

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

3<sup>RD</sup> EDITION

Rev. 49



U.S. DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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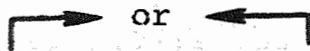
U.S. DEPARTMENT OF COMMERCE  
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MANUAL OF PATENT EXAMINING PROCEDURE  
Third Edition

Instructions regarding Revision No. 49

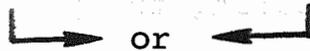
The attached revised pages are replacements for those in the Manual having corresponding numbers, or additional pages to be placed in appropriate numerical sequence.

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



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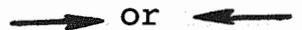
or

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or

Line on which change both begins and ends.



or

Opposite a blank space, indicates deletion of material.

The notation "[R-49]" in the attached pages appears either at the title or at the end of a section that has been revised.

Louis O. Maassel, Editor  
Manual of Patent Examining  
Procedure

Particular attention is called to the following sections:

<u>Section</u>	<u>Change</u>
All	All rule citations are being changed to 37 Code of Federal Regulations citations.
201.06	A new condition in paragraph (d) has been added, where conversion papers are filed under 37 CFR 1.45 in a continuing application, which requires filing a copy of such papers also in the parent application.
201.06(a)	A sentence has been added to state that a new oath or declaration is not required in a rule 1.60 application filed after May 1, 1975 even if the oath or declaration in the parent application filed before May 1, 1975 did not include a reference to the filing of an inventor's certificate.
201.14(b)	Amended to indicate that claims for priority are acknowledged on form PTOL-326.
409.03(d)	A paragraph has been added on the filing of applications under rule 1.47 during the priority year.
706	Amended to include discussion of Black Rock and Ag Pro decisions.
707.05(b)	Amends requirements for consideration of cited prior art after payment of the issue fee by requiring an amendment under rule 1.312 be included.
711.06(a)	Revises procedures for listing of a Defensive Publication as prior art on form PTO-892.
713.09	The requirement that the approval of a primary examiner be obtained for an interview after final rejection has been deleted.
1208	Amended to indicate that all examiners participating in an appeal conference are allowed "non-examining" time.
1701.01	Adds the requirement of supplying a courtesy copy of an examiner's deposition in order for an examiner to testify without issuance of a subpoena.

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# MANUAL OF PATENT EXAMINING PROCEDURE

Original Third Edition, dated November 1961

Latest Revision July 1976



U.S. DEPARTMENT OF COMMERCE

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First Edition, November 1949	Revision 20, April 1969
Revision 1, November 1950	Revision 21, July 1969
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	Revision 49, July 1976

# Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.

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

Examiners will be governed by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated in the text. Orders and Notices, or portions thereof, relating to the examiners' duties and functions which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

Suggestions for improving the form and content of the Manual are always welcome. They should be addressed to:

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

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# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent and Trademark Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent and Trademark Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent and Trademark Office. The patent law is Title 35 of the United States Code, which contains 96 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents) reprints the patent code and some additional statutes.

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

## Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents and Trademarks subject to the

approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

*37 CFR 1.351. Amendments to rules will be published.* All amendments in this part will be published in the Official Gazette and in the Federal Register.

*37 CFR 1.352. Publication of notice of proposed amendments.* (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments in this part will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

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

These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules and forms, as well as trademark rules and forms and copyright rules. Persons desiring a copy of the patent rules should order a copy of "37 Code of Federal Regulations" from the Superintendent of Documents.

The primary function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. The Rules of Practice govern the examiners, as well as applicants and their attorneys.

## Commissioner's Orders and Notices

From time to time, the Commissioner of Patents and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent and Trademark Office. Notices and circulars of in-

formation or instructions have also been issued by other Office Officials under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

### Decisions

In addition to the statutory regulations, the actions taken by the examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

### Publications Available from Superintendent of Documents

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

**Patent Official Gazette.** The official journal of the Patent and Trademark Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and a claim of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification.

**Annual Indexes.** An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual Index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

**Guide for Patent Draftsmen.** Patent and Trademark Office requirements for patent drawings with illustrations.

**Manual of Classification.** A loose-leaf volume listing the numbers and descriptive titles of the more than 300 classes and 66,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are

included in the subscription service, are issued from time to time.

**Manual of Patent Examining Procedure.** A loose-leaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent and Trademark Office's Examining Corps. Subscription service includes basic manual, quarterly revisions, and change notices.

**Patents and Inventions—An Information Aid to Inventors.** The purpose of this publication is to aid inventors in deciding whether to apply for patents, in obtaining patent protection, and in promoting their inventions.

**Patents: Spur to American Progress.** Focuses on the functioning of the patent system, outlining its purpose and practices and charting the "how-to" path to patents. It illustrates how the system nurtures discovery of data and devices on which the American partnership of inventor, industry, and the public builds prosperity. This publication is one of the U.S. Department of Commerce's "Know Your Economic ABC's" series.

**The Story of the United States Patent and Trademark Office.** Cites important events in the development of the United States patent system and lists chronologically inventions having important effects on the economy.

**Patent Laws.** Compilation of patent laws in force.

**Patent Attorneys and Agents Registered to Practice Before The U.S. Patent and Trademark Office.** An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U.S. Patent and Trademark Office.

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**Q & A About Patents.** Brief, non-technical answers to questions most frequently asked about patents. Free.

**Q & A About Plant Patents.** Same as above for plant patents. Free.

**General Information Concerning Patents.** Contains a vast amount of general information concerning the application for and granting of patents, expressed in non-technical language for the layman. Single copy free. Multiple copies available from Superintendent of Documents.

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

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

**Weekly Class Sheets.** Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette*.