

relative proportions were rejected as *prima facie* obvious. Applicant presented evidence alleging unexpected results testing three species of diphenyl ether herbicides over limited relative proportion ranges. The court held that the limited number of species exemplified did not provide an adequate basis for concluding that similar results would be obtained for the other diphenyl ether herbicides within the scope of the generic claims. Claims 6-8 recited a FENAC:diphenyl ether ratio of 1:1 to 4:1 for the three specific ethers tested. For two of the claimed ethers, unexpected results were demonstrated over a ratio of 16:1 to 2:1, and the effectiveness increased as the ratio approached the untested region of the claimed range. The court held these tests were commensurate in scope with the claims and supported the nonobviousness thereof. However, for a third ether, data was only provided over the range of 1:1 to 2:1 where the effectiveness decreased to the "expected level" as it approached the untested region. This evidence was not sufficient to overcome the obviousness rejection.); *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the *prima facie* case of obviousness because there was "no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition.").

DEMONSTRATING CRITICALITY OF A CLAIMED RANGE

To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

716.02(e) Comparison With Closest Prior Art

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "A comparison of the *claimed* invention with the disclosure of each cited

reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." *In re Merchant*, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, *In re Finley*, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. *In re Armstrong*, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential).

THE CLAIMED INVENTION MAY BE COMPARED WITH PRIOR ART THAT IS CLOSER THAN THAT APPLIED BY THE EXAMINER

Applicants may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner. *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978); *Ex parte Humber*, 217 USPQ 265 (Bd. App. 1961) (Claims to a 13-chloro substituted compound were rejected as obvious over nonchlorinated analogs of the claimed compound. Evidence showing unexpected results for the claimed compound as compared with the 9-, 12-, and 14- chloro derivatives of the compound rebutted the *prima facie* case of obviousness because the compounds compared against were closer to the claimed invention than the prior art relied upon.).

COMPARISONS WHEN THERE ARE TWO EQUALLY CLOSE PRIOR ART REFERENCES

Showing unexpected results over one of two equally close prior art references will not rebut *prima facie* obviousness unless the teachings of the prior art references are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984) (Claimed compounds differed from the prior art either by the presence of a trifluoromethyl group instead of a chloride radical, or by the presence of an unsaturated ester group instead of a saturated ester group. Although applicant compared the claimed invention with the prior art compound

containing a chloride radical, the court found this evidence insufficient to rebut the *prima facie* case of obviousness because the evidence did not show relative effectiveness over all compounds of the closest prior art. An applicant does not have to test all the compounds taught by each reference, “[h]owever, where an applicant tests less than all cited compounds, the test must be sufficient to permit a conclusion respecting the relative effectiveness of applicant’s claimed compounds and the compounds of the closest prior art.” *Id.* (quoting *In re Payne*, 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979)) (emphasis in original).).

THE CLAIMED INVENTION MAY BE COMPARED WITH THE CLOSEST SUBJECT MATTER THAT EXISTS IN THE PRIOR ART

Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted *prima facie* case by comparing claimed invention with the most relevant prior art. Note that the majority held the Office failed to establish a *prima facie* case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 “would be requiring comparison of the results of the invention with the results of the invention.” 357 F.2d at 422, 148 USPQ at 714.).

716.02(f) Advantages Disclosed or Inherent

The totality of the record must be considered when determining whether a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. Therefore, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. *In re Chu*, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) (Although the purported advantage of placement of a selective catalytic reduction catalyst in the bag retainer of an apparatus for controlling emis-

sions was not disclosed in the specification, evidence and arguments rebutting the conclusion that such placement was a matter of “design choice” should have been considered as part of the totality of the record. “We have found no cases supporting the position that a patent applicant’s evidence or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of *ex parte* patent prosecution.” 66 F.3d at 299, 36 USPQ2d at 1095.). See also *In re Zenitz*, 333 F.2d 924, 928, 142 USPQ 158, 161 (CCPA 1964) (evidence that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from disclosed use as tranquilizer); *Ex parte Sasajima*, 212 USPQ 103, 104 - 05 (Bd. App. 1981) (evidence relating to initially undisclosed relative toxicity of claimed pharmaceutical compound must be considered).

The specification need not disclose proportions or values as critical for applicants to present evidence showing the proportions or values to be critical. *In re Saunders*, 444 F.2d 599, 607, 170 USPQ 213, 220 (CCPA 1971).

716.02(g) Declaration or Affidavit Form

“The reason for requiring evidence in declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.” Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. *Ex parte Gray*, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989). Publications may, however, be evidence of the facts in issue and should be considered to the extent that they are probative.

716.03 Commercial Success

NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the

claimed invention and evidence of commercial success.

The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. *Cf. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990) (evidentiary routine of shifting burdens in civil proceedings inappropriate in *ex parte* prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also *In re GPAC*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness).

The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

COMMERCIAL SUCCESS ABROAD IS RELEVANT

Commercial success abroad, as well as in the United States, is relevant in resolving the issue of nonobviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

716.03(a) Commercial Success Commensurate in Scope With Claimed Invention

EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope

with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

REQUIREMENTS WHEN CLAIMED INVENTION IS NOT COEXTENSIVE WITH COMMERCIAL PRODUCT OR PROCESS

If a particular range is claimed, applicant does not need to show commercial success at every point in the range. "Where, as here, the claims are directed to a combination of ranges and procedures not shown by the prior art, and where substantial commercial success is achieved at an apparently typical point within those ranges, and the affidavits definitely indicate that operation throughout the claimed ranges approximates that at the particular points involved in the commercial operation, we think the evidence as to commercial success is persuasive." *In re Hollingsworth*, 253 F.2d 238, 240, 117 USPQ 182, 184 (CCPA 1958). See also *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (where the commercially successful product or process is not coextensive with the

claimed invention, applicant must show a legally sufficient relationship between the claimed feature and the commercial product or process).

716.03(b) Commercial Success Derived From Claimed Invention

COMMERCIAL SUCCESS MUST BE DERIVED FROM THE CLAIMED INVENTION

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In *ex parte* proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.").

See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before

the introduction of the patented product); *In re Fielder*, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising hyperbole.).

COMMERCIAL SUCCESS MUST FLOW FROM THE FUNCTIONS AND ADVANTAGES DISCLOSED OR INHERENT IN THE SPECIFICATION DESCRIPTION

To be pertinent to the issue of nonobviousness, the commercial success of devices falling within the claims of the patent must flow from the functions and advantages disclosed or inherent in the description in the specification. Furthermore, the success of an embodiment within the claims may not be attributable to improvements or modifications made by others. *In re Vamco Machine & Tool, Inc.*, 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

IN DESIGN CASES, ESTABLISHMENT OF NEXUS IS ESPECIALLY DIFFICULT

Establishing a nexus between commercial success and the claimed invention is especially difficult in

design cases. Evidence of commercial success must be clearly attributable to the design to be of probative value, and not to brand name recognition, improved performance, or some other factor. *Litton Systems, Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 USPQ 97 (Fed. Cir. 1984) (showing of commercial success was not accompanied by evidence attributing commercial success of Litton microwave oven to the design thereof).

SALES FIGURES MUST BE ADEQUATELY DEFINED

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

716.04 Long-Felt Need and Failure of Others

THE CLAIMED INVENTION MUST SATISFY A LONG-FELT NEED WHICH WAS RECOGNIZED, PERSISTENT, AND NOT SOLVED BY OTHERS

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing

inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a "do-it-yourself" window shade material which was adjustable without the use of tools, a prior art product fulfilled the need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

LONG-FELT NEED IS MEASURED FROM THE DATE A PROBLEM IS IDENTIFIED AND EFFORTS ARE MADE TO SOLVE IT

Long-felt need is analyzed as of the date the problem is identified and articulated, and there is evidence of efforts to solve that problem, not as of the date of the most pertinent prior art references. *Texas Instruments Inc. v. Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

OTHER FACTORS CONTRIBUTING TO THE PRESENCE OF A LONG-FELT NEED MUST BE CONSIDERED

The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

See also *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (presence of legislative regulations for controlling sulfur dioxide emissions did not militate against existence of long-felt need to reduce the sulfur content in the air); *In re Tiffin*, 443 F.2d 344, 170 USPQ 88 (CCPA 1971) (fact that affidavit supporting contention of fulfillment of a long-felt need was sworn by a licensee adds to the weight to be accorded the affidavit, as long as there is a *bona fide* licensing agreement entered into at arm's length).

716.05 Skepticism of Experts

"Expressions of disbelief by experts constitute strong evidence of nonobviousness." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 698, 218 USPQ 865, 869 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 483-484 (1966)) (The patented process converted all the sulfur compounds in a certain effluent gas stream to hydrogen sulfide, and thereafter treated the resulting effluent for removal of hydrogen sulfide. Before learning of the patented process, chemical experts, aware of earlier failed efforts to reduce the sulfur content of effluent gas streams, were of the opinion that reducing sulfur compounds to hydrogen sulfide would not adequately solve the problem.).

"The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, . . . as are the five to six years of research that preceded the claimed invention." *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *Burlington Industries Inc. v. Quigg*, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987) (testimony that the invention met with initial incredulity and skepticism of experts was sufficient to rebut the *prima facie* case of obviousness based on the prior art).

716.06 Copying

Another form of secondary evidence which may be presented by applicants during prosecution of an application, but which is more often presented during litigation, is evidence that competitors in the marketplace are copying the invention instead of using the prior art. However, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors such as a lack of concern for patent property or contempt for the patentees ability to enforce the patent. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985). Evidence of copying was persuasive of nonobviousness when an alleged infringer tried for a substantial length of time to design a product or process similar to the claimed invention, but failed and then copied the claimed invention instead. *Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987). Alleged copying is not persua-

sive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also *Vandenberg v. Dairy Equipment Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness) and *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1098-99, 227 USPQ 337, 348, 349 (Fed. Cir. 1985), *vacated on other grounds*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987) (evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after 10 years of effort and expense).

716.07 Inoperability of References

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability (*Metropolitan Eng. Co. v. Coe*, 78 F.2d 199, 25 USPQ 216 (D.C. Cir. 1935)), examiners should not express any opinion on the operability of a patent. Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969). It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. *In re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947); *In re Reid*, 179 F.2d 998, 84 USPQ 478 (CCPA 1950).

Where the affidavit or declaration presented asserts inoperability in features of the reference which are not relied upon, the reference is still effective as to other features which are operative. *In re Shepherd*, 172 F.2d 560, 80 USPQ 495 (CCPA 1949).

Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, the claims represented by applicant must distinguish from the alleged inoperative reference disclosure. *In re Crosby*, 157 F.2d 198, 71 USPQ 73 (CCPA 1946). See also *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (lack of diagrams, flow charts, and other details in the prior art references did not render them nonenabling in view of the fact that applicant's own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references).

If a patent teaches or suggests the claimed invention, an affidavit or declaration by patentee that he or she did not intend the disclosed invention to be used as claimed by applicant is immaterial. *In re Pio*, 217 F.2d 956, 104 USPQ 177 (CCPA 1954). Compare *In re Yale*, 434 F.2d 66, 168 USPQ 46 (CCPA 1970) (Correspondence from a co-author of a literature article confirming that the article misidentified a compound through a typographical error that would have been obvious to one of ordinary skill in the art was persuasive evidence that the erroneously typed compound was not put in the possession of the public.).

716.08 Utility and Operability of Applicant's Disclosure

See MPEP § 2107.02, for guidance on when it is proper to require evidence of utility or operativeness, and how to evaluate any evidence which is submitted to overcome a rejection under 35 U.S.C. 101 for lack of utility. See MPEP § 2107 - § 2107.03 generally for utility examination guidelines and an overview of legal precedent relevant to the utility requirement of 35 U.S.C. 101.

716.09 Sufficiency of Disclosure

See MPEP § 2164 - § 2164.08(c) for guidance in determining whether the specification provides an enabling disclosure in compliance with 35 U.S.C. 112, first paragraph.

Once the examiner has established a *prima facie* case of lack of enablement, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. *In*

re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). Evidence to supplement a specification which on its face appears deficient under 35 U.S.C. 112 must establish that the information which must be read into the specification to make it complete would have been known to those of ordinary skill in the art. *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981) (copies of patent specifications which had been opened for inspection in Rhodesia, Panama, and Luxembourg prior to the U.S. filing date of the applicant were not sufficient to overcome a rejection for lack of enablement under 35 U.S.C. 112, first paragraph).

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. *In re Buchner*, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); *In re Smyth*, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. *In re Oppenauer*, 143 F.2d 974, 62 USPQ 297 (CCPA 1944). But see *Glaser v. Strickland*, 220 USPQ 446 (Bd. Pat. Int. 1983) which reexamines the rationale on which *In re Oppenauer* was based in light of the Federal Rules of Evidence. The Board stated as a general proposition "Opinion testimony which merely purports to state that a claim or count, is 'disclosed' in an application involved in an interference . . . should not be given any weight. Opinion testimony which purports to state that a particular feature or limitation of a claim or count is disclosed in an application involved in an interference and which explains the underlying factual basis for the opinion may be helpful and can be admitted. The weight to which the latter testimony may be entitled must be evaluated strictly on a case-by-case basis."

716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the

applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent or an application publication identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent or published application so as to justify a rejection under 35 U.S.C. 102(f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under 35 U.S.C. 102(f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article or the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be

accepted as establishing inventorship. *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article, patent, or published application may not be sufficient where there is evidence to the contrary. *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); *In re Carreira*, 532 F.2d 1356, 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species; hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author, patentee, or applicant of the published application of a first reference does not enable an applicant to step into the shoes of that author, patentee, or applicant of the published application in regard to its date of publication so as to defeat a later second reference. *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983).

EXAMPLES

The following examples demonstrate the application of an attribution affidavit or declaration.

Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

Example 2

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that

described in Example 2 to the situation described in Example 1.

718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

See MPEP § 804.03 and § 706.02(I) through § 706.02(I)(3) for subject matter disqualified as prior art under 35 U.S.C. 103(c) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.130(a) addresses those situations in which the rejection in an application or patent under reexamination to be overcome is a rejection under 35 U.S.C. 103 in view of a U.S. patent or U.S. patent application publication due to the requirement in 37 CFR 1.131 that any U.S. patent or U.S. patent application publication to be antedated not claim the same patentable invention (as defined in 37 CFR 1.601(n)) as the application or patent under reexamination. The applicant or patent owner is also prevented from proceeding in an interference due to the

provision in 37 CFR 1.602(a) that an interference will not normally be declared or continued between applications owned by a single party, or an application and an unexpired patent owned by a single party.

As 37 CFR 1.130(a) addresses those situations in which the inventions defined by the claims in the application or patent under reexamination and by the claims in the U.S. patent or patent application publication are not patentably distinct, 37 CFR 1.130(a)(1) requires a terminal disclaimer in accordance with 37 CFR 1.321(c), and 37 CFR 1.130(a)(2) requires an oath or declaration stating, *inter alia*, that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104. The inventor named in the application or patent under reexamination must have invented the claimed subject matter before the actual date of invention of the subject matter of the reference claims. The affidavit or declaration may be signed by the inventor(s), the attorney or agent of record, or assignee(s) of the entire interest.

The phrase "prior inventor under 35 U.S.C. 104" requires that the inventor named in the application or patent be the prior inventor within the meaning of 35 U.S.C. 104, in that an applicant or patent owner may not:

(A) establish a date of invention in a foreign country other than a NAFTA or WTO member country;

(B) establish a date of invention in a WTO member country other than a NAFTA country earlier than January 1, 1996; or

(C) establish a date of invention in a NAFTA country other than the U.S. earlier than December 8, 1993.

37 CFR 1.130(b) provides that when an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with 37 CFR 1.321(c). See MPEP § 804.02.

A U.S. patent or U.S. patent application publication that anticipates the claimed subject matter cannot be

disqualified as prior art under 35 U.S.C. 103(c) or 37 CFR 1.130 or 1.131.

719 File Wrapper

The folder in which the U.S. Patent and Trademark Office maintains the application papers is referred to as a file wrapper.

719.01 Papers in File Wrapper

Papers that do not become a permanent part of the record should not be entered on the "Contents" of the file wrapper. All papers legally entered on the "Contents" of the file wrapper are given a paper number. No paper legally entered on the "Contents" should ever be withdrawn or returned to applicant, especially a part of the original disclosure of the application, without special authority of the Commissioner. However, 37 CFR 1.59 provides that certain documents may be returned to applicant if they were unintentionally submitted or contain proprietary information which has not been made public and is not important to a decision of patentability. See MPEP § 724. Certain oaths executed abroad may be returned but a copy is retained in the file. See MPEP § 604.04(a).

Form paragraph 7.214 may be used to notify applicant that papers in an application that has received a filing date ordinarily will not be returned.

¶ 7.214 Papers Not Returned, Pro Se

Papers in an application that has received a filing date pursuant to 37 CFR 1.53 ordinarily will not be returned. If applicant has not preserved copies of the papers, the Office will furnish copies at applicant's expense. See 37 CFR 1.19 for a list of the current fees. See MPEP § 724.05 for information pertaining to petitions to expunge information.

719.01(a) Arrangement of Papers in File Wrapper

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order, that is, the communication with the latest Mail Center "Office Date" is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the drawing print is always kept on top for the convenience of the examiner.

Where amendments are submitted in duplicate, the copy is destroyed except where the duplicate is received within the time period for reply and the original is late. In this latter situation both copies are placed in the file. The "original" is entered with reference made to the copy.

At allowance, only those papers required by the printer are placed in the left side (center section) of the file wrapper.

719.01(b) Prints

The prints of the drawing are fastened inside the file wrapper by the Office of Initial Patent Examination.

The white paper prints are always kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the application number of the corresponding application. Note MPEP § 608.02(m).

719.02 Data Entered on File Wrapper

See also MPEP § 707.10 and § 719.01.

It is sometimes necessary to return an application to the Office of Initial Patent Examination (OIPE) for correction of the file wrapper label, or, for 09/series applications, to forward the application to the technical support staff of the Technology Center (TC) for correction to the PALM bib-data sheet placed in the file wrapper. If the examiner notices an error in any of the data originally entered on the file wrapper or on the PALM bib-data sheet, he or she should return the application to OIPE for correction or, for 09/series applications, have the technical support staff of his or her TC enter the correction on the PALM database and print a new PALM bib-data sheet, which will then be placed in the file wrapper.

Instances where correction is necessary include:

(A) Correction of inventorship such as changes in the order of the names or a change in the name of an inventor, granted by petition, and additions or deletions of inventors under 37 CFR 1.48. See MPEP § 605.04(g).

(B) Correction of the filing date.

(C) Correction concerning prior U.S. applications which have application number errors. See MPEP § 202.02.

(D) Correction of a claim for priority under 35 U.S.C. 120, 121, or 365(c). See MPEP § 201.11 and § 1302.09.

Any application that must be sent to OIPE for correction of the file wrapper label should be accompanied by an Office of Initial Patent Examination Data Base Routing Slip with an explanation of the correction to be made.

All other corrections are performed in the TC. For example, changes to the title, power of attorney, and correspondence address may be made with red ink.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Division.

Except as otherwise indicated, all of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the technical support staff of the TC, the original entry being canceled but not erased.

719.02(b) Name or Residence of Inventor or Title Changed

The distinction between "residence" and Post Office address should not be lost sight of. See MPEP § 605.02 and § 605.03.

MPEP § 605.04(c) explains the procedure to be followed when applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

719.03 Classification During Examination

When a new application is received in a Technology Center, the classification of the application and the initials or name of the examiner who will examine it or other assigned docket designation are noted in pencil in the designated spaces on the file wrapper. These notations should be kept current.

CLASSIFICATION HISTORY BOX ENTRIES

Classifiers and examiners who review an application for the purpose of assigning a class for examination should indicate in CLASSIFICATION HISTORY

box on the file wrapper that such a review took place. The purpose for providing this information is to reduce needless routing of applications and save examiners' and classifiers' time. The information should include the name and initials of each examiner or classifier consulted, the class(es) an application was considered for, and the date that the review took place. No other information is permitted in this box. These entries will not be printed on any resulting patent publication. See MPEP § 903.07(a) for recording consultations in the SEARCH NOTES box on the file wrapper that involve a question of the propriety of the classification of subject matter and/or the need for a cross-reference.

719.04 Index of Claims

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date so as to be a reliable index of all claims standing in an application, and of the amendment in which the claims are to be found.

The preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented.

Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under 37 CFR 1.121(a), the original claim number should not be stricken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e., "Amend. 1"; if the claim is rewritten a second time, "Amend. 1" should be changed by striking out "1" and inserting "2" above it.

As any claim is canceled, a line in red ink should be drawn through its number.

A space is provided for completion by the examiner to indicate the date and type of each Office action together with the resulting status of each claim. A list of codes for identifying each type of Office action appears below the Index. At the time of allowance, the examiner places the final patent claim numbers in the column marked "Final."

719.05 Field of Search

In the first action on the merits of an application, the examiner shall make an initial endorsement in black ink, in the space provided on the right outside panel of the file wrapper, of the classes and subclasses of domestic and foreign patents, abstract collections, and publications in which the search for prior art was made. Other information collections and sources in which the search for prior art was made must also be identified by the examiner. The examiner must also indicate the date(s) on which the search was conducted. In subsequent actions, where the search is brought up to date and/or where a further search is made, the examiner must endorse and initial on the file wrapper that the search has been updated and/or identify the additional field of search. Any search updates should include all of the databases and the search queries and classifications employed in the original search. See MPEP § 904. Great care should be taken so as to clearly indicate the places searched and the date(s) on which the search was conducted.

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the U.S. Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation. These procedures will also facilitate the printing of certain search data on patents.

Under the procedures, searches are separated into two categories and listed, as appropriate, in either the "SEARCHED" box or "SEARCHED NOTES" box on the file wrapper.

I. "SEARCHED" BOX ENTRIES

Search entries made here, except those for search updates (see item I(C) below), will be printed under "Field of Search" on the patent front page. Therefore, the following searches will be recorded in the "SEARCHED" box by the examiner along with the date and the examiner's initials, according to the following guidelines:

(A) *A complete search of a subclass*, including all United States and foreign patent documents, whether filed by U.S. or IPC classification, and other publications placed therein.

The complete classification (class and subclass) should be recorded.

Examples

424/270, 272, 273
224/42.1 F
414/DIG. 4
D3/32 R
A61K 9/22
A61K 31/56 - A61K 31/585

(B) *A limited search of a subclass*, for example, a search that is restricted to an identifiable portion of the patent documents placed therein. If, however, only the publications in a subclass are searched, such an entry is to be made under "SEARCH NOTES" rather than under "SEARCHED." (See item II(D) below.)

The class and subclass, followed by the information defining the portion of the subclass searched, in parenthesis, should be recorded.

Examples

414/1 (U.S. only)
238/6 (1954 to date)

(C) *An update of a search previously made*. This search entry will be recorded in a manner to indicate clearly which of the previously recorded searches have been updated, followed by the expression "(updated)." Search update entries, although recorded in the "SEARCHED" box, will not be printed.

Examples

424/270 (updated)
414/DIG. 4 (updated)
Above (updated)

When a search made in a parent application is updated during the examination of a continuing application, those searches updated, followed by "(updated from parent S.N.)" will be recorded. If the parent application has been patented, the patent number "Pat. N." instead of application number in the above phrase will be recorded. The examiner should recopy the entire search updated from the parent on the file wrapper of the continuing application to the extent pertinent to the continuing application.

Examples

273/29 BC (updated from
343/114.5 parent S.N. 08/495,123)
116/DIG.47 (updated from
D7/73, 74 parent Pat. N. 4,998,999)

II. "SEARCH NOTES" BOX ENTRIES

Entries made in the "SEARCH NOTES" box are of equal importance to those placed in the "SEARCHED" box; however, these entries are not to be printed on any resulting patent. They are intended to complete the application file record of areas and/or documents considered by the examiner in his or her search. The examiner should record the following searches in this box and in the manner indicated, with each search dated and initialled:

(A) A *cursory search*, or scanning, of a U.S. subclass or IPC subclass/group/subgroup, i.e., a search usually made to determine if the documents classified there are relevant. Record the classification, followed by "(cursory)."

Examples

250/13 (cursory)
A61K 9/44 (cursory)

(B) A *consultation* with other examiners to determine if relevant search fields exist in their areas of expertise.

If the subclass is not searched, record the class and subclass discussed, followed by "(consulted)." This entry may also include the name of the examiner consulted and the art unit.

Examples

24/ fasteners (consulted)
24/ fasteners (consulted J. Doe A.U. 3501)
24/201 R-230 AV (consulted)

(C) A *search of a publication* not located within the classified patent file, e.g., a library search, a text book search, a Chemical Abstracts search, etc. Record according to the following for each type of literature search:

(1) *Abstracting publications*, such as Chemical Abstracts, record name of publications, list terms consulted in index, and indicate period covered.

Examples

Chem. Abs., Palladium hydride Jan.-June 1975
Eng. Index, Data Conversion Analog to Digital 1975

(2) *Periodicals* — list by title and period or volumes covered, as appropriate.

Examples

Popular Mechanics, June-Dec. 1974
Lubrication Engineering, vols. 20-24

(3) *Books* — list by title and author, edition or date, as appropriate.

Example

Introduction to Hydraulic Fluids, Roger E. Hatton, 1962

(4) *Other types of literature* not specifically mentioned herein (i.e., catalogs, manufacturer's literature, private collections, etc.).

Record data as necessary to provide unique identification of material searched.

Example

Sears Roebuck catalog, Spring-Summer, 1973.

Where a book or specific issue of a periodical is cited by the examiner, it is not necessary to list the specific book or periodical in the "SEARCH NOTES" box.

A cursory or browsing search through a number of materials that are not found to be of significant relevance may be indicated in a collective manner, e.g., "Browsed STIC shelves under QA 76.5" or "Browsed text books in STIC relating to". More detailed reviews or searches through books and periodicals or any search of terms in abstracting publications should be specifically recorded, however.

(5) *Computer Search in Scientific and Technical Information Center (STIC)* — An online computerized literature searching service which uses key terms and index terms to locate relevant publications in many large bibliographic data bases is available in the STIC. Members of the STIC staff are assigned to assist examiners in selecting key terms and to conduct a search. To record a computer search conducted by STIC, see instructions in II(F) below.

(D) A search of only the *publications in a subclass*.

Record class and subclass followed by “(publications only).”

Examples

43/56 (publications only)

99/DIG. 15 (publications only)

(E) *A review of art cited in a parent application* or an original patent, as required for all continuation and continuation-in-part applications, divisional applications, reissue applications and reexamination proceedings, or a review of art cited in related applications.

Record the application number of a parent application that is still pending or abandoned, followed by “refs. checked” or “refs. ck’ed.” If for any reason not all of the references have been checked because they are not available or clearly not relevant, such exceptions should be noted.

Examples

S. N. 495,123 refs. checked

S. N. 490,000 refs. checked

S. N. 480,111 refs. checked except for Greek patent to Kam

S. N.410,113 refs. not checked since the file was not available

Record the patent number of a parent or related application that is now patented or of an original patent now being reissued with “refs. checked” or “refs. ck’ed.”

Examples

Pat. 3,900,000 refs. checked

Pat. 3,911,111 refs. ck’ed

(F) *In each action involving a search of a computer accessed text or chemical structure or sequence database*, the examiner shall endorse, in the SEARCH

NOTES box on the file wrapper flap, the name of the database service, the date when the search was made or was brought up to date and the examiner’s initials. All entries shall be made in BLACK INK. Computer database searches including text, chemical structure, or sequences shall be documented in the SEARCH NOTES box on the file wrapper by providing the following minimum information:

(1) The search logic or chemical structure or sequence used as a query;

(2) The name of the file or files searched and the database service;

(3) Date of the search; and

(4) The examiner’s initials.

Three ways in which this minimum documentation can be provided are:

(1) supplying, and as necessary annotating, the computer search printout resulting from a computer assisted search (see examples 1 and 2 and “Printouts” below), or

(2) recording the required information on the Search Request Form PTO-1590, or

(3) recording the required information in the SEARCH NOTES box.

For methods (1) and (2), the name of the database service and the expressions “(see form)” or “(see printout)” should be recorded in the SEARCH NOTES box as appropriate with the date and the examiner’s initials.

Printouts

Most of the database services accessed in application searches provide a command to display or print the search history which includes most, if not all, of the minimum required information for documenting database searches. Table 1 below lists the history command for each database service and which of the required minimum documentation elements are missing when the history command is entered. The missing elements may be documented by writing them on the printout of the search history or by supplying further portions of the search transcript which do include the missing elements. In some instances, depending on the database service, the log off command will supply the missing data element. A printout of the history command and log out response containing the required data elements is acceptable as full documentation of a search. For example, this is the case with

the STN and Questel; the name of the database service is not provided by entering the history command and must be supplied by the inclusion of the log off command. Another example is with WEST. Neither the Freeform Search page nor the Show S Numbers page prints the date of the search, therefore, the date of the WEST search must be documented in writing.

If there are several search statements in the history, the statement or statements of which the results were reviewed should be indicated by circling them in BLACK INK. The form or printout page(s) with the required data elements should be hole punched and placed in the application file on the right hand flap of the file wrapper.

TABLE 1

History Commands and Missing Elements by Database Service

Data-base Service	His-tory Com-mand	Name of Data-base Ser-vice	Search Logic	Name of File Search-ed	Date of Search
Dialog	ds ²	no	yes	miss-ing ⁶	miss-ing ³
STN ¹	d his full	no ⁵	yes	yes	yes
Orbit	his ²	no ⁵	yes	miss-ing ⁷	miss-ing ²
Ques-tel	hi ²	no ⁵	yes	yes	miss-ing ³
Mead	r ²	no	yes	yes	yes
IG Suite	none	yes ³	yes ⁴	yes	yes
EAST	Details grid ⁸	no ¹⁰	yes	yes	yes
WEST	Free Form Search page ⁹ Show S Num-bers page	yes	yes	yes	miss-ing ¹¹

¹ In a structure search in STN, in addition to "d his full", the structure should be printed out while in the Registry File. The command string for this is "d L# que stat," where L# is the number of the answer set of a full file structure search.

² Need to enter history command for each file searched before changing file or logging off.

³ Information provided as part of search result file for each request.

⁴ Search query sequence provided as part of search result file for each request.

⁵ Displayed by log off command.

⁶ Name and number of file provided at file entry; number only of file given when leaving the file; number only of last file accessed given at log off.

⁷ Name of the file given at file entry and when leaving the file; name of last file accessed given at log off.

⁸ Print details grid for Active folder to document current search; print Details grid for Saved folder to document saved search.

⁹ Print Freeform Search page to document current search; print Show S Numbers page to document saved search.

¹⁰ Shown on printed EAST cover page.

¹¹ Must be written in BLACK INK.

Explanation of Table Terminology

History Command - Generally, a display of what the user has asked the search software to do. Will display the search logic entered by the user. Some histories are limited to display of the searches done only in the current file while others deliver a complete record of what file or files were accessed and all searches done since sign on. Dialog, Questel, Orbit, and Mead are services limited to display of the searches done only in the current file.

Name of Database Service - Most services do not display this information as part of the search transcript. None of the services in the table, except WEST, list that information as part of the history command. However, Orbit, Questel, and STN supply the name of the database service during log off.

Search Logic - Generally, a display of the search commands executed by the search software. For a

structure or sequence search, this can be a printout of the structure or sequence used to query the system.

