

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

MANUAL OF PATENT EXAMINING PROCEDURE
Eighth Edition

Instructions Regarding Revision No. 5

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

- (1) “Changes To Implement the Cooperative Research and Technology Enhancement Act of 2004,” which became effective on September 14, 2005;
- (2) “Provisions for Claiming the Benefit of a Provisional Application With a Non-English Specification and Other Miscellaneous Matters,” which became effective on November 25, 2005;
- (3) “Changes To Implement the Patent Search Fee Refund Provisions of the Consolidated Appropriations Act, 2005,” which became effective on March 10, 2006; and
- (4) “Clarification of Filing Date Requirements for *Ex Parte* and *Inter Partes* Reexamination Proceedings,” which became effective on March 27, 2006.

This revision consists of replacement pages for the **Title Page** in the front of the Manual, **entire Chapters 100 – 900, 1100, 1300 - 1500, 1700, 1800, 2100, 2200, 2500 and 2600, Appendices II – List of Decisions Cited, R – Patent Rules, T – Patent Cooperation Treaty, and AI – Administrative Instructions Under the PCT, and entire Index.**

Pages which have been printed in this revision are labeled as “**Rev. 5**” on the bottom. Sections of the Manual that have been changed by this revision are indicated by “[**R-5**]” 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 100:

- 101 Revised to add references to 37 CFR 1.11(a) and 1.14(a).
- 103 Revised to reflect amendments to 37 CFR 1.11. Also revised to indicate that published applications maintained in the IFW system are available via the public PAIR system. Form PTO/SB/68 has been updated. Revised to add references to 37 CFR 41.6.
- 104 Revised to add references to 35 U.S.C. 122 and 37 CFR 1.11 and 1.14.
- 106 Revised to indicate that after an application has published, any restriction on the inventor to access his or her application previously granted will no longer be in effect and the application will be available to the public.
- 115 Revised to delete discussion of 37 CFR 1.51(f). Also revised to indicate that if a provisional application is filed in a foreign language, applicants are strongly encouraged that if they are in possession of an English description of the technology, the English description should be filed with the provisional application to prevent screening delays. Revised to add discussion regarding Licensing and Review status in PALM.
- 120 Revised to reflect amendments to 37 CFR 5.1, 5.2, 5.3 and 5.4. Revised to address identity theft concerns by indicating that applicants no longer need to provide individual personal information to ensure a proper security clearance. Personnel controlling the cleared correspondence address bear the burden of ensuring that individuals obtaining classified information from the correspondence address follow the proper procedures for handling classified information.
- 130 Revised to add references to 37 CFR 5.3 and MPEP § 2306.
- 140 Revised to reflect amendments to 37 CFR 5.11, 5.12, 5.15, 5.19 and 5.25. Revised to add discussion regarding the export of subject matter abroad for purposes not related to foreign filing of a patent application. Revised to indicate that generally, a license will be granted, if there is no national security concern, within 3 business days from receipt of the expedited petition filed under 37 CFR 5.12(b) in Licensing and Review. Applicants are strongly encouraged to hand deliver or fax the license request to Licensing and Review.

CHAPTER 200:

- 201.03 Revised to clarify that where the name of an inventor(s) is to be deleted, applicant can file a continuation or divisional application, using a copy of the executed oath or declaration from the parent application, with a request for deletion of the name of the inventor(s). If a continuing application is filed with a new executed oath or declaration properly naming the correct inventors, a request for deletion of the name(s) of the person(s) who are not inventor(s) in the continuing application is not necessary.
- 201.04(b) Revised to indicate that a provisional application is a regular national filing that starts the Paris Convention priority year. Form PTO/SB/16 has been updated.
- 201.06(c) Revised to indicate that if the copy of the signed oath or declaration from the prior application included a power of attorney, the power of attorney in the copy of the signed oath or declaration from the prior application would carry over to the continuation or divisional application. Also revised to refer to registered attorney or agent as registered patent practitioner.
- 201.09 Form paragraph has been revised.
- 201.11 Revised to reflect amendments to 37 CFR 1.78. Form paragraphs have been revised.
- 201.14 Revised to indicate that where a claim for priority under 35 U.S.C. 119(b) has not been made in the parent application, the claim for priority may be made in the continuing application provided that the parent application has been filed within 12 months from the date of the earliest foreign filing. If the claim for priority and the certified copy of the priority document are not filed in the continuing application within the time period set in 37 CFR 1.55, the right of priority is lost.

CHAPTER 300:

- 302 Revised to reflect amendments to 37 CFR 3.11.
- 302.07 Revised to reflect amendments to 37 CFR 3.28 and 3.31. Form PTO-1595 has been updated.
- 302.09 Revised to indicate that the use of the Credit Card form, PTO-2038 is required for the credit card information to be kept separate from the assignment records.

- 302.10 Revised to reflect amendments to 37 CFR 3.31 and 1.4. Revised to indicate that the use of the Credit Card form, PTO-2038 is required for the credit card information to be kept separate from the assignment records.
- 320 Added information as to how examiners can obtain a title report using the PALM system.
- 324 Revised to reflect amendments to 37 CFR 3.73. Form PTO/SB/96 has been updated.

CHAPTER 400:

- 401 Revised to reflect amendments to 37 CFR 1.31.
- 402 Revised to reflect amendments to 37 CFR 1.31, 1.32 and 1.34. Form PTO/SB/81 has been updated. Form paragraph has been revised.
- 402.01 Revised to indicate that one or more of the joint inventors may give power of attorney to the other joint inventor(s) in the application.
- 402.05 Revised to reflect amendments to 37 CFR 1.36. Form PTO/SB/82 has been updated.
- 402.06 Revised to add references to disciplinary rules 37 CFR 10.40 and 10.57. Form PTO/SB/83 has been updated.
- 402.07 Form PTO/SB/80 has been updated.
- 402.10 References to “attorney” in the examples have been changed to “a patent practitioner.”
- 403 Revised to reflect amendments to 37 CFR 1.33. Revised to remind patent practitioners that the attorney and agent roster must be updated separately from and in addition to any change of address filed in individual patent applications. Forms PTO/SB/122, 123, 124A, 124B, 125A, and 125B have been updated.
- 403.02 The title of this section has been revised. References to “attorney” have been changed to “patent practitioner.”
- 404 The title of this section has been revised.
- 405 The title of this section has been revised. Form PTO/SB/84 has been updated.

- 406 The title of this section has been revised. References to “attorney” have been changed to “patent practitioner.” Form paragraphs have been revised.
- 407 The title of this section has been revised. Revised to indicate that any power of attorney given to a practitioner who has been suspended or disbarred by the Office is ineffective and does not authorize the person to practice before the Office or to represent applicants or patentees in patent matters.
- 408 The title of this section has been revised. References to “attorney” have been changed to “patent practitioner.”
- 409 Revised to correct the references to 37 CFR 1.42, 1.43 and 1.47.
- 409.01 Reference to “attorney” has been changed to “patent practitioner.”
- 410 Revised to correct to the reference to 35 U.S.C. 2(b)(2).

