

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
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MANUAL OF PATENT EXAMINING PROCEDURE
Eighth Edition

Instructions Regarding Revision No. 3

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

- (1) "Revision of Power of Attorney and Assignment Practice," which became effective on June 25, 2004;
- (2) "Changes To Representation of Others Before the United States Patent and Trademark Office," which became effective on July 26, 2004;
- (3) "Elimination of Credit Cards as Payment for Replenishing Deposit Accounts," which became effective on August 23, 2004;
- (4) "Rules of Practice Before the Board of Patent Appeals and Interferences," which became effective on September 13, 2004;
- (5) "Revision of Patent Fees for Fiscal Year 2005," and the correction which became effective on October 1, 2004;
- (6) "Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan," with effective dates of September 21, October 21 and November 22, 2004;
- (7) "Rules of Practice Before the Board of Patent Appeals and Interferences; Correcting Amendments," which became effective on September 30, 2004;
- (8) "Changes To Implement the Patent Fee Related Provisions of the Consolidated Appropriations Act, 2005," which became effective on December 8, 2004;
- (9) "Changes To Implement the Cooperative Research and Technology Enhancement Act of 2004," (interim rules) which became effective on December 10, 2004;
- (10) "Revision of Search and Examination Fees for Patent Cooperation Treaty Applications Entering the National Stage in the United States," (interim rules) which became effective on February 1, 2005;
- (11) "Correspondence With the United States Patent and Trademark Office," which became effective on March 4, 2005;
- (12) "Changes to the Practice for Handling Patent Applications Filed Without the Appropriate Fees," which became effective on July 1, 2005; and
- (13) "Revision of Search and Examination Fees for Patent Cooperation Treaty Applications Entering the National Stage in the United States," which became effective on July 1, 2005.

This revision consists of replacement pages for the **Title Page, Foreword, Table of Contents, and Introduction** in the front of the Manual, **entire Chapters 200 - 900, 1200 - 1400, 1700 - 1900, 2100, 2200, and 2600, 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.**

Chapter 2300 on interference proceedings has not been revised in this revision but will be revised in the next revision. Note that effective September 13, 2004, the rules directed to interference

practice have been revised and are set forth in Part 41, Subparts D and E of title 37, Code of Federal Regulations. Users of the Manual should refer to Appendix R for the revised rules directed to interference practice.

Pages which have been printed in this revision are labeled as “**Rev. 3**” on the bottom. Sections of the Manual that have been changed by this revision are indicated by “[**R-3**]” 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 of the Manual of Patent Examining Procedure

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

CHAPTER 200:

- 201 Revised to add reference to the basic filing fee, search fee and examination fee.
- 201.03 Revised to reflect amendments to 37 CFR 1.48. Also revised to indicate that effective July 1, 2005, the processing and retention fee practice has been eliminated.
- 201.04(b) Revised to reflect amendments to 37 CFR 1.53. Form PTO/SB/16 has been updated.
- 201.05 Revised to clarify the definition of a reissue application.
- 201.06(c) Revised to reflect amendments to 37 CFR 1.63. Also revised to indicate that if applicant wishes to claim the benefit of a prior application under 35 U.S.C. 120, 121 or 365(c), applicant must include a reference to the prior application in compliance with 37 CFR 1.78(a) in the first sentence(s) of the specification or in an ADS. The discussion regarding incorporation by reference has been revised to reflect 37 CFR 1.57, which became effective on September 21, 2004. Form paragraph has been revised. Revised to indicate that any preliminary amendment that is present on the filing date of an application filed under 37 CFR 1.53(b) is part of the original disclosure.
- 201.06(d) Revised to reflect amendments to 37 CFR 1.53. Also revised to reference the basic filing fee, search fee and examination fee and to indicate that no search and examination fees are required for a CPA filed prior to December 8, 2004. The location of the Customer Service Window has been updated. Form paragraphs have been revised. Forms have been updated.
- 201.07 Revised to add reference to MPEP § 201.11.
- 201.08 Revised to add reference to MPEP § 201.11.
- 201.11 The title of this section has been revised. Revised to reflect amendments to 37 CFR 1.78. Form paragraphs have been revised. Material has been rearranged in the section and new subsection headings have been added.
- 201.11(a) Added reference to 35 U.S.C. 365(c) and clarified that the reference to international applications is directed to international applications that have designated the United States.

- 201.12 The title of this section has been revised. Revised to indicate that the assignment records of the USPTO will only reflect an assignment of an application (including a divisional application or a continuation application) if a request for recordation in compliance with 37 CFR 3.28 (along with the required fee) is filed.
- 201.13 Revised to reflect amendments to 37 CFR 1.55. The list of countries to which the right of priority under 35 U.S.C. 119(a)-(d) has been recognized has been updated. The discussion regarding incorporation by reference has been revised to reflect 37 CFR 1.57, which became effective on September 21, 2004.
- 201.14(a) Revised to reflect amendments to 37 CFR 1.55.
- 201.14(c) The discussion regarding the notation in the file history regarding foreign priority application has been revised to reflect IFW processing.
- 201.17 New section added to address incorporation by reference under 37 CFR 1.57(a), which became effective on September 21, 2004.
- 202.02 Revised to indicate that the front page of a printed patent identifies all prior applications for which benefits are claimed. Therefore, the identifying data of all prior applications for which benefits are claimed should be reviewed by the examiner to ensure that the data is accurate.

CHAPTER 300:

- 301 Revised to reflect amendments to 37 CFR 3.1. Revised to indicate that for a patent to issue to an assignee, the assignment must have been recorded or filed for recordation in accordance with 37 CFR 3.11.
- 301.01 Revised to reflect amendments to 37 CFR 1.12. Revised to indicate that assignment records of patents and applications that have been published are available on the USPTO web site. The address of the National Archives at College Park has been updated.
- 302 Revised to reflect amendments to 37 CFR 3.11 and 3.58. Revised to indicate that 37 CFR 3.11(c) which is directed to joint research agreement has been added as a result of the Cooperative Research and Technology Enhancement Act of 2004.
- 302.01 The title of this section has been revised. Revised to reflect amendments to 37 CFR 3.24. Also revised to indicate that documents submitted for recordation will not be returned to the submitter.

- 302.03 Revised to reflect amendments to 37 CFR 3.21.
- 302.04 Revised to reflect amendments to 37 CFR 3.61.
- 302.06 Revised to reflect amendments to 37 CFR 3.41.
- 302.07 Revised to reflect amendments to 37 CFR 3.31. Added discussion regarding the information that must appear in the cover sheet used to record a joint research agreement. Form PTO-1595 has been updated.
- 302.08 Revised to reflect amendments to 37 CFR 3.27. The address for submitting documents for recording has been updated.
- 302.09 The list of documents that cannot be submitted via facsimile has been revised.
- 302.10 New section added to address electronic submission of assignment documents.
- 306 Revised to indicate that the Office's assignment records will only reflect an assignment of a division or continuation application if a request for recordation in compliance with 37 CFR 3.28 and the required fee are filed.
- 306.01 Revised to indicate that if a nonprovisional application claiming the benefit of the filing date of an earlier provisional application includes subject matter that does not have support in the provisional application, new assignment papers must be recorded for the nonprovisional application.
- 307 Revised to reflect amendments to 37 CFR 3.81. Revised to indicate that a request for issuance of the application in the name of the assignee must indicate that the assignment has been previously recorded in the Office or state that the document has been filed for recordation as set forth in 37 CFR 3.11.
- 309 The title of the section has been revised.
- 310 Revised to indicate that if reference is made in the first sentence(s) of the specification following the title to prior copending applications of the applicant, the "Government License Rights" statement should follow immediately as the second paragraph of the specification.
- 311 Revised to reflect amendments to 35 U.S.C. 294.

- 317.02 The title of this section has been revised. Revised to indicate that returned documents may be resubmitted using the Electronic Patent Assignment System.
- 323 Revised to indicate that the corrective document must include a copy of the original assignment document with the corrections made therein.
- 323.01 Revised to reflect amendments to 37 CFR 3.34. Revised to indicate that typographical errors made by the Office will be corrected promptly and without charge upon written request directed to the Assignment Services Division. For any other errors, the party recording the document is responsible for filing the papers and paying the recordation fees necessary to correct the error.
- 323.01(a) New section added to discuss typographical errors in the cover sheet.
- 323.01(b) New section added to discuss typographical errors in the recorded assignment document.
- 323.01(c) New section added to discuss assignment or change of name improperly filed and recorded by another person against the owner's application or patent.
- 323.01(d) New section added to discuss expungement of assignment records.
- 324 Revised to reflect amendments to 37 CFR 3.73. Added discussion regarding the filing of a reissue application to correct inventorship and the consent of the assignee to the filing of the reissue application. Form PTO/SB/96 has been updated.

CHAPTER 400:

- 401 Revised to reflect amendments to 37 CFR 1.31. Form paragraph has been revised.
- 402 The title of this section has been revised. Revised to reflect amendments to 37 CFR 1.32, 1.34 and 10.18. Form paragraphs have been revised. Also revised to indicate that a power of attorney that names more than ten patent practitioners will only be entered if Customer Number practice is used or if the power of attorney is accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office. Form PTO/SB/81 has been updated.
- 402.01 Revised to reflect amendments to 37 CFR 11.9.

- 402.02 Revised to indicate that effective June 25, 2004, the associate power of attorney practice has been eliminated.
- 402.05 Revised to reflect amendments to 37 CFR 1.36. Added form PTO/SB/82.
- 402.06 Added reference to 37 CFR 1.36. Form PTO/SB/83 has been updated.
- 402.07 The title of this section has been revised. Added form PTO/SB/80.
- 402.09 Revised to reflect amendments to 37 CFR 11.9 and 1.455.
- 402.10 Revised to indicate that papers revoking a power of attorney will not be accepted if signed by less than all the applicants or owners of the application unless they are accompanied by an appropriate petition and fee.
- 403 Revised to reflect amendments to 37 CFR 1.33. Revised to indicate that if more than one correspondence address is specified in a single document, the Office will use the address associated with a Customer Number over a typed correspondence address. Also revised to indicate that if an attorney or agent of record assigns a correspondence address which is different than an address where the practitioner normally receives mail, the practitioner is reminded that 37 CFR 10.57 requires the practitioner to keep information obtained by attorney/agent – client relationship in confidence. Forms PTO/SB/122, 123, 124A, 124B, 125A, and 125B have been updated.
- 403.01 Revised to indicate that effective June 25, 2004, the associate power of attorney practice has been eliminated.
- 405 Added a sample of an “Authorization to Act in a Representative Capacity” form.
- 407 Form paragraphs have been revised.
- 408 Revised to indicate that non-registered representatives of the practitioner of record should not be telephoned for restriction requirements, approval of examiner’s amendments or given any information relative to the application even if authorized by the practitioner of record.
- 409 Revised to indicate that employees of the USPTO who were inventors are not permitted to sign an oath or declaration for patent application during the period of their employment with the Office and one year thereafter. These employees will be treated as being unavailable to sign the oath or declaration pursuant to 37 CFR 1.47.

