion of recent Federal Circuit decision.
- 2164.08 Added discussion of recent Federal Circuit decision.
- 2173.01 Revised for consistency with MPEP § 2111.01 to indicate that any special meaning assigned to a claim term must be clearly set forth in the specification.
- 2173.05(a) Revised to add discussion of recent Federal Circuit decision.
- 2181 Revised to add discussion of recent Federal Circuit decisions.

2182 Revised to add discussion of recent Federal Circuit decision.

2184 Revised to add discussion of recent Federal Circuit decision.

#### **CHAPTER 2200:**

A number of the section titles have been revised to indicate that the sections are directed to *ex parte* reexamination.

2201 Added reference to Public Law 107-273 which amended the reexamination statute to expand the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Also added reference to new MPEP Chapter 2600 directed to *inter partes* reexamination. The flowchart has been revised and a new flowchart has been added to illustrate the procedure from time of appeal.

2202 Revised to reflect amendments to 37 CFR 1.502 and 1.902.

2204 Revised to add cross-references to 37 CFR 1.915 and 1.948 for *inter partes* reexamination.

2205 In the examples, the address for submitting prior art under 37 CFR 1.501 to the Office has been updated.

2206 Revised to add cross-references to the *inter partes* reexamination rules.

2207 Revised to add cross-references to *inter partes* reexamination.

2209 Revised to indicate that the paper reexamination file is not available to the public. All public access to and copying of the reexamination file may be made from the electronic format copy.

2211 Revised to clarify that any patent term extensions or adjustments under 35 U.S.C. 154 and any patent term extensions under 35 U.S.C. 156 are taken into account in determining the patent expiration date.

2212 Revised to reflect amendments to 37 CFR 1.510.

2214 Revised to indicate that a copy of the patent for which reexamination is requested should be provided with the specification and claims submitted in a double column format and that the printed patent is to be reproduced on only one side of the paper and that a two-sided copy of the patent is not proper. Form PTO/SB/57 has been updated to reflect the current form that is available on the USPTO web site.

- 2217 Revised to reflect amendment to 35 U.S.C. 102(e) (as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002).
- 2222 Revised the mailing address for submitting change of correspondence address or power of attorney in the record of the patent. Added form PTO/SB/82.
- 2223 Added form PTO/SB/83.
- 2224 Revised to indicate that all requests for *ex parte* reexamination mailed to the Office should be additionally marked “Mail Stop *Ex Parte* Reexam” on the face of the outer envelope to distinguish such requests from *inter partes* reexamination requests. Added reference to MPEP § 2624 for *inter partes* reexamination.
- 2229 Revised to reflect amendments to 37 CFR 1.11. Also revised to indicate that notice of filing of all complete *ex parte* reexamination requests will be published in the *Official Gazette* approximately 4 - 5 weeks after filing.
- 2232 Revised to indicate that in an emergency when the Reexamination Processing System (REPS) terminal in the Patent Search Room is not operative, member of the public should be referred to the Central Reexamination Unit (CRU) as an alternative for viewing only of the reexamination files.
- 2234 Revised to reflect amendments to 37 CFR 1.121.
- 2235 Revised and updated the PALM related activities.
- 2236 Revised to indicate that in situations where a paper directed to the examiner assignment has no right of entry under the rules, the Office may waive the rules to the extent that the paper directed to the examiner assignment will be entered and considered.
- 2238 The project codes have been updated.
- 2239 The title of this section has been changed to read “Reexamination Ordered at the Director’s Initiative.” Revised to reflect amendments to 37 CFR 1.520.
- 2240 Revised to reflect amendments to 35 U.S.C. 303, and 37 CFR 1.515. Also revised to indicate that if a second or subsequent request for *ex parte* reexamination is filed while a first *ex parte* reexamination is pending and if the second or subsequent request includes prior art which raised a substantial new question of patentability in the pending first

reexamination, the second or subsequent request should be granted only if the prior art cited raises a substantial new question of patentability which is different than that raised in the pending first reexamination proceeding. If the same question of patentability is raised then the second or subsequent request should be denied.