CHAPTER 500:

- 501 Revised to reflect amendments to 37 CFR 1.4. The address for replenishing deposit accounts has been updated.
- 502 The telephone number for the Office of Patent Legal Administration has been updated. The list of correspondences that may be hand-delivered to a specific location rather than the Customer Service Window has been updated.
- 502.01 The list of correspondences that may be faxed to other than the central fax number has been updated. Revised to clarify that color drawings may not be faxed to the Office.
- 502.02 Revised to reflect amendments to 37 CFR 1.4.
- 506 Revised to indicate that no refund will be made once the fee for claims is properly paid, even though claims are later canceled, unless a petition for express abandonment under 37 CFR 1.138(d) is granted.
- 509 Revised to indicate that beginning January 28, 2006, credit card payment submissions made on the USPTO web site must include the 3-digit or 4-digit security code associated with the credit card in addition to the credit card number. Form PTO-2038 has been updated.

509.01 Revised to reflect amendments to 37 CFR 1.25. Revised to indicate that in the event a check or credit card payment is refused or charged back by a financial institution, the processing fee under 37 CFR 1.21(m) may be charged to a deposit account based on a general authorization under 37 CFR 1.25. The address for replenishing deposit accounts has been updated.

CHAPTER 600:

601.01(d) Revised to rearrange the material under new subsection headings, “Application Entitled to Filing Date” and “Application Not Entitled to Filing Date.”

601.01(g) Revised to rearrange the material to clearly set forth what applicant may do in response to a notice of omitted items.

601.02 Form PTO/SB/81 has been updated.

601.03 Revised to reflect amendments to 37 CFR 1.33.

601.05 Revised to correct that a paper filed under 37 CFR 1.48(a) is a request rather than a petition.

602 Revised to add reference to MPEP § 608.04. Form PTO/SB/01 has been updated.

602.03 Form paragraph has been revised.

602.04(a) Revised to indicate that a list of the current member countries that are parties to the Hague Convention can be obtained from the Internet web site of the Hague Conference on Private International Law or the Internet web site of the U.S. Department of State.

605.02 The reference to the form, PTO-152 has been deleted.

605.04(a) Revised to indicate that in an application filed by joint inventors, each inventor need not execute the same oath or declaration, however, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity.

605.04(c) The requirement for an “affidavit” or a “certified” copy of the court order has been deleted. Rather a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected or a copy of the court order must be submitted with the petition.

- 606 Revised to indicate that the articles “a,” “an,” and “the” should not be included as the first words of the title of the invention and will be deleted when the Office enters the title into the Office’s computer records and when any patent issues.
- 607 Revised to add reference to MPEP § 607.02 subsection V for refund of excess claims fees.
- 607.02 Revised to add new subsection V to address refund of search fee and excess claims fee.
- 608.01 Revised to reflect amendments to 37 CFR 1.71, and 1.52. Revised to indicate that if a provisional application is filed in a language other than English, an English translation and a statement that the translation is accurate must be filed in the provisional application if benefit of the provisional application is claimed in a later-filed nonprovisional application.
- 608.01(a) Form paragraphs have been revised.
- 608.01(n) References to forms PTO-1360 and PTO-875 have been deleted.
- 608.01(s) Reference to MPEP § 714.24 has been changed to MPEP § 714.
- 608.05 Revised to reflect amendments to 37 CFR 1.52.
- 608.05(a) Revised to reflect amendments to 37 CFR 1.96.
- 609 References to form PTO-1449 have been deleted. Revised to add reference to MPEP § 609.08 regarding electronic processing of IDS.
- 609.01 Revised to add reference to MPEP § 609.08 regarding electronic processing of IDS.
- 609.02 References to form PTO-1449 have been deleted. Revised to indicate that when filing a continuing application that claims benefit under 35 U.S.C. 120 to a parent application (other than an international application that designated the U.S.), it will not be necessary for the applicant to submit an IDS in the continuing application that lists the prior art cited by the examiner in the parent application unless the applicant desires the information to be printed on the patent issuing from the continuing application. Also revised to indicate that when filing a continuing application that claims benefit under 35 U.S.C. 120 to an international application that designated the U.S., it is necessary for the applicant to submit an information disclosure statement complying with 37 CFR 1.97 and 1.98 in the continuing application listing the documents cited in the

international search report and/or the international preliminary examination report of the international application if applicant wishes to ensure that the information will be considered by the examiner in the continuing application.

- 609.04(a) References to form PTO-1449 have been deleted.
- 609.04(b) Revised to add references to MPEP § 502 and § 502.01 regarding hand delivery and facsimile transmission of petitions to withdraw from issue to the Office of Petitions. Also revised to indicate that if an IDS includes a dated communication from a foreign patent office, the copy of the dated communication by itself will not be accepted as the required statement under 37 CFR 1.97(e)(1) since it would not be clear from the dated communication whether the information in the IDS was “first cited” in any communication from a foreign patent office not more than 3 months prior to the filing of the IDS.
- 609.05(a) References to form PTO-1449 have been deleted.
- 609.05(b) References to form PTO-1449 have been deleted.
- 609.05(c) References to form PTO-1449 have been deleted.
- 609.06 References to form PTO-1449 have been deleted.
- 609.07 References to form PTO-1449 have been deleted.
- 609.08 New section added to address electronic processing of IDS.

CHAPTER 700:

- 703 Revised to indicate the booklet “General Information Concerning Patents” available from the U.S. Government Printing Office was last published in 2001, and that an updated version of the booklet is available from the USPTO Web page.
- 704.14(a) Form paragraph has been revised.
- 704.14(d) Revised to delete reference to form PTO-1449.
- 706 Revised to reflect amendments to 37 CFR 1.104.
- 706.02(b) Revised to change “priority” under 35 U.S.C. 119(e) to “benefit” under 35 U.S.C. 119(e).

- 706.02(f)(1) Revised to change “priority” under 35 U.S.C. 119(e) and 120 to “benefit” under 35 U.S.C. 119(e) and 120. Also revised to change “benefit” under 35 U.S.C. 119(a)-(d) to “priority” under 35 U.S.C. 119(a)-(d). Flowcharts have been revised.
- 706.02(k) Revised to add reference to 37 CFR 1.78.
- 706.02(l)(2) Subsection III revised to include a discussion of revised procedures under the CREATE Act, and to include references to 37 CFR 1.71 and 1.104.
- 706.02(m) Form paragraphs have been revised.
- 706.03(a) Form paragraph has been revised.
- 706.07(a) Form paragraph has been revised.
- 706.07(d) Revised to clarify that the examiner cannot withdraw the final rejection once the application is abandoned.
- 706.07(f) References to form paragraphs 7.40.02, 7.42.03, and 7.42.031 added.
- 706.07(g) A missing word was replaced in the Transitional After-Final Practice Flowchart. Form paragraph has been revised.
- 706.07(h) Form PTO/SB/30 has been updated.
- 707 Revised to reflect amendments to 37 CFR 1.104.
- 707.05(d) Reference to form PTO-1449 has been deleted.
- 707.07(h) Reference to MPEP § 714.23 has been changed to MPEP § 714, subsection II. G.
- 707.07(j) Form paragraph has been revised.
- 708.02 Revised to indicate that any petition to make special, other than those based on applicant’s health or age or the Patent Prosecution Highway (PPH) pilot program, filed on or after August 25, 2006 must meet the requirements for the revised accelerated examination program set forth in MPEP § 708.02(a). Also revised to indicate that applications filed prior to August 25, 2006 are not eligible for the revised accelerated examination program set forth in MPEP § 708.02(a).
- 708.02(a) New section added to set forth the requirements of the accelerated examination program effective August 25, 2006.