- 409.03 Revised to reflect amendments to 37 CFR 1.47.
- 409.03(j) Revised to indicate that when an examiner receives an application in which a petition under 37 CFR 1.47 has been filed, the examiner must check to see if the petition has been decided by the Office of Petitions. If the petition has not been decided, the application or an electronic message must be forwarded to the Office of Petitions for appropriate action.
- 410 Revised to reflect amendments to 37 CFR 1.4 and 10.18.

CHAPTER 500:

- 501 Revised to reflect amendments to 37 CFR 1.1 and 1.4. Mailing addresses for certain types of correspondence have been updated. The address for the Customer Service Window has been updated.
- 502 Revised to reflect amendments to 37 CFR 1.5 and 1.6. Revised to indicate that new utility applications and provisional applications can also be filed via the Office's EFS. Revised to indicate that petitions under 37 CFR 1.313(c) may be faxed to the Office of Petitions. All other types of petitions, if faxed to the Office, must be directed to the central fax number. The list of correspondences that may be hand-delivered to a specific location rather than the Customer Service Window has been updated.
- 502.01 Revised to reflect amendments to 37 CFR 1.6. The central fax number has been updated. The list of correspondences that may be faxed to other than the central fax number has been updated.
- 502.02 Revised to reflect amendments to 37 CFR 1.4. Added discussion regarding the three types of signature, i.e., handwritten, s-signature, and EFS character coded signature. Added subsections to address certifications and ratifications.
- 503 Revised to indicate that for nonprovisional applications filed on or after December 8, 2004, search and examination fees set forth in 37 CFR 1.16 are required in addition to the basic filing fee. Also revised to indicate that any return receipt postcard that does not contain sufficient postage or is not acceptable to the USPS may not be delivered by the USPS to the address provided on the postcard, and if returned to the USPTO, may be discarded.
- 506 Revised to reflect amendments to 37 CFR 1.53. Revised to indicate that for applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date, if the search and/or examination fees are paid on a date later than the filing date of the

application, the surcharge under 37 CFR 1.16(f) is not required. For applications filed on or after July 1, 2005, which have been accorded a filing date, if any of the basic filing fee, search fee or examination fee are paid on a date later than the filing date of the application, the surcharge is required.

- 507 The discussion regarding the submission of replacement drawings for purposes of patent application publication has been moved to MPEP § 1121.
- 509 Revised to reflect amendments to 37 CFR 1.23. Added discussion regarding situations in which a payment submitted for the fees due on filing is insufficient and applicant has not specified the fees to which payment is to be applied.
- 509.01 Revised to reflect amendments to 37 CFR 1.25. Revised to indicate how the Office will treat a deposit account authorization to charge certain fees. The address and telephone number of the Deposit Account Division have been updated. The use of credit cards to replenish deposit accounts has been eliminated.
- 509.02 Revised to reflect amendments to 37 CFR 1.27. Added discussion regarding the Consolidated Appropriations Act of 2005. Revised to indicate that a security interest does not involve an obligation to transfer rights in the invention for purposes of 37 CFR 1.27(a)(1) to (a)(3) unless the security interest is defaulted upon.
- 509.03 Revised to reflect amendments to 37 CFR 1.27 and 1.4.
- 510 The address of the Patent Search Room has been updated.
- 511 Revised to reflect amendments to 37 CFR 1.10. Added discussion regarding situations where applicant was unable to deposit correspondences with the USPS due to an interruption or emergency in the “Express Mail” service.
- 512 Revised to reflect amendments to 37 CFR 1.8. Form paragraph has been revised. Added discussion regarding the revised procedures set forth in 37 CFR 1.8(b).
- 513 Revised to reflect amendments to 37 CFR 1.10. Added a new subsection to address petitions for correspondence returned due to postal interruption or emergency.

CHAPTER 600:

- 601 Revised to reflect amendments to 37 CFR 1.51.
- 601.01 Revised to reflect amendments to 37 CFR 1.53.
- 601.01(a) Revised to indicate that for applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date, if the search and/or examination fees are paid on a date later than the filing date of the application, the surcharge is not required. For applications filed on or after July 1, 2005, which have been accorded a filing date, if any of the basic filing fee, search fee or examination fee are paid on a date later than the filing date of the application, the surcharge is required. Also revised to indicate that effective July 1, 2005, the processing and retention fee practice has been eliminated. The basic filing fee, rather than just the processing and retention fee, must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under 35 U.S.C. 120 in a subsequent application.
- 601.01(b) Revised to indicate that if a provisional application omits a required statement regarding federally sponsored research or development (37 CFR 1.51(c)(1)(viii) and 1.77(b)(3)), a corrected cover sheet or a new or supplemental ADS should be filed to correct the omission.
- 601.01(c) Revised to reflect amendments to 37 CFR 1.53.
- 601.01(d) Added discussion regarding 37 CFR 1.57(a) and added cross-reference to MPEP § 201.17.
- 601.01(f) Added discussion regarding 37 CFR 1.57(a) and added cross-reference to MPEP § 201.17.
- 601.01(g) Added discussion regarding 37 CFR 1.57(a) and added cross-reference to MPEP § 201.17.
- 601.02 Form PTO/SB/81 has been updated.
- 601.03 Revised to reflect amendments to 37 CFR 1.33. Revised to indicate how the Office will handle situations where the applicant specifies more than one correspondence address.
- 601.05 Revised to reflect amendments to 37 CFR 1.76. Revised discussion regarding the requirements of an ADS and a supplemental ADS.
- 602 Revised to reflect amendments to 37 CFR 1.63. Added discussion regarding applications filed on or after September 21, 2004. For these

applications, a preliminary amendment that is present on the filing date of the application is part of the original disclosure. If such a preliminary amendment contains subject matter not otherwise included in the specification and drawings of the application and the oath or declaration does not refer to the preliminary amendment, applicant must provide a supplemental oath or declaration that refers to the preliminary amendment. Form PTO/SB/01 has been updated.

- 602.06 Revised to reflect amendments to 37 CFR 1.69.
- 605.04(b) Revised to indicate that since amendments are not permitted after the payment of the issue fee, a petition under 37 CFR 1.182 to change the name of the inventor cannot be granted if filed after the payment of the issue fee. In these situations, applicant may either (A) withdraw the application from issue under 37 CFR 1.313(c)(2) and file a RCE with a request to correct the spelling of the inventor's name, or (B) file a certificate of correction after the patent issues requesting correction of the spelling of the inventor's name.
- 605.04(c) Revised to indicate that since amendments are not permitted after the payment of the issue fee, a petition under 37 CFR 1.182 to change the name of the inventor cannot be granted if filed after the payment of the issue fee.
- 605.04(f) Revised to indicate that since amendments are not permitted after the payment of the issue fee, a petition under 37 CFR 1.182 to change the order of the inventor's name cannot be granted if filed after the payment of the issue fee.
- 607 Added discussion regarding basic filing fee, search fee, examination fee, application size fee, and excess claims fees. Also added discussion regarding situations in which a payment submitted for the fees due on filing is insufficient and applicant has not specified the fees to which payment is to be applied.
- 608.01 Revised to reflect amendments to 37 CFR 1.71, 1.52 and 1.58. Form paragraphs have been revised. Revised to indicate that tables may be included in the description portion of the specification, however, the same tables must not be included in both the drawings and the description portion of the specification. Applications filed under 35 U.S.C. 371 are excluded from this prohibition.
- 608.01(a) Revised to reflect amendments to 37 CFR 1.77. Form paragraphs have been revised.
- 608.01(b) Revised to indicate that the abstract should not exceed 15 lines of text.

- 608.01(f) Revised to reflect amendments to 37 CFR 1.84.
- 608.01(i) Revised to reflect amendments to 37 CFR 1.75.
- 608.01(m) Form paragraph has been revised.
- 608.01(n) Revised to reflect amendments to 37 CFR 1.75.
- 608.01(p) Added discussion regarding 37 CFR 1.57. Effective October 21, 2004, the Office codified in 37 CFR 1.57(b)-(g) existing practice with respect to explicit incorporation by reference with a few changes to reflect the eighteen-month publication of applications. Added reference to MPEP § 201.17 regarding discussion of 37 CFR 1.57(a). Form paragraphs have been revised.
- 608.01(q) Form paragraph has been revised.
- 608.01(u) Deleted reference to MPEP § 506.01.
- 608.02 Revised to reflect amendments to 37 CFR 1.84. Form paragraphs have been revised. Revised to indicate that if the specification includes a sequence listing or a table, such a sequence listing or table is not permitted to be reprinted in the drawings. Applications filed under 35 U.S.C. 371 are excluded from this prohibition. Also revised to indicate that each drawing sheet submitted after the filing date of an application must be identified as either “Replacement Sheet” or “New Sheet.”
- 608.02(b) Revised to reflect amendments to 37 CFR 1.85. Form paragraphs have been revised.
- 608.02(d) Revised to reflect amendments to 37 CFR 1.83. 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) Form paragraph has been revised.
- 608.02(m) The discussion regarding interference prints has been deleted.
- 608.02(p) Revised to reflect amendments to 37 CFR 1.121 and 1.85. Form paragraph has been revised.

- 608.02(z) Revised to indicate that in IFW applications, generally, the most recently filed drawings will be used for printing, unless they have been indicated as “Not Entered.”
- 608.03 Revised to reflect amendments to 37 CFR 1.91.
- 608.03(a) Revised to reflect amendments to 37 CFR 1.94. Added discussion regarding the return of models, exhibits or specimens. Form paragraph added.
- 608.04(b) Added discussion regarding preliminary amendments under 37 CFR 1.115.
- 608.05 Revised to reflect amendments to 37 CFR 1.52 and 1.77. Revised to indicate that CD-R discs must be finalized so that they are closed to further writing to the CD-R.
- 608.05(a) Form paragraphs have been revised.
- 608.05(b) Revised to reflect amendments to 37 CFR 1.58. Revised to indicate that CD-R discs must be finalized so that they are closed to further writing to the CD-R. Revised to indicate that tables in landscape orientation should be identified as landscape orientation in the transmittal letter accompanying the compact disc to allow the Office to properly upload the tables into the IFW or other automated systems. Filings without an identification of landscape mode will be rendered as portrait mode by the Office.
- 609 Revised to reflect amendments to 37 CFR 1.98. This section has been subdivided into multiple sections (MPEP § 609.01 to § 609.07).
- 609.01 New section directed to examiner checklist for IDSs.
- 609.02 New section directed to IDSs in continuing applications.
- 609.03 New section directed to IDSs in national stage applications filed under 35 U.S.C. 371.
- 609.04(a) New section directed to content requirements for an IDS.
- 609.04(b) New section directed to timing requirements for an IDS.
- 609.05 New section directed to examiner handling of IDSs.
- 609.05(a) New section directed to noncomplying IDSs.