Name of File Searched - This is the name of the collection of data accessed. In some services, the file name is only displayed when the file is selected and not in response to the history display command; Dialog and Orbit are two such services. For example, Dialog supplies only the file number with the log off command. The file number alone is not adequate documentation of a search. The name of the file is required.

Date of Search - WEST, Dialog, Orbit, and Questel do not display the date of search as part of the history command. Dialog, Orbit, and Questel supply the date of search during log off; the date of search for WEST must be written on the search report.

Nucleotide and peptide sequence searches will be fully documented by a printout of the search query sequence and the beginning of the search result file. Each query sequence should be clearly related to the appropriate search result, if necessary, by appropriate annotation.

Other Databases

For other types of publicly accessible computer accessed databases (e.g., CD-ROM databases, spe-

cialized databases, etc.), record data as necessary to provide unique identification of material searched and sufficient information as to the search query or request so that the search can be updated. The record should also document the location of the database and its form (CD-ROM, etc.)

Example: Citing a biotech CD-ROM database

Entrez: Sequences, National Center for Biotechnology Information, Version 7.19.91b (CD-ROM, TC 1600) Searched HIV and vaccine; neighbored Galloway article dated 6/5/91 on April 1, 1990.

Example: Citing a nonbiotech CD-ROM database

Computer Select, (November, 1991), Ziff Davis Communications Co., (CD-ROM, STIC), Searched Unix and emulation on December 1, 1991.

III. INFORMATION NOT RECORDED ON THE FILE WRAPPER

For an indication of consideration or nonconsideration of prior art citations submitted by applicant in Information Disclosure Statements (37 CFR 1.97 and 1.98), see MPEP § 609.

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

SEARCH REQUEST FORM

Requestor's Name: _____

Date: _____

Serial Number: _____

Phone: _____

Art Unit: _____

Search Topic:
 Please write a detailed statement of search topic. Describe specifically as possible the subject matter to be searched. Define any terms that may have a special meaning. Give examples of relevant citations, authors, keywords, etc., if known. For sequences, please attach a copy of the sequence. You may include a copy of the broadest and/or most relevant claim(s).

STAFF USE ONLY

<p>Date completed: _____</p> <p>Searcher: _____</p> <p>Terminal time: _____</p> <p>Elapsed time: _____</p> <p>CPU time: _____</p> <p>Total time: _____</p> <p>Number of Searches: _____</p> <p>Number of Databases: _____</p>	<p>Search Site</p> <p>_____ STIC</p> <p>_____ CM-1</p> <p>_____ Pre-S</p> <p>Type of Search</p> <p>_____ N.A. Sequence</p> <p>_____ A.A. Sequence</p> <p>_____ Structure</p> <p>_____ Bibliographic</p>	<p>Vendors</p> <p>_____ IG</p> <p>_____ STN</p> <p>_____ Dialog</p> <p>_____ APS</p> <p>_____ Geninfo</p> <p>_____ SDC</p> <p>_____ DARC/Questel</p> <p>_____ Other</p>
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SEARCHED					
Class	Sub.	Date	Exmr.		
D7	78, 74 (Updated from Present Patent No. 4,000,000)	8-21-91	RKL		
424 D3 414	270 32R 1 (U.S. only)	} 8-21-91	RKL		
424 100	270 (updated) 99			} 11-26-91	AAM
Above IPC	(updated)				
A61K A61K A61k	9/22 31/56 31/585	} 4-22-92	F3		
INTERFERENCE SEARCHED					
Class	Sub.	Date	Exmr.		

SEARCH NOTES		
	Date	Exmr.
S. N. 495,125 refs. Ck'd 250/13 (cursory) 24/ separable fasteners (consulted Globe, All 351)	} 8-21-91	RKL
Chem. Abs., Palladium hydride, Jan.-June 1990		
Popular Mechanics June-Dec. 1990	11-26-91	AAM
Introduction to Hydraulic Fluids Roger E. Hatton, 1962	↓	↓
45/36 (Publications only)		
A61K 9/44 (cursory)		
APS USPAT 3 laser and agric? Dialog (See form)		
STN (See printout)		
Entries: Sequences NCBI Y7-19-91 b (CD ROM GB 130) Searched HIV & vaccine, neighbored Galloway article dated 6/5/91		

719.06 Foreign Filing Dates

See MPEP § 201.14(c), § 202.03 and § 201.14(d).

719.07 Related Applications

The file wrapper or the PALM bib-data sheet (for 09/series applications) should identify earlier filed related applications.

See MPEP § 202.02 and § 202.03.

720 Public Use Proceedings

37 CFR 1.292. *Public use proceedings.*

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations is found, on reference to the examiner, to make a prima facie showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 through 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers, or a notice that such a petition has been filed, shall be entered in the application file if:

(1) The petition is accompanied by the fee set forth in § 1.17(j);

(2) The petition is served on the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and

(3) The petition is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first.

(c) A petition for institution of public use proceedings shall not be filed by a party to an interference as to an application involved in the interference. Public use and on sale issues in an interference shall be raised by a preliminary motion under § 1.633(a).

Public use proceedings are provided for in 37 CFR 1.292. The institution of public use proceedings is discretionary with the Commissioner. This section is intended to provide guidance when a question concerning public use proceedings arises.

Any member of the public other than the applicant, including private persons, corporate entities, and government agencies, may file a petition under 37 CFR 1.292. A petition may be filed by an attorney or other representative on behalf of an unnamed principal since 37 CFR 1.292 does not require that the principal

be identified. A petition and fee (37 CFR 1.17(j)) are required to initiate consideration of whether to institute a public use proceeding. The petitioner ordinarily has information concerning a pending application which claims, in whole or in part, subject matter that the petitioner alleges was in "public use" or "on sale" in this country more than one year prior to the effective United States filing date of the pending application (see 35 U.S.C. 119 and 120). He or she thus asserts that a statutory bar (35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103) exists which prohibits the patenting of the subject matter of the application.

When public use petitions and accompanying papers are submitted they, or a notice in lieu thereof, will be entered in the application file if the petition is:

(A) accompanied by the fee set forth in 37 CFR 1.17(j);

(B) served on the applicant in accordance with 37 CFR 1.248, or filed with the Office in duplicate in the event service is not possible; and

(C) submitted prior to the mailing of a notice of allowance under 37 CFR 1.311.

Duplicate copies should be submitted only when, after diligent effort, it has not been possible for petitioner to serve a copy of the petition on the applicant, or his or her attorney or agent in accordance with 37 CFR 1.248 in which case the Office of Patent Legal Administration of the Office of the Deputy Commissioner for Patent Examination Policy will attempt to get the duplicate copy to the applicant, or his or her attorney or agent.

Notice of a petition for a public use proceeding will be entered in the file in lieu of the petition itself when the petition and the accompanying papers are too bulky to accompany the file. Any public use papers not physically entered in the file will be publicly available whenever the application file wrapper is available.

There are two types of public use proceedings: *ex parte* and *inter partes*. It is important to understand the difference. In the *ex parte* situation, the petitioner is not entitled, as a matter of right, to inspect the pending application. Thus, he or she stands in no better position than any other member of the public regarding access to the pending application. In the *inter partes* situation, the pending application is a reissue

application. In the *inter partes* situation, the petitioner is privy to the contents of the pending application (37 CFR 1.612). Thus, as pointed out below, the petitioner in the *inter partes* situation participates in the public use proceedings to a greater degree than in the *ex parte* situation. A petitioner who was once involved in a terminated interference with a pending application is no longer privy to the application contents and will accordingly be treated as an *ex parte* petitioner. It should be noted that petitions filed on and after February 11, 1985 will not be allowed in accordance with 37 CFR 1.292(c) unless the petition arises out of an interference declared prior to February 11, 1985 or the interference was declared after February 11, 1985 but arose from an interference declared prior to that date.

Since February 11, 1985, a petition for institution of public use proceedings cannot be filed by a party to an interference as to an application involved in the interference. Public use issues can only be raised by a preliminary motion under 37 CFR 1.633(a). However, if the issue of public use arises out of an interference declared prior to February 11, 1985, the petition may be filed by a party to the interference as to an application involved in the interference.

There may be cases where a public use petition has been filed in an application which has been restricted or is subject to a proper restriction requirement. If the petition alleges that subject matter covering both elected claims and nonelected claims is a statutory bar, only that part of the petition drawn to subject matter of the elected claims will be considered. However, if a public use proceeding is ultimately instituted, it will not necessarily be limited to the subject matter of the elected claims but may include the nonelected subject matter. Any evidence adduced on the nonelected subject matter may be used in any subsequently-filed application claiming subject matter without the requirement of a new fee (37 CFR 1.17(j)). The petitioner will not be heard regarding the appropriateness of any restriction requirement.

A petition under 37 CFR 1.292 must be submitted in writing, must specifically identify the application to which the petition is directed by application number or serial number and filing date, and should include a listing of all affidavits or declarations and exhibits relied on. The petition must contain a sufficient description of the subject matter that the petitioner alleges was in "public use" or "on sale," including any

necessary photographs, drawings, diagrams, exits, or flowcharts, to enable the examiner to compare the claimed subject matter to the subject matter alleged to have been in "public use" or "on sale." In addition, the petition and any accompanying papers must either (A) reflect that a copy of the same has been served upon the applicant or upon the applicant's attorney or agent of record; or (B) be filed with the Office in duplicate in the event service is not possible.

It is important that any petition in a pending application specifically identify the application to which the petition is directed with the identification being as complete as possible. The following information, if known, should be placed on the petition:

- (A) Name of Applicant(s).
- (B) Application number.
- (C) Confirmation number.
- (D) Filing date of application.
- (E) Title of invention.
- (F) Technology Center art unit number.
- (G) Name of examiner to whom the application is assigned.
- (H) Current status and location of application.
- (I) The word "ATTENTION:" followed by the area of the Office to which the petition is directed as set forth below.

In addition, to the above information, the petition itself should be clearly identified as a "PETITION UNDER 37 CFR 1.292." If the petition is accompanied by exhibits or other attachments, these should also contain identifying information thereon in order to prevent them from becoming inadvertently separated and lost.

Any petition under 37 CFR 1.292 can be submitted by mail to the Assistant Commissioner for Patents, Washington, D.C. 20231, and should be directed to the attention of the director of the particular Technology Center (TC) in which the application is pending. If the petitioner is unable to specifically identify the application to which the petition is directed, but, nevertheless, believes such an application to be pending, the petition should be directed to the attention of the Office of Patent Legal Administration of the Office of the Deputy Commissioner for Patent Examination Policy or to "Box DAC," along with as much identifying data for the application as possible.

Where a petition is directed to a reissue application for a patent which is involved in litigation, the outside envelope and the top right-hand portion of the petition should be marked with the words "REISSUE LITIGATION." The notations preferably should be written in a bright color with a felt point marker. Any "REISSUE LITIGATION" petition mailed to the Office should be so marked and mailed to "Box DAC." However, in view of the urgent nature of most "REISSUE LITIGATION" petitions, petitioners may wish to hand-carry the petition to the appropriate area in order to ensure prompt receipt and to avoid any unnecessary delays. In litigation-type cases, all responses should be hand-carried to the appropriate area in the Office.

Every effort should be made by a petitioner to effect service of the petition upon the attorney or agent of record or upon the applicant if no attorney or agent is of record. Of course, the copy served upon applicant or upon applicant's attorney or agent should be a complete copy including a copy of each photograph, drawing, diagram, exhibit, flowchart, or other document relied on. The petition filed in the Office should reflect, by an appropriate "Certificate of Service," that service has been made as provided in 37 CFR 1.248. Only in those instances where service is not possible should the petition be filed in duplicate in order that the Office can attempt service. In addition, all other papers filed by the petitioner relating to the petition or subsequent public use proceeding must be served in accordance with 37 CFR 1.248.

720.01 Preliminary Handling

A petition filed under 37 CFR 1.292 should be forwarded to the Office of Patent Legal Administration (OPLA) of the Office of the Deputy Commissioner for Patent Examination Policy. A member of the OPLA staff will ascertain whether the formal requirements of 37 CFR 1.292 have been fulfilled. In particular, the petition will be reviewed to see whether the petition has been filed prior to the mailing of a notice of allowance under 37 CFR 1.311, if the alleged use or sale occurred in this country more than 1 year before the effective filing date of the application, whether the petition contains affidavits or declarations and exhibits to establish the facts alleged, whether the papers have been filed in duplicate, or one copy has been served on applicant and whether the required fee has been tendered. The application file is ordered and

its status ascertained so that appropriate action may be taken.

A petition under 37 CFR 1.292 must be "submitted prior to the mailing of a notice of allowance under 37 CFR 1.311." As a practical matter, any petition should be submitted as soon as possible after the petitioner becomes aware of the existence of the application to which the petition is to be directed. By submitting a petition early in the examination process, i.e., before the Office acts on the application if possible, the petitioner ensures that the petition will receive maximum consideration and will be of the most benefit to the Office in its examination of the application.

Since a petition under 37 CFR 1.292 cannot be considered subsequent to issuance of the application as a patent or abandonment of the application, the petition will not be considered if the application is not pending when the petition and application are provided to the member of the OPLA staff (i.e., that the application was pending at the time the petition was filed would be immaterial to its ultimate consideration). A petition submitted prior to the mailing of a notice of allowance under 37 CFR 1.311, but not provided to the member of the OPLA staff with the application file prior to issuance or abandonment of the application, will be entered in the application file, but will be dismissed as moot. A petition filed after final rejection will be considered if the application is still pending when the petition and application are provided to the member of the OPLA staff. However, prosecution will not ordinarily be reopened after final rejection if the subject matter alleged in the petition to have been in "public use" or "on sale" is merely cumulative of the prior art cited in the final rejection. If a petition is filed after the mailing of a notice of allowance under 37 CFR 1.311, it will be dismissed as untimely.

A petition with regard to a reissue application should be filed within the 2-month period following announcement of the filing of the reissue application in the *Official Gazette*. If, for some reason, the petition cannot be filed within the 2-month period provided by 37 CFR 1.176, the petition can be submitted at a later time, but petitioner must be aware that reissue applications are "special" and a later filed petition may be received after action by the examiner. Any request by a petitioner in a reissue application for an extension of the 2-month period following the announcement in the *Official Gazette*

will be considered only if filed in the form of a petition under 37 CFR 1.182 and accompanied by the petition fee set forth in 37 CFR 1.17(h). The petition must explain why the additional time is necessary and the nature of the allegations to be made in the petition. A copy of such petition must be served upon applicant in accordance with 37 CFR 1.248. The petition should be directed to the appropriate Technology Center (TC). Any such petition will be critically reviewed as to demonstrated need before being granted since the delay of examination of a reissue application of another party is being requested. Accordingly, the requests should be made only where necessary, for the minimum period required, and with a justification establishing the necessity for the extension.

If the petition is a "REISSUE LITIGATION" petition, it is particularly important that it be filed early if petitioner wishes it considered prior to the first Office action on the application. Petitioners should be aware that the Office will entertain petitions under 37 CFR 1.183, when accompanied by the petition fee set forth in 37 CFR 1.17(h), to waive the 2-month delay period of 37 CFR 1.176 in appropriate circumstances. Accordingly, petitioners in reissue applications cannot automatically assume that the full 2-month delay period of 37 CFR 1.176 will always be available.

In those *ex parte* situations where a petitioner cannot identify the pending application by application number, the petition papers will be forwarded to the appropriate TC Director for an identification search. Once the application file(s) is located, it should be forwarded to the OPLA.

If the petition filed in the Office does not indicate service on applicant or applicant's attorney or agent, and is not filed in duplicate, then the Office will undertake to determine whether or not service has been made by contacting applicant or applicant's attorney or agent by telephone or in writing to ascertain if service has been made. If service has not been made and no duplicate has been filed, then the Office may request petitioner to file such a duplicate before the petition is referred to the examiner. Alternatively, if the petition involves only a few pages, the Office may, in its sole discretion, elect to reproduce the petition rather than delay referring it to the examiner. If duplicate petition papers are mailed to applicant or applicant's attorney or agent by the Office, the application file should reflect that fact, either by a letter

transmitting the petition or, if no transmittal letter is used, simply by an appropriate notation in the "Contents" section of the application file wrapper.

If the petition is not submitted prior to the mailing of a notice of allowance under 37 CFR 1.311, it should not be entered in the application file. The applicant should be notified that the petition is untimely and that it is not being entered in the application file. The handling of the petition will vary depending on the particular following situation.

(A) Service Of Copy Included

Where the petition includes an indication of service of copy on the applicant, the original petition should be discarded.

(B) Service Of Copy Not Included

Where the petition does not include an indication of service and a duplicate copy of the petition is or is not present, the duplicate copy (if present) should be discarded and the original petition should be sent to the applicant along with the notification of nonentry.

720.02 Examiner Determination of *Prima Facie* Showing

Once the Office of Patent Legal Administration (OPLA) staff member has determined that the petition meets the formal requirements of 37 CFR 1.292, and the application's status warrants consideration of the petition, he or she will prepare a letter for the Patent Legal Administrator, forwarding the petition and the application file to the examiner for determination of whether a *prima facie* case of public use or sale in this country of the claimed subject matter is established by the petition. Any other papers that have been filed by the parties involved, such as a reply by the applicant or additional submissions by the petitioner, will also be forwarded to the examiner. Whether additional papers are accepted is within the discretion of the OPLA staff member. However, protracted paper filing is discouraged since the parties should endeavor to present their best case as to the *prima facie* showing at the earliest possible time. No oral hearings or interviews will be granted at this stage, and the examiner is cautioned not to answer any inquiries by the petitioner or applicant.

A *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s) or declaration(s), as supported by the exhibits, if

later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b) alone or in combination with 35 U.S.C. 103. See MPEP § 2133.03 *et seq.*

To make this determination, the examiner must identify exactly *what* was in public use or on sale, whether it was in use or on sale in this country more than 1 year before the effective filing date, and whether the pending claims "read" on or are obvious over what has been shown to be in public use or on sale. On this last point, the examiner should compare all pending claims with the matter alleged to have been in use or on sale, not just the claims identified by petitioner.

In situations where the petition alleges only that the claims are obvious over subject matter asserted to be in public use or on sale, the petition should include prior art or other information on which it relies and explain how the prior art or other information in combination with the subject matter asserted to be in public use or on sale renders the claims obvious. The examiner is not expected to make a search of the prior art in evaluating the petition. If, however, the examiner determines that a *prima facie* case of anticipation under 35 U.S.C. 102(b) has not been established but, at the time of evaluating the petition, the examiner is aware of prior art or other information which, in his or her opinion, renders the claims obvious over the subject matter asserted to be in public use or on sale the examiner may determine that a *prima facie* case is made out, even if the petition alleged only that the claims were anticipated under 35 U.S.C. 102(b).

After having made his/her determination, the examiner will forward a memorandum to the Patent Legal Administrator, stating his or her findings and his or her decision as to whether a *prima facie* case has been established. The findings should include a summary of the alleged facts, a comparison of at least one claim with the device alleged to be in public use or on sale, and any other pertinent facts which will aid the Patent Legal Administrator in conducting the preliminary hearing. The report should be prepared in triplicate and addressed to the Patent Legal Administrator.

720.03 Preliminary Hearing

Where the examiner concludes that a *prima facie* showing has not been established, both the petitioner and the applicant are so notified by the Office of the

Deputy Commissioner for Patent Examination Policy and the application proceedings are resumed without giving the parties an opportunity to be heard on the correctness of the examiner's decision. Where the examiner concludes that a *prima facie* case has been established, the Commissioner may hold a preliminary hearing. In such case, the parties will be notified by letter of the examiner's conclusion and of the time and date of the hearing. In *ex parte* cases, whether or not the examiner has concluded that a *prima facie* showing has been established, no copy of the examiner's memorandum to the Patent Legal Administrator will be forwarded to the petitioner. However, in such cases where the petition covers restrictable subject matter and it is evident that petitioner is not aware of a restriction requirement which has been or may be made, petitioner will be informed that the examiner's conclusion is limited to elected subject matter. While not so specifically captioned, the notification of this hearing amounts to an order to show cause why a public use proceeding should not be held. No new evidence is to be introduced or discussed at this hearing. The format of the hearing is established by the member of the Office of Patent Legal Administration staff, and the Patent Legal Administrator presides. The examiner may attend as an observer only.

Where the hearing is held in the *ex parte* situation, great care will be taken to avoid discussion of any matters of the application file which are not already of knowledge to petitioner. Of course, applicant may of his or her own action or consent notify the petitioner of the nature of his or her claims or other related matters.

After the hearing is concluded, the Patent Legal Administrator will decide whether public use proceedings are to be initiated, and he/she will send appropriate notice to the parties.

720.04 Public Use Proceeding Testimony

When the Patent Legal Administrator decides to institute public use proceedings, the application is referred to the examiner who will conduct all further proceedings. The fact that the affidavits or declarations and exhibits presented with the petition for institution of the public use proceedings have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established. The

statutory bar can only be established by testimony taken in accordance with normal rules of evidence, including the right of cross-examination. The affidavits or declarations are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them unless the affidavits or declarations are submitted as a part of the petitioner's testimony.

The procedure for taking testimony in a public use proceeding is similar to that for taking testimony in an interference. Normally, no representative of the Commissioner need be present at the taking of the testimony. Note that 37 CFR 1.672(a) limits noncompelled direct testimony to affidavits. See 37 CFR 1.601(b) for the meaning of affidavit.

The examiner will set a schedule of times for taking testimony and for filing the record and briefs on the basis of the following:

SCHEDULE FOR TESTIMONY

(A) Testimony for petitioner to close
[specify a date, e.g., January 10, 1997, which is approximately 60 days after the letter]

(B) Time for the applicant to file objections to admissibility of petitioner's evidence to close
[specify a date which is approximately 20 days after date (A)]

(C) Time for the petitioner to file supplemental evidence to overcome objections to close 20 days from above date, i.e.,
[specify a date which is exactly 20 days after date (B), unless the date is a Saturday, Sunday or federal holiday, in which case use the next business day]

(D) Time for the applicant to request cross-examination of the petitioner's affiants to close
[specify a date which is approximately 20 days after date (C)]

(E) Time for cross-examination of the petitioner's affiants to close
[specify a date which is approximately 30 days after date (D)]

(F) Rebuttal testimony by applicant to close
[specify a date which is approximately 20 days after date (E)]

SCHEDULE FOR FILING AND SERVING COPIES OF RECORD AND BRIEFS

One copy of each of the petitioner's and the applicant's record and exhibits (see 37 CFR 1.653) is due .

[specify a date which is approximately 30 days after date (F)]

Petitioner's brief is due
[specify a date which is approximately 30 days after previous date]

Applicant's brief is due
[specify a date which is approximately 20 days after previous date]

Applicant and petitioner may agree on a different schedule for testimony, records, and briefs, provided the last brief is due no later than the date set forth above and provided a copy of the new schedule is filed by either applicant or petitioner. No extension of time will be permitted under 37 CFR 1.136(a). Any petition to extend the time for filing the last brief must be filed under 37 CFR 1.136(b).

A certified transcript of a deposition must be filed in the U.S. Patent and Trademark Office within one month after the date of deposition. 37 CFR 1.678.

All papers in the public use proceeding shall be served in accordance with 37 CFR 1.248.

It is understood from the above scheduling of times that a given time period begins with the close of the previous period, and that the completion of testimony or the filing of the record or a brief before the close of the corresponding period does not change its closing date. To avoid confusion, the examiner should indicate specific dates for the close of each period.

In *ex parte* cases and in *inter partes* cases where the pending application is a reissue, an oral hearing is ordinarily not held.

In all public use proceedings, whether the ultimate issue is anticipation under 35 U.S.C. 102(b) or obviousness over 35 U.S.C. 103, testimony will be limited to the issues of public use or on sale. No testimony will be received on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale.

720.05 Final Decision

The final decision of the examiner should be "analogous to that rendered by the [Board of Patent Appeals and Interferences] in an interference

proceeding, analyzing the testimony" and stating conclusions. *In re Townsend*, 1913 C.D. 55, 188 O.G. 513 (Comm'r Pat. 1913). In reaching his or her decision, the examiner is not bound by the prior finding that a *prima facie* case has been established.

If the examiner concludes that a public use or sale bar exists, he or she will enter a rejection to that effect in the application file, predicated that rejection on the evidence considered and the findings and decision reached in the public use proceeding. Even if a rejection is not made, the examiner's written action should reflect that the evidence of 35 U.S.C. 102(b) activity has in fact been considered. Likewise, if the examiner concludes that a *prima facie* case (A) has not been established, or (B) has been established and rebutted (MPEP § 2133.03(e) *et seq.*) then the examiner's written action should so indicate. Strict adherence to this format should cause the rationale employed by the examiner in the written action to be self-evident. In this regard, the use of reasons for allowance pursuant to 37 CFR 1.104(e) may also be appropriate. See MPEP § 1302.14. In *ex parte* cases where the petitioner does not have access to the file, no copy of the examiner's action is mailed to the petitioner by the Office.

There is no review from the final decision of the examiner in the public use proceedings. A petition under 37 CFR 1.181, requesting that the Commissioner exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). Once the application returns to its *ex parte* status, appellate review under 35 U.S.C. 134 and 141-145 may be had of any adverse decision rejecting claim(s), as a result of the examiner's decisions as to public use or sale.

724 Trade Secret, Proprietary, and Protective Order Materials

Situations arise in which it becomes necessary, or desirable, for parties to proceedings in the Patent and Trademark Office relating to pending patent applications or reexamination proceedings to submit to the Office trade secret, proprietary, and/or protective order materials. Such materials may include those which are subject to a protective or secrecy order issued by a court or by the International Trade Com-

mission (ITC). While one submitting materials to the Office in relation to a pending patent application or reexamination proceeding must generally assume that such materials will be made of record in the file and be made public, the Office is not unmindful of the difficulties this sometimes imposes. The Office is also cognizant of the sentiment expressed by the court in *In re Sarkar*, 575 F.2d 870, 872, 197 USPQ 788, 791 (CCPA 1978), which stated:

[T]hat wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is *most* benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest . . . for resolution.

Parties bringing information to the attention of the Office for use in the examination of applications and reexaminations are frequently faced with the prospect of having legitimate trade secret, proprietary, or protective order material disclosed to the public.

Inventors and others covered by 37 CFR 1.56(c) and 1.555 have a duty to disclose to the Office information they are aware of which is material to patentability. 37 CFR 1.56(b) states that

information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to

evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

It is incumbent upon patent applicants, therefore, to bring "material" information to the attention of the Office. It matters not whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order. The obligation is the same; it must be disclosed if "material to patentability" as defined in 37 CFR 1.56(b). The same duty rests upon a patent owner under 37 CFR 1.555 whose patent is undergoing reexamination.

Somewhat the same problem faces a protestor under 37 CFR 1.291(a) who believes that trade secret, proprietary, or protective order material should be considered by the Office during the examination of an application.

In some circumstances, it may be possible to submit the information in such a manner that legitimate trade secrets, etc., will not be disclosed, e.g., by appropriate deletions of nonmaterial portions of the information. This should be done only where there will be no loss of information material to patentability under 37 CFR 1.56 or 1.555.

The provisions of this section do not relate to material appearing in the description of the patent application.

724.01 Completeness of the Patent File Wrapper

It is the intent of the Office that the patent file wrapper be as complete as possible insofar as "material" information is concerned. The Office attempts to minimize the potential conflict between full disclosure of "material" information as required by 37 CFR 1.56 and protection of trade secret, proprietary, and protective order material to the extent possible.

The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material.

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials

Information which is considered by the party submitting the same to be either trade secret material or proprietary material, and any material subject to a protective order, must be clearly labeled as such and be filed in a sealed, clearly labeled, envelope or container. Each document or item must be clearly labeled as a "Trade Secret" document or item, a "Proprietary" document or item, or as an item or document "Subject To Protective Order." It is essential that the terms "Confidential," "Secret," and "Restricted" or "Restricted Data" not be used when marking these documents or items in order to avoid confusion with national security information documents which are marked with these terms (note also MPEP § 121). If the item or document is "Subject to Protective Order" the proceeding, including the tribunal, must be set forth on each document or item. Of course, the envelope or container, as well as each of the documents or items, must be labeled with complete identifying information for the file to which it is directed, including the Office or area to which the envelope or container is directed.

Examples of appropriate labels for such an envelope or container addressed to an application are as follows: (Appropriate changes would be made for papers filed in a reexamination file.)

A. "TRADE SECRET MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

In re Application of
Application No.

Filed:

For: (Title of Invention)

TC Art Unit:

Examiner:

ATTENTION: (Current Location of Application)"

B. "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE.

In re Application of

Application No.

Filed:

For: (Title of Invention)

TC Art Unit:

Examiner:

ATTENTION: (Current Location of Application)"

C. "MATERIAL SUBJECT TO PROTECTIVE ORDER — NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADE-MARK OFFICE EMPLOYEE.

Tribunal Issuing Protective Order:

Civil Action or Other Identification No.:

Date of Order:

Current Status of Proceeding: (Pending, Stayed, etc.)

In re application of:

Application No.

Filed:

For: (Title of Invention)

TC Art Unit:

Examiner:

ATTENTION: (Current Location of Application)"

The envelope or container must be accompanied by a transmittal letter which also contains the same identifying information as the envelope or container. The transmittal letter must also state that the materials in the envelope or container are considered trade secrets or proprietary, or are subject to a protective order, and are being submitted for consideration under MPEP § 724. A petition under 37 CFR 1.59 and fee therefor (37 CFR 1.17(h)) to expunge the information, if found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, may also accompany the envelope or container.

In order to ensure that such an envelope or container is not mishandled, either prior to reaching the Office, or in the Office, the envelope or container should preferably be hand-carried to the particular area to which it is directed and in which the application or reexamination is pending at that time. If the proceeding is then pending in a Technology Center (TC), the envelope or container should be hand-carried to the office of the TC Director. The Office personnel receiving the envelope or container should be informed that it contains such material. If the enve-

lope or container cannot be hand-carried to the Office, it can be mailed to the U.S. Patent and Trademark Office in the normal manner, but that method of submission is not as desirable as hand-carrying the envelope or container to the Office or area involved.

724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02

The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/ or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 Fed. Reg. 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

Insofar as protestors under 37 CFR 1.291(a) are concerned, submissions can be made in accordance with MPEP § 724.02 before the patent application is published, if protestor or petitioner has access to the application involved. After the patent application has been published under 35 U.S.C. 122(b)(1), no protest may be filed without the express consent of the applicant. Any submission filed by a protestor must follow the requirements for service. The Office cannot ensure that the party or parties served will maintain the information secret. If the party or parties served find it necessary or desirable to comment on material submitted under MPEP § 724 before it is, or without its being, found "material to patentability," such comments should either (A) not disclose the details of the material or (B) be submitted in a separate paper under MPEP § 724.02.