- 709 Form PTO/SB/37 has been updated.
- 711.01 Revised to include new subsection III directed to abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and excess claims fee in an application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b). Subsections III and IV have been renumbered as subsections IV and V. Forms PTO/SB/24 and PTO/SB/24A have been updated and new form PTO/SB/24B has been added.
- 711.03(c) Forms PTO/SB/64, 64a, 64/PCT, 61, 61/PCT, 62 and 63 have been updated. Revised to indicate that where a petition under 37 CFR 1.137(b) is not filed within 1 year of the date of abandonment, the Office may require further information from the applicant.
- 711.04(b) Updated to reflect changed location of USPTO buildings.
- 713.01 Revised to reflect amendments to 37 CFR 1.133.
- 713.02 Revised to reflect amendments to 37 CFR 1.133.
- 713.05 Revised to indicate that interviews are generally not granted to registered individuals who are known to be the local representatives of the attorney in the application unless a power of attorney to them or Authorization to Act in a Representative Capacity (e.g., form PTO/SB/84) is of record in the particular application. Also revised to include a cross-reference to MPEP § 405.
- 714 Form PTOL-324 has been updated.
- 714.01(e) Revised to include the procedure the Office now follows to ensure that any preliminary amendments present on the filing date of an application are included in the publication of the patent application under 35 U.S.C. 122(b) and 37 CFR 1.215(a).
- 714.13 References to form paragraphs 7.40.02 and 7.42.03 have been added.
- 714.19 Reference to MPEP § 714.23 has been changed to MPEP § 714, subsection II.G.
- 715.04 Revised to remove the statement that the signature of the remaining joint inventors is sufficient if it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable.
- 715.05 Form paragraphs have been revised.

719.05 The procedures for recording search history of nucleotide and peptide sequence searches have been revised.

CHAPTER 800:

802.01 Revised to clarify that restriction may be proper if the claimed inventions are either independent (i.e., unrelated), or related but distinct.

803.02 Revised to add reference to MPEP § 808.02. Also revised to indicate that if an examiner determines that the elected species in a Markush-type claim is allowable, the examination of the Markush-type claim will be extended.

804 Charts I-B and II-B have been revised to add an indication that in situations where a reference is properly excluded as prior art under 35 U.S.C. 103(c) based on common ownership or a joint research agreement, if the reference is available as anticipatory prior art, a rejection should also be made under 35 U.S.C. 102(e). Revised to clarify that a nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

806.04(e) Revised to indicate that claims themselves are never species and that a claim may encompass two or more of the disclosed embodiments.

806.05 Revised to clarify that related inventions in the same statutory class are considered mutually exclusive, or not overlapping in scope, if a first invention would not infringe a second invention, and the second invention would not infringe the first invention.

806.05(c) Revised to correct a spelling error. Also revised to indicate that where a combination as claimed requires the details of a subcombination, there is usually no evidence that the combination is patentable without the details of the subcombination as separately claimed. Revised to add a reference to MPEP § 806.05(d). Form paragraph has been revised.

806.05(d) Revised to add explanation of when it is appropriate to restrict between separately claimed plural subcombinations usable together in a single combination and a claimed combination that requires the particulars of at least one, or at least two, subcombinations. Form paragraph has been revised.

806.05(e) Form paragraph has been revised.

806.05(f) Form paragraph has been revised.

- 806.05(j) Form paragraph has been revised.
- 806.06 Form paragraph 8.20.03 has been added.
- 808.01(a) Revised to add reference to MPEP § 809.02(a).
- 808.02 Revised to delete the word “related” in the second paragraph of this section.
- 809 Revised to add reference to MPEP § 821.04 for information regarding rejoinder practice.
- 809.03 Revised to add references to MPEP § 809 and § 821.04. Form paragraph has been revised.
- 817 Form paragraphs have been revised.
- 821.04(a) Form paragraphs have been revised.
- 821.04(b) Form paragraphs have been revised.

CHAPTER 900:

- 901.05(d) The Intranet address for STIC’s homepage has been updated.
- 901.06(a) The location of STIC and information and services available in STIC have been updated.
- 901.07 Revised to indicate that in the TCs, the only documents that are maintained in paper form are patents from the plant class, foreign patent documents, and non-patent literature.
- 902.01 Information regarding the Manual of Classification has been updated.
- 902.01(a) Revised to indicate that the index to the USPC is regularly updated. The Intranet address for the Classification Home Page has been added.
- 902.02 The Intranet address for the Classification Home Page has been added.
- 902.02(a) Discussion regarding definition notes has been updated.
- 902.02(b) This section directed to search cards has been deleted.
- 902.03(a) Information regarding the Patent Classification Home Page has been updated.

- 902.03(b) Information regarding the Patent Classification Home Page has been updated.
- 902.03(c) Information regarding Classification Insight on USPTO Local Area Network has been updated.
- 902.03(d) The title of this section has been revised.
- 902.03(e) Information regarding EAST and WEST has been updated.
- 902.04 Information regarding a classification order has been updated.
- 902.04(a) The Intranet address for the Classification Home Page has been added.
- 903.02(a) Information regarding the establishment of new and revised classes has been updated.
- 903.02(c) Revised to indicate that any examiner having the TC Director's approval to create new subclasses should contact the SPC for his or her technology before work is begun.
- 903.04 Discussion of classification for publication as a patent application publication has been updated.
- 903.06 New section added to address harmonized subclasses.
- 903.07 The Intranet address for the Classification Home Page has been added. Revised to indicate that where an official classification order affects an application already passed to issue, the Office of Patent Classification oversees any necessary changes.
- 903.08(d) The transfer procedures have been updated.
- 903.09 Revised to delete references to the Seventh Edition of the International Patent Classification. Revised to add reference to the Intranet address for the Classification homepage.
- 903.09(a) The title of the Office of Patent Classification has been revised.
- 904.01(c) Revised to indicate that all analogous arts must be searched regardless of where the claimed invention is classified.

CHAPTER 1100:

- 1105 Revised to reflect amendments to 37 CFR 1.295.