- 609.05(b) New section directed to complying IDSs.
- 609.05(c) New section directed to documents submitted as part of applicant's reply to an Office action.
- 609.06 New section directed to information printed on a patent.
- 609.07 New section directed to e-IDS using EFS.

CHAPTER 700:

- 704.10 Revised to reflect amendments to 37 CFR 1.105. Replaced the district court citation of *Star Fruits S.N.C. v. United States* with the Federal Circuit citation.
- 704.11 Revised to indicate that pursuant to 37 CFR 1.105, it is facts and factual information, that are known to applicant or readily obtained after reasonable inquiry by the applicant, that are sought and not opinions.
- 704.11(a) Added examples of information that may be reasonably required under 37 CFR 1.105.
- 704.12(b) Revised to indicate that there is no need for applicants to distinguish between whether the required information is unknown or is not readily available. If information remains unknown after a reasonable inquiry is made, applicant may simply reply that the requested information is either unknown or is not readily available.
- 704.14(a) Added discussion regarding interrogatories and stipulations. Form paragraphs have been revised.
- 706 Revised to reflect amendments to 37 CFR 1.104 and 1.112. Added reference to the new appeal rules.
- 706.02 Revised to reflect amendments to 35 U.S.C. 103.
- 706.02(b) Added reference to the new appeal rules.
- 706.02(k) Added discussion regarding 35 U.S.C. 103(c) as amended by the CREATE Act. Added example 5 to illustrate the application of 35 U.S.C. 103(c) as amended by the CREATE Act.
- 706.02(l) The title of this section has been revised. Revised to reflect amendments to 35 U.S.C. 103. Subsection heading has been added.

- 706.02(1)(1) The title of this section has been revised. Added subsection headings. Added discussion regarding the CREATE Act.
- 706.02(1)(2) The title of this section has been revised. Added subsection to address evidence required to establish a joint research agreement.
- 706.02(1)(3) Revised to indicate that if a reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c) and a new subsequent double patenting rejection based on the disqualified reference is applied, the next Office action which contains the new double patenting rejection may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an IDS filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). Also revised to indicate that for a double patenting rejection based on a non-commonly owned patent (treated as if commonly owned pursuant to the CREATE Act), the double patenting rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(d).
- 706.02(m) Form paragraphs have been revised.
- 706.03(a) Revised to indicate that a rejection under 35 U.S.C. 101 for lack of utility should not be based on grounds that the invention is frivolous, fraudulent or against public policy. Added discussion of Federal Circuit decision.
- 706.03(d) Form paragraphs have been revised.
- 706.03(o) Form paragraph has been revised.
- 706.03(u) Form paragraph has been revised.
- 706.03(x) Revised to indicate that when a reissue application is applied for within 2 years from grant or a reissue application properly claims the benefit of a broadening reissue application filed within 2 years from grant, the examiner does not go into the question of undue delay.
- 706.07 Revised to reflect amendments to 37 CFR 1.113.
- 706.07(a) Revised to indicate that if a reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c) and a new subsequent double patenting rejection based on the disqualified reference is applied, the next Office action which contains the new double patenting rejection may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an IDS filed during the time period

set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)).
Form paragraphs have been revised.

- 706.07(f) Form PTOL-303 has been updated. Form paragraph has been revised.
- 706.07(g) The flowchart has been revised. Form paragraphs have been revised.
Added subsection to address submissions under 37 CFR 1.129(a) filed on
or after June 8, 2005.
- 706.07(h) Revised to reflect amendments to 37 CFR 1.114. Forms PTO/SB/30 and
PTO-2051 have been updated.
- 707 Form PTOL-326 has been updated.
- 707.05(a) Revised to indicate that copies of U.S. patents and U.S. patent application
publications are not provided in paper to applicants and are not placed in
the application file. Form paragraph has been revised.
- 707.05(g) Form paragraph has been revised.
- 707.07(a) Form paragraph has been revised.
- 707.07(f) Form paragraph has been revised.
- 707.13 Revised to set forth procedures regarding Office actions that are returned
to the USPTO.
- 708.02 Revised to reflect amendments to 37 CFR 1.102. Revised to indicate that
for petitions filed under 37 CFR 1.102 based on applicant's health or
applicant's age, if applicant does not wish to have personal/medical
information submitted as evidence to support the petition become part of
the application file record, the information must be submitted pursuant to
MPEP § 724.02. Also revised to indicate that for petitions filed under 37
CFR 1.102 based on environmental quality or energy, if the application
disclosure is not clear on its face that the claimed invention materially
enhances the quality of the environment or materially contributes to the
conservation of energy, the petition must be accompanied by a statement
explaining how the materiality standard is met. Also revised to indicate
that no fee is required for a petition under 37 CFR 1.102 based on the
reason that the invention materially contributes to countering terrorism.
- 709 Revised to reflect amendments to 37 CFR 1.103. Revised to indicate that
a supplemental reply will be entered if it is filed with the period during
which action is suspended by the Office under 37 CFR 1.103(a) or
1.103(c). Form PTO/SB/37 has been updated.

- 710.02 Revised to reflect amendments to 37 CFR 1.136.
- 710.02(c) Added reference to the new interference rules.
- 710.02(d) Added reference to the new appeal rules.
- 710.02(e) Revised to reflect amendments to 37 CFR 1.136. Updated the address of the Customer Service Window. Form paragraph has been revised.
- 711.01 Revised to indicate that a letter of express abandonment or a petition under 37 CFR 1.138(c) for express abandonment to avoid publication of the application may be mailed to the Office or faxed to the Pre-Grant Publication Division. Also revised to indicate that if a letter of express abandonment is submitted after the payment of the issue fee, the letter must be accompanied by a petition to withdraw from issue under 37 CFR 1.313(c) and the appropriate fee. A petition under 37 CFR 1.313 will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate official before the date of issue. The address for the Office of Petitions has been updated. Forms PTO/SB/24 and PTO/SB/24A have been updated.
- 711.02 Form paragraph has been revised.
- 711.03(c) Revised to reflect amendments to 37 CFR 1.137 and 1.181. Added discussion regarding 37 CFR 1.8(b) which permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 CFR 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time has elapsed from the time of mailing or transmitting the correspondence without having to wait until the application becomes abandoned. Forms PTO/SB/64, PTO/SB/64A, PTO/SB/64/PCT, PTO/SB/61, PTO/SB/61/PCT, PTO/SB/62, and PTO/SB/63 have been updated.
- 713.01 Revised to indicate that the Patent Academy is now called the Office of Patent Training. Updated the address of the Office of Patent Training. Form PTOL-413A has been updated.
- 713.04 Form PTOL-413B has been updated.
- 714 Revised to reflect amendments to 37 CFR 1.121. Added reference to the new appeal rules. Discussions regarding amendments to the claims and amendments to the drawing have been revised. Added subsections to address examiner's amendments, non-compliant amendments, defective directions for the entry of an amendment, and amendment of amendments. Added form PTOL-324.

- 714.01(a) Revised to reflect amendments to 37 CFR 1.33.
- 714.01(e) Revised to reflect amendments to 37 CFR 1.115. Revised to indicate that for applications filed on or after September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed prior to September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration. Also revised to indicate that an amendment canceling claims in order to reduce the excess claims fees should be filed before the expiration of the time period set forth in the notice that requires the excess claims fees. The discussion in the subsection directed to preliminary amendments present on the filing date of the application has been revised. Added new subsections.
- 714.02 Revised to reflect amendments to 37 CFR 1.111.
- 714.03(a) The title of this section has been revised. Revised to reflect amendments to 37 CFR 1.111. The discussion of supplemental replies has been revised. Form paragraph has been revised.
- 714.08 This section on “telegraphic amendment” has been deleted.
- 714.10 The title of this section has been revised. Revised to indicate that when applicant adds a new excess claim that is in excess of the number of claims that were previously paid for after taking into account claims that have been canceled, applicant must pay the required excess claims fees before the examiner considers the new claim.
- 714.12 The title of this section has been revised. Revised to reflect amendments to 37 CFR 1.116. Added reference to the new appeal rules.
- 714.13 The title of this section has been revised. Added reference to the new appeal rules. Form paragraph has been revised. The address of the Customer Service Window has been updated.
- 714.14 Added reference to MPEP § 714.
- 714.15 Revised to indicate that if an amendment is filed prior to the mailing of a notice of allowance, but is received by the examiner after the mailing of the notice of allowance, the amendment may not be approved for entry.
- 714.16 Added examples of amendments by applicant after allowance which must comply with 37 CFR 1.312. Revised to indicate that if an amendment under 37 CFR 1.312 does not comply with 37 CFR 1.121 and entry of the

amendment would have been otherwise recommended, the examiner may enter the amendment and correct the non-compliance using an examiner's amendment.

- 714.16(b) The title of this section has been revised.
- 714.16(d) The addresses of the Customer Service Window and the Office of Patent Publication have been updated.
- 714.18 Added reference to MPEP § 714.
- 714.19 Added reference to MPEP sections. Revised to indicate that a supplemental reply is not entered as a matter of right unless it is filed during a suspension period under 37 CFR 1.103(a) or (c).
- 715 Revised to reflect amendments to 37 CFR 1.131. Revised to indicate that if the prior art reference under 35 U.S.C. 102(a) is a U.S. patent or U.S. patent application publication, the reference may not be antedated if it claims the same patentable invention.
- 715.05 Form paragraphs have been revised. Added reference to the new interference rules.
- 715.09 Revised examples illustrating seasonable presentation.
- 716.01 Added examples to illustrate when an affidavit submitted under 37 CFR 1.132 is considered to be timely.
- 718 Revised to reflect amendments to 37 CFR 1.130.
- 719.05 The procedures for recording searches have been revised.
- 719.07 Revised to set forth the IFW processing.
- 720 Revised to reflect amendments to 37 CFR 1.292. The address of the Customer Service Window has been updated.
- 720.04 Added reference to 37 CFR Part 41, Subpart D.
- 724.02 The address of the Customer Service Window has been updated.
- 724.06 Revised to reflect amendments to 37 CFR 1.59. Form paragraphs have been revised.

CHAPTER 800:

- 802.01 Revised to define when two or more inventions are “related” and to clarify the meaning of the terms “independent” and “distinct.”
- 802.02 Revised to clarify the definition of “restriction.”
- 803.02 Revised to add an explanation of what a Markush-type claim is, clarify when the provisional election of a single species is given effect, and clarify when a second action on a Markush-type claim can be made final.
- 803.04 Revised to define what is meant by “nucleotide sequences” in the context of this section and to clarify when rejoinder should be considered.
- 804 Revised to incorporate discussion of double patenting between non-commonly owned inventions resulting from activities undertaken within the scope of a joint research agreement pursuant to 35 U.S.C. 103(c) as amended by the CREATE Act. Revised charts that set forth an overview of the treatment of applications having conflicting claims. Incorporated the substance of former Charts III-A and III-B into Charts I-A and I-B respectively. Revised procedure to be followed if a “provisional” double patenting rejection is the only rejection remaining in an application.
- 804.01 Added recent Federal Circuit cases pertaining to situations wherein the prohibition against double patenting rejections under 35 U.S.C. 121 does not apply.
- 804.02 Revised to add information regarding terminal disclaimers where the conflicting applications resulted from activities undertaken within the scope of a joint research agreement.
- 804.03 Added discussion of treatment of non-commonly owned inventions subject to a joint research agreement and timing of double patenting rejections when a reference relied upon in a rejection under 35 U.S.C. 103(a) may be disqualified under 35 U.S.C. 103(c).
- 806.01 Added subject matter formerly in MPEP § 809.02(d).
- 806.02 Section deleted.
- 806.04 Added information formerly in MPEP § 809.02 pertaining to genus claims that link species claims. Information previously in this section moved to MPEP § 806.06.
- 806.04(a) Section deleted.