- 2241 Revised to clarify that if the 3-month period under 37 CFR 1.515(a) ends on a Saturday, Sunday or Federal holiday within the District of Columbia, then the determination must be mailed by the preceding business day.
- 2242 The discussion of the *In re Portola Packaging* decision has been deleted in view of Public Law 107-273, which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based.
- 2246 Form paragraph has been revised.
- 2247 Revised to indicate the procedures to be followed after the mailing of a decision denying a request for reexamination.
- 2248 Revised to reflect amendments to 37 CFR 1.515.
- 2250 Revised to reflect amendments to 37 CFR 1.121 and 1.52. Form paragraph has been revised. Added reference to MPEP § 2666.01 for form paragraphs to use in *inter partes* reexamination. Added a subsection V. to discuss cross references to other areas.
- 2250.01 Added discussion regarding the procedures to handle new sheets of drawings.
- 2250.02 Revised to reflect amendments to 37 CFR 1.530.
- 2254 Revised to reflect amendments to 37 CFR 1.550.
- 2256 The title of this section has been changed to read “Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination.”
- 2257 Revised to add references to forms PTO/SB/08A, PTO/SB/08B and PTO/SB/42. Also revised to indicate that all citations listed on the form PTO-892 and all citations not lined-through on any form PTO-1449, PTO/SB/08A or 08B, or PTO/SB/42 will be printed on the reexamination certificate.
- 2258 Revised to reflect amendment to 35 U.S.C. 102(e) (as amended by the Intellectual Property and High Technology Technical Amendments Act of

- 2002). Form paragraphs have been revised. Also revised to add discussion on claiming foreign and domestic priority in reexamination.
- 2258.01 New section added to discuss use of previously cited/considered art in rejections. The discussion is directed to reexamination that was ordered on or after November 2, 2002 (date of enactment of Public Law 107-273, which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based) and reexamination that was ordered prior to November 2, 2002 (the decision in *In re Portola Packaging* would apply).
- 2259 The title of this section has been changed to read “*Res Judicata* and Collateral Estoppel in Reexamination Proceedings.” Revised to indicate that since claims finally held invalid by a Federal Court, after all appeals, will be withdrawn from consideration and not reexamined during a reexamination proceeding, a rejection on the grounds of *res judicata* will not be appropriate in reexamination.
- 2260 Form paragraph has been revised.
- 2266 Revised to reflect amendments to 37 CFR 1.111 and 1.550.
- 2266.01 Revised to indicate that where a patent owner’s submission contains a serious deficiency (i.e., omission) and the period for response has expired, or there is insufficient time remaining to take corrective action before the expiration of the period for response, the patent owner should be notified of the deficiency and given a new time period for response. The patent owner must supply the omission within the new time period for response to avoid termination of the proceeding. Form paragraph has been revised.
- 2266.03 Form paragraph has been revised.
- 2268 The title of this section has been changed to read “Petition for Entry of Late Papers for Revival of Reexamination Proceeding.” Revised to reflect amendments to 37 CFR 1.137.
- 2271 Form paragraphs have been revised.
- 2274 Revised to update the correct forms to be used to notify the patent owner that the appeal is dismissed and also to notify the patent owner that the appeal brief is defective.
- 2275 Revised to reflect amendments to 37 CFR 1.193.
- 2280 Revised to reflect amendments to 37 CFR 1.555.

- 2281 Revised to reflect amendments to 37 CFR 1.560.
- 2282 Form paragraphs added.
- 2283 Revised to indicate that the discussion in this section is directed to multiple copending reexamination requests which are filed on the same patent where none of the requests is an *inter partes* request. Added cross-reference to MPEP § 2686.01.
- 2285 Form paragraph has been revised. Added subsection on examiner assignment.
- 2286 Revised to reflect amendments to 37 CFR 1.565. Revised to indicate that if the examiner discovers, during the reexamination proceeding, that there is litigation on the patent, this fact will be brought to the attention of the TC SPRE (rather than the TC Director) prior to any further action by the examiner.
- 2287 Revised to indicate that an examiner's amendment can be made to change the abstract, where the patent owner's narrowing amendments during prosecution of the reexamination have changed the focus of the invention.
- 2288 Revised to reflect amendments to 37 CFR 1.570.
- 2290 Revised to indicate the two exceptions to issuing a reexamination certificate at the close of the *ex parte* reexamination proceeding.
- 2294 Section has been rewritten to identify the four ways that an *ex parte* reexamination proceeding may be terminated.
- 2295 Added a subsection to discuss the situation where the prior reexamination matures to a certificate while the later reexamination is pending.

#### **CHAPTER 2500:**

- 2501 Updated maintenance fee amounts and revised the mailing address for submitting requests to update post-issuance patent information.
- 2504 Revised to indicate that no payment of additional maintenance fees is required for second and subsequent reissue patents.
- 2506 Revised to indicate that maintenance fees cannot be paid in advance.
- 2510 Title revised to indicate that the section addresses submission of maintenance fee payments and documents. Section revised to indicate that maintenance fee payments can be made over the Internet by electronic

funds transfer (EFT), credit card, or deposit account payment methods. Also revised to add mailing address for maintenance fee payments not electronically submitted over the Internet.