724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02

The exact methods of treating and handling materials submitted under MPEP § 724.02 will differ slightly depending upon whether the materials are submitted in an original application subject to the requirements of 35 U.S.C. 122 or whether the submission is made in a reissue application or reexamination file open to the public under 37 CFR 1.11(b) or (d). Prior to publication, an original application is not open to the public under 35 U.S.C. 122(a). After the application has been published under 35 U.S.C. 122(b)(1), copies of the file wrapper of the pending application are available to any member of the public who has filed a request under 37 CFR 1.14(c)(2). See MPEP § 103. In any event, Office personnel must not disclose such materials to the public without authorization. Upon receipt of the submission, the transmittal letter and the envelope or container will be date stamped and brought to the attention of the examiner or other Office employee responsible for evaluating the submission. The receipt of the transmittal letter and envelope or container will be noted on the "Contents" of the application or reexamination file. In addition, the face of the application or reexamination file will have the notation placed thereon to indicate that trade secret, proprietary, or protective order material has been filed. The location of the material will also be specified. The words "TRADE SECRET MATERIALS FILED WHICH ARE NOT OPEN TO PUBLIC" on the face of the file are sufficient to indicate the presence of trade secret material. Similar notations will be made for either proprietary or protective order materials.

724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122

Any materials submitted under MPEP § 724.02 in an application covered by 35 U.S.C. 122 will be treated in the following manner:

(A) The submitted material will be maintained in the original envelope or container (clearly marked "Not Open To The Public") and will not be publicly

available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether to allow the application to issue as a patent. After the application has been published pursuant to 35 U.S.C. 122(b)(1), copies of the submitted material should not be made available to any member of the public requesting a copy of the pending application file wrapper under 37 CFR 1.14(c)(2) so long as the application is pending. If the application published pursuant to 35 U.S.C. 122(b)(1) is abandoned and a petition to expunge was not filed, the material will be available to the public under 37 CFR 1.14(c) or (e).

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, it will be cited in the next Office action, or other appropriate Office communication and will become a part of the file history, which upon issuance of the application as a patent would become available to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the next Office action or other appropriate Office communication will so indicate without including the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, that information will be resealed in its envelope or container and retained pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge, the sealed envelope or container should be clearly marked "Not Open To The Public."

(G) Any petition to expunge the submitted information or any portion thereof under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)

Any materials submitted under MPEP § 724.02 in a reissue application open to the public under 37 CFR 1.11(b) will be treated in the following manner:

(A) The submitted information will be maintained separate from the reissue application file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether to allow the application to issue as a patent.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether to allow the application to issue as a patent, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reissue application file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, the next Office action or other appropriate Office communication will so indicate without including in the communication the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether to allow the application to issue as a patent, that information will be resealed in its envelope or container and retained separate from the application file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked "Not Open To The Public."

(G) Any petition to expunge a portion or all of the submitted information will be treated in accordance with MPEP § 724.05.

724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

Any materials submitted under MPEP § 724.02 in a reexamination file open to the public under 37 CFR 1.11(d) will be treated in the following manner:

(A) The submitted information will be maintained separate from the reexamination file and will not be publicly available until a determination has been made as to whether or not the information is important to a reasonable examiner in deciding whether or not a claim is patentable.

(B) The examiner, or other appropriate Office official who is responsible for considering the information, will make a determination as to whether or not any portion or all of the information submitted is important to a reasonable examiner in deciding whether or not a claim is patentable.

(C) If any portion or all of the submitted information is found important to a reasonable examiner in deciding whether or not a claim is patentable, it will be cited in the next Office action or other appropriate Office communication and will thereafter become a permanent part of the reexamination file and open to the public.

(D) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, the next Office action or other appropriate Office communication will so indicate without including in the communication the details of the submitted information.

(E) If any portion or all of the submitted information is found *not* to be important to a reasonable examiner in deciding whether or not a claim is patentable, that information will be resealed in its envelope or container and retained separate from the reexamination file, and unavailable to the public, pending the possible filing of a petition to expunge the information.

(F) Pending the filing of the petition to expunge the sealed envelope or container should be clearly marked "Not Open To The Public."

(G) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

724.05 Petition To Expunge Information or Copy of Papers in Application File

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02 will be entertained only if the petition fee (37 CFR 1.17(h)) is filed and the information has been found *not* to be important to a reasonable examiner in deciding on patentability. If the information is found to be important to a reasonable examiner in deciding on patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR 1.17(i) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the date on which the patent or reexamination certificate issues or the application becomes abandoned. The files of abandoned published applications are open to any member of the public for physical inspection (subject to the same conditions that apply to inspection of patented files). Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or

reexamination is pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If, for any reason, a decision to expunge cannot be, or is not, made prior to the date on which the patent or reexamination certificate issues or the application becomes abandoned, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Commissioner that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(h) is included.

A request to return information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may

inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

III. INFORMATION SUBMITTED IN INCORRECT APPLICATION

37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request return of the papers rather than transfer of the papers to the correct application file. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g., application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the papers to the correct application file for which they were intended without the need of a petition.

IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions. The petition must explain why justice requires waiver of the rules to permit the requested material to be expunged. It should be noted that petitions to expunge information which is a part of the original disclosure, such as the specification and drawings, will ordinarily not be favorably entertained. The original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the USPTO record of the originally filed application be changed, which may not be possible.

724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File

37 CFR 1.59. Expungement of information or copy of papers in application file.

(a)(1) Information in an application will not be expunged and returned, except as provided in paragraph (b) of this section. See § 1.618 for return of unauthorized and improper papers in interferences.

(2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge and return information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge and return information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Commissioner that the return of the information is appropriate.

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(h) are filed, and further that petitioner has established to the satisfaction of the Commissioner that the return of the information is appropriate. Return of information that was originally submitted to the Office under MPEP § 724.02 is appropriate when the petitioner complies with items (A)-(E) set forth in MPEP § 724.05, paragraph I, and the examiner or other appropriate Office official who is responsible for considering the information has determined that the information is not important to a reasonable examiner in deciding whether to allow the application (i.e., the information is not material to patentability). Return of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied. See also MPEP § 724.

Where the information to be expunged was not submitted pursuant to MPEP § 724.02 or as part of an Information Disclosure Statement, the petition should be sent to the Office of Petitions for decision.

The decision on the petition to expunge should be held in abeyance until the application is allowed or an *Ex parte Quayle* action, or a Notice of Abandonment

is mailed, at which time the petition will be decided. However, where it is clear that the information was submitted in the wrong application, then the decision on the petition should not be held in abeyance. See MPEP § 724.05, paragraph III. In a pending application that has not been allowed or in which an *Ex parte Quayle* action has not been mailed, the examiner may not have finally considered what is material to a decision of patentability of the claims. Petitioner may be notified that the decision on the petition under 37 CFR 1.59(b) to expunge information in an application will be held in abeyance and be decided upon allowance of the application, or the mailing of an *Ex parte Quayle* action or a Notice of Abandonment using form paragraph 7.204.

¶ 7.204 Petition Under 37 CFR 1.59(b) To Expunge Information: Decision Held in Abeyance

Paper No. [1]

In re Application of [2] :
 Appl. No.: [3] : RESPONSE TO PETITION
 Filed: [4] : UNDER 37 CFR 1.59
 For: [5] :

This is a response to the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The decision on the petition will be held in abeyance until allowance of the application or mailing of an *Ex parte Quayle* action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to applicant.

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02.
2. The petition should be sent to the Office of Petitions for decision if:
 - (a) the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or
 - (b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).
3. This decision is printed with the USPTO letterhead.
4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.
5. Mail with PTO-90C cover sheet.

When an application has been allowed, an *Ex parte Quayle* action has been mailed, or an application is abandoned, a petition to expunge should be decided by a TC Director (see MPEP § 1002.02(c)). At this time a determination must be made as to whether the information in question is material. Form paragraph 7.205 should be used to grant a petition to expunge, whereas form paragraphs 7.206 - 7.213 should be used to dismiss such a petition.

¶ 7.205 Petition Under 37 CFR 1.59(b) To Expunge Information Granted

Paper No. [1]

In re Application of [2] :
 Appl. No.: [3] : DECISION ON PETITION
 Filed: [4] : UNDER 37 CFR 1.59
 For: [5] :

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is granted.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record. Petitioner states that either (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material is returned herewith.

Enclosure: [9]

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02. Furthermore, a petition to expunge may not be granted unless the application has been allowed or is abandoned, or an *Ex Parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (specification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In brackets 7 and 9, clearly identify the expunged document. For example, refer to the author and title of the document.

5. Mail with PTO-90C cover sheet.

¶ 7.206 Petition Under 37 CFR 1.59(b) To Expunge Information Dismissed

Paper No. [1]

In re Application of [2] :

Appl. No.: [3] : DECISION ON PETITION

Filed: [4] : UNDER 37 CFR 1.59

For: [5] :

This is a decision on the petition under 37 CFR 1.59(b), filed [6], to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a document entitled [7], filed [8], be expunged from the record.

"Materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims.

The petition is deficient because:

Examiner Note:

1. A Technology Center Director decides this petition only if the information was submitted pursuant to MPEP § 724.02. However, the petition should not be granted until the application has been allowed or abandoned, or an *Ex parte Quayle* action has been mailed.

2. The petition should be sent to the Office of Petitions for decision if:

(a) the information was not submitted pursuant to MPEP § 724.02. Information which is part of the original disclosure (spec-

ification including any claims, drawings, and any preliminary amendment referred to in the oath or declaration) cannot be expunged under 37 CFR 1.59. Some papers entered into the application file, e.g., arguments made in an amendment, may be expunged under appropriate circumstance, however, the petition should be sent to the Office of Petitions for decision; or

(b) the petition is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.59 (e.g., requesting expungement of part of the original disclosure).

3. This decision is printed with the USPTO letterhead.

4. In bracket 7, clearly identify the document which petitioner requests to expunge. For example, refer to the author and title of the document.

5. This form paragraph must be followed with one or more of form paragraphs 7.207, 7.208, and 7.209.

¶ 7.207 Petition To Expunge, Conclusion, Lacks Fee

the petition was not accompanied by the required fee under 37 CFR 1.17(h).

¶ 7.208 Petition to Expunge, Conclusion, Material to Determination of Patentability

the information that petitioner requests to expunge is considered to be material to the determination of patentability because [1].

Examiner Note:

In bracket 1, provide an explanation of basis for conclusion that information is material to the determination of patentability.

¶ 7.209 Petition To Expunge, Conclusion, Information Made Public

the information has been made public. [1]

Examiner Note:

In bracket 1, provide explanation of basis for conclusion that information has been made public.

¶ 7.210 Petition to Expunge, Conclusion, No Commitment to Retain Information

the petition does not contain a commitment on the part of petitioner to retain the information to be expunged for the period of any patent with regard to which such information is submitted.

¶ 7.211 Petition to Expunge, Conclusion, No Clear Statement That Information is Trade Secret, Proprietary, and/or Subject to Protective Order, or that Submission Was Unintentional

the petition does not contain a clear statement that the information requested to be expunged is either: (1) a trade secret, proprietary, and/or subject to a protective order; or (2) was unintentionally submitted and failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted. [1]

Examiner Note:

In bracket 1, indicate whether any such statement was provided and, if so, explain why such statement is not clear.

¶ 7.212 *Petition to Expunge, Conclusion, No Clear Identification of Information to be Expunged*

the petition does not clearly identify the information requested to be expunged. [1]

Examiner Note:

In bracket 1, explain why the identification of the information requested to be expunged is not clear.

¶ 7.213 *Petition to Expunge, Conclusion, No Statement That Petition Is Submitted By, or on Behalf of, Party in Interest Who Originally Submitted the Information*

the petition does not contain a statement that the petition is being submitted by, or on behalf of, the party in interest who originally submitted the information.



Chapter 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

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818.03 Express Election and Traverse

818.03(a) Reply Must Be Complete

818.03(b) Must Elect, Even When Requirement Is Traversed

818.03(c) Must Traverse To Preserve Right of Petition

- 818.03(d) Traverse of Nonallowance of Linking Claims
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- 819 Office Generally Does Not Permit Shift**
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- 821.03 Claims for Different Invention Added After an Office Action
- 821.04 Rejoinder
- 822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity**
- 822.01 Copending Before the Examiner
- 823 Unity of Invention Under the Patent Cooperation Treaty**

801 Introduction

This chapter is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Code of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a). The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the U.S. Patent and Trademark Office is covered in Chapter 1800.

802 Basis for Practice in Statute and Rules

The basis for restriction and double patenting practices is found in the following statute and rules:

35 U.S.C. 121. Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a refer-

ence either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

37 CFR 1.141. Different inventions in one national application.

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

37 CFR 1.142. Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

The pertinent Patent Cooperation Treaty (PCT) Articles and Rules are cited and discussed in Chapter 1800. Sections 1850, 1875, and 1893.03(d) should be consulted for discussions on unity of invention:

- (A) before the International Searching Authority;
- (B) before the International Preliminary Examining Authority; and
- (C) in the National Stage under 35 U.S.C. 371.

802.01 Meaning of "Independent" and "Distinct"

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the

term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

802.02 Definition of Restriction

Restriction, a generic term, includes the practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species.

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent

(MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a).

803.01 Review by Examiner with at Least Partial Signatory Authority

Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section of the statute apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. Therefore, to guard against this possibility, only an examiner with permanent or temporary full signatory authority may sign final and non-final Office actions containing a final requirement for restriction, except that an examiner with permanent or temporary partial signatory authority may sign non-final Office actions containing a final requirement for restriction.

803.02 Restriction — Markush Claims

PRACTICE RE MARKUSH-TYPE CLAIMS

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a

common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be

rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

803.03 Restriction — Transitional Applications

PRACTICE RE TRANSITIONAL APPLICATION

37 CFR 1.129. *Transitional procedures for limited examination after final rejection and restriction practice.*

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995, taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

“Restriction” under 37 CFR 1.129(b) applies to both restriction requirements under 37 CFR 1.142 and election of species requirements under 37 CFR 1.146.

37 CFR 1.129(b)(1) provides for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121, or 365(c). Applicant will not be permitted to have such additional invention(s) examined in an application if:

(A) the requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121, or 365(c) prior to April 8, 1995;

(B) no restriction requirement was made with respect to the invention(s) in the application or earlier application prior to April 8, 1995, due to actions by the applicant; or

(C) the required fee for examination of each additional invention was not paid.

Only if one of these exceptions applies is a normal restriction requirement appropriate and telephone restriction practice may be used.

Examples of what constitute “actions by the applicant” in 37 CFR 1.129(b)(1) are:

(A) applicant abandoned the application and continued to refile the application such that no Office action could be issued in the application,

(B) applicant requested suspension of prosecution under 37 CFR 1.103(a) such that no Office action could be issued in the application,

(C) applicant disclosed a plurality of independent and distinct inventions in the present or parent application, but delayed presenting claims to more than one of the disclosed independent and distinct inventions in the present or parent application such that no restriction requirement could be made prior to April 8, 1995, and

(D) applicant combined several applications, each of which claimed a different independent and distinct invention, into one large “continuing” application, but delayed filing the continuing application first claiming more than one independent and distinct invention such that no restriction requirement could be made prior to April 8, 1995.

In examples (A) and (B), the fact that the present or parent application claiming independent and distinct inventions was on an examiner’s docket for at least 3 months prior to abandonment or suspension, or in examples (C) and (D), the fact that the amendment claiming independent and distinct inventions was first filed, or the continuing application first claiming the additional independent and distinct inventions was on an examiner’s docket, at least 3 months prior to April 8, 1995, is *prima facie* evidence that applicant’s actions did not prevent the Office from making a requirement for restriction with respect to those independent and distinct inventions prior to April 8, 1995. Furthermore, an extension of time under 37 CFR 1.136(a) does not constitute such “actions by the applicant” under 37 CFR 1.129(b)(1).

NOTE: If an examiner believes an application falls under the exception that no restriction could be made prior to April 8, 1995, due to applicant’s action, the application must be brought to the attention of the Technology Center (TC) Special Program Examiner for review.

Under 37 CFR 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to:

(A) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects,

(B) in situations where an election was made in reply to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or

(C) file a petition under 37 CFR 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required.

37 CFR 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in 37 CFR 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

Under 37 CFR 1.129(b)(3), each additional invention for which the required fee set forth in 37 CFR 1.17(s) has not been paid will be withdrawn from consideration under 37 CFR 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

37 CFR 1.129(c) clarifies that the provisions of 37 CFR 1.129(a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20-year patent term.

Form paragraph 8.41 may be used to notify applicant that the application is a transitional application and is entitled to consideration of additional inventions upon payment of the required fee.

¶ 8.41 Transitional Restriction or Election of Species Requirement To Be Mailed After June 8, 1995

This application is subject to the transitional restriction provisions of Public Law 103-465, which became effective on June 8, 1995, because:

1. the application was filed on or before June 8, 1995, and has an effective U.S. filing date of June 8, 1992, or earlier;
2. a requirement for restriction was not made in the present or a parent application prior to April 8, 1995; and
3. the examiner was not prevented from making a requirement for restriction in the present or a parent application prior to April 8, 1995, due to actions by the applicant.

The transitional restriction provisions permit applicant to have more than one independent and distinct invention examined in the same application by paying a fee for each invention in excess of one.

Final rules concerning the transition restriction provisions were published in the *Federal Register* at 60 FR 20195 (April 25, 1995) and in the *Official Gazette* at 1174 O.G. 15 (May 2, 1995). The final rules at 37 CFR 1.17(s) include the fee amount required to be paid for each additional invention as set forth in the following requirement for restriction. See the current fee schedule for the proper amount of the fee.

Applicant must either: (1) elect the invention or inventions to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) for each independent and distinct invention in excess of one which applicant elects; or (2) file a petition under 37 CFR 1.129(b) traversing the requirement.

Examiner Note:

1. This form paragraph should be used in all restriction or election of species requirements made in applications subject to the transition restriction provisions set forth in 37 CFR 1.129(b) where the requirement is being mailed after June 8, 1995. The procedure is NOT applicable to any design or reissue application.

803.03(a) Transitional Application — Linking Claim Allowable

Whenever divided inventions in a transitional application are rejoined because a linking claim is allowed (MPEP § 809) and applicant paid the fee set forth in 37 CFR 1.17(s) for the additional invention, applicant should be notified that he or she may request a refund of the fee paid for that additional invention.

803.03(b) Transitional Application — Generic Claim Allowable

Whenever claims drawn to an additional species in a transitional application for which applicant paid the fee set forth in 37 CFR 1.17(s) are no longer withdrawn from consideration because they are fully embraced by an allowed generic claim, applicant should be notified that he or she may request a refund of the fee paid for that additional species.

The determination of when claims to a nonelected species would no longer be withdrawn

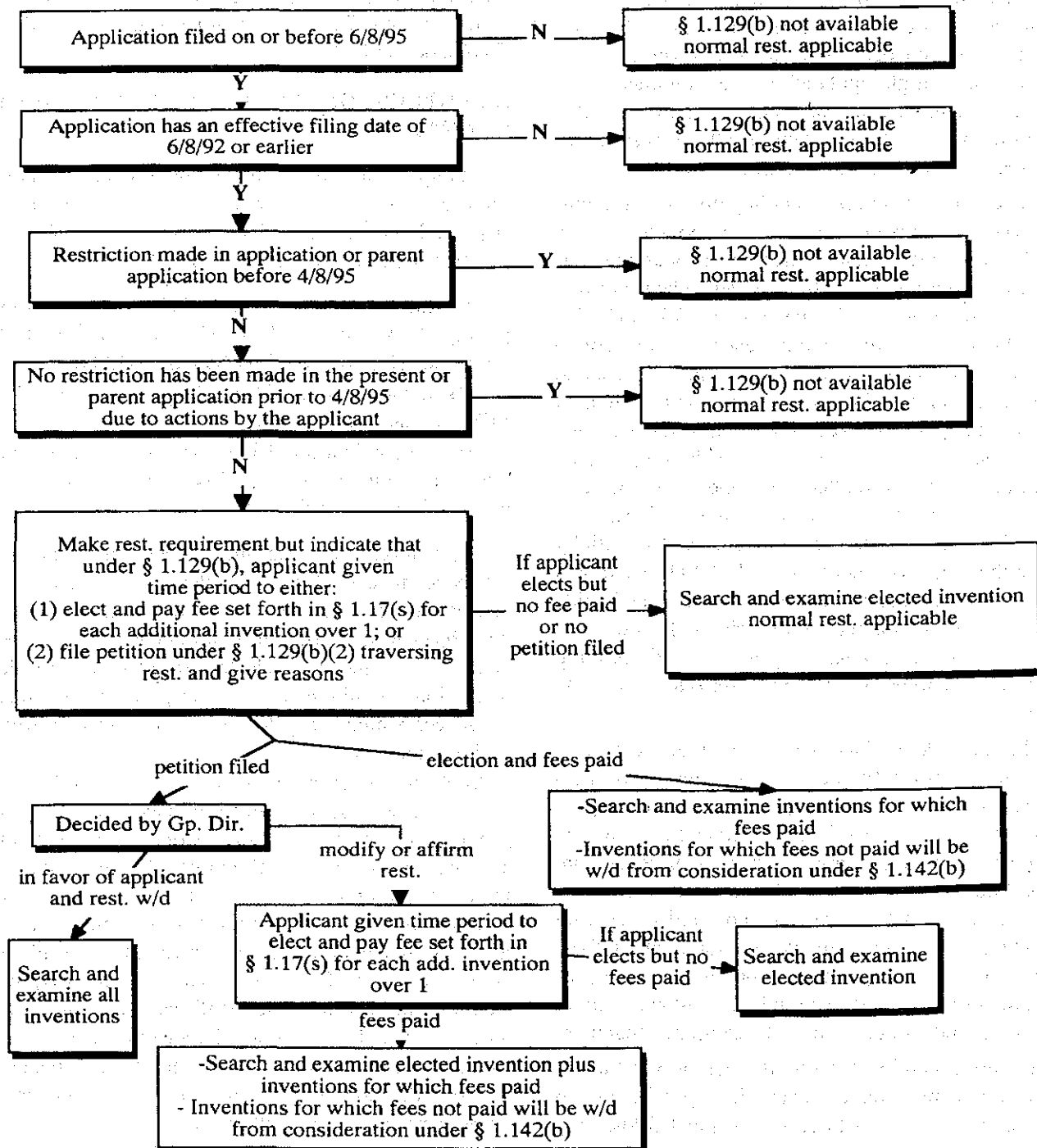
from consideration should be made as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).

Transitional Restriction Provision - 37 CFR 1.129(b)

Starting June 8, 1995

No Telephone restriction

Charge time for examination of additional inventions to 112055



803.04 Restriction - Nucleotide Sequences

By statute, “[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.” 35 U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted.” 37 CFR 1.142(a). See also 37 CFR 1.141(a).

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

In some exceptional cases, the complex nature of the claimed material, for example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten. In other cases, applicants

may petition pursuant to 37 CFR 1.181 for examination of additional nucleotide sequences by providing evidence that the different nucleotide sequences do not cover independent and distinct inventions.

See MPEP § 1850 for treatment of claims containing independent and distinct nucleotide sequences in international applications filed under the Patent Cooperation Treaty (PCT) and national stage applications filed under 35 U.S.C. 371.

EXAMPLES OF NUCLEOTIDE SEQUENCE CLAIMS

Examples of typical nucleotide sequence claims impacted by the partial waiver of 37 CFR 1.141 *et seq.* (and the partial waiver of 37 CFR 1.475 and 1.499 *et seq.*, see MPEP § 1850) include:

(A) an isolated and purified DNA fragment comprising DNA having at least 95% identity to a DNA sequence selected from SEQ ID Nos. 1-1,000;

(B) a combination of DNA fragments comprising SEQ ID Nos. 1-1,000; and

(C) a combination of DNA fragments, said combination containing at least thirty different DNA fragments selected from SEQ ID Nos. 1-1,000.

Applications claiming more than ten individual independent and distinct nucleotide sequences in alternative form, such as set forth in example (A), will be subject to a restriction requirement. Only the ten nucleotide sequences selected in response to the restriction requirement and any other claimed sequences which are patentably indistinct therefrom will be examined.

Applications claiming only a combination of nucleotide sequences, such as set forth in example (B), will generally not be subject to a restriction requirement. The presence of one novel and nonobvious sequence within the combination will render the entire combination allowable. The combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claim allowable.

Applications containing only composition claims reciting different combinations of individual

nucleotide sequences, such as set forth in example (C), will be subject to a restriction requirement. Applicants will be required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be examined following the procedures set forth above for example (B). More specifically, the combination will be searched until one nucleotide sequence is found to be allowable with the examiner choosing the order of search to maximize the identification of an allowable sequence. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed.

In applications containing all three claims set forth in examples (A)-(C), the Office will require restriction of the application to ten sequences for initial examination purposes. Based upon the finding of allowable sequences, claims limited to the allowable sequences as in example (A), all combinations, such as in examples (B) and (C), containing the allowable sequences and any patentably indistinct sequences will be rejoined and allowed.

Rejoinder will be permitted for claims requiring any allowable sequence(s). Any claims which have been restricted and nonselected and which are limited to the allowable sequence(s) will be rejoined and examined.

804 Definition of Double Patenting

35 U.S.C. 101. *Inventions Patentable.*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 121. *Divisional Applications.*

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

Before consideration can be given to the issue of double patenting, there must be some common relationship of inventorship and/or ownership of two or more patents or applications. Since the doctrine of double patenting seeks to avoid unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis necessarily is on the claims in the multiple patents or patent applications involved in the analysis.

There are generally two types of double patenting rejections. One is the "same invention" type double patenting rejection based on 35 U.S.C. 101 which states in the singular that an inventor "may obtain a patent". The second is the "nonstatutory-type" double patenting rejection based on a judicially created doctrine grounded in public policy and which is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. Nonstatutory double patenting includes rejections based on one-way determination of obviousness and on two-way determination of obviousness. Nonstatutory double patenting could include a rejection which is not the usual "obviousness-type" double patenting rejection. This type of double patenting rejection is rare and is limited to the particular facts of the case. *In re*

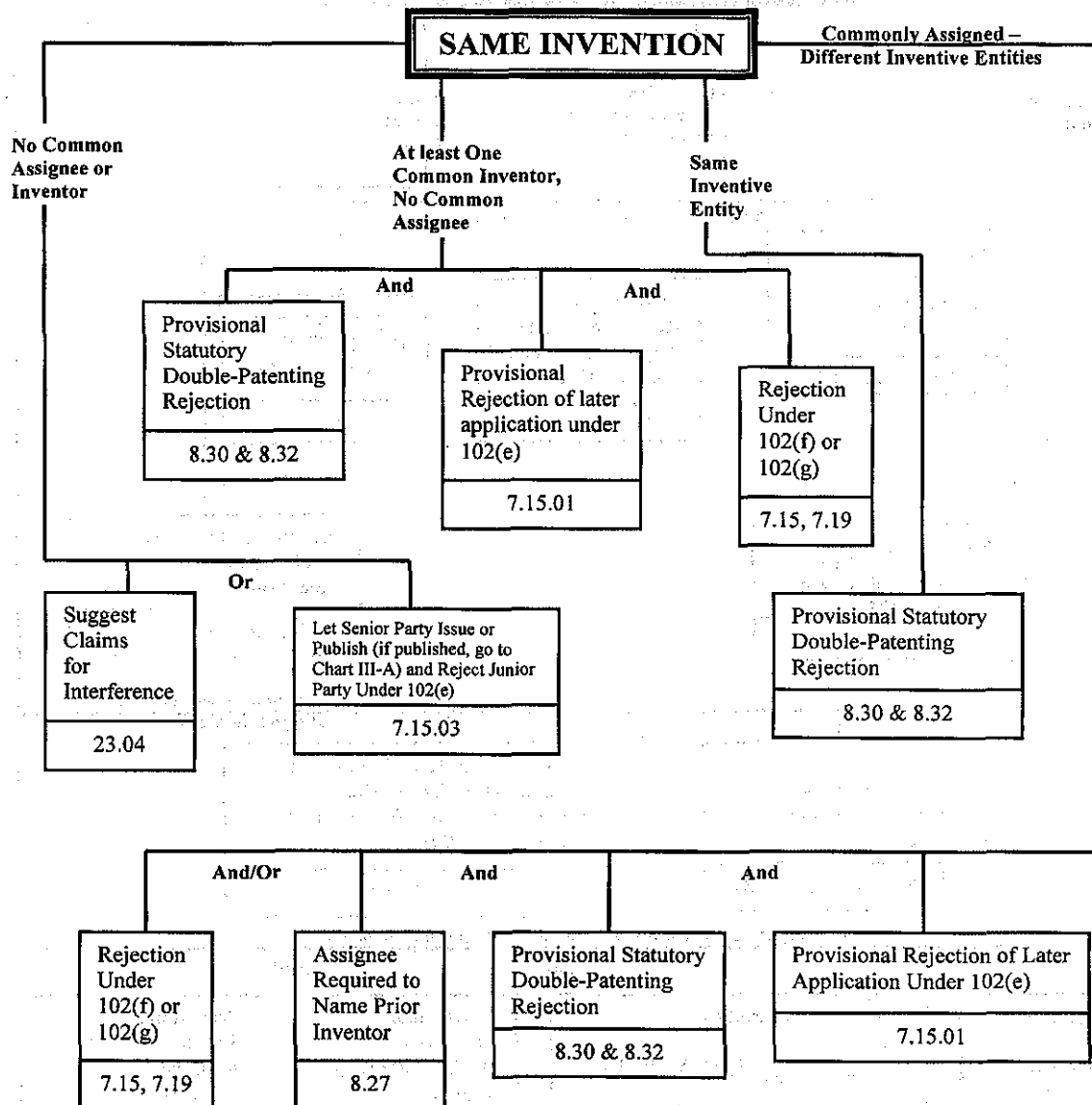
Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Refer to Charts I-A, I-B, II-A, II-B, III-A, and III-B for an overview of the treatment of applications

having conflicting claims (e.g., where a claim in an application is not patentably distinct from a claim in a patent or another application).