- 806.04(b) Information pertaining to restriction requirements between intermediate and final products moved to added MPEP § 806.05(j).
- 806.04(c) Section deleted.
- 806.04(d) Revised to clarify definition of a generic claim.
- 806.04(e) Revised to clarify that species may be either independent or distinct.
- 806.04(f) Revised to clarify meaning of “mutually exclusive” as it applies to species.
- 806.04(h) Revised to clarify when a double patenting rejection of species may be appropriate.
- 806.04(i) Revised to discuss treatment of generic claims presented anytime after the issuance of a patent claiming at least one species within the scope of the generic claim.
- 806.05(b) Section deleted.
- 806.05(c) Revised order of examples of situations wherein restriction between a subcombination and combination invention is proper and discussion of when rejoinder should be considered. Added discussion of treatment of applications that include claims to plural combinations requiring a subcombination common to each combination.
- 806.05(d) Revised to explain that subcombinations usable together are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.
- 806.05(e) Revised to delete discussion of apparatus claims that include a “means” for practicing the process.
- 806.05(f) Revised to add form paragraph 8.21.04 advising applicants of rejoinder practice with regard to process inventions that require all the limitations of an allowable product claim.
- 806.05(h) Revised to add form paragraph 8.21.04 advising applicants of rejoinder practice with regard to process inventions that require all the limitations of an allowable product claim.
- 806.05(i) Revised to clarify when restriction between a product, process of making, and process of using would not be proper.

- 806.05(j) Added new section to explain requirements for restricting between two or more related product inventions or two or more related process inventions. Incorporated information from MPEP § 806.04(b) concerning restriction between intermediate and final products.
- 806.06 Added new section to explain requirements for restricting between independent inventions. Incorporates information previously in MPEP § 806.04 and § 808.01.
- 808 Revised to clarify that every requirement to restrict should set forth why each invention as claimed is independent or distinct from the other(s), and why there would be a serious burden on the examiner if restriction is not required.
- 808.01 Revised to incorporate information previously in MPEP § 816 pertaining to the need for the examiner to set forth the reasons for determining that the inventions as claimed are independent or distinct. Information pertaining to independent inventions previously in the section moved to new MPEP § 806.06.
- 808.01(a) Revised to clarify requirements for making a requirement for restriction between independent or distinct species.
- 808.02 Revised to indicate that an examiner must establish burden in order to restrict between either independent or distinct inventions.
- 809 Revised to incorporate and clarify definition of “linking claim” as previously set forth in MPEP § 809.03, and to explain that linking claims and the inventions they link together are usually either all directed to products or all directed to processes. Revised examples of linking claims by adding subcombination claims linking plural combinations and removing product claims that link means claims or process claims. Provided reference to new section MPEP § 821.04(a) for rejoinder between product inventions or between process inventions. Clarified that rejoinder applies to claims which require all the limitations of an allowable claim.
- 809.02 Section deleted and the subject matter previously therein moved to MPEP § 806.04.
- 809.02(a) Clarified that election of species or restriction practice for species requires reasons for independence or distinctness, and reasons why examination of the claimed or disclosed species would be burdensome if election of species practice were not required. Revised to indicate that a restriction requirement must identify the species from which an election is to be made.

- 809.02(b) Section deleted.
- 809.02(c) Section deleted. Moved information previously therein to MPEP § 821.01, § 821.02, and § 821.04(a).
- 809.02(d) Section deleted. Moved information previously therein to MPEP § 806.01 and § 808.01(a).
- 809.02(e) Section deleted.
- 809.03 Revised to clarify how examiners may restrict between linked inventions. Text concerning definition of linking claims moved to MPEP § 809.
- 809.04 Section deleted. Moved information pertaining to rejoinder of claims directed to nonelected invention(s) to MPEP § 821.04(a).
- 810 Revised to explain when an Office action on the merits is included with a restriction requirement. Incorporates information previously in MPEP § 810.03.
- 810.01 Section deleted.
- 810.02 Section deleted.
- 810.03 Section deleted.
- 812.01 Revised to indicate that an examiner should determine if any allowable claims are linking or generic claims, or if any nonelected invention is eligible for rejoinder, before canceling claims drawn to the nonelected invention(s).
- 814 Added recent Federal Circuit case discussing why a clear and detailed record of the restriction requirement is necessary.
- 816 Section deleted and information previously therein moved to MPEP § 808.01.
- 817 Revised to set forth the outline that should be used to set forth a restriction requirement, whether between independent or related inventions.
- 818.02(b) Revised to clarify that the examiner may require an applicant to elect a single species upon later presentation of claims to more than one patentably distinct species.

- 818.03 Revised to incorporate text from MPEP § 818.03(e) regarding the requirement for applicant to make his or her own election.
- 818.03(b) Revised form paragraph 8.22 to provide additional guidance concerning the requirement for election and means for traversal.
- 818.03(e) Section deleted; information previously therein moved to MPEP § 818.03.
- 819 Revised to delete references to File Wrapper Continuation practice and to incorporate text from former MPEP § 820 and § 820.02.
- 819.01 Section deleted.
- 820 Section deleted. Subject matter pertaining to an allowable genus claim moved to MPEP § 819.
- 820.01 Section deleted.
- 820.02 Section deleted; subject matter moved to MPEP § 819.
- 821.01 Revised to indicate that a restriction requirement may be withdrawn in whole or in part.
- 821.02 Revised to indicate that where an application is in condition for allowance but for the presence of claims drawn to invention(s) nonelected without traverse, the claims drawn to the nonelected invention(s) may be canceled by examiner's amendment unless those claims are eligible for rejoinder.
- 821.03 Revised to clarify that election by original presentation practice is not applicable to a provisional election of species made in accordance with MPEP § 803.02, or to claims that could not have been restricted from the examined invention had they been presented earlier.
- 821.04 Rewritten to set forth general information pertaining to reconsideration of the propriety of a restriction requirement and rejoinder of certain previously nonelected inventions upon the determination that (1) all claims directed to the elected invention are in condition for allowance, and (2) claims to the previously nonelected invention depend from or otherwise require all the limitations of an allowable claim. Revised to clarify that if any claims are rejoined, the restriction requirement between the elected invention and rejoined invention(s) must be withdrawn.
- 821.04(a) Added new section to discuss rejoinder between product inventions and rejoinder between process inventions.

821.04(b) Added new section directed to rejoinder of processes requiring an allowable product. Incorporates and revises subject matter formerly in MPEP § 821.04. Indicates that rejoinder based on this section may only occur if all claims to the elected product invention are allowable, and all process claims subject to rejoinder depend from or otherwise require all the limitations of an allowable product claim. Clarifies that cancellation of all claims directed to a process invention *prior to rejoinder* preserves the 35 U.S.C. 121 prohibition against a double patenting rejection in a divisional application of claims directed to that process.

CHAPTER 900:

- 901.01 Added reference to U.S. patent application publication.
- 901.02 Added reference to 37 CFR 1.14(a)(1)(iv).
- 901.03 Revised reference to 37 CFR 1.14.
- 901.04 Added reference to MPEP § 706.02(f)(1).
- 901.04(a) Corrected the spelling of the word “Reexamination” in the chart.
- 901.05 Revised to indicate that *Chemical Abstracts* is available online via commercial databases or on CD-ROM in STIC.
- 901.05(c) Added reference to the Foreign Patent and Scientific Literature Branch of STIC.
- 901.05(d) Revised to indicate that effective January 1, 2004, the Translations Branch of STIC will use e-mail as the sole delivery method for written translations. Paper copies of the translation request form, the foreign language document, and the translation will no longer be returned to the examiner.
- 901.06 Revised to indicate that copies of non-patent literature can be requested from the EIC or Library of STIC in each TC.
- 901.06(a) The location of STIC and information and services available in STIC have been updated.
- 901.09 This section on missing copies and replacement copies of references has been deleted since the Office no longer maintains a paper search file.
- 902.01 Information regarding the Manual of Classification has been updated.

- 902.01(a) Revised to indicate that the index to the U.S. Patent Classification System is available online from the Classification Home Page, which is accessible from the desktop via the Patent Examiner's Toolkit.
- 902.02 Revised to indicate that the class and subclass definitions are available online from the Classification Home Page.
- 902.03(a) Information regarding the Patent Classification Home Page on the Internet has been updated.
- 902.03(b) Information regarding the Patent Classification Home Page on the Intranet has been updated.
- 902.03(d) Information regarding the Cassis CD-ROM has been updated.
- 902.03(e) Information regarding EAST and WEST has been updated.
- 902.04 Revised to indicate that copies of classification orders are available online from the Classification Home Page.
- 902.04(a) Revised to indicate that the reclassification alert report is available online from the Classification Home Page.
- 903.02 Revised to indicate that the Examiner Handbook to the U.S. Patent Classification System is available online from the Classification Home Page.
- 903.02(a) Revised to indicate that the notification of the new class or subclass is published in a classification order which is available online from the Classification Home Page.
- 903.04 New section added to address classifying applications for publication as a patent application publication.
- 903.05 The title of this section has been revised.
- 903.06 This section on practice to be followed in ordering official cross-references has been deleted since the Office no longer maintains a paper search file.
- 903.07 Revised to add a reference to the IFW issue classification form.
- 903.07(b) Revised to set forth the procedure to follow when the primary examiners of two TCs disagree on the proper original classification of the allowed claims.