- 1109 Revised to reflect amendments to 37 CFR 1.296.
- 1120 Revised to reflect amendments to 37 CFR 1.211. Revised to indicate that the Office may delay publication until the application includes any application size fee required by the Office. Also revised to indicate that applicants should carefully review their filing receipts and should promptly file a request for corrected filing receipt if the information on the filing receipt needs to be corrected. If the corrections are not recognized by the Pre-Grant Publication Division before the technical preparation for publication has begun, the Office cannot change the projected publication date and include the corrections in the publication.
- 1121 Revised to reflect amendments to 37 CFR 1.215. The heading for subsection I has been moved. Revised to add discussion regarding preliminary amendments. The discussion regarding amended applications filed via EFS has been amended. Revised to indicate that providing the assignee information on the application transmittal letter or the application data sheet does not substitute for compliance with any requirements of 37 CFR Part 3 to have the assignment recorded by the Office.
- 1122 The discussion regarding the filing of a nonpublication request has been revised.
- 1125 Revised to reflect amendments to 37 CFR 1.138.
- 1126 Revised to indicate that applicant may file a request for a refund of the publication fee after 4 weeks from the issue date of the patent if the application did not publish.
- 1127 Revised to indicate that if applicant timely adds or deletes a benefit or priority claim and the Office recognizes the correction and changes the projected publication date before the technical preparations of the application has begun, the Office will mail a notice informing applicant of the newly assigned projected publication date.
- 1130 The examples of material mistake have been revised.
- 1134.01 Revised to indicate that submissions after the time period specified in 37 CFR 1.99(e) must be accompanied by the processing fee and a satisfactory explanation why the patents or publications being submitted could not have been submitted to the Office earlier. Form paragraph has been revised.
- 1135 The forms have been updated.

CHAPTER 1300:

- 1302.01 Revised to indicate that no pencil notes should be made in the application file that is maintained in paper when the application is ready for allowance.
- 1302.03 The discussion regarding situations where delays in processing the Notice of Allowability are expected has been deleted.
- 1302.07 This section on the use of retention labels to preserve abandoned companion applications has been deleted.
- 1302.12 Revised to delete references to form PTO-1449.
- 1302.14 Revised to add reference to Federal Circuit decision.
- 1303 Form PTOL-85 has been updated.
- 1306 Revised to indicate that the issue fee due identified in the Notice of Allowance does not reflect any credit for previously paid issue fee in the application. If an issue fee has previously been paid in the application as reflected in the Notice of Allowance, the return of the form PTOL-85B will be considered a request to reapply the previously paid issue fee toward the issue fee that is now due.
- 1306.01 The title of the form PTOL-85B has been corrected.
- 1306.03 Revised to clarify that the discussion under the subsection heading “ordering of allowed applications” is directed to allowed applications that are maintained in paper.
- 1308 Revised to add references to MPEP § 1306 regarding request to reapply a previously paid issue fee toward the issue fee that is now due in the same application. Revised to add reference to Federal Circuit decision.
- 1308.01 Revised to add reference to MPEP § 1306 regarding request to reapply a previously paid issue fee toward the issue fee that is now due in the same application.
- 1309 Revised to indicate that where an allowed application falls within one of the categories identified in the section, examiners should notify, via e-mail, the Manager of the Publishing Division in the Office of Publication that the allowed application should be handled special for printing purposes.

CHAPTER 1400:

- 1402 Revised to add discussion of a CCPA decision. In view of the CCPA decision, the Office has reconsidered its position and will permit the use of reissue as a mechanism to correct an applicant's mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e) where the application which became the patent to be reissued was filed on or after November 29, 2000. A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) would not be required in addition to filing a reissue application.
- 1410.01 Revised to reflect amendments to 37 CFR 3.73. Form paragraph has been revised.
- 1412.02 Revised to add reference to recent Federal Circuit decision.
- 1412.04 Revised to correct reference to 37 CFR 1.63.
- 1414 Revised to indicate that a statement that the original patent is wholly or partly inoperative or invalid by reason that the patentee claiming more or less than the patentee had the right to claim in the patent is improper since a claim cannot claim "more or less" at the same time. Forms PTO/SB/51 and 52 have been updated.
- 1414.01 Revised to add discussion regarding form PTO/SB/51S. Form PTO/SB/51S has been updated.
- 1415 Revised to add discussion regarding the filing of a request for refund of the search fee and excess claims fee paid in a reissue application filed on or after December 8, 2004 where a petition to expressly abandon the application was filed on or after March 10, 2006.
- 1415.01 Revised to indicate that the TC SPRE should contact OPLA as to what appropriate action to take on a reissue application when the maintenance fee on the original patent has not been paid and the window for the maintenance fee due has closed.
- 1417 Revised to add discussion regarding a CCPA decision.
- 1442.01 Revised to add instructions for noting the existence of litigation in reissue applications that are maintained in IFW.
- 1442.02 Revised to change "Group" to "Technology Center."
- 1444 Form paragraph has been revised.

- 1449.01 Revised to add reference to the CRU.
- 1449.02 Revised to correct the subsection heading.
- 1453 Form paragraph has been revised.
- 1481.03 Revised to reflect amendments to 37 CFR 1.78.
- 1485 The mailing address for the Certificate of Correction Branch has been updated.
- 1490 Revised to reflect amendments to 37 CFR 1.321. Form paragraphs have been revised. Form PTO/SB/25 has been updated.

CHAPTER 1500:

- 1503.01 Form paragraphs have been revised.
- 1503.02 Form paragraphs have been revised. Revised to indicate that contrast in materials may be shown by using line shading in one area and stippling in another.
- 1504.01(a) Revised to add subsection to address changeable computer generated icons.
- 1504.01(b) The discussion regarding design comprising multiple articles or multiple parts embodied in a single article has been revised.
- 1504.01(c) Form paragraphs have been revised. Revised to add a subsection to discuss how to overcome a rejection under 35 U.S.C. 171 based on lack of ornamentality.
- 1504.03 Revised to reflect amendments to 35 U.S.C. 103(c) as a result of the CREATE Act. Revised to change “basic reference” to “primary reference.” Form paragraphs have been revised.
- 1504.04 Revised to change “special description” to “descriptive statement.” Form paragraphs have been revised.
- 1504.05 Revised to indicate that more than one embodiment of a design may be protected by a single claim. However, such embodiments may be presented only if they involve a single inventive concept according to the obviousness-type double patenting practice for designs. The discussion regarding distinct inventions has been revised.

- 1504.06 The discussion regarding obviousness-type double patenting has been revised.
- 1504.10 Form paragraph 15.52 has been deleted.
- 1504.20 Form paragraphs have been revised. Revised to add reference to 37 CFR 1.57(a) for applications filed on or after September 21, 2004.
- 1504.30 Revised to indicate that the basic design application filing fee is set forth in 37 CFR 1.16(b). The address for hand-delivering a request for expedited examination to the Office has been changed. The centralized facsimile number has been updated.
- 1509 Revised to indicate that the design reissue application fee is set forth in 37 CFR 1.16(e).