CONFLICTING CLAIMS BETWEEN: TWO APPLICATIONS *

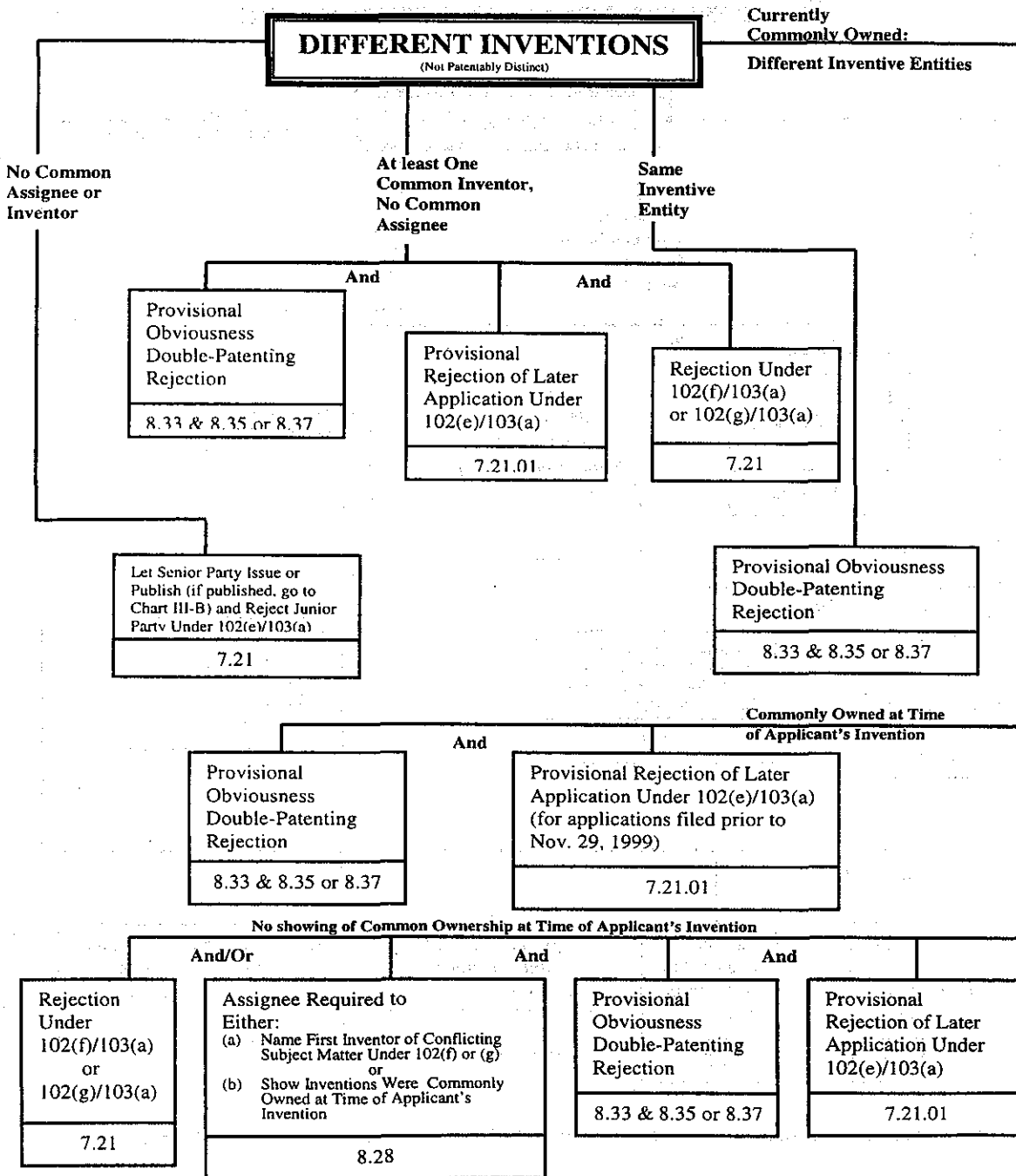
CHART I-A



* This chart applies where the application being applied as a reference has NOT been published.

CONFLICTING CLAIMS BETWEEN: TWO APPLICATIONS *

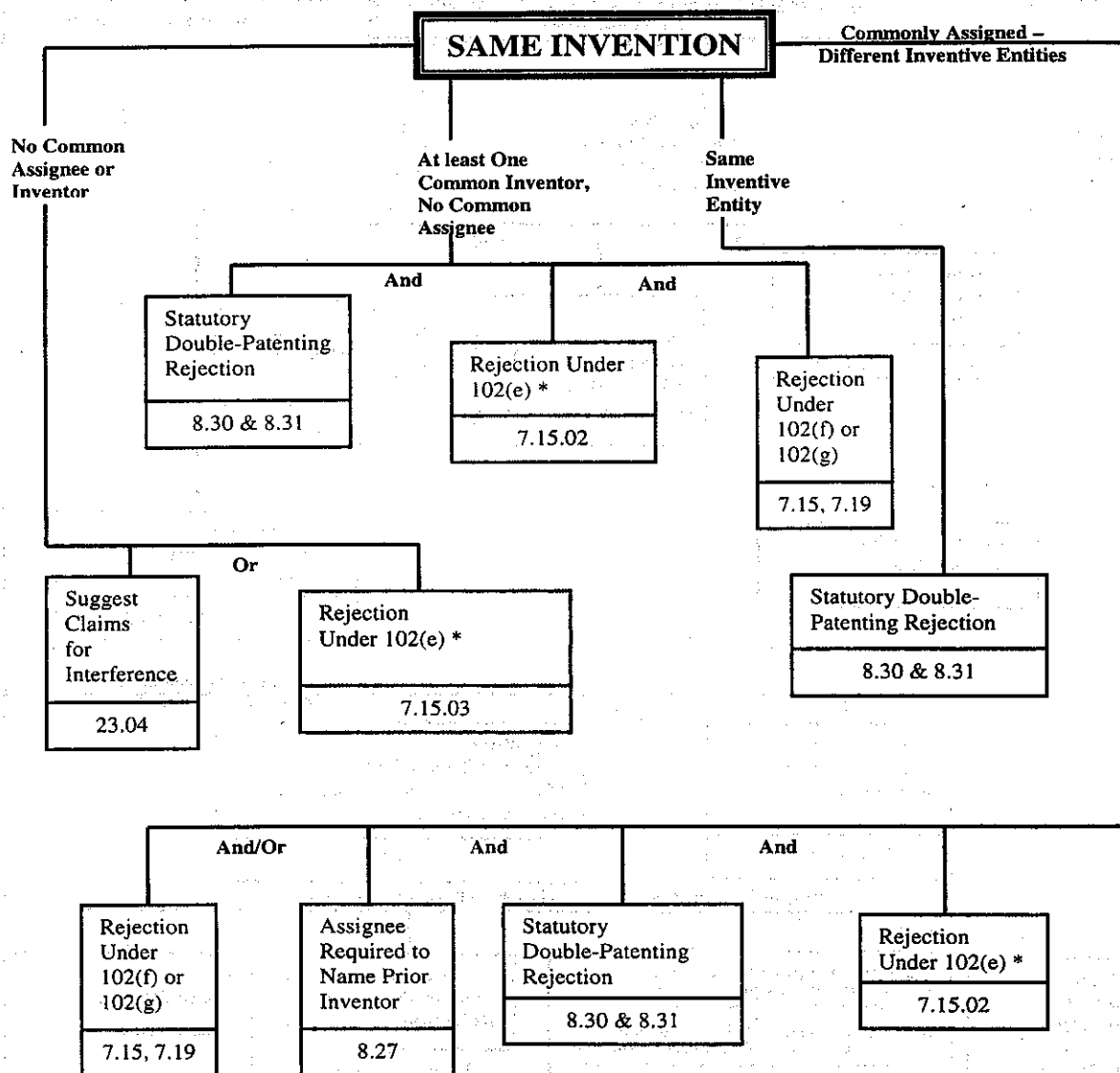
CHART I-B



* This chart applies where the application being applied as a reference has NOT been published.

CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

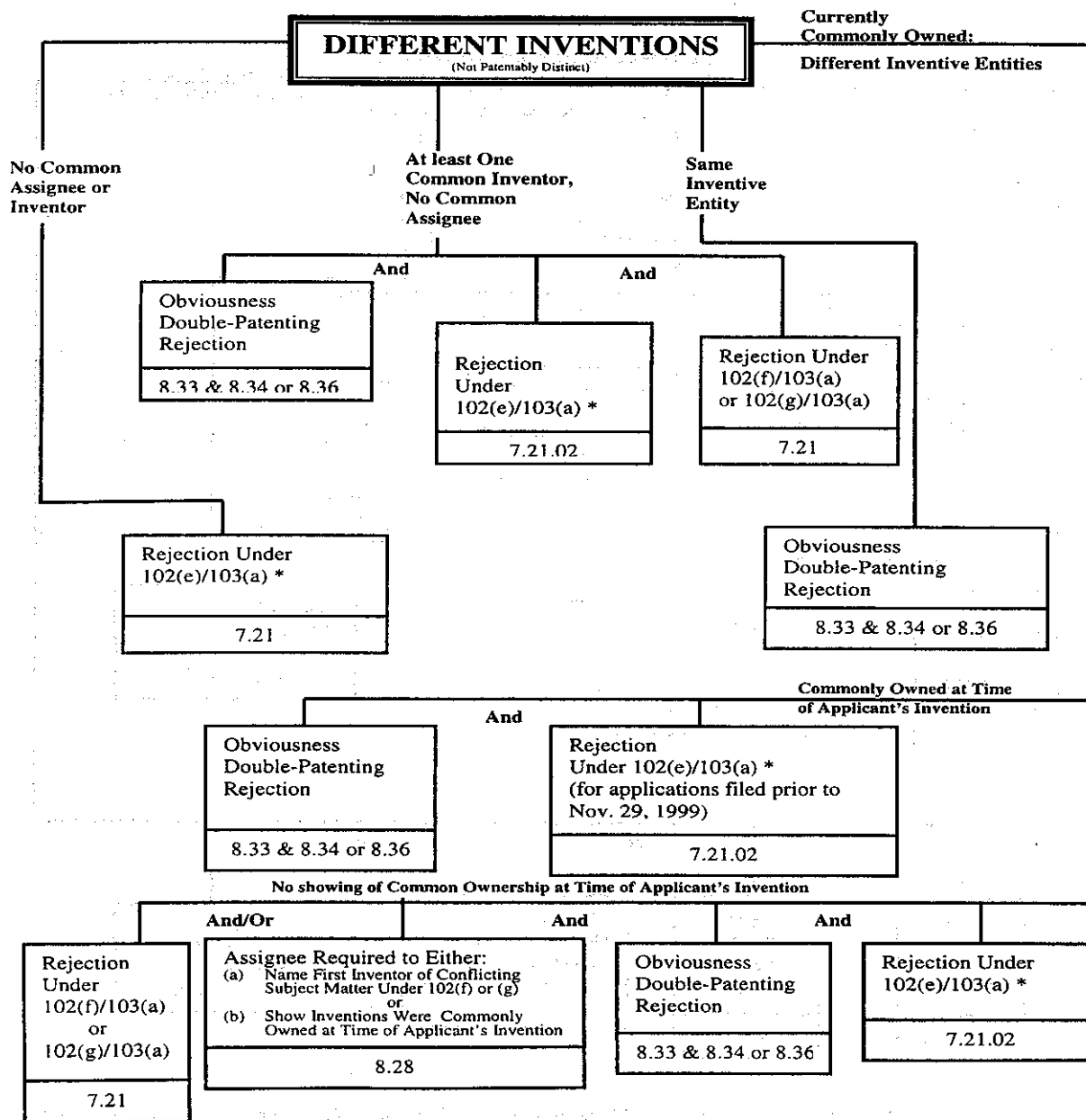
CHART II-A



* A rejection under 35 U.S.C. 102(e) would NOT be appropriate where the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, and the reference patent issued from an international application (reference patent has no 102(e) prior art effect).

CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

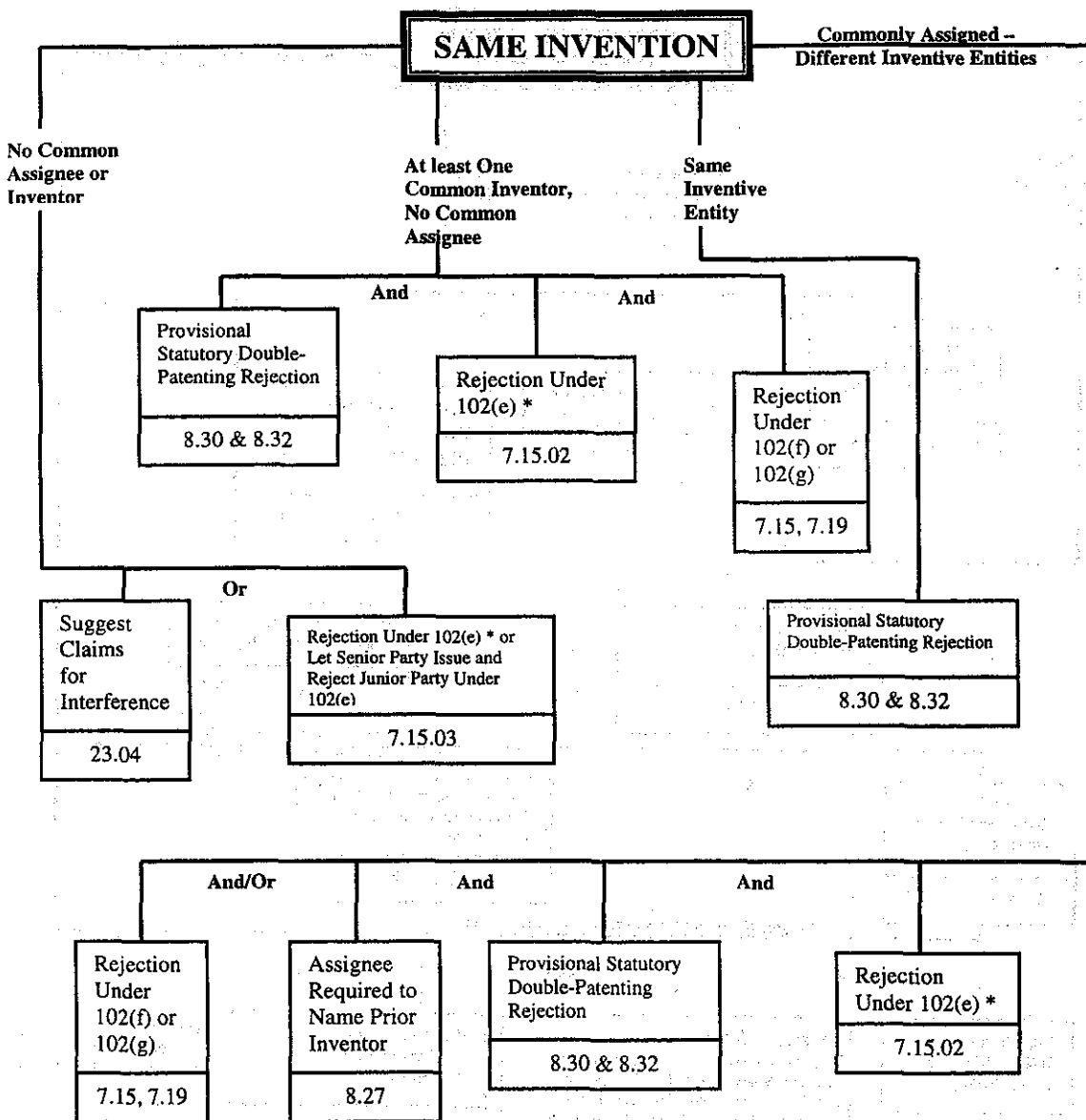
CHART II-B



*The reference patent would NOT be prior art under 35 U.S.C. 102(e) where the patent issued from an international application and the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published.

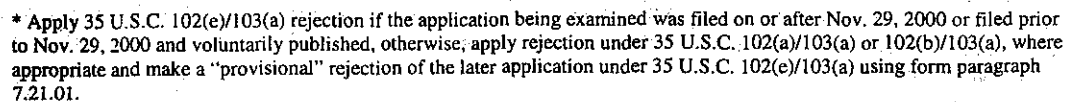
**CONFLICTING CLAIMS BETWEEN:
APPLICATION AND A PUBLISHED
APPLICATION**

CHART III-A



* Apply 35 U.S.C. 102(e) rejection if the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, otherwise, apply rejection under 35 U.S.C. 102(a) or (b), where appropriate and make a "provisional" rejection of the later application under 35 U.S.C. 102(e) using form paragraph 7.15.01.

CHART III-B



I. INSTANCES WHERE DOUBLE PATENTING ISSUE CAN BE RAISED

A double patenting issue may arise between two or more pending applications, between one or more pending applications and a patent, or between one or more pending applications and a published application. A double patenting issue may likewise arise in a reexamination proceeding between the patent claims being reexamined and the claims of one or more applications and/or patents. Double patenting does not relate to international applications which have not yet entered the national stage in the United States.

A. Between Issued Patent and One or More Applications

Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by an inventive entity having a common inventor with the patent, and/or by the owner of the patent. Since the inventor/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent.

B. Between Copending Applications—Provisional Rejections

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications (35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each

application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

C. Between One or More Applications and a Published Application - Provisional Rejections

Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection on the ground of double patenting. See the discussion regarding "provisional" double patenting rejection in subsection B. above.

D. Reexamination Proceedings

A double patenting issue may raise a substantial new question of patentability of a claim of a patent, and thus be addressed in a reexamination proceeding. *In re Lonardo*, 119 F.3d 960, 966, 43 USPQ2d 1262, 1266 (Fed. Cir. 1997) (In giving the Commissioner authority under 35 U.S.C. 303(a) in determining the presence of a substantial new question of patentability, "Congress intended that the phrases 'patents and publications' and 'other patents or publications' in section 303(a) not be limited to *prior art* patents or printed publications." (emphasis added)). Accordingly, if the issue of double patenting was not

addressed during original prosecution, it may be considered during reexamination.

II. REQUIREMENTS OF A DOUBLE PATENTING REJECTION (INCLUDING PROVISIONAL REJECTIONS)

When a double patenting rejection is appropriate, it must be based either on statutory grounds or nonstatutory grounds. The ground of rejection employed depends upon the relationship of the inventions being claimed. Generally, a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application under 35 U.S.C. 121.

Where the claims of an application are substantively the same as those of a first patent, they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor" Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957). Where the claims of an application are not the "same" as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a double patenting rejection under nonstatutory grounds is proper.

In determining whether a proper basis exists to enter a double patenting rejection, the examiner must determine the following:

(A) Whether a double patenting rejection is prohibited by the third sentence of 35 U.S.C. 121 (see MPEP § 804.01; if such a prohibition applies, a double patenting rejection cannot be made);

(B) Whether a statutory basis exists; and

(C) Whether a nonstatutory basis exists.

Each determination must be made on the basis of all the facts in the application before the examiner. Charts I-A, I-B, II-A, II-B, III-A, and III-B illustrate the methodology of making such a determination.

Domination and double patenting should not be confused. They are two separate issues. One patent or application "dominates" a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. *In re Kaplan*, 789 F.2d 1574, 1577-78, 229 USPQ 678, 681 (Fed. Cir. 1986); and *In re Sarrett*, 327 F.2d 1005, 1014-15, 140 USPQ 474, 482 (CCPA 1964). However, the presence of domination does not preclude double patenting. See, e.g., *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

A. Statutory Double Patenting — 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 precludes the grant of the second patent regardless of the presence or absence of a terminal disclaimer. *Id.*

Form paragraphs 8.30 and 8.31 (between an issued patent and one or more applications) or 8.32 (provisional rejections) may be used to make statutory double patenting rejections.

¶ 8.30 35 U.S.C. 101, Statutory Basis for Double Patenting "Heading" Only

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Examiner Note:

The above form paragraph must be used as a heading for all subsequent double patenting rejections of the statutory (same invention) type using either of form paragraphs 8.31 or 8.32.

¶ 8.31 Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of prior U.S. Patent No. [3]. This is a double patenting rejection.

Examiner Note:

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the "scope" of the inventions claimed is identical.
2. If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.
3. Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting patent and the pending application are:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and are commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but have at least one common inventor.
5. In bracket 3, insert the number of the conflicting patent.

6. If the patent is to a different inventive entity and is commonly assigned with the application, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

7. If evidence is of record to indicate that the patent is prior art under either 35 U.S.C. 102(f) or (g), a rejection should also be made using paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.

8. If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under 35 U.S.C. 102(e) should additionally be made using form paragraph 7.15.02.

¶ 8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting

Claim [1] provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [2] of copending Application No. [3]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Examiner Note:

1. This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.
2. If the conflicting claims are from an issued patent, do not use this paragraph. See paragraph 8.31.
3. Do not use this paragraph for non-statutory-type double patenting rejections. See paragraphs 8.33 to 8.39.
4. This paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor.
5. Paragraph 8.28 may be used in place of or along with this paragraph to resolve any remaining issues relating to priority under 35 U.S.C. 102(f) or (g).
6. In bracket 3, insert the number of the conflicting application.
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If the copending application is by a different inventive entity and is commonly assigned, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.
9. If evidence is also of record to show that either application is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection should also be made in the other application using paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.
10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using paragraph 7.15.01.

If the "same invention" is not being claimed twice, an analysis must be made to determine whether a non-statutory basis for double patenting exists.

B. Nonstatutory Double Patenting

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

1. Obviousness-Type

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an “obviousness-type” nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guide-

lines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized “that it is most difficult, if not meaning-

less, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined."

(a) One-Way Obviousness

If the application at issue is the later filed application or both are filed on the same day, only a one-way determination of obviousness is needed in resolving the issue of double patenting, i.e., whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. See, e.g., *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a one-way test where both applications were filed the same day). If a claimed invention in the application is obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and an obvious-type double patenting rejection is proper. Unless a claimed invention in the application is obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made, but this does not necessarily preclude a rejection based on another type of nonstatutory double patenting (see MPEP § 804, paragraph II.B.2. below).

Similarly, even if the application at issue is the earlier filed application, only a one-way determination of obviousness is needed to support a double patenting rejection in the absence of a finding of: (A) administrative delay on the part of the Office causing delay in prosecution of the earlier filed application; and (B) applicant could not have filed the conflicting claims in a single (i.e., the earlier filed) application. See MPEP § 804, paragraph II.B.1.(b) below.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.34 - 8.37 may be used to make nonstatutory rejections of the obvious-type.

(b) Two-Way Obviousness

If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before the claims for a genus in an earlier application. . . . In *Berg's* case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution."). In the absence of administrative delay, a one-way test is appropriate. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993) (applicant's voluntary decision to obtain early issuance of claims directed to a species and to pursue prosecution of previously rejected genus claims in a continuation is a considered election to postpone by the applicant and not administrative delay). Unless the record clearly shows administrative delay by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination and shift the burden to applicant to show why a two-way obviousness determination is required.

When making a two-way obviousness determination where appropriate, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made, but this does not necessarily preclude a nonstatutory double patenting rejection based on the fundamental reason to prevent unjustified timewise extension of the right to exclude granted by a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Although a delay in the processing of applications before the Office that would cause patents to issue in an order different from the order in which the applications were filed is a factor to be considered in determining whether a one-way or two-way obviousness determination is necessary to support a double patenting rejection, it may be very difficult to assess whether an applicant or the administrative process is primarily responsible for a delay in the issuance of a patent. On the one hand, it is applicant who presents claims for examination and pays the issue fee. On the other hand, the resolution of legitimate differences of opinion that must be resolved in an appeal process or the time spent in an interference proceeding can significantly delay the issuance of a patent. Nevertheless, the reasons for the delay in issuing a patent have been considered in assessing the propriety of a double patenting rejection. Thus, in *Pierce v. Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 131 USPQ 340 (3d. Cir. 1961), the court found that administrative delay may justify the extension of patent rights beyond 17 years but "a considered election to postpone acquisition of the broader [patent after the issuance of the later filed application] should not be tolerated." In *Pierce*, the patentee elected to participate in an interference proceeding [after all claims in the application had been determined to be patentable] whereby the issuance of the broader patent was delayed by more than 7 years after the issuance of the narrower patent. The court determined that the second issued patent was invalid on the ground of double patenting. Similarly, in *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997), the court found that the one-way test is appropriate where applicants, rather than the Office, had significant control over the rate of prosecution of the application at issue. In support of its finding that the applicants were responsible for delaying prosecution of the application during the critical period, the court noted that the applicants had requested and received numerous time extensions in various filings. More importantly, the court noted, after initially receiving an obviousness rejection of all claims, applicants had waited the maximum period to reply (6 months), then abandoned the application in favor of a substantially identical continuation application, then received another obviousness rejection of all claims, again waited the maximum period to reply, and then again abandoned the application in favor of a second

continuation application substantially identical to the original filing. On the other hand, in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992), the court elected not to hold the patentee accountable for a delay in issuing the first filed application until after the second filed application issued as a patent, even where the patentee had intentionally refiled the first filed application as a continuation-in-part after receiving a Notice of Allowance indicating that all claims presented were patentable. Similarly, where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). While acknowledging that allowance of the claims in the earlier filed application would result in the timewise extension of an invention claimed in the patent, the court was of the view that the extension was justified under the circumstances in this case, indicating that a double patenting rejection would be proper only if the claimed inventions were obvious over each other — a two-way obviousness determination.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.34-8.37 may be used to make non-statutory rejections of the obvious type.

¶ 8.33 Basis for Nonstatutory Double Patenting, "Heading" Only

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Examiner Note:

This form paragraph is to be used as a heading before a non-statutory double patenting rejection using any of form paragraphs 8.34 - 8.39.

¶ 8.34 Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)

Claim [1] rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3]. Although the conflicting claims are not identical, they are not patentable distinct from each other because [4].

Examiner Note:

1. This paragraph is used for obviousness-type double patenting rejections based upon a patent.
2. If the obviousness-type double patenting rejection is based upon another application, do not use this paragraph. A provisional double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.
3. This paragraph may be used where the conflicting invention is claimed in a patent which is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one inventor in common.
4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
5. In bracket 3, insert the number of the patent.
6. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 102(f)/103(a) or 102(g)/103(a) using paragraph 7.21.
7. If the patent is to another inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e)/103(a) may be made using form paragraph 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.
8. In bracket 4, provide appropriate rationale of obviousness for any claims being rejected over the claims of the cited patent.

¶ 8.35 Provisional Rejection, Obviousness Type Double Patenting - No Secondary Reference(s)

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending Application No. [3]. Although the conflicting claims are not identical, they are not patentably distinct from each other because [4].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner Note:

1. This paragraph should be used when the conflicting claims are in another copending application.

2. If the conflicting claims are in a patent, do not use this paragraph. Use form paragraphs 8.33 and 8.34.

3. This paragraph may be used where the conflicting claims are in a copending application that is:

- (a) by the same inventive entity, or
- (b) is commonly assigned even though there is no common inventor, or
- (c) not commonly assigned but has at least one common inventor.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.

5. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).

6. In bracket 3, insert the number of the conflicting application.

7. A provisional double patenting rejection should also be made in the conflicting application.

8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using paragraph 7.21.

9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a) rejection in the other application. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. In bracket 4, provide appropriate rationale for obviousness of claims being rejected over the claims of the cited patent.

¶ 8.36 Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)

Claim [1] rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of U.S. Patent No. [3] in view of [4]. [5]

Examiner Note:

1. This paragraph is used for obviousness-type double patenting rejections where the primary reference is a conflicting patent.
2. If the obviousness double patenting rejection is based on another application, do not use this paragraph. A provisional obviousness-type double patenting rejection should be made using form paragraphs 8.33 and 8.35 or 8.37.
3. This paragraph may be used where the prior invention is claimed in a patent which is:
 - (a) by the same inventive entity, or
 - (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or

- (c) not commonly assigned but has at least one common inventor.
- 4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
- 5. In bracket 3, insert the number of the conflicting patent.
- 6. In bracket 4, insert the secondary reference.
- 7. In bracket 5, insert an explanation of the obviousness-type rejection.
- 8. If evidence shows that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using paragraph 7.21.
- 9. If the patent issued to a different inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e)/103(a) may be made using paragraphs 7.15.02 or 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

¶ 8.37 Provisional Rejection, Obviousness Type Double Patenting - With Secondary Reference(s)

Claim [1] provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim [2] of copending Application No. [3] in view of [4]. [5]

This is a provisional obviousness-type double patenting rejection.

Examiner Note:

- 1. This paragraph is used for obviousness-type double patenting rejections where the primary reference is a conflicting application.
- 2. If the conflicting claims are in a patent, do not use this paragraph, use form paragraph 8.34.
- 3. This paragraph may be used where the conflicting claims are in a copending application that is:
 - (a) by the same inventive entity, or
 - (b) is commonly assigned even though there is no common inventor, or
 - (c) not commonly assigned but has at least one common inventor.
- 4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
- 5. If the conflicting cases are currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 102(f) and/or (g).
- 6. In bracket 3, insert the number of the conflicting application.
- 7. In bracket 4, insert the secondary reference.
- 8. In bracket 5, insert an explanation of the obviousness-type rejection.
- 9. A provisional double patenting rejection should also be made in the conflicting application.

10. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 35 U.S.C. 103(a) rejection based on common ownership, a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using paragraph 7.21.

11. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Another Type of Nonstatutory Double Patenting Rejection

There are some unique circumstances where it has been recognized that another type of nonstatutory double patenting rejection is applicable even where the inventions claimed in two or more applications/patents are considered nonobvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). In affirming the double patenting rejection, the court summed up the situation:

in appellant's own terms: The combination ABC was old. He made two improvements on it, (1) adding X and (2) adding Y, the result still being a unitary clip of enhanced utility. While his invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming [a clip comprising] BCX and ABCX, . . . so claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus *covering effectively ABCXY*. He now, many years later, seeks more claims directed to ABCY and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.

397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).

The court recognized that "there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against 'double patenting,' however, is not so circumscribed. The

fundamental reason for the rule is to *prevent unjustified timewise extension of the right to exclude* granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims...appellant has clearly not established the independent and distinct character of the inventions of the appealed claims." 397 F.2d at 354-55, 158 USPQ at 214-15 (emphasis in original). The court observed:

The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

397 F.2d at 355, 158 USPQ at 215.

The decision in *In re Schneller* did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in *Schneller* cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." *Schneller*, 397 F.2d at 355, 158 USPQ at 215. Non-statutory double patenting rejections based on *Schneller* will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.

A fact situation similar to that in *Schneller* was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the

application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, *per se*, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications (as the applications in *Braat*) were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, November 8, 1984) amending 35 U.S.C. 116 to expressly authorize filing a patent application in the names of joint inventors who did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and narrow inventions. Accordingly, there was a valid reason, driven by statute, why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Each double patenting situation must be decided on its own facts.

Form paragraph 8.33 and the appropriate one of form paragraphs 8.38 (between an issued patent and one or more applications) and 8.39 (provisional rejections) may be used to make this type of nonstatutory double patenting rejection.

¶ 8.38 Double Patenting - Non-Statutory (Based Solely on Improper Timewise Extension of Patent Rights) With a Patent

Claim [1] rejected under the judicially created doctrine of double patenting over claim [2] of U. S. Patent No. [3] since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which

matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common).
3. In bracket 3, insert the number of the patent.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the patent.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.
6. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21.
7. If the patent is to another inventive entity and has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e)/103(a) may be made using paragraph 7.21.02. For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

¶ 8.39 Double Patenting - Non-Statutory (Based Solely on Improper Timewise Extension of Patent Rights) With Another Application

Claim [1] provisionally rejected under the judicially created doctrine of double patenting over claim [2] of copending Application No. [3]. This is a provisional double patenting rejection because the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: [4]

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph should only be used where approval from the TC Director to make a nonstatutory double patenting rejection based on *In re Schneller* has been obtained.
2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by at least one claim of, another copending application which is commonly owned or where there is common inventorship (one or more inventors in common).

3. In bracket 3, insert the number of the conflicting application.
4. In bracket 4, insert a description of the subject matter being claimed which is covered in the copending application.
5. Form paragraph 8.33 must precede any one of form paragraphs 8.34 to 8.39 and must be used only ONCE in an office action.
6. If the conflicting application is currently commonly assigned but the file does not establish that the conflicting inventions were commonly owned at the time the later invention was made, form paragraph 8.28 may be used in place of or in addition to this form paragraph to also resolve any issues relating to priority under 35 U.S.C. 102(f) and/or (g).
7. A provisional double patenting rejection should also be made in the conflicting application.
8. If evidence shows that either application is prior art unto the other under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified (as prior art in a 103 rejection based on common ownership), a rejection should additionally be made in the other application under 35 U.S.C. 102(f)/103(a) or 102(g)/103(a) using form paragraph 7.21.
9. If the disclosure of one application may be used to support a rejection of the other and the applications have different inventive entities and different U.S. filing dates, use paragraph 7.21.01 to additionally make a rejection under 35 U.S.C. 102(e)/103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Design/Plant — Utility Situations

Double patenting issues may be raised where an applicant has filed both a utility patent application (35 U.S.C. 111) and either an application for a plant patent (35 U.S.C. 161) or an application for a design patent (35 U.S.C. 171). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the patent relied on in the rejection and the claims in issue involve the same

invention, or whether they involve inventions which are obvious variations of one another. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

In *Carman Indus.*, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way obviousness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88. But see *Carman Indus.* (J. Nies, concurring).