- 903.08(d) Revised to indicate that each TC has developed internal procedures for transferring applications between art units and resolving application assignment disputes. Revised to set forth the procedures for transferring an application between different TCs. The application transfer request form, PTO-447A has been deleted.
- 903.08(e) The general guidelines governing the assignment of nonprovisional applications have been updated. Added flowchart to illustrate the Inter-TC Classification Dispute Resolution Procedures. Added subsection to address PALM EXPO.
- 903.08(f) This section on “post classifier’s decision” has been deleted.
- 903.08(g) This section on “transfer to another TC after decision” has been deleted.
- 903.09 Added reference to the IFW issue classification form.
- 903.09(a) Added reference to the IFW issue classification form.
- 903.10 This section on “duties of the post classifier” has been deleted.
- 904 Revised to indicate that an inventor’s name search should be made. Also revised to indicate that for a national stage application filed under 35 U.S.C. 371, the examiner will consider the documents cited in the international search report when the form PCT/DO/EO/903 indicates that both the international search report and the copies of the document are present in the national stage application.
- 904.02 Revised to indicate that the Patent Academy is now called the Office of Patent Training.
- 904.02(b) The “decision tree” has been updated.
- 904.02(c) Revised to indicate that reissue applications, reexamination proceedings, and applications that have been published need not be kept in confidence, therefore, the restriction on the search queries used when performing an Internet search would not apply.
- 905.02 This section on ordering soft copy of U.S. patents has been deleted since the Office no longer maintains a paper search file.
- 905.04 This section on “marking examiner’s copies of patents” has been deleted since the Office no longer maintains a paper search file.
- 905.06 Added reference to MPEP § 901.06(a) for STIC services.

CHAPTER 1200:

Chapter 1200 has been revised to incorporate the new Board of Patent Appeals and Interferences rules that became effective on September 13, 2004. The new rules are in Part 41 of title 37, Code of Federal Regulations.

- 1201 Revised to indicate that this chapter is primarily directed to *ex parte* appeals and to see MPEP § 2674 to § 2683 for appeals in *inter partes* reexamination proceedings.
- 1202 The section on “Composition of Board” has been redesignated as MPEP § 1202. Revised to reflect amendments to 35 U.S.C. 6 and to include the definition of the “Board” as set forth in 37 CFR 41.2.
- 1203 The section on “Administrative Handling” has been redesignated as MPEP § 1203. Revised to include the Board’s docketing and review procedures.
- 1204 The section on “Notice of Appeal” has been redesignated as MPEP § 1204. Revised to reflect amendments to 35 U.S.C. 134, 35 U.S.C. 6, and 37 CFR 41.31. Added discussion of Board decision (*Ex Parte Lemoine*). Revised to indicate that applicant cannot file an appeal in a continuation or an RCE until the application is under a rejection. Forms PTO/SB/31 and PTOL-461 have been updated. Added a subsection on defective notice of appeal.
 - 1204.01 New section added to discuss reinstatement of appeal.
- 1205 The section on “Appeal Brief” has been redesignated as MPEP § 1205. Referenced new appeal rule, 37 CFR 41.37.
 - 1205.01 New section added to discuss time for filing appeal brief.
 - 1205.02 New section added to discuss appeal brief content.
 - 1205.03 New section added to discuss non-compliant appeal brief and amended brief. Forms PTOL-462 and PTOL-462R have been updated. Form paragraphs have been revised.
- 1206 Revised to discuss amendments and affidavits or other evidence filed with or after appeal. Referenced new appeal rule, 37 CFR 41.33. Forms PTOL-303 and PTOL-304 have been updated.
- 1207 The section on “Examiner’s Answer” has been redesignated as MPEP § 1207. Referenced new appeal rule, 37 CFR 41.39. Revised to indicate the actions available to the examiner after an appeal brief is filed.

- 1207.01 New section added to discuss appeal conference.
- 1207.02 New section added to discuss contents of the examiner's answer. Form paragraphs have been revised.
- 1207.03 The section on "New Ground of Rejection in Examiner's Answer" has been redesignated as MPEP § 1207.03. Added subsections to discuss the requirements for a new ground of rejection, situations where new grounds of rejection are not permitted, request for designation as new ground of rejection, and appellant's reply to new grounds of rejection.
- 1207.04 The section on "Reopening of Prosecution After Appeal" has been redesignated as MPEP § 1207.04. Form paragraph has been revised. Revised to indicate that if prosecution was reopened prior to a decision on the merits by the Board, the fees paid for the notice of appeal, appeal brief, and request for an oral hearing, if applicable, will be applied to a later appeal on the same application. If the fees set forth in 37 CFR 41.20 have increased since they were previously paid, applicant must pay the difference between the increased fees and the amount previously paid.
- 1207.05 New section added to discuss supplemental examiner's answer. Referenced new appeal rule, 37 CFR 41.43.
- 1208 New section added to discuss reply briefs and examiner's responses to reply brief. Referenced new appeal rule, 37 CFR 41.41.
- 1209 Referenced new appeal rule, 37 CFR 41.47. Added discussion as to when a request for an oral hearing is improper. Revised to indicate that at the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present arguments that have been relied upon in the brief or reply brief. Form paragraph has been revised.
- 1210 Referenced new appeal rule, 37 CFR 41.35.
- 1211 Added reference to other relevant MPEP sections.
- 1211.01 New section added to discuss remand by Board for further consideration of rejection. Form paragraphs have been revised.
- 1211.02 The section on "Remand by Board To Consider Amendment" has been redesignated as MPEP § 1211.02.
- 1211.03 The section on "Remand by Board To Consider Affidavits or Declarations" has been redesignated as MPEP § 1211.03. Revised to indicate that where an affidavit or declaration is filed after the filing of a

notice of appeal but before a decision by the Board, the examiner is without authority to consider the affidavit or declaration unless the examiner determines that the affidavit or declaration overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or declaration is necessary and was not earlier presented have been made.

- 1211.04 The section on “Remand by Board for Further Search” has been redesignated as MPEP § 1211.04. Revised to indicate that it should be extremely rare for the Board to remand a case to the examiner for further search.
- 1212 Referenced new appeal rule, 37 CFR 41.50.
- 1213 Referenced new appeal rule, 37 CFR 41.50.
- 1213.01 The section title has been revised. Referenced new appeal rule, 37 CFR 41.50. Revised to indicate that an explicit statement by the Board on how a claim on appeal may be amended to overcome a specific rejection is not a statement that a claim so amended is allowable.
- 1213.02 Referenced new appeal rule, 37 CFR 41.50.
- 1213.03 The section title has been revised. Referenced new appeal rule, 37 CFR 41.6. Revised to indicate that any Board decision is available for public inspection if rendered in a file open to the public. If the Board decision is rendered in a file that is not open to the public, and if the Director believes that special circumstances warrant publication, then the decision may be published or made available for public inspection.
- 1214 Referenced new appeal rule, 37 CFR 41.54.
- 1214.01 Revised to refer to the new appeal rules.
- 1214.03 Referenced new appeal rule, 37 CFR 41.52. Revised to indicate that arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief are not permitted in the request for rehearing except (A) upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of the Board or a Federal Court, and (B) new arguments responding to a new ground of rejection made under 37 CFR 41.50(b).
- 1214.04 Revised to indicate that the request for rehearing by the examiner must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not

permitted in the request for rehearing except upon a showing of good cause, the examiner may present new argument based upon a recent relevant decision of the Board or a Federal Court. Also revised to indicate that if the request for rehearing is approved by the Office of the Deputy Commissioner for Patent Examination Policy, the TC will mail a copy of the request for rehearing to the appellant.

- 1214.06 Revised to reflect amendments to 37 CFR 1.197. Form paragraphs have been revised.
- 1214.07 Revised to reflect amendments to 37 CFR 1.198. Form paragraph has been revised.
- 1215.01 Revised to add discussion as to when an appellant may request that prosecution be reopened.
- 1215.03 Form paragraphs have been revised.
- 1215.04 Added reference to the new appeal rules.
- 1216 Revised to reflect amendments to 35 U.S.C. 141, and 37 CFR 1.301, 1.303, and 1.304. Revised the address for filing requests for extension of time to seek judicial review under 37 CFR 1.304.
- 1216.01 Revised to reflect amendments to 35 U.S.C. 143 and 37 CFR 1.302. Revised the mailing address for filing a notice of appeal to the Federal Circuit.
- 1216.02 Revised to indicate that all the expenses of the 35 U.S.C. 145 proceeding must be paid by the applicant.

CHAPTER 1300:

- 1302.01 The discussion regarding having the examiner to check whether a copending application that is referred to in the specification has matured into a patent or has become abandoned has been deleted. It is no longer necessary for the examiner to check the status of these referenced copending applications.
- 1302.03 Form PTOL-37 has been updated.
- 1302.04 The list of obvious errors and omissions has been revised. Form paragraph has been revised.
- 1302.04(f) This section on “data of copending application referred to should be brought up-to-date” has been deleted.

- 1302.04(h) New section to address rejoinder of claims.
- 1302.08 Revised to incorporate new interference search procedures.
- 1302.09 Deleted discussion regarding paper file wrappers.
- 1302.10 Deleted discussion regarding paper file wrappers.
- 1302.12 Revised to indicate that pertinent art cited by the examiner (and listed on the form PTO-892) at the time of allowance of an application is not sent to the applicant. However, foreign patent documents and NPL will be scanned and added to the IFW for viewing and downloading by the applicant if desired.
- 1302.13 Deleted discussion regarding paper file wrappers.
- 1303 Revised to reflect amendments to 37 CFR 1.311. Form PTOL-85 has been updated.
- 1303.01 Revised to indicate that any submissions of replacement drawing filed after allowance should be forwarded to the Office of Patent Publication.
- 1306.03 The title of this section has been revised.
- 1308 The fax number of the Office of Petitions has been updated.

CHAPTER 1400:

- 1402 Revised to indicate when a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) is required to be filed in a reissue application.
- 1403 Revised to indicate that a reissue application can be granted a filing date without the basic filing fee, search fee, or examination fee.
- 1406 Revised to indicate that the requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS has been eliminated unless required by the Office.
- 1410 Revised discussion regarding how amendments submitted at the time of filing of a reissue application may be made. Also revised to indicate that the physical surrender of the original patent is no longer required. Form PTO/SB/50 has been updated.
- 1410.01 Revised the references to 37 CFR 1.16 and 1.17.

- 1411 Revised discussion regarding how amendments submitted at the time of filing of a reissue application may be made.
- 1412.02 Form paragraph has been revised.
- 1412.03 The heading of subsection III has been corrected to be consistent with the discussion in that subsection. Revised to indicate that a broadened claim may be presented in a reissue application after the two year period even though the broadened claim presented after the two years is different than the broadened claim presented within the two year period.
- 1412.04 Revised to add discussion of when inventor X, whose name is to be deleted in a reissue application to correct inventorship, must consent to the filing of the reissue application.
- 1414 Revised to reflect amendments to 37 CFR 1.175. Revised to indicate that form paragraph 14.01.05 should be used in conjunction with the content of form paragraphs 6.05 through 6.05.02, as appropriate, where the reissue oath/declaration fails to comply with the requirements of 37 CFR 1.63. Forms PTO/SB/51 and PTO/SB/52 have been updated.
- 1414.01 Form PTO/SB/51S has been updated.
- 1415 The title of this section has been revised. Revised to add discussion regarding the basic reissue application filing fee, search fee, examination fee, excess claims fees, application size fee, and issue fee. Form PTO/SB/56 has been updated.
- 1415.01 Added subsection to address payment of maintenance fees where the patent has been reissued.
- 1416 The title of this section has been revised. Revised to reflect amendments to 37 CFR 1.178(a) and to indicate that amended 37 CFR 1.178(a) applies retroactively to all pending applications. Also revised to indicate that effective October 21, 2004, the requirement for physical surrender of the original letters patent in a reissue application has been eliminated. The surrender of the original patent is automatic upon the grant of the reissue patent. Form PTO/SB/55 has been deleted since this form is no longer necessary.
- 1417 Added discussion regarding IFW processing.
- 1418 Revised to indicate that form paragraph 14.11.01 may be used to remind applicant of the duties to timely make the Office aware of any prior or concurrent proceeding in which the patent to be reissued is or was

involved, and any information which is material to patentability of the claims in the reissue application.