CHAPTER 1700:

- 1705 Subsection III revised to include Requests for Continued Examination in the list of examiner's actions for which a disposal count is received.
- 1730 Subsection II revised to include a discussion of EFS-Web.

CHAPTER 1800:

- 1801 Revised to reflect that international publication of international applications and any republications of previously published international applications now takes place wholly in electronic form.
- 1805 Revised to reflect amendments to 37 CFR 1.6(d)(4).
- 1817 Revised to update the list of PCT Contracting States and to correct the name of the African Intellectual Property Organization (OAPI).
- 1817.01 Revised to include a discussion of the States (Germany, Japan, Republic of Korea, and Russian Federation) that may be excluded from the all-inclusive designation system when filing a new international application.
- 1821 Revised to include a list of the PCT-EASY physical media accepted by the United States Receiving Office.
- 1823 Revised to reflect amendments to PCT Administrative Instruction Section 209(b).

- 1823.01 Revised to reflect amendments to PCT Rule 13*bis*.4(d) and PCT Administrative Instruction Section 209(b).
- 1825 Revised to indicate color drawings are not acceptable in a PCT application.
- 1834.01 Revised to reflect amendments to 37 CFR 1.6(d)(4).
- 1836 Revised to reflect amendments to PCT Rule 91.1(f).
- 1840 Revised to include the Korean Intellectual Property Office (KIPO) as a competent International Searching Authority for international applications filed with the U.S. Receiving Office.
- 1840.01 Revised to include the Korean Intellectual Property Office (KIPO) as a competent International Searching Authority for international applications filed with the U.S. Receiving Office and to replace Int.Cl.⁷ information with the current Int.Cl.⁸ information.
- 1840.02 New section added to address the availability of the Korean Intellectual Property Office (KIPO) as an International Searching Authority for PCT Applications filed by U.S. nationals or residents in the U.S. Patent and Trademark Office as receiving Office or in the International Bureau as receiving Office.
- 1844 Revised to change “pamphlet” to “publication of the international application.”
- 1847 Revised to include the Korean Intellectual Property Office (KIPO) as a competent International Searching Authority for international applications filed with the U.S. Receiving Office.
- 1850 Revised to include the Korean Intellectual Property Office (KIPO) as a competent International Searching Authority for international applications filed with the U.S. Receiving Office.
- 1851 Revised to change “African Regional Industrial Property Organization (ARIPO)” to “African Regional Intellectual Property Organization (ARIPO).”
- 1853 Revised to change “pamphlet” to “publication of the international application.”

- 1857 Revised to reflect amendments to PCT Administrative Instruction Section 404. Also revised to indicate that the USPTO, as a designated Office, has requested the International Bureau to effect communication of the published application on the day of publication.
- 1865 Revised to include the address for filing a demand for international preliminary examination with the Korean Intellectual Property Office (KIPO) as International Preliminary Examining Authority.
- 1865.01 Revised to update the website location of the PCT Newsletter. Also revised to replace Int.Cl.⁷ information with the current Int.Cl.⁸ information.
- 1866 Revised to indicate that when filling in Chapter II forms, the examiner should check the Patent Application Locating and Monitoring (PALM) system and Box No. III of the demand, Form PCT/IPEA/401, to ensure that the Chapter II forms are mailed to the most recently updated correspondence address.
- 1893 Revised to change “normally 30 months or more” to “normally 30 months”.
- 1893.01(a)(1) Revised to delete statement that in most instances payment of the basic national fee indicated applicant’s intention to enter the national stage and provided a U.S. correspondence address. Also revised to indicate that national stage submissions may now be filed using the EFS-Web system. Further revised to indicate the copy of the international application is ordinarily communicated to the U.S. Designated or Elected Office by the International Bureau on the day of publication of the international application.
- 1893.01(d) Revised to replace the reference to 37 CFR 1.496(a) with a reference to 37 CFR 1.115(b)(3)(iii).
- 1893.02 Revised the discussion of abandonment for failure to meet the requirements set forth in 37 CFR 1.495. If the requirements for the basic national fee and any necessary copy of the international application under 37 CFR 1.495(b) are timely met, but the requirements under 37 CFR 1.495(c) for an English translation of the international application, oath/declaration, search fee, examination fee and application size fee are not met within a time period set in a notice provided by the Office, then the application will become abandoned upon expiration of the time period set in the notice. Also revised to include references to forms PTO/SB/61PCT (unavoidably abandoned application) and PTO/SB/64PCT (unintentionally abandoned application).

- 1893.03 Revised to provide an indication that in some situations, it is the priority date that should be kept in mind when searching the prior art. Also revised to delete the requirement that the examiner must check to ensure that the International Publication Number and the Publication date are in the national stage application if the application is allowed.
- 1893.03(a) Revised to indicate that applicants seeking to enter the national stage are advised to use transmittal Form PTO-1390, as this form clearly indicates that the submission is under 35 U.S.C. 371. Also revised to indicate that PALM records will indicate that the application is a national stage entry of the PCT application (e.g., under “Continuity Data”) and that initially, the examiner should check the application file for the presence of Form PCT/DO/EO/903 and review the PALM Bib-data sheet for an indication that the application is a national stage entry (371) of the PCT application. Further revised to advise the examiner to consult the Office of PCT Legal Administration if he or she has any question as to whether the application should be treated under 35 U.S.C. 111(a) or 371.
- 1893.03(b) Revised to indicate that filing receipts are mailed concurrently with the mailing of the Form PCT/DO/EO/903.
- 1893.03(c) Revised to reflect amendments to 37 CFR 1.78(a)(5)(iv) and to provide a cross-reference to MPEP § 201.11, subsection VI.
- 1893.03(e) Revised in view of ongoing efforts by the International Bureau to replace paper document distribution with electronic document distribution. Information relating to the source of the title of the invention for the national stage application has been moved to new section 1893.03(e)(1).
- 1893.03(e)(1) New section added to explain the source of the title of the invention included on the official filing receipt of a national stage application.
- 1896 Revised to indicate that if a copy of the foreign priority document is not in the national stage application file but applicant asserts that a certified copy of the priority document was timely furnished under PCT Rule 17 in the international phase, then the examiner should consult with a Special Program Examiner in his or her Technology Center or a PCT Special Program Examiner.

CHAPTER 2100:

- 2106 The title of this section has been revised. This section has also been revised to incorporate the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” which was published in the *Official Gazette* on November 22, 2005 at 1300 *Off. Gaz. Pat. Office* 142. Information pertaining to computer-related inventions that are

nonstatutory subject matter has been moved to MPEP § 2106.01. Information pertaining to mathematical algorithms has been moved to MPEP § 2106.02. Flowchart has been revised.