In *Thorington*, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. *In re Barber*, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire construction was affirmed over an earlier issued design patent. *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931).

III. CONTRAST BETWEEN DOUBLE PATENTING REJECTION AND REJECTIONS BASED ON PRIOR ART

Rejections over a patent or another copending application based on double patenting or 35 U.S.C. 103(a) are similar in the sense that both require comparison of the claimed subject matter with at least part of the content of another patent or application, and both may require that an obviousness analysis be made. However, there are significant differences between a rejection based on double patenting and one based on 35 U.S.C. 102(e) prior art under

35 U.S.C. 103(a). *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

One significant difference is that a double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed) in the same issued or to be issued patent. In a 35 U.S.C. 102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it fairly discloses to one of ordinary skill in the art, regardless of what is claimed. *In re Bowers*, 359 F.2d 886, 149 USPQ 570 (CCPA 1966).

A second significant difference is that a terminal disclaimer cannot be used to obviate a rejection based on 35 U.S.C. 102(e)/103(a) prior art. *In re Fong*, 378 F.2d 977, 154 USPQ 25 (CCPA 1967). The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art.

Where the inventions are made by inventors that have assigned their rights to a common assignee, the assignee can take some preemptive measures to avoid having a copending application become prior art under 35 U.S.C. 102(e). The applications can be filed on the same day, or copending applications can be merged into a single continuation-in-part application and the parent applications abandoned. If these steps are undesirable or the first patent has issued, the prior art effect of the first patent may be avoided by a showing under 37 CFR 1.132 that any unclaimed invention disclosed in the first patent was derived from the inventor of the application before the examiner in which the 35 U.S.C. 102(e)/103(a) rejection was made. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See also MPEP § 716.10. It may also be possible for applicant to respond to a 35 U.S.C. 102(e)/103(a) rejection by showing, under 37 CFR 1.131, that the date of invention of the claimed subject matter was prior to the effective filing date of the reference patent which has been relied upon for its unclaimed disclosure. See MPEP § 715. See also 37 CFR 1.130 and MPEP § 718 for affidavits or declarations to disqualify a commonly owned patent as prior art under 35 U.S.C. 103.

Because there are significant differences between a rejection based on double patenting and one based on prior art under 35 U.S.C. 102(e)/103 over the same issued patent, it is both appropriate and necessary that an examiner make both rejections when the facts support both rejections. A prior art reference that renders claimed subject matter obvious under 35 U.S.C. 102(e)/103(a) does not create a double patenting situation where that subject matter is not claimed in the reference patent. Where the subject matter that renders a claim obvious is both claimed and disclosed in a U.S. patent which satisfies the criteria of 35 U.S.C. 102(e), the examiner should make rejections based both on double patenting and 35 U.S.C. 103(a). For applications filed on or after November 29, 1999, rejections under 35 U.S.C. 102(e)/103(a) should not be made or maintained if the applicant provides evidence that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121

35 U.S.C. 121 authorizes the Commissioner to restrict the claims in a patent application to a single invention when independent and distinct inventions are presented for examination. The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. The prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in differ-

ent language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

The prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in MPEP § 806.04 through § 806.05(i), namely, between combination and subcombination thereof, between subcombinations disclosed as usable together, between process and apparatus for its practice, between process and product made by such process and between apparatus and product made by such apparatus, etc., so long as the claims in each application are filed as a result of such requirement.

The following are situations where the prohibition of double patenting rejections under 35 U.S.C. 121 does not apply:

(A) The applicant voluntarily files two or more applications without a restriction requirement by the examiner. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

(B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) and *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. 916 F.2d at 688, 16 USPQ2d at 1440.

(C) The restriction requirement was written in a manner which made it clear to applicant that the requirement was made subject to the nonallowance of generic or other linking claims and such generic or linking claims are subsequently allowed. Therefore, if a generic or linking claim is subsequently allowed, the restriction requirement must be withdrawn.

(D) The requirement for restriction (holding of lack of unity of invention) was only made in an international application by the International Searching Authority or the International Preliminary Examining Authority.

(E) The requirement for restriction was withdrawn by the examiner before the patent issues. *In re Ziegler*, 443 F.2d 1211, 170 USPQ 129 (CCPA 1971).

(F) The claims of the second application are drawn to the "same invention" as the first application or patent. *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986).

While the situation should not arise where appropriate care is exercised in defining the independent and distinct inventions in a restriction requirement, the issue might arise as to whether 35 U.S.C. 121 prevents the use of a double patenting rejection when the identical invention is claimed in both the patent and the pending application. Under these circumstances, the Office will make the double patenting rejection because the patentee is entitled only to a single patent for an invention. As expressed in *Studiengesellschaft Kohle*, 784 F.2d at 361, 228 USPQ at 844, (J. Newman, concurring), "35 U.S.C. 121 of course does not provide that multiple patents may be granted on the identical invention."

804.02 Avoiding a Double Patenting Rejection

I. STATUTORY

A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope. Where the conflicting claims are in one or more pending applications and a patent, a rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all the pending applications. Where the conflicting claims are in two or more pending applications, a provisional rejection based on statutory type double patenting can also be avoided by canceling the conflicting claims in all but one of the pending applications. A terminal disclaimer is not effective in overcoming a statutory double patenting rejection.

The use of a 37 CFR 1.131 affidavit in overcoming a statutory double patenting rejection is inappropriate.

In re Dunn, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). *Knell v. Muller*, 174 USPQ 460 (Comm'r. Pat. 1971), citing the CCPA decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 650 (CCPA 1962).

II. NONSTATUTORY

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and *In re Griswold*, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

The use of a 37 CFR 1.131 affidavit in overcoming a double patenting rejection is inappropriate because the claim or claims in the application are being rejected over a patent which claims the rejected invention. *In re Dunn*, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). 37 CFR 1.131 is inapplicable if the claims of the application and the patent are "directed to substantially the same invention". It is also inapplicable if there is a lack of "patentable distinctness" between the claimed subject matter. *Knell v. Muller*, 174 USPQ 460 (Comm'r. Pat. 1971), citing the court decisions in *In re Ward*, 236 F.2d 428, 111 USPQ 101

(CCPA 1956); *In re Teague*, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and *In re Hidy*, 303 F.2d 954, 133 USPQ 65 (CCPA 1962).

A patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term of a patent. 35 U.S.C. 253. The statute does not provide for a terminal disclaimer of only a specified claim or claims. The terminal disclaimer must operate with respect to all claims in the patent.

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. If an appropriate double patenting rejection of the nonstatutory type is made in two or more pending applications, an appropriate terminal disclaimer must be filed in each application.

Claims that differ from each other (aside from minor differences in language, punctuation, etc.), whether or not the difference is obvious, are not considered to be drawn to the same invention for double patenting purposes under 35 U.S.C. 101. In cases where the difference in claims is obvious, terminal disclaimers are effective to overcome double patenting rejections. However, such terminal disclaimers must include a provision that the patent shall be unenforceable if it ceases to be commonly owned with the other application or patent. Note 37 CFR 1.321(c). It should be emphasized that a terminal disclaimer cannot be used to overcome a rejection under 35 U.S.C. 102(e)/103(a).

III. TERMINAL DISCLAIMER REQUIRED DESPITE REQUEST TO ISSUE ON COMMON ISSUE DATE

Applicants are cautioned that reliance upon a common issue date cannot effectively substitute for the filing of one or more terminal disclaimers in order to

overcome a proper double patenting rejection, particularly since a common issue date alone does not avoid the potential problem of dual ownership of patents to patentably indistinct inventions. In any event, the Office cannot ensure that two or more applications will have a common issue date.

IV. DISCLAIMING MULTIPLE DOUBLE PATENTING REFERENCES

If multiple conflicting patents and/or pending applications are applied in double patenting rejections made in a single application, then prior to issuance of that application, it is necessary to disclaim each one of the conflicting double patenting references applied, rather than disclaiming only the conflicting double patenting reference with the earliest issue date (assuming at least one of the references is a patent). A terminal disclaimer fee is required for each terminal disclaimer filed. To avoid paying multiple terminal disclaimer fees, a single terminal disclaimer may be filed, wherein all the conflicting double patenting references are disclaimed therein.

Disclaiming each one of the conflicting double patenting references is necessary to avoid the problem of dual ownership of patents to patentably indistinct inventions in the event that the patent issuing from the application being examined ceases to be commonly owned with any one of the double patenting references that have issued or may issue as a patent. Note that 37 CFR 1.321(c)(3) requires that a terminal disclaimer "[i]nclude a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection."

V. REQUIREMENTS OF A TERMINAL DISCLAIMER

A terminal disclaimer is a statement filed by an owner (in whole or in part) of a patent or a patent to be granted that is used to disclaim or dedicate a portion of the entire term of all the claims of a patent. The requirements for a terminal disclaimer are set forth in 37 CFR 1.321. Sample forms of a terminal disclaimer, and guidance as to the filing and treatment of a terminal disclaimer, are provided in MPEP § 1490.

VI. TERMINAL DISCLAIMERS REQUIRED TO OVERCOME JUDICIALLY CREATED DOUBLE PATENTING REJECTIONS IN APPLICATIONS FILED ON OR AFTER JUNE 8, 1995

Public Law 103-465 (1994) amended 35 U.S.C. 154(a)(2) to provide that any patent issuing on a utility or plant application filed on or after June 8, 1995 will expire 20 years from its filing date, or, if the application claims the benefit of an earlier filed application under 35 U.S.C. 120, 121, or 365(c), 20 years from the earliest filing date for which a benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. Therefore, any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), subject to the provisions of 35 U.S.C. 154(b).

There are at least two reasons for insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a)(2). First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a judicially created double patenting rejection include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. This requirement serves to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention (37 CFR 1.601(n)). See, e.g., *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). Not insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid.

Accordingly, a terminal disclaimer under 37 CFR 1.321 is required in an application to overcome a judicially created double patenting rejection, even if the application was filed on or after June 8, 1995 and claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing date of the patent or application which forms the basis for the rejection. Examiners should respond to arguments that a terminal disclaimer under 37 CFR 1.321 should not be required in a continuing application filed on or after June 8, 1995 to overcome a judicially created double patenting rejection due to the change to 35 U.S.C. 154 by citing to this section of the MPEP or to the *Official Gazette* notice at 1202 O.G. 112 (Sept. 30, 1997).

804.03 Treatment of Commonly Owned Cases of Different Inventive Entities

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

37 CFR 1.78. Claiming benefit of earlier filing date and cross references to other applications.

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same party and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and, if not, indicate which named inventor is the prior inventor.

37 CFR 1.130. Affidavit or declaration to disqualify commonly owned patent or published application as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the

patent or published application are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent or patent application publication as prior art. The patent or patent application publication can be disqualified as prior art by submission of:

(1) A terminal disclaimer in accordance with § 1.321(c); and

(2) An oath or declaration stating that the application or patent under reexamination and patent or published application are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

I. DOUBLE PATENTING

The Office has withdrawn the Commissioner's Notice of January 9, 1967, Double Patenting, 834 O.G. 1615 (Jan. 31, 1967), to the extent that it does not authorize a double patenting rejection where different inventive entities are present. The examiner may reject claims in commonly owned applications of different inventive entities on the ground of double patenting. This is in accordance with existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See *In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963) (the doctrine is well established that claims in different applications need be more than merely different in form or content and that patentable distinction must exist to entitle applicants to a second patent) and *In re Christensen*, 330 F.2d 652, 141 USPQ 295 (CCPA 1964).

Double patenting rejections can be overcome in certain circumstances by disclaiming, pursuant to the provisions of 37 CFR 1.321, the terminal portion of the term of the later patent and including in the disclaimer a provision that the patent shall be enforceable only for and during the period the patent is commonly owned with the application or patent which formed the basis for the rejection, thereby eliminating the problem of extending patent life. 37 CFR 1.130(b).

II. IDENTIFYING COMMONLY OWNED CASES OR DETERMINING INVENTION PRIORITY

A determination of priority is not required when two inventions come within the provisions of 35 U.S.C. 103(c). Two inventions of different inventive entities come within the provisions of 35 U.S.C. 103(c) when:

(A) the later invention is not anticipated by the earlier invention under 35 U.S.C. 102;

(B) the earlier invention qualifies as prior art for purposes of obviousness under 35 U.S.C. 103 against the later invention only under subsection (f) or (g) of 35 U.S.C. 102, or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999; and

(C) the inventions were, at the time the later invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Pursuant to 37 CFR 1.78(c), where an application or a patent under reexamination and at least one other application of different inventive entities are owned by the same party and contain conflicting claims, the examiner may require the assignee to state whether the claimed inventions come within the provisions of 35 U.S.C. 103(c) (i.e., indicate whether common ownership or an obligation of assignment to the same person existed at the time the later invention was made). If the assignee states that the provisions of 35 U.S.C. 103(c) do not apply to the conflicting claimed inventions, the assignee is required to indicate which named inventor is the prior inventor. Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to identify the prior inventor under 37 CFR 1.78(c). In order to avoid abandonment, the assignee must comply with the requirement under 37 CFR 1.78(c) by naming the prior inventor unless the conflicting claims are eliminated in all but one application. If, however, the two inventions come within the provisions of 35 U.S.C. 103(c), it is not necessary to determine priority of invention since the earlier invention is disqualified as prior art against the later invention and since double patenting rejections can be used to ensure that the patent terms expire together. Accordingly, a response to a requirement under 37 CFR 1.78(c) which states that the inventions of different inventive entities come within the provi-

sions of 35 U.S.C. 103(c), is complete without any further inquiry under 37 CFR 1.78(c) as to the prior inventor.

Before making the requirement to identify the prior inventor under 37 CFR 1.78(c), with its threat to hold the application abandoned if the statement is not made by the assignee, the examiner must make sure that claims are present in each application which are conflicting as defined in MPEP § 804. See *In re Rekors*, 203 USPQ 1034 (Comm'r Pat. 1979).

In some situations the application file wrappers may reflect which invention is the prior invention, e.g., by reciting that one invention is an improvement of the other invention. See *Margolis v. Banner*, 599 F.2d 435, 202 USPQ 365 (CCPA 1979) (Court refused to uphold a holding of abandonment for failure to name the prior inventor since the record showed what was invented by the different inventive entities and who was the prior inventor.).

An application in which a requirement to name the prior inventor has been made will not be held abandoned where a timely response indicates that the other application is abandoned or will be permitted to become abandoned and will not be filed as a continuing application. Such a response will be considered sufficient since it renders the requirement to identify the prior inventor moot because the existence of conflicting claims is eliminated. Also note that the conflict between two or more pending applications can be avoided by abandoning the applications and filing a continuation-in-part application merging the conflicting inventions into a single application.

A. *Excluding A Prior Art Reference Where Common Ownership Or Assignment Obligation Exists*

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter that would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. For applications filed prior to November 29, 1999, the subject matter that is disqualified as prior art under 35 U.S.C. 103 is strictly limited to subject matter that qualifies as prior art only under 35 U.S.C. 102(f) or 35 U.S.C. 102(g) and was commonly owned with the claimed invention at the time the claimed invention was made. For applications filed on or after November 29, 1999,

the subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is also disqualified as prior art against the claimed invention if that subject matter and the claimed invention were commonly owned at the time the claimed invention was made. 35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103.

To rely upon 35 U.S.C. 103(c), a statement of common ownership must be provided in the record of the application being examined. See MPEP § 706.02(1)(2) regarding evidence required to establish common ownership.

For applications filed prior to November 29, 1999, the subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) will not be disqualified as prior art under 35 U.S.C. 103(c). However, the prior art under 35 U.S.C. 102(e)/103(a) may be disqualified under 37 CFR 1.130 if: (A) the prior art and the application being examined are commonly owned; (B) the prior art does not anticipate the claimed invention of the application; (C) a terminal disclaimer pursuant to 37 CFR 1.321 is filed; and (D) an oath or declaration is filed stating that the application being examined and the prior art are currently owned by the same party, and that the inventor named in the application is the prior inventor under 35 U.S.C. 104. See MPEP § 718.

III. *REJECTIONS UNDER 35 U.S.C. 102 AND 103 AND DOUBLE PATENTING*

Form paragraphs 8.27, 8.28 and 8.28.01 may be used to require the applicant to name the prior inventor under 37 CFR 1.78(c).

¶ 8.27 *Different Inventors, Common Assignee, Same Invention*

Claim [1] directed to the same invention as that of claim [2] of commonly assigned [3]. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Examiner Note:

1. In bracket 3, insert the U.S. patent number or the copending application number.
2. The claims listed in brackets 1 and 2 must be for the same invention. If one invention is obvious in view of the other, do not use this form paragraph; see form paragraph 8.28.
3. A provisional or actual statutory double patenting rejection may also be made using form paragraphs 8.31 or 8.32.
4. If the commonly assigned application or patent has an earlier U.S. filing date, a rejection under 35 U.S.C. 102(e) may also be made using form paragraph 7.15.01 or 7.15.02.

¶ 8.28 *Different Inventors, Common Assignee, Obvious Inventions, No Evidence of Common Ownership at Time of Invention*

Claim [1] directed to an invention not patentably distinct from claim [2] of commonly assigned [3]. Specifically, [4].

Examiner Note:

1. This form paragraph should be used when the application being examined is commonly assigned with a conflicting application or patent, but there is no indication that they were commonly assigned at the time the invention was actually made.
2. If the conflicting claims are in a patent or a published application with an earlier U.S. filing date, make a rejection under 35 U.S.C. 102(e)/103(a) using form paragraph 7.21.02 in addition to this paragraph.
3. If the conflicting claims are in a commonly assigned, copending application with an earlier filing date, make a provisional 102(e)/103(a) rejection using form paragraph 7.21.01 in addition to this paragraph.
4. In bracket 3, insert the number of the conflicting patent or application.
5. An obviousness double patenting rejection may also be included in the action using form paragraphs 8.34 to 8.36.
6. In bracket 4, explain why the claims in the conflicting cases are not considered to be distinct.
7. Form paragraph 8.28.01 MUST follow this paragraph.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

¶ 8.28.01 *Advisory Information Relating to Paragraph 8.28*

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned [1], discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the con-

flicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Examiner Note:

This form paragraph should follow paragraph 8.28 and should only be used ONCE in an Office action.

If it is determined that the provisions of 35 U.S.C. 103(c) apply to the commonly owned conflicting inventions of different inventive entities and thereby overcoming the obviousness rejection(s), double patenting rejection(s) should be made as appropriate. If, however, it is determined that the provisions of 35 U.S.C. 103(c) do NOT apply because the inventions were not commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and there is evidence of record to indicate that a patent or application is prior art against the application being examined, the examiner should make (A) the appropriate double patenting rejection(s), and (B) the appropriate prior art rejection(s) under 35 U.S.C. 102 and/or 35 U.S.C. 103 in the application being examined. See Charts I-A, I-B, II-A, II-B, III-A and III-B in MPEP § 804. Rejections under 35 U.S.C. 102 or 35 U.S.C. 103 cannot be obviated solely by filing a terminal disclaimer.

¶ 7.15 *Rejection, 35 U.S.C. 102(a), (b) Patent or Publication, and (g)*

Claim [1] rejected under 35 U.S.C. 102[2] as being [3] by [4].

Examiner Note:

1. In bracket 2, insert the appropriate paragraph letter or letters of 35 U.S.C. 102 in parentheses. If paragraph (e) of 35 U.S.C. 102 is applicable, use form paragraph 7.15.02.
2. In bracket 3, insert either --clearly anticipated-- or --anticipated-- with an explanation at the end of the paragraph.
3. In bracket 4, insert the prior art relied upon.
4. This rejection must be preceded either by form paragraph 7.07 and form paragraphs 7.08, 7.09, and 7.14 as appropriate, or by form paragraph 7.103.
5. If 35 U.S.C. 102(e) is also being applied, this paragraph must be followed by either form paragraph 7.15.02 or 7.15.03.

¶ 7.19 *Rejection, 35 U.S.C. 102(f), Applicant Not the Inventor*

Claim [1] rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. [2]

Examiner Note:

1. This form paragraph must be preceded either by form paragraphs 7.07 and 7.13 or by form paragraph 7.103.
2. In bracket 2, insert an explanation of the supporting evidence establishing that applicant was not the inventor. See MPEP § 2137.

¶ 7.21 Rejection, 35 U.S.C. 103(a)

Claim [1] rejected under 35 U.S.C. 103(a) as being unpatentable over [2].

Examiner Note:

1. This form paragraph must be preceded by either form paragraph 7.20 or form paragraph 7.103.
2. An explanation of the rejection applying the *Graham v. Deere* test must follow this form paragraph.
3. If this rejection relies upon art that is disqualified under 35 U.S.C. 102(f) or (g) based upon the common ownership of the invention, form paragraph 7.20.01 must follow this form paragraph.
4. If this rejection is a provisional 35 U.S.C. 103(a) rejection based upon a copending application that would comprise prior art under 35 U.S.C. 102(e) if patented, use paragraph 7.21.01 instead of this paragraph.

¶ 7.21.01 Provisional Rejection, 35 U.S.C. 103(a), Common Assignee or at Least One Common Inventor

Claim [1] provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. [2] which has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future patenting of the conflicting application. [4]

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Examiner Note:

1. This form paragraph is used to provisionally reject claims not patentably distinct from the disclosure in a copending application having an earlier U.S. filing date and also having either a common assignee or at least one common inventor. This form paragraph should **not** be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference application were owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made. See MPEP § 706.02(l)(3).

2. If the claimed invention is fully disclosed in the copending application, use form paragraph 7.15.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, insert explanation of obviousness.
5. If the claimed invention is also claimed in the copending application, a provisional obviousness double patenting rejection should additionally be made using form paragraphs 8.33 and 8.37.
6. If evidence indicates that the copending application is also prior art under 35 U.S.C. 102(f) or (g) and the copending application has not been disqualified as prior art in a 35 U.S.C. 103(a) rejection based upon common ownership, a rejection should additionally be made under 35 U.S.C. 103(a) using form paragraph 7.21 (e.g., applicant has named the prior inventor in response to a requirement made using form paragraph 8.28).

Further, if the conflicting applications have different effective U.S. filing dates, the examiner should consider making a provisional rejection in the later filed application, based on the earlier filed application, under 35 U.S.C. 102(e) or 102(e)/103(a), using form paragraph 7.15.01 or 7.21.01. Similarly, if an application has a later effective U.S. filing date than a conflicting issued patent, the examiner should consider making a rejection in the application, based on the patent, under 35 U.S.C. 102(e) or 102(e)/103(a), using form paragraph 7.15.02 or 7.21.02. Rejections under 35 U.S.C. 102 or 103 cannot be obviated solely by the filing of a terminal disclaimer. However, for applications filed on or after November 29, 1999, a rejection under 35 U.S.C. 102(e) can be overcome by submitting evidence of common ownership, or an obligation to assign to the same person, at the time the invention was made.

¶ 7.15.01 Provisional Rejection, 35 U.S.C. 102(e) - Common Assignee or At Least One Common Inventor

Claim [1] provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. [2] which has a common [3] with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. [4].

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Examiner Note:

1. This form paragraph is used to provisionally reject over a copending application with an earlier filing date that discloses the claimed invention. The copending application must have either a common assignee or at least one common inventor.
2. If the claims are obvious over the invention disclosed in the other copending application, use form paragraph 7.21.01.
3. In bracket 3, insert either --assignee-- or --inventor--.
4. In bracket 4, an appropriate explanation may be provided in support of the examiner's position on anticipation, if necessary.
5. If the claims of the copending application conflict with the claims of the instant application, a provisional double patenting rejection should also be given using form paragraphs 8.30 and 8.32.
6. If evidence is additionally of record to show that either invention is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection using form paragraphs 7.13 and/or 7.14 should also be made.

¶ 7.15.02 Rejection, 35 U.S.C. 102(e), Common Assignee or Inventor(s)

Claim [1] rejected under 35 U.S.C. 102(e) as being anticipated by [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Examiner Note:

1. This form paragraph is used to reject over a patent with an earlier filing date that discloses but does not claim the same invention. The patent must have either a common assignee or a common inventor.
2. In bracket 3, insert either --assignee-- or --inventor--.

¶ 7.21.02 Rejection, 35 U.S.C. 103(a), Common Assignee or At Least One Common Inventor

Claim [1] rejected under 35 U.S.C. 103(a) as being obvious over [2].

The applied reference has a common [3] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2). [4]

Examiner Note:

1. This form paragraph is used to reject over a patent with an earlier filing date that discloses the claimed invention, and that only qualifies as prior art under 35 U.S.C. 102(e). If the patent qualifies as prior art under 35 U.S.C. 102(a) or (b), then this form paragraph should not be used (form paragraphs 7.07 and either 7.08 or 7.09 should be used instead). The patent must have either a common assignee or at least one common inventor. This form paragraph should not be used in applications filed on or after November 29, 1999 when the application being examined establishes that it and any reference patent were owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made. See MPEP § 706.03(1)(3).
2. In bracket 3, insert either --assignee-- or --inventor--.
3. In bracket 4, insert explanation of obviousness.

804.04 Submission to Technology Center Director

In order to promote uniform practice, every Office action containing a rejection on the ground of double patenting which relies on the parent application rejecting the claims in a divisional or continuing application where the divisional or continuing application was filed because of a requirement to restrict made by the examiner under 35 U.S.C. 121, including a requirement to elect species, must be submitted to the Technology Center Director for approval prior to mailing. If the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. Note MPEP § 1003.

805 Effect of Improper Joinder in Patent

35 U.S.C. 121, last sentence, provides "the validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." In other words, under this statute, no patent can be held void for improper joinder of inventions claimed therein.

806 Determination of Distinctness or Independence of Claimed Inventions

The general principles relating to distinctness or independence may be summarized as follows:

(A) Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(i), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto. 37 CFR 1.141, MPEP § 809.02 - § 809.02(e).

(B) Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

(C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) see MPEP § 806.05 - § 806.05(i) and § 809.03. See MPEP § 802.01 for criteria for patentably distinct inventions.

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.

806.02 Patentability Over the Prior Art Not Considered

For the purpose of a decision on the question of restriction, and for this purpose only, the claims are ordinarily assumed to be in proper form and patentable (novel and unobvious) over the prior art.

This assumption, of course, is not continued after the question of restriction is settled and the question of patentability of the several claims in view of prior art is taken up.

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Where such claims appear in different applications optionally filed by the same inventor, disclosing the same embodiments, see MPEP § 804 - § 804.02.

806.04 Independent Inventions

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS.

806.04(a) Species — Genus

35 U.S.C. 121 provides that restriction may be required to one of two or more independent and distinct inventions. However, 37 CFR 1.141 provides that a reasonable number of species may still be

claimed in one application if the other conditions of the rule are met.

806.04(b) Species May Be Related Inventions

Species, while usually independent, may be related under the particular disclosure. Where inventions as disclosed and claimed are both (A) species under a claimed genus and (B) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restrictions such as those covered in MPEP § 806.05 - § 806.05(i). If restriction is improper under either practice, it should not be required.

For example, two different subcombinations usable with each other may each be a species of some common generic invention. In *Ex parte Healy*, 1898 C.D. 157, 84 O.G. 1281 (Comm'r Pat. 1898), a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the Commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

As a further example, species of carbon compounds may be related to each other as intermediate and final product. Thus, these species are not independent and in order to sustain a restriction requirement, distinctness must be shown. Distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product. Otherwise, the disclosed relationship would preclude their being issued in separate patents.

Form Paragraph 8.14 may be used in intermediate — final product restriction requirements.

¶ 8.14 Intermediate-Final Product

Inventions [1] and [2] are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is

useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as [3] and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note:

1. This form paragraph is to be used when claims are presented to both an **intermediate** and **final product** (MPEP § 806.04(b)).
2. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

The intermediate and final product must have a mutually exclusive species relationship and as with all species restrictions, must be patentably distinct.

Typically, the intermediate loses its identity in the final product.

Additionally, the intermediate must be shown to be useful to make other than the final product. The examiner must give an example of an alternative use but need not provide documentation. Applicant then has the burden to prove or provide a convincing argument that the intermediate does not have the suggested use.

806.04(c) Subcombination Not Generic to Combination

The situation is frequently presented where two different combinations are disclosed, having a subcombination *common to each*. It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto.

This was recognized in *Ex parte Smith*, 1888 C.D. 131, 44 O.G. 1183 (Comm'r Pat. 1888), where it was held that a subcombination was not generic to the different combinations in which it was used.

To exemplify, a claim that defines only the subcombination, e.g., the mechanical structure of a joint, is not a generic or genus claim to two different combinations, e.g., a doughnut cooker and an automobile transmission, each of which utilizes the same form of joint.

806.04(d) Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species. See MPEP § 809.02(c).

806.04(e) Claims Restricted to Species

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodi-

ments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Species are always the specifically different embodiments.

Species are *usually* but not always independent as disclosed (see MPEP § 806.04(b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any commonality of operation, function or effect.

806.04(f) Claims Restricted to Species, by Mutually Exclusive Characteristics

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

806.04(h) Species Must Be Patentably Distinct From Each Other

Where an applicant files a divisional application claiming a species previously claimed but nonelected in the parent case, pursuant to and consonant with a requirement to restrict, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.

In a national application containing claims directed to more than a reasonable number of species, the examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the

species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Where generic claims are allowed in a national application, applicant may claim in the *same application* additional species as provided by 37 CFR 1.141.

Where, however, an applicant optionally files another national application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See MPEP § 804.01 and § 804.02.

806.04(i) Generic Claims Presented for First Time After Issue of Species

The Office no longer follows the practice of prohibiting the allowance of generic claims that are presented for the first time after the issuance of a copending application claiming plural species. Instead, the Office may reject the generic claims on the grounds of obviousness-type double patenting. Applicant may overcome such a rejection by filing a terminal disclaimer. See *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

806.05 Related Inventions

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If nondistinct inventions are claimed in separate applications or patents, double patenting must be held, except where the

additional applications were filed consonant with a requirement to restrict in a national application.

The various pairs of related inventions are noted in the following sections.

806.05(a) Combination and Subcombination or Element

A combination is an organization of which a subcombination or element is a part.

Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in MPEP § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be allowable and must be treated on that basis.

806.05(b) Old Combination — Novel Subcombination

Restriction is ordinarily not proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pat.1923). See MPEP § 820.01.

806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

AB_{br}/B_{sp} Restriction Proper

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

This situation can be diagrammed as combination AB_{br} ("br" is an abbreviation for "broad"), and subcombination B_{sp} ("sp" is an abbreviation for "specific"). B_{br} indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B_{sp} are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B_{sp} in the combination claim AB_{br} is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

II. SUBCOMBINATION ESSENTIAL TO COMBINATION

AB_{sp}/B_{sp} No Restriction

If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination AB_{sp} as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

III. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUBCOMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.

AB_{sp}/AB_{br} (Evidence Claim)/B_{sp} Restriction Proper

Claim AB_{br} is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim AB_{br} is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be considered and the letter to the applicant should so state. Therefore, where the combination evidence claim AB_{br} does not set forth the details of the subcombination B_{sp} and the subcombination B_{sp} has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

Form paragraph 8.15 may be used in combination-subcombination restriction requirements.