- 1430 Revised to indicate that the general public can view the entire content of an IFW reissue application file history by way of Public PAIR via the USPTO Internet site.
- 1441 Revised to indicate that where the basis for a petition under 37 CFR 1.182 is ongoing litigation, the petition must clearly identify the litigation, and detail the specifics of the litigation that call for prompt action on the reissue application prior to the expiration of the 2-month delay period.
- 1441.01 Revised to add explanation as to why a protest under 37 CFR 1.291 may be filed throughout the pendency of a reissue application. Also revised to indicate that where a final rejection has been issued or the prosecution on the merits has been otherwise closed, a petition under 37 CFR 1.182 along with the required fee for entry of the protest are required. Revised to indicate that if the protest is a “reissue litigation” protest, it is important that the protest be filed early if the protestor wishes the protest considered at the time the Office first acts on the reissue application.
- 1442.02 Revised to indicate that an *ex parte* reexamination proceeding will not be stayed where there is litigation, therefore, where a reissue application has been merged with an *ex parte* reexamination proceeding, the merged proceeding will not be stayed where there is litigation.
- 1442.04 Added discussion regarding IFW processing.
- 1443 The discussion regarding having the examiner check that an offer to surrender the original patent or a statement to the effect that the original patent is lost or inaccessible has been deleted since the physical surrender of the original patent is no longer required.
- 1449.01 Revised to indicate that if an examiner becomes aware that multiple reissue applications are pending for the same patent, and an *ex parte* or *inter partes* reexamination proceeding is pending for the same patent, the examiner should inform the TC SPRE immediately. Added reference to MPEP § 2285 and § 2686.03.
- 1449.02 Added reference to new interference rules, 37 CFR 41.8 and 41.202. Revised to indicate that pursuant to 37 CFR 41.202(c), an examiner may require a reissue applicant to add a claim to provoke an interference, unless the reissue applicant cannot present the added claim to provoke an interference based on the provisions of the reissue statute and rules. Also revised to indicate that if a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant must

promptly notify the Board of the filing of the reissue application within 20 days from the filing date of the reissue application.

- 1451 Added discussion regarding IFW processing. Revised to indicate that the same patent claim cannot be presented for examination in more than one of the divisional reissue applications, as a pending claim, in either its original or amended versions.
- 1453 Revised to reflect amendments to 37 CFR 1.173.
- 1454 Revised to reference the new appeal rule.
- 1455 Revised to add discussion regarding processing of IFW reissue applications.
- 1456 Revised to add discussion regarding processing of IFW reissue applications.
- 1457 Revised to indicate that for design reissue applications filed on or after December 8, 2004, a search fee and an examination fee are also required.
- 1470 Revised to indicate that members of the public can view the entire content of IFW reissue application file history by way of Public PAIR via the USPTO Internet site.
- 1480 Revised to reflect amendments to 37 CFR 1.322. The address of the Certificate of Correction Branch has been updated.
- 1481 Revised to reflect amendments to 37 CFR 1.323. Form paragraphs have been revised. This section has been subdivided into multiple sections (MPEP § 1481.01 to § 1481.03).
- 1481.01 New section directed to correction of assignees' names.
- 1481.02 New section directed to correction of inventors' names.
- 1481.03 New section directed to correction of 35 U.S.C. 119 and 120 benefits.
- 1485 Revised to add reference to 37 CFR 41.121. Form PTO/SB/44 has been updated.
- 1490 Revised to reflect amendments to 37 CFR 1.321. Revised to indicate that a registered practitioner acting in a representative capacity under 37 CFR 1.34 is not permitted to sign a disclaimer. Added discussion regarding IFW processing. Added discussion regarding 37 CFR 1.321(d). Form

paragraphs have been revised. Forms PTO/SB/43, PTO/SB/25 and PTO/SB/26 have been updated.

CHAPTER 1700:

- 1701 The title of this section has been revised. Revised to indicate that the question of enforceability or unenforceability is exclusively a matter to be determined by a court. Added reference to 37 CFR 104.1 and 104.21.
- 1701.01 Added reference to 37 CFR 104.1 and 104.21.
- 1702 The title of this section has been revised. Revised to reflect amendments to 37 CFR 11.10.
- 1706 Revised to indicate that the disclosure document deposit request form is available at the USPTO Internet site or by calling the USPTO Contact Center. The three partnership PTDLs identified have been updated.
- 1720 Revised to indicate that the Patent Academy is now called the Office of Patent Training.
- 1721 Revised to indicate that the Patent Academy is now called the Office of Patent Training.
- 1730 Revised to update the location, telephone numbers and fax numbers of various USPTO organizations.

CHAPTER 1800:

- 1801 Revised to reflect amendments to PCT Rule 69.1.
- 1805 Revised to indicate international applications and related papers may be delivered to the Customer Service Window in the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.
- 1807 Revised to reflect amendments to 37 CFR 1.455(a).
- 1808 Revised to reflect amendments to 37 CFR 1.455(a).
- 1817 Revised to update the list of PCT Contracting States.
- 1817.02 Revised to reflect amendments to 37 CFR 1.78(a)(2)(iii). In a continuation or continuation-in-part application, a specific reference to the parent application must be included in an application data sheet or in the first sentence(s) of the specification.

- 1819 Revised to reflect amendments to 37 CFR 1.445(a)(2) and to clarify that a corresponding U.S. national application having the same filing date as the international application is not a “prior” application for purposes of 37 CFR 1.445(a)(2).
- 1823.02 Revised to reflect amendments to PCT Rule 13*ter* and to the PCT Administrative Instructions. The hand-carry address for submissions made under Part 8 of the PCT Administrative Instructions has been updated.
- 1834 Revised to include the current version of PCT Administrative Instruction Section 105.
- 1840 Revised to add Egypt to the list of countries for whose residents or nationals, the USPTO will, as an International Searching Authority, conduct international searches, prepare international search reports, and prepare written opinions.
- 1843 Revised to reflect amendments to PCT Rule 43*bis*.1(a).
- 1844.01 Revised to include updated Form PCT/ISA/210.
- 1845.01 Revised to include updated Form PCT/ISA/237.
- 1845.02 Revised to include updated Form PCT/ISA/220.
- 1848 Revised to reflect amendments to PCT Rule 13*ter* and to the PCT Administrative Instructions.
- 1850 Revised to reflect amendments to PCT Rule 40 and PCT Administrative Instruction Section 502. Effective April 1, 2005, the time limit for applicant to reply to an invitation to pay additional fees (Form PCT/ISA/206) will be set at one month by the International Searching Authority.
- 1865 Revised to update the hand-carry address for a demand filed with the IPEA/US. Egypt was added to the list of countries for whose residents or nationals the IPEA/US will serve as International Preliminary Examining Authority if the U.S. was the International Searching Authority. Form PCT/IPEA/401 has been updated.
- 1865.01 Revised to reflect amendments to PCT Rule 68. Effective April 1, 2005, the time limit for applicant to reply to an invitation to pay additional fees (Form PCT/IPEA/405) will be set at one month by the International Preliminary Examining Authority.

- 1875.01 Revised to reflect amendments to PCT Administrative Instruction Section 603.
- 1877 Revised to reflect amendments to PCT Rule 13*ter*.
- 1878.01 Revised to indicate that new matter which appears on a replacement sheet will be disregarded for the purpose of establishing the opinion. However, the remainder of the replacement sheet, including any amendments which do not constitute new matter, will be taken into consideration for the purpose of establishing the opinion.
- 1878.02 Revised to indicate that new matter which appears on a replacement sheet will be disregarded for the purpose of establishing the report. However, the remainder of the replacement sheet, including any amendments which do not constitute new matter, will be taken into consideration for the purpose of establishing the report.
- 1879 Revised to include updated Forms PCT/IPEA/416 and PCT/IPEA/409.
- 1879.01 Revised to reflect amendments to PCT Rule 69.1
- 1879.04 Revised to reflect amendments to 37 CFR 1.14(h)(1).
- 1893.01 Revised to indicate that, in the absence of an express request for early processing of an international application under 35 U.S.C. 371(f) and compliance with the conditions provided therein, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application. Pursuant to 35 U.S.C. 371(f), the national stage may commence earlier than 30 months from the priority date, provided applicant makes an express request for early processing and has complied with the applicable requirements under 35 U.S.C. 371(c).
- 1893.01(a) Revised to reflect amendments to 37 CFR 1.495(c).
- 1893.01(a)(1) Revised to indicate that if the basic national fee has been paid and the copy of the international application (if required) has been received by expiration of 30 months from the priority date, but the required oath or declaration, translation, search fee (37 CFR 1.492(b)), examination fee (37 CFR 1.492(c)), or application size fee (37 CFR 1.492(j)) has not been filed prior to commencement of the national stage, the Office will send applicant a notice identifying any deficiency and provide a period of time to correct the deficiency as set forth in 37 CFR 1.495(c). Also revised to indicate that the processing fee set forth in 37 CFR 1.492(i) will be required for acceptance of an English translation of the international application later than the expiration of thirty months after the priority date,

and the surcharge set forth in 37 CFR 1.492(h) will be required for acceptance of any of the search fee, examination fee, or oath or declaration of the inventor after the date of commencement.

- 1893.01(a)(2) Revised to indicate that the Article 19 amendment(s) and the English translation of the amendment(s) must be received by the Office by the date of commencement of the national stage. Otherwise, the amendment(s) will be considered to be canceled.
- 1893.01(a)(3) Revised to indicate that if the annexes are in a foreign language, a proper translation of the annexes must be furnished to the Office not later than the expiration of 30 months from the priority date, unless a period has been set pursuant to 37 CFR 1.495(c) to furnish an oath or declaration, English translation of the international application, search fee (37 CFR 1.492(b)), examination fee (37 CFR 1.492(c)), or application size fee (37 CFR 1.492(j)), in which case the translations of the annexes, accompanied by the processing fee set forth in 37 CFR 1.492(f), may be submitted within the period set pursuant to 37 CFR 1.495(c).
- 1893.01(c) Revised to indicate that the processing fee set forth in 37 CFR 1.492(i) will be required for acceptance of an English translation of the international application later than the expiration of thirty months after the priority date, and the surcharge set forth in 37 CFR 1.492(h) will be required for acceptance of any of the search fee, examination fee, or oath or declaration of the inventor after the date of commencement.
- 1893.01(d) Revised to reflect amendments to 37 CFR 1.492.
- 1893.01(e) Revised to reflect amendments to 37 CFR 1.492 and to clarify some of the procedures for correcting the inventorship in a national stage application. Where there has been no change of inventorship but the name of an inventor indicated in the international application during the international phase is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error. Similarly, a typographical or transliteration error in the name of an inventor identified in a previously submitted oath or declaration may be corrected by simply notifying the Office of the error. A new oath or declaration is not required to correct such error.