- 2106.01 The title of this section has been revised. Information previously in this section has been moved to new MPEP § 2161.01. Incorporated information from MPEP § 2106 pertaining to computer-related inventions that are nonstatutory subject matter.
- 2106.02 The title of this section has been revised. Information previously in this section has been moved to new MPEP § 2164.06(c). Incorporated information from MPEP § 2106 pertaining to mathematical algorithms.
- 2107.01 Revised to add discussion of recent Federal Circuit decision. Added reference to CCPA decisions in the discussion pertaining to specific utility.
- 2107.02 Revised to clarify that generally, a dependent claim will define an invention that has utility if the independent claim from which the dependent claim depends is drawn to the same statutory class of invention as said dependent claim and the independent claim defines an invention having utility. Also revised to clarify that utility rejections under 35 U.S.C. 101 have been rarely sustained by federal courts.
- 2111 Revised to add discussion of recent Federal Circuit decision.
- 2111.01 The title of a subsection heading has been revised and subsections have been renumbered. Revised to add new subsection heading. Discussion revised in view of recent Federal Circuit decision.
- 2123 Revised to add discussion of recent Federal Circuit decision. Added references to MPEP § 2131.05 and § 2145.
- 2126 Revised to correct the citation to *In re Carlson*.
- 2127 Revised to add discussion of recent Federal Circuit decision.
- 2128 Revised to clarify that absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date, it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b). However, it may be relied upon to provide evidence regarding the state of the art.
- 2131.03 Revised to add discussion of recent Federal Circuit decision.

- 2131.05 The title of this section has been revised. Revised to add discussion of recent Federal Circuit decision.
- 2133.03 Revised to clarify that the concepts of “experimental use” may have different significance in “commercial” and “non-commercial” environment.
- 2133.03(a) Revised to add discussion of recent Federal Circuit decision.
- 2133.03(b) Revised to delete the phrase “under the totality of the circumstances” in the discussion under subsection III.C.
- 2133.03(c) Revised to delete the discussion pertaining to the level of completeness required for cases of “public use.” The title of a subsection has been revised. Revised to add discussion of recent Federal Circuit decision.
- 2133.03(e)(4) Revised to add discussion of recent Federal Circuit decision.
- 2133.03(e)(5) Revised to add discussion of recent Federal Circuit decision.
- 2138.04 Revised to add discussion of recent Federal Circuit decision.
- 2138.05 Revised to add discussion of CCPA and Federal Circuit decisions in subsection II.
- 2141.02 Revised to add reference to MPEP § 2123.
- 2143.01 Revised to add discussion of recent Federal Circuit decision.
- 2144 Revised to add discussion of recent Federal Circuit decisions.
- 2144.05 Revised to add discussion of recent Federal Circuit decision.
- 2161.01 New section added to incorporate information previously in MPEP § 2106.01.
- 2163 Revised to add discussion of recent Federal Circuit decisions.
- 2164.01 Revised to add discussion of recent Federal Circuit decision.
- 2164.06(c) New section added to incorporate information previously in MPEP § 2106.02.
- 2173.05(b) Revised to add discussion of recent Federal Circuit decision.
- 2173.05(e) Revised to add discussion of recent Federal Circuit decision.

2173.05(p) Revised to add discussion of recent Federal Circuit decision. Also revised to clarify that a claim which claims both an apparatus and the method steps of using the apparatus may be rejected under 35 U.S.C. 101, if appropriate.

2181 Revised to clarify that a claim limitation will be presumed to invoke 35 U.S.C. 112, 6th paragraph if it meets the 3-prong analysis. Also revised to clarify that the examples set forth in this section are fact specific and should not be applied as *per se* rules.

2190 Revised to add discussion of recent Federal Circuit decision.

CHAPTER 2200:

2201 The flowcharts have been revised.

2205 Revised to add reference to other written evidence.

2206 The sample letter has been revised.

2207 Revised to indicate that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive or lengthy, the Office may return all or part of the submission. The party that submitted the papers may limit the submission in accordance with what is deemed relevant and resubmit the papers. Cross-references to MPEP § 2282 for *ex parte* reexamination and MPEP § 2686 for *inter partes* reexamination have been added where a request for reexamination has been filed.

2210 Revised to reflect amendments to 37 CFR 1.510.

2212.01 New section added to address inquiries from persons other than the patent owner.

2214 Reference to form PTO-1449 has been deleted. The sample request for reexamination has been revised.

2215 Revised to reflect amendments to 37 CFR 1.510. Also revised to indicate that if the request is found to be incomplete and the defect is not cured, a refund in accordance with 37 CFR 1.26(a) will be made to the identified requester.

2216 Revised to delete the sentence that if a substantial new question of patentability is found as to one claim, all claims will be reexamined. This change is consistent with the discussion in MPEP § 2240.

- 2217 Revised to add subsection headings. Revised to add examples of inappropriate and appropriate proposed rejections. Revised to add reference to other written evidence.
- 2218 Revised to indicate that if the copy of the prior art is not legible, it is deemed to not have been provided. Also revised to indicate that there is no assurance that the Office will consider the non-English language patent or printed publication beyond the translation matter that is submitted.
- 2220 Revised to indicate that if service was not possible, a duplicate copy of the request papers must be supplied to the Office together with an explanation of what effort was made to effect service, and why that effort was not successful.
- 2222 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 address for submitting to the Office all requests for *ex parte* reexamination and all subsequent *ex parte* reexamination correspondence has been updated. The fax number for the Central Reexamination Unit has been updated.
- 2225 Revised to add reference to the CRU.
- 2227 Revised to reflect amendments to 37 CFR 1.510. Revised to add discussion regarding Office procedures where the request fails to comply with the requirements for a filing date.
- 2228 This section has been deleted in view of the amendments to 37 CFR 1.510.
- 2229 Revised to indicate that reexamination requests that have been assigned a filing date and Director initiated orders to reexamine made without a request will be announced in the *Official Gazette*.
- 2231 Revised to indicate that all processing of submissions to cure an incomplete request for *ex parte* reexamination is carried out in the preprocessing area of the CRU.
- 2232 The instructions to access a reexamination file via Public PAIR have been updated.

- 2232.01 The instructions to access the USPTO website to determine whether a reexamination request has been filed for a patent have been updated.
- 2233 The title of this section has been revised. Revised to add references to the CRU.
- 2235 Revised to add references to the CRU.
- 2236 Revised to indicate that reexamination requests are normally assigned to the CRU art unit which examined the technology. The discussion regarding assignment of reexamination/reissue when the reexamination proceeding and the reissue application are pending has been revised.
- 2237 Discussion regarding the transfer procedure for a reexamination proceeding has been revised.
- 2238 Revised to add project code for reporting conferee examiner's panel review conference time in reexamination proceeding.
- 2239 Revised to indicate that a decision to order reexamination at the Director's initiative is rare. Only in compelling circumstances, after a review of all the facts concerning the patent, would such a decision be made.
- 2240 Revised to add discussion of recent district court decision. Also revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case.
- 2242 Form paragraph has been revised.
- 2243 Revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case. Also revised to indicate what information should be included in the decision on the request for reexamination.
- 2245 Revised to indicate that after the examiner has signed the decision, the reexamination file and the decision are given to the CRU LIE for clerical processing.