¶ 8.15 Combination-Subcombination

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both **combination(s)** and **subcombination(s)** (MPEP § 806.05(c)).
2. In situations involving evidence claims, see MPEP § 806.05(c); example 3, and explain in bracket 3.
3. In bracket 4, suggest utility other than used in the combination.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

The burden is on the examiner to suggest an example of separate utility.

If applicant proves or provides an argument supported by facts, that the other utility, suggested by the examiner, cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement.

806.05(d) Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. See MPEP § 806.04(b).

Form paragraph 8.16 may be used in restriction requirements between subcombinations.

¶ 8.16 Subcombinations, Usable Together

Inventions [1] and [2] are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention [3] has separate utility such as [4]. See MPEP § 806.05(d).

Examiner Note:

1. This form paragraph is to be used when claims are presented to subcombinations usable together (MPEP § 806.05(d)).
2. In bracket 3, insert the appropriate group number or identify the invention.
3. In bracket 4, suggest utility other than with the other invention.
4. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

Only one-way distinctness is required.

The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination.

Care must be taken to determine if the subcombinations are generically claimed.

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

The burden is on the examiner to provide an example.

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

806.05(e) Process and Apparatus for Its Practice — Distinctness

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement. See MPEP § 806.05(c).

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

If the apparatus claims include a claim to “means” for practicing the process, the claim is a linking claim and must be examined with the elected invention. If it is ultimately allowed, rejoinder is required. See MPEP § 809.04.

Form paragraph 8.17 may be used to make restriction requirements between process and apparatus.

¶ 8.17 Process and Apparatus

Inventions [1] and [2] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both a **process** and **apparatus for its practice** (MPEP § 806.05(e)).
2. In bracket 3, use one or more of the following reasons:
 - (a) --the process as claimed can be practiced by another and materially different apparatus such as--
 - (b) --the process as claimed can be practiced by hand--
 - (c) --the apparatus as claimed can be used to practice another and materially different process such as--
3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

The burden is on the examiner to provide reasonable examples that recite material differences.

If the apparatus claims include a claim to "means" for practicing the process, this claim is a linking claim (except for the presence of this claim restriction between apparatus and process claims would be proper). The linking claim must be examined with the elected invention, but only to the extent necessary to determine if the linking claim is unpatentable. If the linking claim is unpatentable, restriction is proper.

It should be noted that a claim such as, "An apparatus for the practice of the process of claim 1, comprising" and then the claim continues with purely apparatus limitations, is not a linking claim. This is merely a preamble similar to a statement of intended use and should be treated as any preamble.

If applicant proves or provides convincing argument that there is no material difference or in the case of a process that cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement.

806.05(f) Process of Making and Product Made — Distinctness

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or (B) that the product *as claimed* can be made by another and materially different process.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

Form paragraph 8.18 may be used in restriction requirements between product and process of making.

¶ 8.18 Product and Process of Making

Inventions [1] and [2] are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both a **product** and the **process of making** the product (MPEP § 806.05(f)).
2. In bracket 3, use one or more of the following reasons:
 - (a) --the process as claimed can be used to make a materially different product such as--
 - (b) --the product as claimed can be made by a materially different process such as--
3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

806.05(g) Apparatus and Product Made — Distinctness

An apparatus and a product made by the apparatus can be shown to be distinct inventions if either or both of the following can be shown: (A) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different apparatus.

Form paragraph 8.19 may be used for restriction requirements between apparatus and product made.

¶ 8.19 Apparatus and Product Made

Inventions [1] and [2] are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both the **apparatus** and **product made** (MPEP § 806.05(g)).
2. In bracket 3, use one or more of the following reasons:
 - (a) --the apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as--
 - (b) --the product can be made by a materially different apparatus such as--

3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

ONLY ONE-WAY DISTINCTNESS IS REQUIRED

The examiner must show by way of example either (A) that the apparatus as *claimed* is not an obvious apparatus for making the product and the apparatus as *claimed* can be used to make other and different products or (B) that the product as *claimed* can be made by another and materially different apparatus.

The burden is on the examiner to provide an example, but the example need not be documented.

If applicant either proves or provides convincing argument that the alternative example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

806.05(h) Product and Process of Using

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

Form paragraph 8.20 may be used in restriction requirements between the product and method of using.

¶ 8.20 Product and Process of Using

Inventions [1] and [2] are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case [3].

Examiner Note:

1. This form paragraph is to be used when claims are presented to both the **product** and **process of using the product** (MPEP § 806.05(h)).
2. In bracket 3, use one or more of the following reasons:

(a) --the process as claimed can be practiced with another materially different product such as--.

(b) --the product as claimed can be used in a materially different process such as--.

3. Conclude restriction requirement with one of form paragraphs 8.21.01 through 8.21.03.

806.05(i) Product, Process of Making, and Process of Using — Product Claim Not Allowable

37 CFR 1.141. *Different inventions in one national application.*

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

Where an application contains claims to a product, claims to a process specially adapted for (i.e., not patentably distinct from, as defined in MPEP § 806.05(f)) making the product, and claims to a process of using the product, and the product claims are not allowable (i.e., not novel and nonobvious), restriction is proper between the process of making and the process of using. In this instance, applicant may be required to elect either (A) the product and process of making it; or (B) the process of using. Unless the examiner can make a showing of distinctness between the process of using and the product (MPEP § 806.05(h)), the product must also be joined with the process of using in grouping (B).

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (MPEP § 806.05(f)); otherwise, the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP § 806.05(h)).

Determination of patentability of the product need not be made prior to making a requirement for restriction unless the requirement is based on a determination that the product claims are not allowable.

Form paragraph 8.20.01 may be used in product, process of making and process of using situations where the product is not allowable.

¶ 8.20.01 Product, Process of Making and Process of Using-Product Not Allowable

Inventions [1] and [2] are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

Examiner Note:

This form paragraph is to be used when claims are presented to the **product, process of making and process of using** where the product claim(s) are not allowable (MPEP § 806.05(i)).

807 Patentability Report Practice Has No Effect on Restriction Practice

Patentability report practice (MPEP § 705), has no effect upon, and does not modify in any way, the practice of restriction, being designed merely to facilitate the handling of cases in which restriction cannot properly be required.

808 Reasons for Insisting Upon Restriction

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections.

808.01 Independent Inventions

Where the inventions claimed are independent, i.e., where they are not connected in design, operation, or effect under the disclosure of the particular application under consideration (MPEP § 806.04), *the facts relied on for this conclusion are in essence the reasons for insisting upon restriction*. This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

Form paragraph 8.20.02 may be used when claims are directed to independent, unrelated inventions.

¶ 8.20.02 Unrelated Inventions

Inventions [1] and [2] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions [3].

Examiner Note:

1. This form paragraph is to be used only when claims are presented to unrelated inventions, e. g., a necktie and a locomotive bearing.
2. In bracket 3, insert reasons for concluding that the inventions are unrelated.

808.01(a) Species

Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. See MPEP § 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification.

A single disclosed species must be elected as a prerequisite to applying the provisions of 37 CFR 1.141 to additional species if a generic claim is allowed.

Even if the examiner rejects the generic claims, and even if the applicant cancels the same and admits that the genus is unpatentable, where there is a relationship disclosed between species, such disclosed relationship must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Election of species should be required prior to a search on the merits (A) in all applications containing claims to a plurality of species with no generic claims;

and (B) in all applications containing both species claims and generic or Markush claims.

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim.

In all applications where a generic claim is found allowable, the application should be treated as indicated in MPEP § 809.02 (b), § 809.02 (c), or § 809.02 (e). If an election is made pursuant to a telephone requirement, the next action should include a full and complete action on the elected species as well as on any generic claim that may be present.

808.02 Related Inventions

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated

different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

809 Claims Linking Distinct Inventions

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP § 809.03 for definition of linking claims.

A letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. See MPEP § 812.01 for telephone practice in restriction requirements.

No art will be indicated for this type of linking claim and no rejection of these claims made.

A 1-month (not less than 30 days) shortened statutory period will be set for reply to a written requirement. Such action will not be an "action on the merits" for the purpose of the second action final program.

To be complete, a reply to a requirement made according to this section need only include a proper election.

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability.

809.02 Generic Claim Linking Species

Under 37 CFR 1.141, an allowed generic claim may link a reasonable number of species embraced thereby.

The practice is stated in 37 CFR 1.146 as follows:

37 CFR 1.146. Election of species.

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

809.02(a) Election Required

Where generic claims are present, the examiner should send a letter including only a restriction requirement or place a telephone requirement to restrict (the latter being encouraged). See MPEP § 812.01 for telephone practice in restriction requirements.

Action as follows should be taken:

(A) Identify generic claims or indicate that no generic claims are present. See MPEP § 806.04(d) for definition of a generic claim.

(B) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted*. The species are preferably identified as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

(C) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete reply and his or her rights under 37 CFR 1.141.

For generic claims, a search should not be made and art should not be cited.

A 1-month (not less than 30 days) shortened statutory period will be set for reply when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program.

To be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added.

In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

¶ 8.01 Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention: [1].

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, [2] generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note:

In bracket 2, insert the appropriate generic claim information.

¶ 8.02 Election When Claims Are Not Restricted to Species

Claim [1] generic to a plurality of disclosed patentably distinct species comprising [2]. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Examiner Note:

1. This paragraph should be used for the election of requirement described in MPEP § 803.02 (Markush group) and § 809.02(d) (burdensome search necessary).
2. In bracket 2, clearly identify the species from which an election is to be made.

If claims are added after the election, applicant must indicate which are readable on the elected species.

It is necessary to (A) identify generic claims or state that none are present, and (B) clearly identify each species involved.

809.02(b) Election Required — Generic Claim Allowable

When a claim generic to two or more claimed species is found to be allowable on the first or any subsequent action on the merits *and election of a single species has not been made*, applicant should be informed that the claim is allowable and generic, and a requirement should be made that applicant elect a single species embraced by the allowed genus unless the species claims are all in the form required by 37 CFR 1.141 and no more than a reasonable number of species are claimed. Form paragraph 8.48 may be used.

¶ 8.48 Generic Claim(s) Allowable, No Election of Single Species

Allowed claim [1] generic to a plurality of disclosed patentably distinct species comprising [2]. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species embraced by the allowed genus.

Applicant is advised that a complete reply to this requirement must include an identification of the species that is elected and a listing of all claims readable thereon. Applicant is entitled to consideration of claims to a reasonable number of disclosed species in addition to the elected species provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. Applicant's reply must include an identification of such additional species along with a listing of the claims readable on each additional species.

Examiner Note:

1. This form paragraph is to be used whenever a claim generic to two or more species is found to be allowable and election of a

single disclosed species embraced thereby has not been made of record.

2. In bracket 1, identify the claim(s) found to be generic and allowable.
3. In bracket 2, identify the plurality of species embraced by the allowed generic claim(s).

809.02(c) Action Following Election

An examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species.

(A) When the generic claims are rejected, or there is no generic claim, all claims not readable on the elected species should be treated using Form Paragraphs 8.05 and 8.06, as appropriate.

¶ 8.05 Claims Stand Withdrawn With Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. [3].

Examiner Note:

In bracket 2, insert --invention-- or --species--.

¶ 8.06 Claims Stand Withdrawn Without Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected [2], there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. [3].

Examiner Note:

In bracket 2, insert --invention--, or --species--.

(B) When a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment shall be as follows:

(1) When *all* claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim.

(2) When *any* claim directed to one of said additional species embraced by an allowed generic claim is not in the required form, all claims to that species should be held to be withdrawn from further consideration by the examiner. The holding should be worded as set forth in form paragraph 8.49.

¶ 8.49 Allowance of Generic Claim(s), Claims Stand Withdrawn as Not In Required Form

Claim [1], directed to the species of [2] withdrawn from further consideration since [3] depend upon or otherwise include each of the limitations of an allowed generic claim as required by 37 CFR 1.141.

Examiner Note:

1. In bracket 2, insert identification of species followed by --, is-- or --, are--.
2. In bracket 3, insert --it does not-- or --they do not all--.

Note that each additional species is handled separately. When all of the claims to one nonelected species are embraced by an allowable generic claim but each of the claims to another nonelected species is not embraced by an allowable generic claim, applicant must be advised that the claims to the one nonelected species are no longer withdrawn from further consideration but that the claims to the other nonelected species remain withdrawn from further consideration since all of the claims to this other species do not depend upon or fully include all of the limitations of an allowed generic claim as required by 37 CFR 1.141. This holding should be worded as set forth in form paragraph 8.50.

¶ 8.50 Allowance of Generic Claim(s), Some Claims No Longer Considered Withdrawn

Claim [1] generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim [2], directed to the species of [3] no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claim [4], directed to the species of [5] remain withdrawn from consideration since [6] depend upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. In bracket 3, insert an identification of species followed by --, is-- or --, are--.
2. In bracket 5, insert an identification of species.
3. In bracket 6, insert --it does not-- or --they do not all--.

4. If all of the pending claims are in proper form, i.e., they include all the limitations of an allowed generic or linking claim, one of form paragraphs 8.45, 8.46 or 8.47 must be used.

When the application is otherwise ready for issue and there is an allowed generic claim, and applicant has not been previously notified as to the allowance of a generic claim, applicant must be advised of the allowance of a generic claim and given a time limit of 1 month (not less than 30 days) to conform all of the claims to the nonelected species to fully embrace an allowed generic claim or the examiner will cancel the claims to each nonconforming species by examiner's amendment and pass the application to issue. If the election is traversed, an additional paragraph worded as form paragraph 8.03 should be added to the holding.

¶ 8.03 In Condition for Allowance, Non-elected Claims

This application is in condition for allowance except for the presence of claim [1] to an invention non-elected with traverse in Paper no. [2]. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

809.02(d) No Species Claims

Where only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. See MPEP § 808.01(a). If after an action on only generic claims with no restriction requirement, applicant presents species claims to more than one species of the invention, he or she must at that time indicate an election of a single species.

809.02(e) Generic Claim Allowable in Substance

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed.

The treatment of the application should be as indicated in MPEP § 809.02(b), § 809.02(c), or § 809.02(d).

809.03 Linking Claims

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible.

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) a claim to the necessary process of making a product linking proper process and product claims;
- (C) a claim to "means" for practicing a process linking proper apparatus and process claims; and
- (D) a claim to the product linking a process of making and a use (process of using).

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking. Examiners should use Form Paragraph 8.12 to make restrictions involving linking claims.

¶ 8.12 Restriction, Linking Claims

Claim [1] link(s) inventions [2] and [3]. The restriction requirement [4] the linked inventions is **subject to** the nonallowance of the linking claim(s), claim [5]. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph must be included in any restriction requirement with at least one linking claim present.

2. In bracket 4, insert either --between-- or --among--.
3. In bracket 5, insert the claim number(s) of the linking claims.
4. See related form paragraphs 8.45, 8.46 and 8.47.

For traverse of rejection of linking claim in applications, see MPEP § 818.03(d).

809.04 Retention of Claims to Non-elected Invention

Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

Form paragraph 8.45 should be used to notify applicant of the allowance of a linking claim and that the nonelected claim(s) depending from or including all the limitations of the allowable linking claim, previously withdrawn from consideration, is/are rejoined and fully examined for patentability under 37 CFR 1.104.

¶ 8.45 Allowance of Linking Claim(s), Nonelected Claims Not Canceled

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claim [6], previously withdrawn from consideration as a result of the restriction requirement, [7] hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims have NOT been canceled. Use form paragraph 8.46 where the nonelected claims HAVE BEEN canceled.

2. In bracket 2, insert either --between-- or --among--.
3. In bracket 7, insert either --is-- or --are--.

Form paragraph 8.46 (or form paragraph 8.47 if appropriate) must be used to notify applicant of the allowance of a linking claim and that the nonelected claim(s) which depended from or included all the limitations of the allowable linking claim canceled by applicant may be reinstated by submitting the claim(s) in an amendment.

¶ 8.46 Allowance of Linking Claim(s), Nonelected Claims Canceled, Other Issues Remain Outstanding

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claim [6], which depended from or included all the limitations of the allowable linking claim(s), previously withdrawn from consideration as a result of the restriction requirement, [7] canceled by applicant in Paper No. [8]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in a timely filed amendment in reply to this action. Upon entry of the amendment, such amended claim(s) will be examined for patentability under 37 CFR 1.104.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph (or form paragraph 8.47) **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled.
2. If no issues remain outstanding and application is otherwise ready for allowance, use form paragraph 8.47 instead of this form paragraph.
3. In bracket 2, insert either --between-- or --among--.
4. In bracket 7, insert either --was-- or --were--.

¶ 8.47 Allowance of Linking Claim(s), Nonelected Claims Canceled, No Outstanding Issues Remaining

Linking claim [1] allowed. Since the restriction requirement [2] inventions [3], as set forth in Paper No. [4] mailed on [5], was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claim [6], which depended from or included all the limitations of the allowable linking claim(s), previously withdrawn from consideration as a result of the restriction require-

ment, [7] canceled by applicant in Paper No. [8]. The canceled, nonelected claim(s) may be reinstated by applicant if submitted in an amendment, limited to the addition of such claim(s), filed within a time period of ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Upon entry of the amendment, such amended claim(s) will be examined for patentability under 37 CFR 1.104. If NO such amendment is submitted within the set time period, the application will be passed to issue. PROSECUTION ON THE MERITS IS OTHERWISE CLOSED.

In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner Note:

1. This form paragraph (or form paragraph 8.46) **must** be used upon the allowance of a linking claim following a restriction requirement with at least one linking claim present and wherein the nonelected claims HAVE BEEN canceled. Use form paragraph 8.45 where the nonelected claims have NOT been canceled.
2. This form paragraph should be used only when there are no outstanding issues remaining and is to be used with only a PTO-90C cover sheet.
3. In bracket 2, insert either --between-- or --among--.
4. In bracket 7, insert either --was-- or --were--.

When a final requirement is contingent on the nonallowability of the linking claims, applicant may petition from the requirement under 37 CFR 1.144 without waiting for a final action on the merits of the linking claims or applicant may defer his or her petition until the linking claims have been finally rejected, but not later than appeal. See 37 CFR 1.144 and MPEP § 818.03(c).

810 Action on the Merits

In general, in an application when only a written requirement to restrict is made, no action on the merits is given.

810.01 Not Objectionable When Coupled With Requirement

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper. See MPEP § 706.07(a). In those applications wherein a requirement for

restriction or election is accompanied by a complete action on the merits of all the claims, such action will be considered to be an action on the merits and the next action by the examiner should be made final. When preparing a final action in an application where applicant has traversed the restriction requirement, see MPEP § 821.01.

Although an action on the merits is not necessary to a requirement, it is not objectionable. *Ex parte Lantzke*, 1910 C.D. 100, 156 O.G. 257 (Comm'r Pat. 1910). However, note that a question may arise as to whether there is a serious burden on the examiner.

However, except as noted in MPEP § 809 and § 812.01, if an action is given on the merits, *it must be given on all claims*.

810.02 Usually Deferred

The Office policy is to usually defer action on the merits until after the requirement for restriction is complied with, or withdrawn. *Ex parte Pickles*, 1904 C.D. 126, 109 O.G. 1888 (Comm'r Pat. 1904); *Ex parte Snyder*, 1904 C.D. 242, 110 O.G. 2636 (Comm'r Pat. 1904); and *Ex parte Weston*, 1911 C.D. 218, 173 O.G. 285 (Comm'r Pat. 1911).

810.03 Given on Elected Invention When Requirement Is Made Final

37 CFR 1.143 last sentence states: "[i]f the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected." Thus, action is ordinarily given on the elected invention in the action making the requirement final.

811 Time for Making Requirement

37 CFR 1.142(a), second sentence states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible; otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

811.02 Even After Compliance With Preceding Requirement

Since 37 CFR 1.142(a) provides that restriction is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied. *Ex parte Benke*, 1904 C.D. 63, 108 O.G. 1588 (Comm'r Pat. 1904).

811.03 Repeating After Withdrawal Proper

Where a requirement to restrict is made and withdrawn, because it was improper, when it becomes proper at a later stage in the prosecution, restriction may again be required.

811.04 Proper Even Though Grouped Together in Parent Application

Even though inventions are grouped together in a requirement in a parent application, restriction or election among the inventions may be required in the divisional applications, if proper.

812 Who Should Make the Requirement

The requirement should be made by an examiner who would examine at least one of the inventions.

An examiner should not require restriction in an application if none of the claimed subject matter is classifiable in his or her Technology Center. Such an application should be transferred to a Technology Center to which at least some of the subject matter belongs.

812.01 Telephone Restriction Practice

If an examiner determines that a requirement for restriction should be made in an application, the examiner should formulate a draft of such restriction requirement including an indication of those claims considered to be linking or generic. No search or rejection of the linking claims should be made.

Thereupon, the examiner should telephone the attorney or agent of record and request an oral election, with or without traverse if desired, after the attorney or agent has had time to consider the restriction requirement. However, no telephone communication need be made where the requirement for restriction is complex, the application is being prosecuted by the applicant *pro se*, or the examiner knows from past experience that an election will not be made by telephone. The examiner should arrange for a second telephone call within a reasonable time, generally within 3 working days. If the attorney or agent objects to making an oral election, or fails to respond, the usual restriction letter will be mailed, and this letter should contain reference to the unsuccessful telephone call. (See MPEP § 809 and § 809.02(a)). When an oral election is made, the examiner will then proceed to incorporate into the Office action a formal restriction requirement including the date of the election, the attorney's or agent's name, and a complete record of the telephone interview, followed by a complete action on the elected claims including linking or generic claims if present.

Form paragraphs 8.23 or 8.23.01 should be used to make a telephone election of record.

¶ 8.23 Requirement, When Elected by Telephone

During a telephone conversation with [1] on [2] a provisional election was made [3] traverse to prosecute the invention of [4], claim [5]. Affirmation of this election must be made by applicant in replying to this Office action. Claim [6] withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Examiner Note:

1. In bracket 3, insert --with-- or --without--, whichever is applicable.
2. In bracket 4, insert either the elected group or species.
3. An action on the merits of the claims should follow.

¶ 8.23.01 Requirement, No Election by Telephone

A telephone call was made to [1] on [2] to request an oral election to the above restriction requirement, but did not result in an election being made.

Examiner Note:

1. In bracket 1, insert the name of the applicant or attorney or agent contacted.
2. In bracket 2, insert the date(s) of the telephone contact(s).
3. This form paragraph should be used in all instances where a telephone election was attempted and the applicant's representative did not or would not make an election.

4. This form paragraph should **not** be used if no contact was made with applicant or applicant's representative.

If, on examination, the examiner finds the elected claims to be allowable and no traverse was made, the letter should be attached to the Notice of Allowability form PTOL-37 and should include cancellation of the nonelected claims, a statement that the prosecution is closed, and that a notice of allowance will be sent in due course. Correction of formal matters in the above-noted situation which cannot be handled by a telephone call and thus requires action by the applicant should be handled under the *Ex parte Quayle* practice, using Office Action Summary form PTOL-326.

Should the elected claims be found allowable in the first action, and an oral traverse was noted, the examiner should include in his or her action a statement under MPEP § 821.01, making the restriction final and giving applicant 1 month to either cancel the nonelected claims or take other appropriate action. (37 CFR 1.144). Failure to take action will be treated as an authorization to cancel the nonelected claims by an examiner's amendment and pass the application to issue. Prosecution of the application is otherwise closed.

In either situation (traverse or no traverse), caution should be exercised to determine if any of the allowed claims are linking or generic claims before canceling the nonelected claims.

Where the respective inventions are located in different Technology Centers (TCs), the requirement for restriction should be made only after consultation with and approval by all TCs involved. If an oral election would cause the application to be examined in another TC, the initiating TC should transfer the application with a signed memorandum of the restriction requirement and a record of the interview. The receiving TC will incorporate the substance of this memorandum in its official letter as indicated above. Differences as to restriction should be settled by the existing chain of command, e.g., supervisory patent examiner or TC director.

This practice is limited to use by examiners who have at least negotiation authority. Other examiners must have the prior approval of their supervisory patent examiner.

814 Indicate Exactly How Application Is To Be Restricted

SPECIES

The mode of indicating how to require restriction between species is set forth in MPEP § 809.02(a).

As pointed out in *Ex parte Ljungstrom*, 1905 C.D. 541, 119 O.G. 2335 (Comm'r Pat. 1905), the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.

INVENTIONS OTHER THAN SPECIES

It is necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate subject should be noted along with a statement of the subject matter to which they are drawn.

This is the best way to most clearly and precisely indicate to applicant how the application should be restricted. It consists in identifying each separate subject amongst which restriction is required, and grouping each claim with its subject.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to a subcombination, or to a product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass.

While every claim should be accounted for, the omission to group a claim, or placing a claim in the wrong group will not affect the propriety of a final requirement where the requirement is otherwise proper and the correct disposition of the omitted or erroneously grouped claim is clear.

LINKING CLAIMS

The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be examined with any one of the

linked inventions that may be elected. This fact should be clearly stated.

815 Make Requirement Complete

When making a requirement every effort should be made to have the requirement complete. If some of the claimed inventions are classifiable in another art unit and the examiner has any doubt as to the proper line among the same, the application should be referred to the examiner of the other art unit for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

Note form paragraph 8.13.

¶ 8.13 Distinctness (Heading)

The inventions are distinct, each from the other because:

Examiner Note:

This form paragraph should be followed by one of form paragraphs 8.14-8.20.02 to show distinctness.

817 Outline of Letter for Restriction Requirement Between Distinct Inventions

The statement in MPEP § 809.02 through § 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product.

(4) Classify each group.

Form paragraphs 8.08-8.11 should be used to group inventions.

¶ 8.08 Restriction, Two Groupings

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.Claim [1], drawn to [2], classified in class [3], subclass [4].

II.Claim [5], drawn to [6], classified in class [7], subclass [8].

¶ 8.09 Restriction, 3rd Grouping

III.Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ 8.10 Restriction, 4th Grouping

IV.Claim [1], drawn to [2], classified in class [3], subclass [4].

¶ 8.11 Restriction, Additional Groupings

[1].Claim[2], drawn to [3], classified in class [4], subclass [5].

Examiner Note:

In bracket 1, insert the appropriate roman numeral, e.g., --V--, --VI--, etc.

(B) Take into account claims not grouped, indicating their disposition.

(1) Linking claims

(i) Indicate (make no action)

(ii) Statement of groups to which linking claims may be assigned for examination

(2) Other ungrouped claims

(3) Indicate disposition, e.g., previously non-elected, nonstatutory, canceled, etc.

(C) Allegation of distinctness

(1) Point out facts which show distinctness

(2) Treat the inventions as claimed, don't merely state the conclusion that inventions in fact are distinct

(i) Subcombination - Subcombination disclosed as usable together

Each usable alone or in other identified combination

Demonstrate by examiner's suggestion

(ii) Combination - Subcombination

Combination as claimed does not require subcombination

AND

Subcombination usable alone or in other combination

Demonstrate by examiner's suggestion

(iii) Process - Apparatus

Process can be carried out by hand or by other apparatus

Demonstrate by examiner's suggestion

OR

Demonstrate apparatus can be used in other process (rare).

(iv) Process of making and/or Apparatus for making — Product made

Claimed product can be made by other process (or apparatus)

Demonstrate by examiner's suggestion

OR

Demonstrate process of making (or apparatus for making) can produce other product (rare)

(D) Provide reasons for insisting upon restriction

(1) Separate status in the art

(2) Different classification

(3) Same classification but recognition of divergent subject matter

- (4) Divergent fields of search, or
- (5) Search required for one group not required for the other

(E) Summary statement

- (1) Summarize (i) distinctness and (ii) reasons for insisting upon restriction, if applicable
- (2) Include paragraph advising as to reply required.
- (3) Indicate effect of allowances of linking claims, if any present
- (4) Indicate effect of cancellation or nonallowance of evidence claims (see MPEP § 806.05(c))

One of form paragraphs 8.21.01 through 8.21.03 must be used at the conclusion of each restriction requirement.

¶ 8.21.01 Conclusion to All Restriction Requirements: Different Classification

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.02 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

¶ 8.21.02 Conclusion to All Restriction Requirements: Recognized Divergent Subject Matter

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.03) MUST BE ADDED AS A CONCLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

¶ 8.21.03 Conclusion to All Restriction Requirements: Different Search

Because these inventions are distinct for the reasons given above and the search required for Group [1] is not required for Group [2], restriction for examination purposes as indicated is proper.

Examiner Note:

THIS FORM PARAGRAPH (OR ONE OF FORM PARAGRAPHS 8.21.01 OR 8.21.02) MUST BE ADDED AS A CON-

CLUSION TO ALL RESTRICTION REQUIREMENTS employing any of form paragraphs 8.14 to 8.20.02.

Form paragraph 8.23.02 must be included in all restriction requirements for applications having joint inventors.

¶ 8.23.02 Joint Inventors, Correction of Inventorship

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Examiner Note:

This form paragraph must be included in all restriction requirements for applications having joint inventors.

818 Election and Reply

Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application.

A reply should be made to each point raised by the examiner's action, and may include a traverse or compliance.

A traverse of a requirement to restrict is a statement of the reasons upon which the applicant relies for his or her conclusion that the requirement is in error.

To be complete, a reply to a requirement which merely specifies the linking claims need only include a proper election.

Where a rejection or objection is included with a restriction requirement, applicant, besides making a proper election must also distinctly and specifically point out the supposed errors in the examiner's rejection or objection. See 37 CFR 1.111.

818.01 Election Fixed by Action on Claims

Election becomes fixed when the claims in an application have received an action on their merits by the Office.

818.02 Election Other Than Express

Election may be made in other ways than expressly in reply to a requirement as set forth in MPEP § 818.02(a) and § 818.02(c).

818.02(a) By Originally Presented Claims

Where claims to another invention are properly added and entered in the application before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03.

**818.02(b) Generic Claims Only —
No Election of Species**

Where only generic claims are first presented and prosecuted in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention, he or she must at that time indicate an election of a single species. The practice of requiring election of species in cases with only generic claims of the unduly extensive and burdensome search type is set forth in MPEP § 808.01(a).

**818.02(c) By Optional Cancellation
of Claims**

Where applicant is claiming two or more inventions (which may be species or various types of related inventions) and as a result of action on the claims, he or she cancels the claims to one or more of such inventions, leaving claims to one invention, and such claims are acted upon by the examiner, the claimed invention thus acted upon is elected.

818.03 Express Election and Traverse**37 CFR 1.143. Reconsideration of requirement.**

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the exam-

iner will at the same time act on the claims to the invention elected.

Election in reply to a requirement may be made either with or without an accompanying traverse of the requirement.

818.03(a) Reply Must Be Complete

As shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) which reads in part: "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. . . . The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. . . ."

Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR § 1.111. Thus the required provisional election (see MPEP § 818.03(b)) becomes an election without traverse.

**818.03(b) Must Elect, Even When
Requirement Is Traversed**

As noted in the second sentence of 37 CFR 1.143, a provisional election must be made even though the requirement is traversed.

All requirements for restriction should include form paragraph 8.22.

¶ 8.22 Requirement, Election, Mailed

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Examiner Note:

This paragraph can be used in Office actions with or without an action on the merits.

818.03(c) Must Traverse To Preserve Right of Petition

37 CFR 1.144. *Petition from requirement for restriction.*

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.02.