- 1893.03 Revised to reflect amendments to 37 CFR 1.496(b).
- 1893.03(b) Revised to include a more recent example of a certified priority document and to include an updated description of the processing procedures for priority documents.
- 1893.03(d) Revised to indicate that if an examiner determines that the claims lack unity of invention and requires election of a single invention, when all of the claims drawn to the elected invention are allowable, the claims directed to the nonelected invention(s) should be considered for rejoinder following the guidance set forth in MPEP § 821.04(b).
- 1895.01 Revised to indicate the specific reference to the international application required under 35 U.S.C. 120 and 365(c) must either be contained in the first sentence(s) of the specification following the title or included in an application data sheet. Also revised to indicate that, in order to expedite examination, applicant should certify at the time of filing a national application claiming benefit under 35 U.S.C. 120 and 365(c) to an international application that the international application has not been withdrawn.

CHAPTER 1900:

- 1901 Revised to reflect amendments to 37 CFR 1.291 and 1.248. Revised to add explanation as to why a protest under 37 CFR 1.291 may be filed throughout the pendency of a reissue application.
- 1901.01 Revised to indicate that where a protest is not the first protest by the real party in interest, 37 CFR 1.291(b)(2) requires compliance with 37 CFR 1.291(c)(5).
- 1901.03 Revised to add reference to form PTO/SB/08. Added reference to MPEP § 609.04(a). Updated the mailing address of the Commissioner for Patents. Revised to indicate that active participation by the protestor ends with the filing of the initial protest and no further submission on behalf of the protestor will be acknowledged or considered unless the submission is made pursuant to 37 CFR 1.291(c)(5).
- 1901.04 Revised to indicate that except where a protest is accompanied by the written consent of the applicant, a protest under 37 CFR 1.291(a) must be submitted prior to the date the application was published under 37 CFR 1.211. Revised to add explanation as to why a protest under 37 CFR 1.291 may be filed throughout the pendency of a reissue application. Also revised to indicate that where a final rejection has been issued or the prosecution on the merits has been otherwise closed for a reissue

application, a petition under 37 CFR 1.182 along with the required fee for entry of the protest are required.

- 1901.05 Revised to indicate that a protest that is submitted in compliance with 37 CFR 1.291(a), (b) and (c) will be considered by the Office if the protest is matched with the application in time to permit review by the examiner during prosecution. Also revised to indicate that the receipt of the self-addressed postcard from the Office is not an indication that the protest complies with 37 CFR 1.291. The postcard receipt only shows that the Office has received the protest.
- 1901.06 Form paragraph has been revised. Revised to indicate that improper protest will be returned to the protestor or discarded at the option of the Office. Revised the discussion regarding treatment of timely submitted protest. Added reference to MPEP § 609.04(a) and § 609.05(a).
- 1901.07(a) Revised to indicate that effective November 22, 2004, 37 CFR 1.291(c) was amended to no longer permit the submission of additional (cumulative) prior art by the same real party in interest.

CHAPTER 2100:

- 2106 Added reference to MPEP § 2111.04. Added discussion of Federal Circuit decision. Updated the citation of *In re Ngai*.
- 2111.01 Updated the citation of *In re American Academy of Science Tech Center*. Added discussion of Federal Circuit decisions.
- 2111.02 Revised to add discussion of recent Federal Circuit decisions.
- 2111.03 Revised to add discussion of recent Federal Circuit decisions.
- 2111.04 New section added to discuss phrases such as “adapted to,” “adapted for,” “wherein,” and “whereby.”
- 2112 Revised to add discussion of recent Federal Circuit decisions.
- 2112.01 Updated citation of *In re Ngai*.
- 2121.03 Revised to add discussion of recent Federal Circuit decision.
- 2123 Revised to add discussion of recent Federal Circuit decision.
- 2126.01 Updated the location of the Lutrelle F. Parker, Sr. Memorial Law Library.

- 2128.01 Added new subsection regarding “publicly displayed documents can constitute a ‘printed publication’ even if the duration of display is for only a few days and the documents are not disseminated by copies or indexed in a library or database.”
- 2133.03(a) Added subsection regarding “the presence or absence of a confidentiality agreement is not dispositive of the public use issue.”
- 2133.03(b) Revised to add discussion of recent Federal Circuit decision. Added subsection regarding “material terms of an offer for sale must be present.”
- 2133.03(c) Revised to add discussion of recent Federal Circuit decision.
- 2133.03(e) The discussion regarding *SmithKline Beecham Corp. v. Apotex Corp.* has been deleted since the original decision was vacated by the court.
- 2133.03(e)(3) The discussion regarding *SmithKline Beecham Corp. v. Apotex Corp.* has been deleted since the original decision was vacated by the court.
- 2133.03(e)(6) The discussion regarding *SmithKline Beecham Corp. v. Apotex Corp.* has been deleted since the original decision was vacated by the court.
- 2136.01 Revised to add discussion regarding 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2136.02 Revised to discuss 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2137.01 Revised to add discussion regarding 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2137.02 Revised to discuss 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2138 Revised to discuss 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2138.01 Revised to refer to the new interference rules which are now set forth in 37 CFR Part 41, Subparts D and E.
- 2138.05 Added discussion regarding *In re Costello*.
- 2141 Revised to reflect amendments to 35 U.S.C. 103(c). Revised to add discussion of recent Federal Circuit decision.
- 2141.01 Added discussion regarding 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2141.01(a) Revised to add discussion of recent Federal Circuit decision.

- 2141.02 Revised to add discussion of recent Federal Circuit decision.
- 2143.01 Revised to add discussion of recent Federal Circuit decision.
- 2144.05 Revised to add discussions of recent Federal Circuit decision.
- 2145 Revised to add discussion of recent Federal Circuit decision.
- 2146 Revised to reflect amendments to 35 U.S.C. 103(c). Added discussion regarding 35 U.S.C. 103(c) as amended by the CREATE Act.
- 2163.07 Revised to add discussion regarding 37 CFR 1.57(a). Added reference to MPEP § 201.17.
- 2163.07(b) Added reference to 37 CFR 1.57.
- 2165.04 Revised to add discussion of recent Federal Circuit decision.
- 2173.02 Revised to add discussion of recent Federal Circuit decisions.
- 2173.05(a) Revised to add reference to MPEP § 2111.01.
- 2173.05(g) Revised to add discussion of recent Federal Circuit decision.
- 2181 Revised to indicate when an examiner should include a statement in the Office action as to whether or not a claim limitation is being treated under 35 U.S.C. 112, sixth paragraph. Revised to add discussion of recent Federal Circuit decision.

CHAPTER 2200:

- 2201 The flowcharts have been revised to reference the new appeal rules.
- 2204 Revised to indicate that citations of prior art under 37 CFR 1.501(a) submitted after the date of any order to reexamine will not be entered into the patent file until the reexamination proceeding has been concluded.
- 2209 Revised to indicate that when the prosecution of a reexamination proceeding is terminated, a reexamination certificate is issued which indicates the status of all claims following the reexamination. Unless prosecution is reopened by the Director, the reexamination proceeding is concluded by the issuance and publication of a reexamination certificate.

- 2210 Revised to indicate that if a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees may also apply.
- 2214 Revised to indicate that if a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees may also apply. Form PTO/SB/57 has been updated.
- 2215 Revised to indicate that if a request filed by the patent owner includes a proposed amendment in accordance with 37 CFR 1.530, excess claims fees may also apply.
- 2221 Revised to indicate that if an amendment is submitted to add claims to the patent being reexamined, excess claims fees may apply.
- 2222 Revised to reflect amendments to 37 CFR 1.33. The addresses for submitting to the Office a change of the correspondence address or a power of attorney have been revised. Form PTO/SB/82 has been updated.
- 2223 Form PTO/SB/83 has been updated.
- 2224 The addresses for submitting to the Office all requests for *ex parte* reexamination and all subsequent *ex parte* reexamination correspondence have been updated.
- 2232 Revised to indicate that the general public may view the entire content of a reexamination file via Public PAIR.
- 2232.01 New section added. Some of the material that was in MPEP § 2232 has been moved to this new section.
- 2233 Revised to indicate that the fees for a reexamination proceeding include the fees for the request, for addition of claims, for a request for an extension of time, for any appeal, brief, and oral hearing. No fee is required for the issuance of a reexamination certificate.
- 2234 Revised to include instructions for entry of amendments for an IFW reexamination file.
- 2235 Revised to add discussion regarding reexamination e-File.
- 2236 Revised to indicate that where a reexamination proceeding is pending and a reissue application is filed, the Office of Patent Legal Administration should be notified by e-mail as promptly as possible after the reissue application reaches the TC that the proceedings are ready for consideration of merger.

- 2237 Discussion regarding the transfer procedure for a reexamination proceeding has been revised.
- 2239 Added reference to the Central Reexamination Unit (CRU).
- 2240 Revised to indicate that if a second or subsequent request for reexamination is filed while a first *ex parte* reexamination is pending, the second or subsequent request for reexamination may raise a substantial new question of patentability with respect to any new or amended claim which has been proposed in the first (or prior) pending reexamination proceeding.
- 2242 Revised to indicate that where a request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending for that patent, the substantial new question of patentability may be raised with respect to any new or amended claim which has been proposed in the pending reexamination proceeding.
- 2245 Revised to indicate that where the request for reexamination was filed by a third party, copies of any prior art documents not already supplied by or to the patent owner or requester will be provided to the patent owner and the requester.
- 2246 Added reference to the example in MPEP § 2247.01. The citations to *Heinl v. Godici* and *Patlex Corp. v. Quigg* have been corrected.
- 2247 Added reference to the example in MPEP § 2247.01.
- 2247.01 Revised to indicate that the first example illustrates a grant of an *ex parte* reexamination request and the second example illustrates a denial of an *ex parte* reexamination request.
- 2250 Revised to reflect amendments to 37 CFR 1.52. Revised to indicate that if an amendment is submitted to add claims to the patent being reexamined, excess claims fees may apply. Form paragraphs have been revised.
- 2250.03 New section added to discuss excess claims fees.
- 2254 Revised to reflect amendments to 37 CFR 1.550.
- 2258 Discussion regarding double patenting has been revised in view of the CREATE Act.
- 2258.01 The citation of *Heinl v. Godici* has been corrected. Revised to clarify that it is the prosecution of the reexamination that is terminated.