- 2246 The reference to form PTO-1449 has been deleted. Revised to indicate that form paragraph 22.01 should be used at the beginning of each decision letter and form paragraph 22.73 should be used at the end of each decision letter. Revised to add discussion regarding panel review conference.
- 2247 Revised to add discussion regarding panel review conference.
- 2247.01 The decision letters have been revised.
- 2248 Revised to indicate that petitions under 37 CFR 1.515 are decided by the CRU Director.
- 2249 Revised to indicate that where the patent owner has determined that a statement under 37 CFR 1.530 will not be filed, the patent owner may expedite the reexamination proceeding by filing a paper that indicates that the patent owner waives the filing of a statement under 37 CFR 1.530 and serving the waiver on the requester, if any.
- 2250 Revised to reflect amendments to 37 CFR 1.52.
- 2252 Revised to indicate that any paper for which proof of service is required, which is filed without proof of service, may be denied consideration.
- 2254 Revised to delete the discussion regarding possible harassment.
- 2255 Revised to delete reference to the TC.
- 2256 Revised to add discussion regarding the degree of consideration given by the examiner to patents, publications, and other information submitted in a reexamination proceeding. Revised to add subsection to address the submission of patents, publications, and other information after the NIRC has been mailed.
- 2257 References to form PTO-1449 have been deleted.
- 2258 Revised to add subsection regarding joint research agreement in view of the CREATE Act. Revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the "live" claim(s) (i.e., existing claims not held invalid by a final decision, after all appeals) for which reexamination was requested. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case. Revised to add reference to other written

- evidence. Also revised to add discussion of recent Federal Circuit decision.
- 2258.01 Form paragraph has been revised. Reference to form PTO-1449 has been deleted.
- 2262 Revised to add subsection to address panel review conference. The sample Office action has been revised.
- 2263 Revised to add additional example of when a SSP of 1 month will be set rather than the 2 months usually set in reexamination proceedings.
- 2265 Revised to indicate what must be included in the reasons for requesting an extension of time in a reexamination proceeding. Also revised to add references to the CRU.
- 2266.02 Revised to indicate that if, in response to the notice (form PTOL-475), the defect still is not corrected, the submission will not be entered. If the failure to comply with the notice results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding generally will be terminated under 37 CFR 1.550(d).
- 2266.03 Revised to indicate that any paper for which proof of service is required, which is filed without proof of service, may be denied consideration.
- 2267 Revised to add references to the CRU.
- 2270 Revised to add reference to the CRU.
- 2271 Discussion regarding the panel review conference has been revised.
- 2271.01 The title of this section has been revised. Discussion regarding the make-up of the panel and the panel process has been revised.
- 2274 Revised to add references to the CRU.
- 2280 Revised to indicate that the exception to the requirement for copies noted in 37 CFR 1.98(d) does not apply to reexamination proceedings, since a reexamination proceeding does not rely on the patent for an earlier effective filing date.
- 2281 Revised to indicate that where a panel review has been conducted for an action in a reexamination proceeding, every effort will be made to have the panel members present at an interview requested by the patent owner to discuss that action. An interview such as a telephone interview initiated

by the examiner to obtain an amendment to allow the case will not have the panel member participating in the telephone interview.

- 2282 Revised to indicate that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive or lengthy, the Office may return all or part of the submission. The party that submitted the papers may limit the submission in accordance with what is deemed relevant, and resubmit the papers.
- 2283 Revised to add references to the CRU. Discussion regarding when reexamination proceedings are merged has been revised. Discussion regarding when reexamination proceedings are not merged has been revised.
- 2284 Revised to add reference to the CRU.
- 2285 Discussion regarding when a reissue application is filed after an *ex parte* reexamination request has been filed has been revised.
- 2286 Revised to add additional example of when a SSP of 1 month or 30 days, whichever is longer, will be set rather than the 2 months usually set in reexamination proceedings.
- 2287 Revised to indicate that no panel review conference is needed where the proceeding is to be concluded by the cancellation of all claims since the issuance of the NIRC is essentially ministerial. Reference to form PTO-1449 has been deleted.
- 2289 Revised to indicate that all reexamination cases are monitored and reviewed in the CRU or the TC by the SPRE.
- 2290 Reference to form PTO-1449 has been deleted.
- 2294 Revised to add reference to the CRU.
- 2295 Revised to add references to the CRU.

CHAPTER 2500:

- 2501 Revised to reflect amendments to 35 U.S.C. 41(b), which are in effect during fiscal years 2005 and 2006. The mailing address for submitting requests to update all post-issuance patent information has been updated.

- 2504 Revised to indicate that where there are multiple continuation/divisional reissues of an original patent, the maintenance fee must be directed to the first reissue patent. Where there is a reissue of a reissue patent, the maintenance fee must be directed to the reissue of the reissue patent.
- 2510 Revised to add instructions as to how to access the USPTO website to obtain additional information regarding maintenance fees. Revised to add new subsection IV to address hand delivery of maintenance fee payments to the Office of Finance.
- 2530 The procedures for special acceptance of maintenance fee payments containing informalities have been revised.
- 2540 Revised to reflect amendments to 37 CFR 1.363.
- 2560 Revised to indicate that copies of the completed action (processing of revocation or withdrawal of an attorney) are forwarded by OIPE to the appropriate party.
- 2570 Revised to add instructions as to how to access the USPTO website to obtain additional information regarding maintenance fees.
- 2575 Revised to delete statement that the original document submitted by the patentee when paying the maintenance fee will be appropriately marked and returned to the fee address as set forth in 37 CFR 1.363.
- 2580 Revised to reflect amendments to 37 CFR 1.377.
- 2590 Revised to reflect amendments to 37 CFR 1.378.
- 2595 Revised to add forms PTO/SB/125 and PTO/SB/66. All forms have been updated.

CHAPTER 2600:

- 2601.01 The flowcharts have been revised.
- 2602 Revised to add reference to the CRU.
- 2610 Revised to reflect amendments to 37 CFR 1.915.
- 2614 Revised to reflect amendments to 37 CFR 1.915. Reference to form PTO-1449 has been deleted. The sample request for reexamination has been revised.