¶ 8.25.02 *Election Without Traverse Based on Incomplete Reply*

Applicant's election of [1] in Paper No. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

818.03(d) Traverse of Nonallowance of Linking Claims

A traverse of the nonallowance of the linking claims is not a traverse of the requirement to restrict; it is a traverse of a holding of nonallowance.

Election combined with a traverse of the nonallowance of the linking claims only is an agreement with the position taken by the Office that restriction is proper if the linking-type claim is not allowable and improper if they are allowable. If the Office allows such a claim, it is bound to withdraw the requirement and to act on all linked inventions. But once all linking claims are canceled 37 CFR 1.144 would not apply, since the record would be one of agreement as to the propriety of restriction.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking-type claim) that also prevents restriction, the merits of the requirement are contested and not admitted. Assume a particular situation of process of making and product made where the claim held linking is a claim to product limited by the process of making it. The traverse may set forth particular reasons justifying the conclusion that restriction is improper where the process necessarily makes the product and there is no other present known process

by which the product can be made. If restriction is made final in spite of such traverse, the right to petition is preserved even though all linking claims are canceled.

818.03(e) Applicant Must Make Own Election

Applicant must make his or her own election. The examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143, second sentence.

819 Office Generally Does Not Permit Shift

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

Where a continued prosecution application (CPA) filed under 37 CFR 1.53(d), is a continuation of its parent application and not a divisional, or where a File Wrapper Continuation (FWC) filed under former 37 CFR 1.62, is a continuation of its parent application and not a divisional or C-I-P, an express election made in the prior (parent) application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. In no other type of continuing application may an election carry over from the prior application.

Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of

the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

819.01 Office May Waive Election and Permit Shift

While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues. *Ex parte Heritage*, Pat. No. 2,375,414 decided January 26, 1944. If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned. *Meden v. Curtis*, 1905 C.D.272, 117 O.G. 1795 (Comm'r Pat. 1905).

820 Not an Election; Permissible Shift

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift: *Ex parte Trevette*, 1901 C.D. 170, 97 O.G. 1173 (Comm'r Pat. 1901).

Where a product is elected, there is no shift where examiner holds invention to be in the process. *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923).

Where a genus is allowed, applicant may prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141. This does not constitute a shift. *Ex parte Sharp*, Patent No. 2,232,739.

820.01 Old Combination Claimed — Not an Election

Where an application originally presents claims to a combination (AB) and the examiner holds the novelty, if any, to reside only in the subcombination (B) *per se* (see MPEP § 806.05(b)), and the claims directed to the combination are rejected, subsequently presented claims to subcombination (B) of the originally claimed combination should not be held constructively nonelected on the ground of previous election of the combination. See MPEP § 821.03. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pat. 1923). The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. See MPEP § 806.05(c).

820.02 Interference Issues — Not an Election

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the interference, elect any one of the inventions claimed.

821 Treatment of Claims Held To Be Drawn to Nonelected Inventions

Claims held to be drawn to nonelected inventions, including claims to nonelected species, are treated as indicated in MPEP § 821.01 through § 821.03.

The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144. *In re Hengehold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

All claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration by the examiner in accordance with 37 CFR 1.142(b). See MPEP § 809.02(c) and § 821.01 through § 821.03. The examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention. Applicant may traverse the requirement pursuant to 37 CFR 1.143. If a final requirement for restriction is made by the examiner, applicant may file a petition under 37 CFR 1.144 for review of the restriction requirement.

821.01 After Election With Traverse

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

¶ 8.25 Answer to Arguments With Traverse

Applicant's election with traverse of [1] in Paper No. [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [4].

The requirement is still deemed proper and is therefore made FINAL.

Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground(s) on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper, he or she should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated by using form paragraph 8.05.

¶ 8.05 Claims Stand Withdrawn With Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. [3].

Examiner Note:

In bracket 2, insert --invention-- or --species--.

This will show that applicant has retained the right to petition from the requirement under 37 CFR 1.144. (See MPEP § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case by using form paragraph 8.03. (See MPEP § 809.02(c).)

When preparing a final action in an application where there has been a traversal of a requirement for

restriction, the examiner should indicate in the Office action that a complete reply must include cancellation of the claims drawn to the nonelected invention, or other appropriate action (37 CFR 1.144). See form paragraph 8.24.

¶ 8.24 Reply to Final Must Include Cancellation

This application contains claim [1] drawn to an invention nonelected with traverse in Paper No. [2]. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Examiner Note:

For use in FINAL rejections of applications containing claims nonelected with traverse.

Where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the application to issue after the expiration of the period for reply.

Note that the petition under 37 CFR 1.144 must be filed not later than appeal. This is construed to mean appeal to the Board of Patent Appeals and Interferences. If the application is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the nonelected claims by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims. Form paragraphs 8.25.01 or 8.25.02 should be used by the examiner to acknowledge the election without traverse.

¶ 8.25.01 Election Without Traverse

Applicant's election without traverse of [1] in Paper No. [2] is acknowledged.

¶ 8.25.02 Election Without Traverse Based on Incomplete Reply

Applicant's election of [1] in Paper No. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims to the nonelected invention should be treated by using form paragraph 8.06.

¶ 8.06 Claims Stand Withdrawn Without Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected [2], there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. [3].

Examiner Note:

In bracket 2, insert --invention--, or --species--.

This will show that applicant has not retained the right to petition from the requirement under 37 CFR 1.144.

Under these circumstances, when the application is otherwise ready for issue, the claims to the nonelected invention, including nonelected species, may be canceled by an examiner's amendment, and the application passed to issue. However, where the application contains an allowed generic claim, and applicant has not been previously notified as to the allowance of a generic claim, the examiner must, prior to canceling the nonelected claims, notify applicant of the allowance of a generic claim and give applicant a time limit of 1-month (not less than 30 days) to conform all of the claims to the nonelected species to fully embrace an allowed generic claim. See MPEP § 809.02(c). The examiner's amendment should include form paragraph 8.07.

¶ 8.07 Ready for Allowance Without Traverse

This application is in condition for allowance except for the presence of claim [1] to [2] nonelected without traverse. Accordingly, claim [3] been canceled.

Examiner Note:

In bracket 2, insert --an invention--, --inventions--, --a species--, or --species--.

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed

if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

The action should include form paragraph 8.04.

¶ 8.04 Election by Original Presentation

Newly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2]

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Of course, a complete action on all claims to the elected invention should be given.

Note that the above practice is intended to have no effect on the practice stated in MPEP § 2303.

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

¶ 8.26 Canceled Elected Claims, Non-Responsive

The amendment filed on [1] canceling all claims drawn to the elected invention and presenting only claims drawn to a nonelected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because [2].

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

821.04 Rejoinder

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where applicant voluntarily presents claims to the product and process in separate applications (i.e., no restriction requirement was made by the Office), and one of the applications issues as a patent, the remaining application may be rejected under the doctrine of obviousness-type double patenting, where appropriate (see MPEP § 804 - § 804.03), and applicant may overcome the rejection by the filing of a terminal disclaimer under 37 CFR 1.321(c) where appropriate. Similarly, if copending applications separately present product and process claims, provisional obviousness-type double patenting rejections should be made where appropriate. However, once a determination as to the patentability of the product has been reached any process claim which contains limitations identical to the allowed/allowable product should not be rejected over prior art without consultation with a Technology Center Director.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR 1.129(b), applicant may either: (A) elect the

invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (B) elect the invention to be searched and examined and not pay the additional fee (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee...will not entitle a party to a refund of such fee..." In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

¶ 8.42 Rejoinder of Less Than All Process Claims

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26, 1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Process claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104. In accordance with the *Official Gazette* notice, *supra*, process claim [5], which [6] not depend from or otherwise include all the limitations of the allowable product, [7] NOT been rejoined.

Examiner Note:

1. If ALL previously withdrawn claims are being rejoined, then form paragraph 8.43 should be used instead of this form paragraph.
2. If other non-process claims are present and are NOT being rejoined, use form paragraph 8.44 instead of this form paragraph.
3. In bracket 1, insert the claim number(s) of the allowable product claims followed by either -- is-- or -- are--.
4. In bracket 2, insert the claim number(s) of ALL process claims previously withdrawn from consideration.
5. In bracket 3, insert either --is-- or --are--.
6. In bracket 4, insert the number(s) of the rejoined process claims.
7. In bracket 5, insert the number(s) of the process claims NOT being rejoined followed by either -- is-- or -- are--.
8. In bracket 6, insert --do-- or --does--.
9. In bracket 7, insert --has-- or --have--.
10. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

¶ 8.43 Rejoinder of All Previously Withdrawn Claims

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26, 1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Paper No. [5] is hereby withdrawn.

Examiner Note:

1. If LESS THAN ALL previously withdrawn process claims are being rejoined, then form paragraph 8.42 should be used instead of this form paragraph. If LESS THAN ALL previously withdrawn claims are being rejoined, then form paragraph 8.44 should be used instead of this form paragraph.
2. In bracket 1, insert the claim number(s) of the allowable product claim(s) followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of the process claim(s) previously withdrawn from consideration.
4. In bracket 3, insert either --is-- or --are--.
5. In bracket 4, insert the number(s) of the process claims being rejoined (should correspond to bracket 2 insert).
6. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

¶ 8.44 Rejoinder of Process Claims, Other Claims Present and Not Rejoined

Claim [1] directed to an allowable product. Pursuant to the procedures set forth in the *Official Gazette* notice dated March 26,

1996 (1184 O.G. 86), claim [2], directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, [3] now subject to being rejoined. Process claim [4] hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claim [5], not directed to the process of making or using the patentable product, will not be rejoined.

Examiner Note:

1. If LESS THAN ALL previously withdrawn process claims are being rejoined, then form paragraph 8.42 should be used instead of this form paragraph. If ALL previously withdrawn claims are being rejoined then form paragraph 8.43 should be used instead of this form paragraph.
2. In bracket 1, insert the claim number(s) of the allowable product claim(s) followed by either -- is-- or -- are--.
3. In bracket 2, insert the claim number(s) of the process claim(s) previously withdrawn from consideration.
4. In bracket 3, insert either --is-- or --are--.
5. In bracket 4, insert the number(s) of the process claims being rejoined (should correspond to bracket 2 insert).
6. In bracket 5, insert the number(s) of all previously withdrawn claims which are not being rejoined.
7. If rejoinder occurs after the first Office action on the merits and if any of the rejoined claims are unpatentable, e.g., if a rejection under 35 U.S.C. 112, first paragraph is made, then the next Office action may be made final since the new ground of rejection was necessitated by applicant's reply.

See MPEP § 706.02(n) for the applicability of 35 U.S.C. 103(b) to biotechnological processes and compositions of matter.

See MPEP § 2116.01 for guidance on the treatment of process claims which make or use a novel, nonobvious product.

See MPEP § 806.05(c) for rejoinder of restricted combination/subcombination inventions when an evidence claim is found to be unallowable, and see MPEP § 809 and § 809.04 for rejoinder of restricted inventions when a linking claim is found allowable.

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity

The treatment of plural applications of the same inventive entity, none of which has become a patent, is treated in 37 CFR 1.78(b) as follows:

- (b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

See MPEP § 804.03 for conflicting subject matter, different inventors, common ownership.

See MPEP § 706.03(k) for rejection of one claim on another in the same application.

See MPEP § 706.03(w) and § 706.07(b) for *res judicata*.

See MPEP § 709.01 for one application in interference.

See MPEP § 806.04(h) to § 806.04(i) for species and genus in separate applications.

Wherever appropriate, such conflicting applications should be joined. This is particularly true, where the two or more applications are due to, and consonant with, a requirement to restrict which the examiner now considers to be improper.

Form paragraph 8.29 should be used when the conflicting claims are identical or conceded by applicant to be not patentably distinct.

¶ 8.29 Conflicting Claims, Copending Applications

Claim [1] of this application conflict with claim [2] of Application No. [3]. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Examiner Note:

This paragraph is appropriate only when the conflicting claims are patentably distinct.

822.01 Copending Before the Examiner

37 CFR 1.78. *Claiming benefit of earlier filing date and cross-references to other applications.*

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

37 CFR 1.130. *Affidavit or declaration to disqualify commonly owned patent or published application as prior art.*

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an

invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

Where claims in one application are unpatentable over claims of another application of the same inventive entity (or different inventive entity with common ownership) because they recite the same invention, a complete examination should be made of the claims of each application and all appropriate rejections should be entered in each application, including rejections based upon prior art. The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. See also MPEP § 804.01 and § 822.

ONLY PROVISIONAL DOUBLE PATENTING REJECTION REMAINING IN ONE APPLICATION

The “provisional” double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that “provisional” double patenting rejection is the only rejection remaining in one of the applications. If the “provisional” double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the “provisional” double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. See also MPEP § 804.01 and § 822.

ONLY PROVISIONAL DOUBLE PATENTING REJECTIONS REMAINING IN BOTH APPLICATIONS

If the “provisional” double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the

other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

823 Unity of Invention Under the Patent Cooperation Treaty

See Chapter 1800 for a detailed discussion of unity of invention under the Patent Cooperation Treaty (PCT).



MANUAL OF PATENT EXAMINING PROCEDURE

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Note 37 CFR 1.104(a)(1) in MPEP § 707. See also MPEP § 2121- § 2129.

901.01 Canceled Matter in U.S. Patent Files

Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e). See *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966). However, matter

canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a). *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § 2127 and § 2136.02.

901.02 Abandoned Applications

If an abandoned application was previously published under 35 U.S.C. 122(b), that patent application publication is available as prior art under 35 U.S.C. 102(a) and 102(b) as of its patent application publication date because the patent application publication is considered to be a "printed" publication within the meaning of 35 U.S.C. 102(a) and 102(b), even though the patent application publication is disseminated by the U.S. Patent and Trademark Office (Office) using only electronic media. See MPEP § 2128. Additionally, as described in MPEP § 901.03, a patent application publication published under 35 U.S.C. 122(b) is available as prior art under 35 U.S.C. 102(e) as of the earliest effective U.S. filing date of the published application against U.S. applications filed on or after November 29, 2000 and applications filed prior to November 29, 2000 which are voluntarily published. As provided in 37 CFR 1.11(a), unless a redacted copy of the application was used for the patent application publication, the specification, drawings, and all papers relating to the file of an abandoned published application are open to inspection by the public, and copies may be obtained from the Office. The information that is available to the public under 37 CFR 1.11(a) may be used as prior art under 35 U.S.C. 102(a) or 102(b) as of the date the information became publicly available.

Where an abandoned application is referred to in an issued U.S. patent or in one of the types of published or publicly available patent applications described in 37 CFR 1.14(e), access to the abandoned application file may be provided to the public. See 37 CFR 1.14 (e)(2). Similarly, a copy of the application-as-filed and/or a copy of the file wrapper and its contents may be publicly available. See 37 CFR 1.14(c). Subject matter from abandoned applications which is available to the public under 37 CFR 1.14(c) or 37 CFR 1.14(e) may be used as prior art against a pending U.S. application under 35 U.S.C. 102(a) or 102(b) as

of the date the subject matter became publicly available.

In re Heritage, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a previously copending but subsequently abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).

It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 166 F.2d 827, 77 USPQ 156 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940). See MPEP § 2127(a).

Published abstracts, abbreviations, defensive publications (MPEP § 901.06(d)), and statutory invention registrations (MPEP Chapter 1100) are references.

901.03 Pending Applications

Except as provided in 37 CFR 1.11(b), 37 CFR 1.14(c) and 37 CFR 1.14(e), pending U.S. applications filed before November 29, 2000 which are not voluntarily published and applications filed on or after November 29, 2000 which have not been published are generally preserved in confidence (37 CFR 1.14(a)) and are not available as references. However, claims in one nonprovisional application may be rejected on the claimed subject matter of a copending nonprovisional application of the same inventive entity. See MPEP § 804. For applications having a common assignee and different inventive entities claiming a single inventive concept, see MPEP § 804.03. See also MPEP § 2127, paragraph IV.

The American Inventors Protection Act of 1999 (AIPA) was enacted into law on November 29, 1999. The AIPA amended 35 U.S.C. 122 to provide that, with certain exceptions, applications for patent filed on or after November 29, 2000 shall be published promptly after the expiration of a period of eighteen (18) months from the earliest filing date for which a benefit is sought under title 35, United States Code, and that an application may be published earlier at the request of the applicant. See 35 U.S.C. 122(b) and

37 CFR 1.215 and 1.219. In addition, applications filed prior to November 29, 2000, but pending on November 29, 2000, may be published if a request for voluntary publication is filed. See 37 CFR 1.221. Patent applications filed on or after November 29, 2000, and those including a request for voluntary publication shall be published except for the following enumerated exceptions.

First, an application shall not be published if it is:

- (A) no longer pending;
- (B) subject to a secrecy order under 35 U.S.C. 181 or an application for which publication or disclosure would be detrimental to national security;
- (C) a provisional application filed under 35 U.S.C. 111(b);
- (D) an application for a design patent filed under 35 U.S.C. 171; or
- (E) a reissue application filed under 35 U.S.C. 251.

Second, an application shall not be published if an applicant submits at the time of filing of the application a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen month publication. See 37 CFR 1.213(a). An applicant may rescind such a request at any time. See 37 CFR 1.213(b). If the applicant who has submitted a nonpublication request subsequently files an application directed to the invention disclosed in the U.S. application, in which the nonpublication request was submitted, in another country, or under a multilateral international agreement, that requires publication of the application eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. See 37 CFR 1.213(c). In addition, if an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy of the application filed in the Office eliminating any part or description of the invention in the U.S.

application that is not also contained in any of the corresponding applications filed in a foreign country. If the redacted copy of the U.S. application is timely received in the Office, the Office may publish only the redacted copy. See 35 U.S.C. 122(b)(2)(B)(v) and 37 CFR 1.217.

U.S. patent application publications are prior art under 35 U.S.C. 102(a) and 102(b) as of the publication date. Under amended 35 U.S.C. 102(e)(1), a U.S. patent application publication is considered to be prior art as of the earliest effective U.S. filing date of the published application. Additionally, a U.S. patent application publication of a National Stage application is considered to be prior art under 35 U.S.C. 102(e) as of the international filing date only if the International Application designated the United States and was published by the International Bureau (IB) in English.

Any new prior art created by the changes to 35 U.S.C. 102(e) may only be applied against applications that are filed on or after November 29, 2000, and against applications filed prior to November 29, 2000 that are pending on November 29, 2000 and are voluntarily published. The new prior art effects created by amended 35 U.S.C. 102(e) will not be applicable to any application filed before November 29, 2000 and not voluntarily published, nor a reexamination of a patent issued on such an application. Additionally, the new prior art effect created by amended 35 U.S.C. 102(e) will not be applicable to any National Stage application, complying with 35 U.S.C. 371(c), whose international filing date is before November 29, 2000 if it is not voluntarily published.

901.04 U.S. Patents

The following different series of U.S. patents are being or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)). See MPEP § 2127, paragraph II. The 35 U.S.C. 102(e) date for a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application.

X-Series. These are the approximately 10,000 patents issued between 1790 and July 4, 1836. They were not originally numbered, but have since been assigned numbers in the sequence in which they were issued. The number should *not* be cited. When copies are ordered, the patentee's name and date of issue suffice for identification.

1836 Series. The mechanical, electrical, and chemical patents issued since 1836 and frequently designated as "utility" patents are included in this series. A citation by number only is understood to refer to this series. This series comprises the bulk of all U.S. patents issued. Some U.S. patents issued in 1861 bear two numbers but only the larger number should be cited.

Reissue Series. Reissue patents (MPEP § 1401) have been given a separate series of numbers preceded by "Re." In citing, the letters and the number must be given, e.g., Re. 1776. The date that it is effective as a reference is the effective date of the original patent application, not the filing date of the reissue application.

Design reissue patents are numbered with the same number series as "utility" reissue patents. The letter prefix does, however, indicate them to be design reissues.

A.I. Series. From 1838 to 1861, patents covering an inventor's improvement on his or her own patented device were given a separate series of numbers preceded by "A.I." to indicate Additional Improvement. In citing, the letters and the number must be given, e.g., A.I. 113. About 300 such patents were issued.

Plant Patent Series. When the statutes were amended to provide for patenting certain types of plants (see MPEP Chapter 1600) these patents were given a separate series of numbers. In citing, the letters "P.P." and the number must be given, e.g., P.P. 13.

Design Patents. Patents for designs (see MPEP Chapter 1500) are issued under a separate series of numbers preceded by "D." In citing, the letter "D" and the number must be given, e.g., D. 140,000.

NUMBERS FOR IDENTIFICATION OF BIBLIOGRAPHIC DATA ON THE FIRST PAGE OF PATENT AND LIKE DOCUMENTS (INID NUMBERS)

The purpose of INID Codes ("INID" is an acronym for "Internationally agreed Numbers for the Identification of (bibliographic) Data") is to provide a means whereby the various data appearing on the first page of patent and like documents can be identified without knowledge of the language used and the laws applied. They are now used by most patent offices and have been applied to U.S. patents since Aug. 4, 1970. Some of the codes are not pertinent to the documents of a particular country and some which are may, in fact, not be used. For a list of INID Codes, see MPEP § 901.05(b).

901.04(a) Kind Codes

On January 2, 2001, the United States Patent and Trademark Office (USPTO) began printing the World Intellectual Property Organization (WIPO) Standard ST.16 code on each of its published patent documents. WIPO Standard ST.16 codes (kind codes) include a letter, and in many cases a number, used to distinguish the kind of patent document (e.g., publication of an application for a utility patent (patent application publication), utility patent, plant patent application publication, plant patent, or design patent) and the level of publication (e.g., first publication, second publication, or corrected publication). Detailed information on Standard ST.16 and the use of kind codes by patent offices throughout the world is available on the WIPO web site at <http://www.wipo.int/scit/en> under the links for WIPO standards and other documentation.

In addition, some kind codes assigned to existing USPTO patent documents were changed because, beginning on March 15, 2001, patent application publications began to be published weekly on Thursdays.

The tables below give a summary of the kind codes which are no longer being used on certain published patent documents as well as a summary of the kind codes which will be used on published patent documents after January 2, 2001. It is recommended that USPTO documents be identified by the following three elements: (A) the two-character country code (US for United States of America); (B) the patent or publication number; and (C) the WIPO ST.16 kind code. For example, "US 7,654,321 B1" for U.S.

Patent No. 7,654,321 where there was no previously-published patent application publication, and "US 2003/1234567 A1" for U.S. Patent Application Publication No. 2003/1234567, in 2003. Each year the numbering of published patent applications will begin

again with the new four digit year and the number 0000001, so the number of a patent application publication must include an associated year.

Summary of USPTO Kind Codes No Longer Used as of January 2, 2001*		
WIPO ST.16 Kind Codes	Kind of document	Comments
A	Patent	Kind code replaced by B1 or B2
P	Plant Patent	Kind code replaced by P2 or P3
B1, B2, B3...	Reexamination Certificate	Kind code replaced by C1, C2, C3...

*See the table below for the new uses for codes B1 and B2 beginning January 2, 2001.

Summary of USPTO Kind Codes Used on Documents Published Beginning January 2, 2001		
WIPO ST.16 Kind Codes	Kind of document	Comments
A1	Patent Application Publication	Pre-grant publication available March 2001
A2	Patent Application Publication (Republication)	Pre-grant publication available March 2001
A9	Patent Application Publication (Corrected Publication)	Pre-grant publication available March 2001
B1	Patent	No previously published pre-grant publication
B2	Patent	Having a previously published pre-grant publication and available March 2001
C1, C2, C3, ...	Reexamination Certificate	Previously used codes B1 and B2 are now used for granted Patents
E	Reissue Patent	No change
H	Statutory Invention Registration (SIR)	No change
P1	Plant Patent Publication Applica- tion	Pre-grant publication available March 2001

Summary of USPTO Kind Codes Used on Documents Published Beginning January 2, 2001		
WIPO ST.16 Kind Codes	Kind of document	Comments
P2	Plant Patent	No previously published pre-grant publication
P3	Plant Patent	Having a previously published pre-grant publication and available March 2001
P4	Plant Patent Application Publication (Republication)	Pre-grant publication available after March 2001
P9	Plant Patent Application Publication (Corrected Publication)	Pre-grant publication available March 2001
S	Design Patent	No change

901.05 Foreign Patent Documents

All foreign patents, published applications, and any other published derivative material containing portions or summaries of the contents of published or unpublished patents (e.g., abstracts) which have been disseminated to the public are available to U.S. examiners. See MPEP § 901.06(a), paragraphs I.C. and IV.C. In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner's review of a copy of the document. Examiners should remember that in some countries, there is a delay between the date of the patent grant and the date of publication.

Information pertaining to those countries from which the most patent publications are received are given in the following sections and in MPEP § 901.05(a). Additional information can be obtained from the Scientific and Technical Information Center.

See MPEP § 707.05(e) for data used in citing foreign references.

I. PLACEMENT OF FOREIGN PATENT EQUIVALENTS IN THE SEARCH FILES

There are approximately 25 countries in which the specifications of patents are published in printed form either before or after a patent is granted.

UNTIL OCTOBER 1, 1995, THE FOLLOWING PRACTICE WAS USED IN PLACING FOREIGN PATENT EQUIVALENTS IN THE SEARCH FILES:

When the same invention is disclosed by a common inventor(s) and patented in more than one country, these patents are called a family of patents. Whenever a family of patents or published patent disclosures existed, the Office selected from a prioritized list of countries a single family member for placement in the examiners' search file and selected the patent of the country with the earliest patent date. If the U.S. was one of the countries granting a patent in the "family" of patents, none of the foreign "equivalents" was placed in our search file. See paragraph III., below. However, foreign patents or published patent disclosures within a common family which issued prior to the final highest priority patent (e.g., U.S.) may have been placed in our paper search file and these copies were generally not removed when the higher priority patent was added to our search files at a later date.

Beginning in October 1995, paper copies of foreign patents were no longer classified into the U.S. Classification System by the U.S. Patent and Trademark Office. See MPEP § 901.05(c) for search of recently issued foreign patents.

II. OVERVIEW OF FOREIGN PATENT LAWS

This section includes some general information on foreign patent laws and summarizes particular features and their terminology. Some additional details on the most commonly cited foreign patent publications may be found under the individual country in

paragraph V., below. Examiners should recall, by way of contrast to the practice in many other countries, under U.S. patent law a number of different events all occur on the issue date of a U.S. patent. These events include the following:

- (A) a patent document, the "letters patent" which grants and thereby creates the legal rights conferred by a patent, is executed and sent to the applicant;
- (B) the patent rights come into existence;
- (C) the patent rights can be exercised;
- (D) the specification of the patent becomes available to the public;
- (E) the patented file becomes available to the public;
- (F) the specification is published in printed form; and
- (G) an issue of an official journal, the *Official Gazette*, containing an announcement of the patent and a claim, is published.

In most foreign countries, various ones of these events occur on different days and some of them may never occur at all.

The following list catalogs some of the most significant foreign variations from U.S. practices:

A. Applicant

In most countries, the owner of the prospective rights, derived from the inventor, may also apply for a patent in the owner's name as applicant; in a few, other persons may apply as well or be joined as coapplicants. Hence applicant is not synonymous with inventor, and the applicant may be a company. Some countries require the inventors' names to be given and regularly print them on the published copies. Other countries may sometimes print the inventors' names only when available or when requested to do so.

B. Application

The word "application" is commonly used in the U.S. to refer to the entire set of papers filed when seeking a patent. However, in many countries and in PCT cases, the word application refers only to the paper, usually a printed form, which is to be "accompanied by" or have "attached" to it certain other papers, namely a specification, drawings when necessary, claims, and perhaps other papers. Unless it is otherwise noted in the following portions of this sec-

tion, the term "application" refers to the entire set of papers filed.

C. Publication of Contents of Pending Applications

In general, pending applications are confidential until a certain stage in the proceedings (e.g., upon patent grant), or until a certain date (e.g., 18 months after filing), as may be specified in a particular law.

Many countries have adopted the practice of publishing the specification, drawing, or claims of pending applications. In these countries, the publication of the contents of the application occurs at a certain time, usually 18 months after filing. The applicant is given certain provisional rights upon publication even though examination has not been completed or in some cases has not even begun at the time of publication.

This publication may take either of two forms. In the first form, some countries publish a notice giving certain particulars in their official journal and thereafter any one may see the papers at the patent office or order copies. This procedure is referred to as "laying open for public inspection." There is no printed publication of the specification, although an abstract may be published in printed form. If anyone can inspect or obtain copies of the laid open application, then it is sufficiently accessible to the public to constitute a "publication" within the meaning of 35 U.S.C. 102(a) and (b). The full application is thus available as prior art as of either the date of publication of its notice or its laying open to public inspection if this is a later date. *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981). See MPEP § 2127, paragraph III.

In the second form, several other countries publish the specifications of pending applications in printed form at a specified time, usually 18 months after filing. These documents, of course, constitute references as printed publications.

D. Administrative Systems

Patent law administration varies from country to country. In some countries, all that is undertaken is an inspection of the papers to determine if they are in proper form. Other countries perform an examination of the merits on the basis of an extensive search of the prior art, as is done in the U.S. The former are referred to as nonexamining or registration countries, although

some systems allow for a rejection on matters apparent on the face of the papers, such as matters of form or statutory subject matter.

Of the examining countries, the extent of the material searched prior to issue varies greatly. Only a few countries include both their own patents and a substantial amount of foreign patent material and non-patent publications in their search files. Some countries specifically limit the search by rule, or lack of facilities, to their own patents with very little or no additional material. An increasing number of countries are requiring applicants to give information concerning references cited in corresponding applications filed in other countries.

E. Opposition

Some examining countries consider participation by the public an inherent feature of their examining system. When an application is found to be allowable by the examiner, it is "published" for opposition. Then there is a period, usually 3 or 4 months, within which members of the public can oppose the grant of the patent. In some countries, the opposing party can be any person or company. In other countries, only those parties who are affected by the outcome can participate in the opposition. The opposition is an *inter partes* proceeding and the opposing party can ordinarily raise any ground on the basis of which a patent would be refused or held invalid, including any applicable references.

The publication for opposition may take the form of a laying open of the application by the publication of a notice in the official journal with the application being then open to public inspection and the obtaining of copies. Otherwise publication occurs by the issue of the applications in printed form. Either way, these published documents constitute printed publications which are available as references under 35 U.S.C. 102(a) and 102(b).

F. The Patent

Practices and terminology vary worldwide regarding patents. In some countries, there is no "letters patent" document which creates and grants the rights. In other countries, the examiner grants the patent by signing the required paper. In a few countries, the patent is granted by operation of law after certain events have occurred. The term "granting the patent"

is used here for convenience, but it should be noted that 35 U.S.C. 102(a) and 102(b) do not use this terminology.

A list of granted patents is ordinarily published in each country's official journal and some of these countries also print an abstract or claims at or after the granting date. Not all countries publish the granted patent. Where the specifications of granted patents are issued in printed form, publication seldom occurs simultaneously with the day of grant; instead, publication occurs a short time thereafter. There also are a few countries in which publication does not take place until several years after the grant.

The length of time for which the patent is enforceable (the patent term) varies from country to country. The term of the patent may start as of the grant of the patent, or as of the filing date of the application.

Most countries require the payment of periodic fees to maintain a patent in force. These fees often start a few years after filing and increase progressively during the term of the patent. If these fees are not paid within the time allowed, the patent lapses and is no longer in force. This lapsing does not affect the use of the patent as a reference.