- 2260 Revised to reflect amendments to 37 CFR 1.104. Form paragraph has been revised.
- 2265 Revised to reflect amendments to 37 CFR 1.550. Revised to indicate that the automatic one-month extension of time granted as a result of a timely first response to a final rejection does not apply once the Notice of Appeal has been filed.
- 2266 Revised to reflect amendments to 37 CFR 1.111 and 1.550. Added discussion regarding supplemental replies.
- 2266.01 Form paragraph has been revised. Revised to indicate that where a submission after appeal (e.g., amendment filed under 37 CFR 41.33) does not place the reexamination proceeding in condition for issuance of a reexamination certificate, the period for filing an appeal brief continues to run (i.e., 2 months from the date of filing the notice of appeal – 37 CFR 41.37(a)(1)) until an appeal brief or an amendment that places the proceeding in condition for issuance of a reexamination certificate is filed.
- 2266.02 Added an additional example to illustrate a defective submission. Added form PTOL-475.
- 2266.03 Added discussion regarding IFW processing.
- 2267 Revised to indicate that where a paper is to be returned based on subsection II., and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the TC Director will return the paper. Where a petition under 37 CFR 1.182 or 1.183 has been filed, the reexamination proceeding should be forwarded to OPLA for a decision on the petition.
- 2268 Revised to reflect amendments to 35 U.S.C. 41.
- 2270 Revised to indicate that the Office of the TC SPRE provides oversight as to clerical processing.
- 2271 Form paragraphs have been revised.
- 2272 Revised to indicate that consideration of amendments submitted after appeal will be governed by 37 CFR 41.33.
- 2273 Added reference to the new appeal rules.
- 2274 Added reference to the new appeal rules.
- 2275 Added reference to the new appeal rules.

- 2276 Added reference to the new appeal rules.
- 2283 Revised to state that where the merger decision indicates that an Office action will follow, the merged proceeding is returned to the examiner immediately after the decision for appropriate action. Where the merger decision indicates that the patent owner is given 1 month to provide an amendment to make the claims the same in each file, the Office of the TC SPRE will retain jurisdiction over the merged reexamination proceeding to await submission of the amendment or the expiration of the time to submit the amendment.
- 2284 Revised to reflect amendments to 37 CFR 1.565 and 41.8. Added reference to the new interference rules.
- 2285 Revised to indicate that the OPLA should be notified by the TC via e-mail when a reexamination proceeding and a reissue application are ready for consideration of merger. Also revised to state that where the merger decision indicates that an Office action will follow, the merged proceeding is returned to the examiner immediately after the decision for appropriate action. Where the merger decision indicates that the patent owner is given 1 month to provide an amendment to make the claims the same in each file, the Office of the TC SPRE will retain jurisdiction over the merged reexamination proceeding to await submission of the amendment or the expiration of the time to submit the amendment.
- 2286 Form paragraph has been revised.
- 2287 The discussion regarding the preparation of the reexamination file for publication has been revised.
- 2289 Revised to indicate that a patentability review is made in a sample of reexamination cases by the TC QASs in the manner previously carried out by the former Office of Patent Quality Review.
- 2294 The title of this section has been revised.
- 2296 The list of forms to be used in an *ex parte* reexamination proceeding has been updated.

CHAPTER 2600:

- 2601.01 The flowcharts have been revised to reflect the new appeal rules.

- 2609 Revised to indicate that when the prosecution of an *inter partes* reexamination proceeding is terminated, an *inter partes* reexamination certificate is issued and the reexamination proceeding is concluded.
- 2612 Revised to correct the reference to 37 CFR 1.915(b)(7).
- 2614 Revised to indicate that a request for *inter partes* reexamination cannot be filed by the patent owner, therefore, there will be no proposed amendment to generate excess claims fees at the filing of a request for *inter partes* reexamination. Form PTO/SB/58 has been updated.
- 2622 Revised to reflect amendments to 37 CFR 1.33. Form PTO/SB/82 has been updated.
- 2623 Form PTO/SB/83 has been updated.
- 2624 The addresses for the Mail Stop *Inter Partes* Reexam and the Customer Service Window have been updated. The fax number for the Central Reexamination Unit has been updated.
- 2632 Revised to indicate that reexamination files are open to inspection by the general public by way of the Public PAIR via the USPTO Internet site.
- 2633 Revised to clarify that the “case” previously referred to in this section is directed to the reexamination file.
- 2634 Revised to add reference to the excess claims fees and the fee for request for extension of time.
- 2635 Revised to add discussion regarding reexamination e-File.
- 2636 Revised to indicate that the OPLA should be notified by the TC via e-mail when a reexamination proceeding and a reissue application are ready for consideration of merger.
- 2637 The transfer procedure for an *inter partes* reexamination request has been revised.
- 2640 Revised to indicate that a copy of the litigation computer search performed by STIC is scanned into the IFW reexamination file history and that the “Litigation Review” box on the reexamination IFW file jacket form is completed to indicate that the review was conducted and the form is then scanned into the IFW reexamination file history. Also revised to indicate that the second or subsequent request for reexamination may raise a substantial new question of patentability with respect to any new or

amended claim which has been proposed in the first (or prior) pending reexamination proceeding.

- 2641 Revised to clarify that the “case” previously referred to in this section is directed to the reexamination file.
- 2642 Revised to indicate that where a request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending for that patent, the substantial new question of patentability may be raised with respect to any new or amended claim which has been proposed in the pending reexamination proceeding.
- 2646 Revised to add reference to forms PTO/SB/08 and PTO/SB/42.
- 2647 Revised to indicate that the decision denying the request for reexamination is mailed by the CRU and jurisdiction over the reexamination is retained by the CRU to await any petition seeking review of the decision.
- 2647.01 The sample decisions have been revised to reflect the new address of the Customer Service Window and the telephone and fax numbers of the CRU.
- 2647.02 Revised to indicate that the clerical staff should make 2 copies of the prior art documents not already supplied by the 3rd party requester, one for the patent owner and one for the 3rd party requester.
- 2648 Revised to add reference to MPEP § 2647 and § 2694.
- 2660 Revised to reflect amendments to 37 CFR 1.104. Form paragraphs have been revised. The sample Office action has been revised to reflect the new address of the Customer Service Window and the telephone and fax numbers of the CRU.
- 2662 Revised to add reference to the new appeal rules.
- 2665 Revised to reflect amendments to 37 CFR 1.956.
- 2666 Revised to reflect amendments to 37 CFR 1.111. Added new subsection to address supplemental responses.
- 2666.01 Revised to indicate that if an amendment is submitted to add claims to the patent being reexamined, then excess claims fees may apply. Form paragraphs have been revised.
- 2666.04 New section added to address excess claims fees.

- 2666.05 Revised the discussion regarding an examiner withdrawing a ground of rejection in the prosecution of an *inter partes* reexamination proceeding.
- 2666.06 Revised to add reference to 37 CFR 1.915(b)(6).
- 2666.20 Revise to add reference to the new appeal rules.
- 2666.30 Form paragraph has been revised.
- 2666.40 Revised to indicate that where there is a failure to pay an excess claims fee by the patent owner, the 3rd party requester does not have the new claim “package” to comment on. Thus, the 3rd party requester comments may be filed within 30 days from the date of service of the patent owner’s response correcting the excess claims fee deficiency.
- 2666.50 Form PTOL-2069 has been updated.
- 2666.60 Revised to indicate that if the failure to comply with the notice of defective paper results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.957(b) or limited under 37 CFR 1.957(c) (as is appropriate).
- 2667 Revised to indicate that where a paper is to be returned based on one of the reasons identified in subsection I., and the paper is not accompanied by a petition under 37 CFR 1.182 or 1.183, the TC Director or the Reexamination Legal Advisor will return the paper. Where the submission is accompanied by a petition under 37 CFR 1.182 or 1.183, the reexamination proceeding will be forwarded to the OPLA for a decision on the petition. The discussion regarding the response being too long has been revised.
- 2671.01 The spelling of withdrawal has been corrected. Added reference to the new appeal rules. The discussion regarding the examiner withdrawing a ground of rejection has been revised. Form paragraphs have been revised.
- 2671.02 Revised to add reference to the new appeal rules.
- 2673.02 Revised to add reference to the new appeal rules. Form paragraph has been revised. Revised to indicate that pursuant to 37 CFR 1.116(d)(1), no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claims in the proceeding, can be made in an *inter partes* reexamination proceeding after the RAN except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1).

- 2674 Revised to reflect amendments to 37 CFR 1.959. Added reference to the new appeal rules. Revised to indicate that amendments filed after the date of filing an appeal are governed by 37 CFR 41.63.
- 2674.01 Revised to add reference to 37 CFR 41.61.
- 2675 Revised to add reference to 37 CFR 41.66 and 41.67. Revised to add a new subsection directed to amendments, affidavits, declarations and exhibits submitted after the date of filing an appeal.
- 2675.01 Revised to add reference to 37 CFR 41.66 and 41.68.
- 2675.02 Revised to add reference to 37 CFR 41.67. Form paragraphs have been revised.
- 2677 Revised to add reference to 37 CFR 41.69. The discussion regarding the requirements for examiner's answer has been revised to reflect the new appeal rules. Form paragraphs have been revised.
- 2678 Revised to add reference to 37 CFR 41.66 and 41.71.
- 2679 Revised to add reference to the new appeal rules.
- 2680 Revised to add reference to 37 CFR 41.73. Also revised to indicate that where the appeal involves reexamination proceedings, oral hearings are open to the public as observers unless one of the appellants and/or the respondents petitions under 37 CFR 41.3 that the hearing not be open to the public and the petition is granted.
- 2681 Revised to add reference to 37 CFR 41.77.
- 2682 Revised to add reference to 37 CFR 41.79 and 41.81. Revised to reflect amendments to 37 CFR 1.981. Form paragraph has been revised. Revised to indicate that where at least one request for rehearing of the decision is granted, the Board's decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and the decision is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.
- 2683 Revised to add reference to the new appeal rules.
- 2686.01 Revised to state that where the merger decision indicates that an Office action will follow, the merged proceeding is returned to the examiner immediately after the decision for appropriate action. Where the merger decision indicates that the patent owner is given 1 month to provide an

amendment to make the claims the same in each file, the CRU will retain jurisdiction over the merged reexamination proceeding to await submission of the amendment or the expiration of the time to submit the amendment.

- 2686.02 Revised to reflect amendments to 37 CFR 1.993. Revised to add reference to 37 CFR 41.8, 41.102 and 41.103. Revised to add discussion regarding a 1991 Board decision. Also revised to indicate that a request to stay an interference under 37 CFR 1.993 will be decided by the Chief Administrative Patent Judge of the Board.
- 2686.03 Revised to indicate that the OPLA should be notified by the TC via e-mail when a reexamination proceeding and a reissue application are ready for consideration of merger.
- 2690 Revised to add reference to forms PTO/SB/08 and PTO/SB/42.
- 2692 Revised to indicate that an e-copy of the *inter partes* reexamination certificate will be associated with the e-copy of the patent in the search files.
- 2694 The title of this section has been revised.
- 2696 The list of forms to be used in an *inter partes* reexamination proceeding has been updated.