- 2615 Revised to indicate that in order for a request to be given a filing date, the request papers must satisfy all the requirements of 37 CFR 1.915. Also revised to indicate that if the request is found to be incomplete and the defect is not cured, a refund in accordance with 37 CFR 1.26(a) will be made to the identified requester.
- 2616 Revised to delete the sentence regarding all claims will be reexamined during the reexamination proceeding if a substantial new question of patentability is found as to one claim such that the section is consistent with MPEP § 2642.
- 2617 Revised to add subsection headings. Revised to add examples of inappropriate and appropriate proposed rejections. Also revised to add reference to other written evidence.
- 2618 Revised to indicate that if the copy of the prior art is not legible, it is deemed to not have been provided. Also revised to indicate that there is no assurance that the Office will consider the non-English language patent or printed publication beyond the translation matter that is submitted.
- 2620 Revised to indicate that if service was not possible, a duplicate copy of the request papers must be supplied to the Office together with an explanation of what effort was made to effect service, and why that effort was not successful.
- 2622 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.
- 2623 Form PTO/SB/83 has been updated.
- 2624 The address for submitting to the Office all requests for *inter partes* reexamination and all subsequent *inter partes* reexamination correspondence has been updated. The fax number for the Central Reexamination Unit has been updated.
- 2627 Revised to reflect amendments to 37 CFR 1.915 and 1.919. Revised to add discussion regarding Office procedures where the request fails to comply with the requirements for a filing date.
- 2628 This section has been deleted in view of the amendments to 37 CFR 1.915 and 1.919.
- 2629 Revised to indicate that reexamination requests that have been assigned a filing date will be announced in the *Official Gazette*.

- 2631 Revised to indicate that all processing of submissions to cure an incomplete request for *inter partes* reexamination is carried out in the preprocessing area of the CRU.
- 2632 The instructions to access a reexamination file via Public PAIR have been updated.
- 2632.01 The instructions to access the USPTO website to determine whether a reexamination request has been filed for a patent have been updated.
- 2633 The title of this section has been revised. Revised to add references to the CRU. Revised to add discussion regarding the use of form PTOL-501.
- 2634 Revised to delete reference to the TC.
- 2635 Revised to clarify that the discussion in item (C) is directed to paper files.
- 2636 Revised to indicate that reexamination requests are normally assigned to the CRU art unit which examined the technology. Revised to add references to the CRU. The discussion regarding assignment of reexamination/reissue when the reexamination proceeding and the reissue application are copending has been revised.
- 2637 Discussion regarding the transfer procedure for an *inter partes* reexamination request has been revised.
- 2638 Revised to add reference to the CRU. Patentability review conference has been changed to panel review conference.
- 2640 Revised to add discussion of recent district court decision. Also revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case.
- 2641 Revised to delete reference to the TC.
- 2642 Form paragraph has been revised. Added discussion of district court decision.
- 2643 Revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. The decision to reexamine any claim for

which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case. Also revised to indicate what information should be included in the decision on the request for reexamination.

- 2646 Revised to delete reference to form PTO-1449. Revised to indicate that form paragraph 26.01 should be used at the beginning of each decision letter and form paragraph 26.73 should be used at the end of each decision letter. Revised to add discussion regarding panel review conference.
- 2647 Revised to add discussion regarding panel review conference.
- 2647.01 The decision letters have been revised.
- 2647.02 Revised to add references to the CRU. Deleted references to the TC.
- 2648 Revised to add references to the CRU. Deleted references to the TC.
- 2655 Revised to delete reference to the TC.
- 2656 Revised to add discussion regarding the degree of consideration given by the examiner to patents, publications, and other information submitted in a reexamination proceeding. Revised to add subsection to address the submission of patents, publications, and other information after the NIRC has been mailed.
- 2657 Revised to delete references to form PTO-1449.
- 2658 Revised to indicate that the Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the "live" claims (i.e., existing claims not held invalid by a final decision, after all appeals) for which reexamination was requested. The decision to reexamine any claim for which reexamination has not been requested lies within the sole discretion of the Office, to be exercised based on the individual facts of each case.
- 2660 Revised to reflect amendments to 37 CFR 1.104. Revised to indicate that the examiner is not to refuse to adopt a rejection properly proposed by the requester as being cumulative to other rejections applied, rather, any such proposed rejection must be adopted to preserve the parties' appeal rights as to such proposed rejections. Form paragraph has been revised. Revised to add subsection to address panel review conference. The sample Office action has been revised.
- 2662 Revised to add discussion regarding litigation.

- 2664 Revised to indicate that the mailing of the action is done by the CRU support staff.
- 2665 Revised to add reference to the CRU and to delete reference to the TC. Revised to indicate what must be included in the reasons for requesting an extension of time in a reexamination proceeding.
- 2666.05 Revised to indicate that where the rejection is first withdrawn in the RAN, there will be no requester opportunity to comment prior to appeal, and the requester may appeal the withdrawal of rejection in the RAN ad a final decision favorable to patentability.
- 2666.06 Revised to indicate that if service was not made, or the party making the submission cannot be contacted where an effort to do so was made, the submission is placed in the reexamination file and normally would not be considered. Where the submission is not considered because of a service defect, the submission is added to the IFW file history as an unentered paper.
- 2666.50 Revised to indicate that if, in response to the notice (form PTOL-2069), the defect still is not corrected, the submission will not be entered. If the failure to comply with the notice results in a patent owner failure to file a timely and appropriate response to any Office action, the prosecution of the reexamination proceeding generally will be terminated or limited under 37 CFR 1.957 (whichever is appropriate).
- 2667 Revised to add references to the CRU and to delete references to the TC.
- 2670 Revised to indicate that clerical handling and processing of *inter partes* reexamination cases are carried out by the CRU and not the TCs.
- 2671 Revised to delete references to the TC.
- 2671.01 Form paragraph has been revised. Revised to add subsection to address panel review conference.
- 2671.02 Form paragraph has been added. Revised to add subsection to address panel review conference.
- 2671.03 The title of this section has been changed. Patentability review conference has been changed to panel review conference.
- 2673.02 Form paragraph has been added. Revised to add subsection to add panel review conference.
- 2675 Revised to add references to the CRU.

- 2675.01 Revised to add reference to the CRU and to delete reference to the TC.
- 2676 The reference to the SPE has been changed to the SPRE.
- 2677 Revised to add references to the CRU and to delete references to the TC. Form paragraph has been revised.
- 2679 Revised to add reference to the CRU and to delete reference to the TC.
- 2682 Revised to add references to the CRU and to delete references to the TC.
- 2686 Revised to indicate that if the Office, in its sole discretion, deems the volume of the papers filed from litigations or other proceedings to be too extensive or lengthy, the Office may return all or part of the submission. The party that submitted the papers may limit the submission in accordance with what is deemed relevant, and resubmit the papers.
- 2686.01 Discussion regarding when proceedings are merged and when proceedings are not merged has been revised.
- 2686.03 Revised to add references to the CRU and to delete references to the TC.
- 2686.04 Revised to add additional example of when a SSP of 1 month or 30 days, whichever is longer, will be set rather than the 2 months usually set in reexamination proceedings. Revised to add subsection to address affect of litigation where requester was a party to the litigation.
- 2687 Revised to indicate that no panel review conference is needed where the proceeding is to be concluded by the cancellation of all claims since the issuance of the NIRC is essentially ministerial. Revised to add references to the CRU.
- 2687.01 Revised to delete reference to the TC.
- 2689 Revised to delete references to the TC.