- 2515 Revised to reflect amendment to 37 CFR 1.366(b).
- 2520 Revised to indicate that if the term of a patent is shortened, e.g., by a terminal disclaimer, the maintenance fee amount cannot be prorated to cover only the amount of time past the due date before the patent expires.
- 2522 Revised to indicate that money orders and checks must be made payable to the Director of the United States Patent and Trademark Office, but that checks made payable to the Commissioner of Patents and Trademarks will continue to be accepted.
- 2530 Rewritten to set forth guidelines for specially accepting maintenance fee payments containing informalities (inconsistent or missing patent number or application number information). Also revised to recommend that a maintenance fee submission include both a telephone number and a mailing address for the fee submitter in case the Office needs to confirm the patent to which the fee is to be applied. Information pertaining to late or insufficient payment of maintenance fees deleted from this section and moved to new section 2531.
- 2531 Information pertaining to late or insufficient payment of maintenance fees moved to this new section from section 2530, and revised to indicate that that if a payment is deemed insufficient because it was submitted in the small entity amount without a written assertion of entitlement to small entity status, a notice of non-acceptance of the maintenance fee will be mailed to the fee submitter.
- 2532 Added to explain Office treatment of a duplicate maintenance fee received from a second fee submitter.
- 2540 Revised to suggest the use of a current version of the “Fee Address” Indication Form (PTO/SB/47) and, if necessary, a Request for Customer Number (PTO/SB/125) when requesting establishment of a fee address, and to explain the importance of using a Form PTO/SB/47 having a revision date of March 2002 or later. Also revised to indicate that all fee addresses established at the Office will be represented by a customer number.
- 2550 Revised to indicate that if a payment is submitted that conflicts with the Office record of the patentee’s entity status, either a Notice of Overpayment of Maintenance Fee (PTO-211) or a Notice of Non-Acceptance of Small Entity Patent Maintenance Fee (PTO-2140) will be

sent as appropriate. Also revised to explain the time period for reply to each of these notices.

- 2570 Revised to indicate that maintenance fee status information can be requested by telephone, facsimile, or e-mail, or obtained over the Internet at [www.uspto.gov](http://www.uspto.gov).
- 2580 Revised to update mailing address for petitions under 37 CFR 1.377.
- 2590 Revised to update mailing address for petitions under 37 CFR 1.378.
- 2595 Revised to update forms reproduced therein.

#### **CHAPTER 2600:**

2601

- 2696 New Chapter 2600 added to set forth policies and procedures pertaining to optional *inter partes* reexamination pursuant to 35 U.S.C. 311-318 and 37 CFR 1.902 – 1.997. The subject matter appearing in each section of this chapter parallels the subject matter in the corresponding section of Chapter 2200 (Citation of Prior Art and *Ex Parte* Reexamination of Patents) to the extent practicable.

#### **CHAPTER 2700:**

- 2701 Revised to clarify that patents that issue from applications filed before June 8, 1995, are not eligible for patent term extension or patent term adjustment under 35 U.S.C. 154.
- 2710 Revised to clarify that utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension provisions of former 35 U.S.C. 154(b) and 37 CFR 1.701.
- 2720 Revised to indicate that if the patent issues with a different patent term extension value than that indicated on the Notice of Allowance or Office computer records, patentee may seek correction of the information by filing a request for a Certificate of Correction pursuant to 37 CFR 1.322. Also revised to update the mailing address for petitions and Certificates of Correction regarding patent term extension under former 35 U.S.C. 154(b).
- 2731 Added to discuss the period of adjustment of patent term due to examination delay pursuant to 37 CFR 1.703.
- 2732 Added to discuss reduction of the period of adjustment of patent term pursuant to 37 CFR 1.704.

- 2733 Added to discuss the notification of patent term adjustment determination as set forth in the notice of allowance pursuant to 37 CFR 1.705(a).
- 2734 Added to discuss requirements for an application for patent term adjustment pursuant to 37 CFR 1.705(b).
- 2735 Added to discuss requests for reconsideration of the patent term adjustment determination pursuant to 37 CFR 1.705(d).
- 2736 Added to discuss 37 CFR 1.705(f), which indicates that no submission or petition on behalf of a third party concerning patent term adjustment under 35 U.S.C. 154(b) will be considered by the Office.
- 2751 Revised to explain that terminally disclaimed patents are eligible for patent term extension under 35 U.S.C. 156.
- 2754 Revised to update mailing address for applications for patent term extension under 35 U.S.C. 156.