G. Patents of Addition

Some countries issue patents of addition, which should be identified as such, and when separately numbered as in France, the number of the addition patent should be cited. "Patents of addition" generally cover improvements of a patented parent invention and can be obtained by the owner of the parent invention. Inventiveness in relation to the parent invention need not be demonstrated and the term is governed by the term of the parent patent.

III. CORRESPONDING SPECIFICATIONS IN A FAMILY OF PATENTS

Since a separate patent must be obtained in each country in which patent rights are desired (except for EP, the European Patent Convention, AP, the African Regional Industrial Property Organization, OA, African Intellectual Property Organization, GC, Patent Office of the Cooperation Council for the Arab States of the Gulf, and EA, Eurasian Patent Office, whose members issue a common patent), there may be a large number of patents issued in different countries

for the same invention. This group of patents is referred to as a family of patents.

All of the countries listed in paragraph V. below are parties to the Paris Convention for the Protection of Industrial Property and provide for the right of priority. If an application is filed in one of these countries, an application for the same invention thereafter filed in another country, within 1 year of the filing of the first application, will be entitled to the benefit of the filing date of the first application on fulfilling various conditions. See MPEP § 201.13. The patents or published specifications of the countries of later filing are required to specify that priority has been claimed and to give the country, date, and number of the priority application. This data serves the purpose, among others, of enabling any patent based on the priority application to be easily located.

In general, the specification of the second application is identical in substance to the specification of the first. In many instances, the second, if in another language, is simply a translation of the first with perhaps some variation in purely formal parts. But in a minority of cases, the two may not be identical. For instance, sometimes two applications filed in one country are combined into one second application which is filed in another country. Alternatively, a second application could be filed for only part of the disclosure of the priority application. The second application may have the relationship to the first which we refer to as a continuation-in-part (e.g., the second application includes additional subject matter discovered after the first was filed). In some instances, the second application could have its disclosure diminished or increased, to meet the requirements or practices of the second country.

Duplicate or substantially duplicate versions of a foreign language specification, in English or some other language known to the examiner, can sometimes be found. It is possible to cite a foreign language specification as a reference, while at the same time citing an English language version of the specification with a later date as a convenient translation if the latter is in fact a translation. Questions as to content in such cases must be settled based on the specification which was used as the reference.

If a U.S. patent being considered as a reference claims the priority of a previously filed foreign application, it may be desirable to determine if the foreign

application has issued or has been published, to see if there is an earlier date. For example, it has occurred that an examiner rejected claims on the basis of a U.S. patent and the applicant filed affidavits to overcome the filing date of the reference; the affidavits were controversial and the case went to appeal, with an extensive brief and an examiner's answer having been filed. After all this work, somebody noticed that the U.S. patent reference claimed the priority of a foreign application filed in a country in which patents were issued fairly soon, checked the foreign application, and discovered that the foreign patent had not only been issued, but also published in printed form, more than 1 year prior to the filing date of the application on appeal.

If a foreign patent or specification claims the priority of a U.S. application, it can be determined whether the latter is abandoned, still pending, or patented. Even if the U.S. case is or becomes patented, however, the foreign documents may still be useful as supplying an earlier printed publication date.

If a foreign patent or specification claims the priority of an application in another foreign country, it may sometimes be desirable to check the latter to determine if the subject matter was patented or published at an earlier date. As an example, if a British specification being considered as a reference claims the priority of an application filed in Belgium, it is known at once that a considerably earlier effective date can be established, if needed, because Belgian patents issue soon after filing. In addition, if the application referred to was filed in one of the countries which publish applications in printed form 18 months after filing, the subject matter of the application will be available as a printed publication as of the 18 month publishing date. These remarks obviously also apply to a U.S. patent claiming a foreign priority.

The determination of whether a foreign patent has been issued or the application published is a comparatively simple matter for some countries, but for some it is quite laborious and time-consuming and may not even be possible from the sources maintained by the Scientific and Technical Information Center. Other sources for this data which are not maintained by the Office do exist and can be utilized for locating corresponding patents. One source is *Chemical Abstracts* which publishes abstracts of patents from a large number of countries. Only one patent or published

specification from a family is abstracted in full and any related family members issued or published are cross-referenced. Chemical Abstract's annual indexes include lists of patent numbers, and also include patentees' and inventors' names in the alphabetical author index. A concordance of corresponding patents appearing during five year periods has also been published. Other sources for this family data are the INPADOC and DERWENT data files.

When an application is filed outside the Paris Convention year from an earlier application, the later application may not refer to the first application. It is hence possible that there will be duplicate specifications published without any indication revealing the fact. These may be detected when the two copies come together in the same subclass. Because the later application is filed outside the convention year, the earlier application may be prior art to the latter if it has been published or issued.

IV. VALIDITY OF DATES DISPLAYED ON FACE OF FOREIGN PATENT DOCUMENTS

The examiner is not required to prove either the date or the occurrence of events specified on specifications of patents or applications, or in official journals, of foreign patent offices which the Office has in its possession. In a court action, certified copies of the Office copies of these documents constitute *prima facie* evidence in view of 28 U.S.C. 1745. An applicant is entitled to show the contrary by competent evidence, but this question seldom arises.

The date of receipt of copies by the Office, as shown by Office records or stamped on the copies, need only to be stated by the examiner, when necessary.

V. NOTES ON INDIVIDUAL COUNTRIES

The following table gives some data concerning the published patent material of a number of countries to assist in their use and citation as references. The countries listed were selected based on the current level of material provided for the examiner search files. Together, the countries and organizations account for over 98% of the patent material that was added to the examiner files each year. This table reflects only the

most current patent office practice for each foreign country specified and is not applicable for many older foreign patent documents. The Scientific and Technical Information Center staff can help examiners obtain data related to any documents not covered by this table. The citation dates listed in the following table are not necessarily the oldest possible dates. Sometimes an earlier effective date, which is not readily apparent from the face of the document, is available. If an earlier date is important to a rejection, the examiner should consult STIC staff, who will attempt to obtain further information regarding the earliest possible effective date.

How To Use Table

Each horizontal row of boxes contains information on one or more distinct patent document from a specified country available as a reference under 35 U.S.C. 102(a) and 102(b). If several distinct patent documents are included within a common box of a row, these documents are related to each other and are merely separate documents published at different stages of the same invention's patenting process. Usually, this related group of documents includes a published application which ripens into an issued patent. Within each box of the second column of each row, the top listed document of a related group is the one that is "published" first (e.g., made available for public inspection by laying open application, or application printed and disseminated to the public). Once an examiner determines the country or organization publishing the documents, the name of the document can be located in the second column of the table and the examiner can determine if a document from the related group containing the same or similar disclosure having an earlier date is available as a reference. Usually, the documents within a related group have identical disclosures; sometimes, however, there are differences in the claims or minor differences in the specification. Therefore, examiners should always verify that the earlier related document also includes the subject matter necessary for the rejection. Some countries issue more than one type of patent and for clarity, in these situations, separate rows are provided for each type.

ISSUING/ PUBLISHING COUNTRY OR ORGANIZATION	DOCUMENT NAME IN LANGUAGE OF ISSUING COUNTRY (TYPE OF DOCUMENT)	FOREIGN LANGUAGE NAME DESIGNATING THE DATE USED FOR CITATION PURPOSES (TYPE OF DATE)	GENERAL COMMENTS
<u>EP</u> European Patent Office	European patent application European patent specifica- tion New European patent speci- fication (above specification amended)	Date application made available to public Date published Date published	Printing of application occurs 18 months after priority date. EP dates are in day/ month/year order.
<u>FR</u> France	Demande de brevet d'inven- tion (patent application) Brevet d'invention (patent)	Disposition du public de la demande (date of lay- ing open application)/ date published Disposition du public du brevet d'invention (date of publication of the notice of patent grant)	Date of laying open the application is the earliest possible date. This usu- ally occurs 18 months after the filing or priority date but can occur earlier at applicant's request. The application is printed a short time after being laid open. FR dates are in day/ month/year order
<u>FR</u> France	Demande de certificat d'uti- lite (utility certificate appli- cation 1st level publication) Certificat d'utilite (utility certificate, 2nd publication)	Disposition du public de la demande (date pub- lished) Disposition du public du certificat d'utilite (date published)	
<u>DE</u> Germany	Offenlegungsschrift (unexam- ined patent application)	Offenlegungstag (date application printed)	Patentschrift are printed (up to four different times) after examination and at various stages of opposition.

ISSUING/ PUBLISHING COUNTRY OR ORGANIZATION	DOCUMENT NAME IN LANGUAGE OF ISSUING COUNTRY (TYPE OF DOCUMENT)	FOREIGN LANGUAGE NAME DESIGNATING THE DATE USED FOR CITATION PURPOSES (TYPE OF DATE)	GENERAL COMMENTS
	Patentschrift (examined patent)	Veröffentlichungstag der patenterteilung (date printed)	DE dates are in day/month/year order
<u>DE</u> Germany	Patentschrift (Ausschlusspatent) (exclusive type patent based on former East German application and published in accordance with E. German laws)	First printing coded "DD" (date of first publication before examination as to novelty)	Several more printings (up to four) occur as examination proceeds and patent is granted. Separate DD numbering series is used.
<u>DE</u> Germany	Patentschrift (Wirtschaftspatent) (economic type patent published in accordance with East German laws)	First printing coded "DD" (date of first printing before examination as to novelty)	Another printing occurs after examination. Separate DD numbering series is used.
<u>DE</u> Germany	Gebrauchsmuster (utility model or petty patent)	Eintragungstag (date laid open after registration as a patent) Bekanntmachung im patentblatt (date published for public)	Copy is supplied only on request. Published from No. DE-GM 1 186 500J.
<u>JP</u> Japan	Kôkai Tokkyo kôhō (unexamined patent application) Kôhyo Tokkyo kôhō (unexamined patent application based on international application)	Upper right corner beneath number (date laid open and printed)	INID codes (41)-(47) include first date listed in terms of the year of the Emperor. To convert yrs. prior 1989, add 1925. To convert yrs. after 1988, add 1988.

ISSUING/ PUBLISHING COUNTRY OR ORGANIZATION	DOCUMENT NAME IN LANGUAGE OF ISSUING COUNTRY (TYPE OF DOCUMENT)	FOREIGN LANGUAGE NAME DESIGNATING THE DATE USED FOR CITATION PURPOSES (TYPE OF DATE)	GENERAL COMMENTS
	Tokkyo kôhō (examined patent application)	Upper right corner beneath number (date laid open and printed; 1st publication when Kôkai Tokkyo kôhō or Kôhyo Tokkyo kôhō not published)	Newer documents also include second date following the first given in OUR Gregorian Calendar in year/month/day sequence in Arabic numerals intermixed with their equivalent JP characters.
<u>JP</u> Japan	Tokkyo shinpan seikyû kôkoku (corrected patent specification)	Upper right corner beneath number (date laid open and printed)	
<u>JP</u> Japan	Kôkai jitsuyô shin-an kôhō (unexamined utility model application) or Kôhyo jitsuyô shin-an kôhō (unexamined utility model application based on international) Jitsuyô shin-an kôhō (examined utility model application)	Upper right corner beneath number (date laid open and printed) Upper right corner beneath number (date laid open and printed; 1st publication when Kôkai or Kôhyo not published)	
<u>JP</u> Japan	Tôroku jitsuyô shin-an shinpan seikyû kôkoku (corrected registered utility model)		
<u>JP</u> Japan	Isyô kôhō (registered design application)		
<u>RU</u> Russian Federation	Zayavka Na Izobretenie (unexamined application for invention) Patent Na Izobreteniy (Patent)	Date application printed (1st publication) Date printed (normally 2nd publication, but 1st publication when application not published)	

ISSUING/ PUBLISHING COUNTRY OR ORGANIZATION	DOCUMENT NAME IN LANGUAGE OF ISSUING COUNTRY (TYPE OF DOCUMENT)	FOREIGN LANGUAGE NAME DESIGNATING THE DATE USED FOR CITATION PURPOSES (TYPE OF DATE)	GENERAL COMMENTS
<u>RU</u> Russian Federation	Svidetelstvo Na Poleznuyu Model (utility model)		Supplied upon request only
<u>RU</u> Russian Federation	Patent Na Promishlenniy Obrazec (design patent)		Supplied upon request only
<u>GB</u> United Kingdom	Published patent application (searched, but unexamined) Patent Specification (granted examined patent)	(date of printing the application) (date of printing)	
<u>GB</u> United Kingdom	Amended or Corrected Patent Specification (amended granted patent)	(date of printing)	
<u>WO</u> World Intellectual Property Organiza- tion	International application (PCT patent application)	(date of printing the application)	

901.05(a) Citation Data

Foreign patent publications that use Arabic and Roman numerals in lieu of names to indicate the date show in order the day, month, and year, or alternatively, the year, month, and day. Roman numerals always refer to the month.

Japanese patent application publications show the date in Arabic numerals by indicating in order the year of the reign of the Emperor, the month, and the day. To convert the Japanese year of the Emperor to the Western calendar year, for years prior to 1989, add 1925 to the JAPANESE YEAR. For example: 40.3.6 = March 6, 1965. For years after 1988, add 1988 to the JAPANESE YEAR.

Alphabetical lists of the foreign language names of the months and of the names and abbreviations for the United States of America follow. The lists set forth only selected commonly encountered foreign language names and do not include those which are similar to the English language names and thus easily translatable.

In using the lists, identification of the foreign language (except for Russian), is not necessary. The translation into English is ascertained by alphabetically locating the foreign language name on the list.

The list of the foreign language names and abbreviations for the United States is useful in determining whether a foreign language patent publication indicates the filing of a similar application in the United States.

ALPHABETICAL LIST OF SELECTED FOREIGN LANGUAGE NAMES OF MONTHS

agosto	August
août	August
augusti	August
avril	April
brezen	March
Cerven	June
Cervenec	July
czerwiec	June
décembre	December
dicembre	December
duben	April
elokuu	August
febbraio	February
Feber [Februar]	February
februari	February
février	February
gennaio	January
giugno	June
grudzieN	December
heinäkuu	July
helmikuu	February
huhtikuu	April
Jänner [Januar]	January
janvier	January
joulukuu	December
juillet	July
juin	June

kesäkuu	June
kvĚten	May
kwiecieN	April
leden	January
lipiec	July
listopad	November
lokakuu	October
luglio	July
luty	February
maaliskuu	March
maart	March
maggio	May
Mai	May
maj	May
maraskuu	November
marzec	March
mars	March
marts	March
März	March
marzo	March
mei	May
ottobre	October
paZdziernik	October
prosinec	December
ríjna	October
settembre	September
sierpieN	August
srpen	August
styczeN	January
syyskuu	September

tammikuu	January
toukokuu	May
ùnora	February
wrzesieN	September
září	September

RUSSIAN

август	August
апрель	April
декабрь	December
июль	July
июнь	June
май	May
март	March
ноябрь	November
октябрь	October
сентябрь	September
февраль	February
январь	January

LIST OF SELECTED FOREIGN LANGUAGE NAMES AND ABBREVIATIONS FOR THE UNITED STATES OF AMERICA

Amerikas Förenta Stater;
 [Förenta Staterna av Amerika]
 De forenete stater av Amerika
 De vorende Stater av Amerika
 EE.UU.
 E.U.
 E.U.A.
 E.U.d Am.
 Etats-Unis d'Amérique
 Sp. St. A.
 Spoj. St. Am.
 Spojene Staty Americké
 Stany Zjednoczone Amériki
 Stati Uniti d'America
 S.U.A.
 S.Z.A.
 V.St.A.
 V.St.v.A.

Ver. St. v. Am(erika)
 de Vereinigde Staten van Amerika
 Vereinigde Staaten van Noord-Amerika
 Vereinigten Staaten von Amerika
 Vorende Stater i Amerika

901.05(b) Other Significant Data

NUMBERS FOR IDENTIFICATION OF BIBLIOGRAPHIC DATA ON THE FIRST PAGE OF PATENT AND LIKE DOCUMENTS INCLUDING INDUSTRIAL DESIGNS (INID NUMBERS)

The purpose of INID Codes ("INID" is an acronym for "Internationally agreed Numbers for the Identification of (bibliographic) Data") is to provide a means whereby the various data appearing on the first page of patent and like documents or in patent gazettes can be identified without knowledge of the language used and the laws applied. They are now used by most patent offices and have been applied to U.S. patents since Aug. 4, 1970. Some of the codes are not pertinent to the documents of a particular country and some which are pertinent may, in fact, not be used. INID codes for industrial designs are similar to, but not identical to, those used for patents and like documents. INID codes for industrial designs are provided separately below.

INID Codes and Minimum Required for the Identification of Bibliographic Data for Patent and Like Documents (based on WIPO Standard ST.9)

(10) Identification of the patent, SPC or patent document

°(11) Number of the patent, SPC or patent document

°(12) Plain language designation of the kind of document

°(13) Kind of document code according to WIPO Standard ST.16

°(15) Patent correction information

°(19) WIPO Standard ST.3 code, or other identification, of the office or organization publishing the document

Notes:

(i) For an SPC, data regarding the basic patent should be coded by using code (68).

(ii) °° Minimum data element for patent documents only.

(iii) With the proviso that when data coded (11) and (13), or (19), (11) and (13), are used together and on a single line, category (10) can be used, if so desired.

(20) Data concerning the application for a patent or SPC

°(21) Number(s) assigned to the application(s), e.g., "Numéro d'enregistrement national," "Aktenzeichen"

°(22) Date(s) of filing the application(s)

°(23) Other date(s), including date of filing complete specification following provisional specification and date of exhibition

(24) Date from which industrial property rights may have effect

(25) Language in which the published application was originally filed

(26) Language in which the application is published

Notes:

(i) Attention is drawn to the Appendix 3 of WIPO Standard ST. 9 which contains information on the term of protection and on the date from which industrial property rights referred to under code (24) may have effect.

(ii) The language under code (25) and (26) should be indicated by using the two-letter language symbol according to International Standard ISO 639:1988.

(30) Data relating to priority under the Paris Convention

°(31) Number(s) assigned to priority application(s)

°(32) Date(s) of filing of priority application(s)

°(33) WIPO Standard ST.3 code identifying the national industrial property office allotting the priority application number or the organization allotting the regional priority application number; for international applications filed under the PCT, the code "WO" is to be used

(34) For priority filings under regional or international arrangements, the WIPO Standard ST.3 code identifying at least one country party to the Paris Convention for which the regional or international application was made

Notes:

(i) With the proviso that when data coded (31), (32), and (33) are presented together, category (30) can be used, if so desired. If an ST.3 code identifying a country for which a regional or international application was made is published, it should be identified as such using INID Code (34) and should be presented separately from elements coded (31), (32) and (33) or (30).

(ii) The presentation of priority application numbers should be as recommended in WIPO Standards ST.10/C and in ST.34.

(40) Date(s) of making available to the public

°(41) Date of making available to the public by viewing, or copying on request, an unexamined patent document, on which no grant has taken place on or before the said date

°(42) Date of making available to the public by viewing, or copying on request, an examined patent document, on which no grant has taken place on or before the said date

°(43) Date of making available to the public by printing or similar process of an unexamined patent document, on which no grant has taken place on or before the said date

°(44) Date of making available to the public by printing or similar process of an examined patent document, on which no grant or only a provisional grant has taken place on or before the said date

°(45) Date of making available to the public by printing or similar process of a patent document on which grant has taken place on or before the said date

(46) Date of making available to the public the claim(s) only of a patent document

°(47) Date of making available to the public by viewing, or copying on request, a patent document on which grant has taken place on or before the said date

°(48) Date of issuance of a corrected patent document

Note:

°Minimum data element for patent documents only, the minimum data requirement being met by indicating the date of making available to the public the patent document concerned.

(50) Technical information

°(51) International Patent Classification or, in the case of a design patent, as referred to in subparagraph 4(c) of WIPO Standard ST.9, International Classification for Industrial Designs

(52) Domestic or national classification

°(54) Title of the invention

(56) List of prior art documents, if separate from descriptive text

(57) Abstract or claim

(58) Field of search

Notes:

(i) The presentation of the classification symbols of the International Classification for Industrial Designs should be made in accordance with paragraph 4 of WIPO Standard ST.10/C.

(ii) With regard to code (56) attention is drawn to WIPO Standard ST.14 in connection with the citation of references on the front page of patent documents and in search reports attached to patent documents.

(60) References to other legally or procedurally related domestic or previously domestic patent documents including unpublished applications therefor

°(61) Number and, if possible, filing date of the earlier application, or number of the earlier publication, or number of earlier granted patent, inventor's certificate, utility model or the like to which the present document is an addition

°(62) Number and, if possible, filing date of the earlier application from which the present patent document has been divided up

°(63) Number and filing date of the earlier application of which the present patent document is a continuation

°(64) Number of the earlier publication which is "reissued"

(65) Number of a previously published patent document concerning the same application

(66) Number and filing date of the earlier application of which the present patent document is a substitute, i.e., a later application filed after the abandonment of an earlier application for the same invention

(67) Number and filing date of a patent application, or number of a granted patent, on which the present utility model application or registration (or a similar industrial property right, such as a utility certificate or utility innovation) is based

(68) For an SPC, number of the basic patent and/or, where appropriate, the publication number of the patent document

Notes:

(i) Priority data should be coded in category (30).

(ii) Code (65) is intended primarily for use by countries in which the national laws require that republication occur at various procedural stages under different publication numbers and these numbers differ from the basic application numbers.

(iii) Category code (60) should be used by countries which were previously part of another entity for identifying bibliographic data elements relating to applications or grants of patents which data had initially been announced by the industrial property office of that entity.

(70) Identification of parties concerned with the patent or SPC

°°(71) Name(s) of applicant(s)

(72) Name(s) of inventor(s) if known to be such

°°(73) Name(s) of grantee(s), holder(s), assignee(s) or owner(s)

(74) Name(s) of attorney(s) or agent(s)

°°(75) Name(s) of inventor(s) who is (are) also applicant(s)

°°(76) Names(s) of inventor(s) who is (are) also applicant(s) and grantee(s)

Notes:

(i) °°For patent documents for which grant has taken place on or before the date of making available to the public, and gazette entries relating thereto, the minimum data requirement is met by indicating the grantee, and for other documents by indication of the applicant.

(ii) (75) and (76) are intended primarily for use by countries in which the national laws require that the inventor and applicant be normally the same. In other cases (71) or (72) or (71), (72) and (73) should generally be used.

(80) Identification of data related to International Conventions other than the Paris Convention and to legislation

(90) with respect to SPC's

(81) Designated State(s) according to the PCT

(83) Information concerning the deposit of microorganisms, e.g., under the Budapest Treaty

(84) Designated Contracting States under regional patent conventions

(85) Date of commencement of the national phase pursuant to PCT Article 23(1) or 40(1)

(86) Filing date of the PCT international application, i.e., international filing date, international application number, and, optionally, the language in which the published international application was originally filed

(87) Publication data of the PCT international application, i.e., international publication date, international publication number, and, optionally, the language in which the application is published

(88) Date of deferred publication of the search report

(91) Date on which an international application filed under the PCT no longer has an effect in one or several designated or elected States due to failure to enter the national or regional phase or the date on which it has been determined that it had failed to enter the national or regional phase

(92) For an SPC, number and date of the first national authorization to place the product on the market as a medicinal product

(93) For an SPC, number, date and, where applicable, country of origin, of the first authorization to place the product on the market as a medicinal product within a regional economic community

(94) Calculated date of expiry of the SPC or the duration of the SPC

(95) Name of the product protected by the basic patent and in respect of which the SPC has been applied for or granted

(96) Filing date of the regional application, i.e., application filing date, application number, and, optionally, the language in which the published application was originally filed

(97) Publication data of the regional application (or of the regional patent, if already granted), i.e., publication date, publication number, and, optionally, the language in which the application (or, where applicable, the patent) is published

Notes:

(i) The codes (86), (87), (96), and (97) are intended to be used:

- on national documents when identifying one or more of the relevant filing data or publication data of a PCT international application, or of the regional application (or of the regional patent, if already granted), or

- on regional documents when identifying one or more of the relevant filing data or publication data of the PCT international application or of another regional application (or the regional patent, if already granted).

(ii) All data in code (86), (87), (96), or (97) should be presented together and preferably on a single line. The application number or publication number should comprise the three basic elements as shown in the example in paragraph 17 of WIPO Standard ST.10/B, i.e., the two letter code identifying the republishing office, the document number, and the kind of document code.

(iii) When data to be referenced by INID Codes (86) or (87) refer to two or more regional and/or PCT applications, each set of relevant filing or publication data of each such application should be displayed so as to be clearly distinguishable from other sets of relevant data, e.g., by presenting each set on a single line or by presenting the data of each set grouped together on adjacent lines in a column with a blank line between each set. When data to be referenced by codes (86), (87), (96), or (97) refer to two or more PCT international applications and/or regional applications (or regional patents, if already granted), each set of relevant filing or publication data of each such application (or granted patent) should be displayed so as to be clearly distinguishable from other sets of relevant data, e.g., by presenting each set on a single line or by presenting the data of each set grouped together on adjacent lines in a column with a blank line between each set.

(iv) The languages under codes (86), (87), (96), and (97) should be indicated by using the two-letter language symbols according to International Standard ISO 639:1988.

(v) The country of origin in code (93), if mentioned, should be indicated by using the two letter code according to WIPO Standard ST.3.

(vi) Attention is drawn to the Appendix which contains information on the term of protection and on the date from which SPCs referred to under code (94) may have effect.

NUMBERS FOR IDENTIFICATION OF BIBLIOGRAPHIC DATA ON THE FIRST PAGE OF INDUSTRIAL DESIGNS (INID NUMBERS)

INID codes for industrial designs are similar to, but not identical to, those used for patents and like documents. INID codes for industrial designs may be of most interest to design patent examiners.

INID Codes and Minimum Required for the Identification of Bibliographic Data for Industrial Designs (based on WIPO Standard ST.80)

- (10) Data concerning the registration/renewal
 - °(11) Serial number of the registration and/or number of the design document
 - °(12) Plain language designation of the kind of published document
 - °(14) Serial number of the renewal where different from initial registration number
 - °(15) Date of the registration/Date of the renewal
 - (17) Expected duration of the registration/renewal
 - (18) Expected expiration date of the registration/renewal
 - °(19) Identification, using the two-letter code according to WIPO Standard ST.3, of the authority publishing or registering the industrial design.

Note:

- °°Minimum data element for design documents only
- (20) Data concerning the application
- °(21) Serial number of the application
- °(22) Date of filing of the application
- °(23) Name and place of exhibition, and date on which the industrial design was first exhibited there (exhibition priority data)
- (24) Date from which the industrial design right has effect
- (27) Kind of application or deposit (open/sealed)
- (28) Number of industrial designs included in the application
- (29) Indication of the form in which the industrial design is filed, e.g., as a reproduction of the industrial design or as a specimen thereof
- (30) Data relating to priority under the Paris Convention
- °(31) Serial number assigned to the priority application
- °(32) Date of filing of the priority application
- (33) Two-letter code, according to WIPO Standard ST.3, identifying the authority with which the priority application was made

Notes:

- (i) With the proviso that when data coded (31), (32) and (33) are presented together, category code (30) can be used, if so desired.
- (ii) For international deposits made under the Hague Agreement, the two-letter code "WO" is to be used.
- (40) Date(s) of making information available to the public
- (43) Date of publication of the industrial design before examination by printing or similar process, or making it available to the public by any other means
- (44) Date of publication of the industrial design after examination, but before registration, by printing or similar process, or making it available to the public by any other means
- (45) Date of publication of the registered industrial design by printing or similar process, or making it available to the public by any other means
- (46) Date of expiration of deferment
- (50) Miscellaneous Information
- °(51) International Classification for Industrial Designs (class and subclass of the Locarno Classification)
- (52) National classification
- (53) Identification of the industrial design(s) comprised in a multiple application or registration which is (are) affected by a particular transaction when not all are so affected
- °(54) Designation of article () or product () covered by the industrial design or title of the industrial design
- °°(55) Reproduction of the industrial design (e.g., drawing, photograph) and explanations relating to the reproduction
- (56) List of prior art document, if separate from descriptive text

(57) Description of characteristic features of the industrial design including indication of colors

(58) Date of recording of any kind of amendment in the Register (e.g., change in ownership, change in name or address, renunciation to an international deposit, termination of protection)

Notes:

(i) Code (52) should be preceded by the two-letter code, according to WIPO Standard ST.3, identifying the country whose national classification is used (the two-letter code should be indicated within parentheses).

(ii) °°Minimum data element for design documents only.

(60) References to other legally related application(s) and registration(s)

(62) Serial number(s) and, if available, filing date(s) of application(s), registration(s) or document(s) related by division

(66) Serial number(s) of the application, or the registration, of the design(s) which is (are) a variant(s) of the present one

Note:

Category code (60) should be used by countries which were previously part of another entity for identifying bibliographic data elements relating to applications or registrations of industrial designs, which data had initially been announced by the industrial property office of that entity.

(70) Identification of parties concerned with the application or registration

°°(71) Name(s) and address(es) of the applicant(s)

(72) Name(s) of the creator(s) if known to be such

°°(73) Name(s) and address(es) of the owner(s)

(74) Name(s) and address(es) of the representative(s)

(78) Name(s) and address(es) of the new owner(s) in case of change in ownership

Note:

°°If registration has taken place on or before the date of making the industrial design available to the public, the minimum data requirement is met by indicating the owner(s); in other cases, by indicating the applicant(s).

(80) Identification of certain data related to the international deposit of industrial designs under the Hague Agreement Concerning the International Deposit of Industrial Designs and data related to other international conventions.

Designated State(s)/State(s) concerned:

(81) Designated State(s) according to the 1960 Act

(82) State(s) concerned according to the 1934 Act

(84) Designated Contracting State(s) under regional convention.

Information regarding the owner(s):

(86) Nationality of the owner(s)

(87) Residence or headquarters of the owner(s)

(88) State in which the owner(s) has (have) a real and effective industrial or commercial establishment

Note:

The data to be referenced by INID codes (81) to (88) should be indicated by using the two-letter code according to WIPO Standard ST.3.

901.05(c) Obtaining Copies

Until October 1, 1995, the U.S. Patent and Trademark Office (Office) received copies of the published specifications of patents and patent applications from nearly all the countries which issue them in printed form. The Office now receives all foreign patents from these countries in the form of CD-ROM disks and other electronic media. The foreign patents so obtained are available to examiners from the USPTO's automated search tools such as the Examiner's Automated Search Tool (EAST), the Web-based Examiner Search Tool (WEST) and the Foreign Patent Access System (FPAS), and from the foreign patents branch of the Scientific and Technical Information Center (STIC). The U.S. has agreements with these countries to exchange patent documentation.

Until October 1995, it was the practice in the Office to classify and place only a single patent family member for each invention in the examiner search files. In addition, all non-English language patent documents placed in the examiner files were accompanied, to the extent possible, by an English language abstract. For countries where the specification is printed twice, once during the application stage and again after the patent has been granted, only the first printing was in general placed in the search files, since the second printing ordinarily does not vary from the first as to disclosure.

Copies of various specifications not included in the search files, whether non-English-language patent documents or documents not printed or available for exchange, may come to the examiner's attention. For example, they may be cited in a motion to dissolve an interference, be cited by applicants, or turn up in an online search. Upon request, STIC will obtain a copy from its extensive collection, or if necessary, from the patent office of the particular country. In the case of unprinted patent documents, STIC will request that the date of granting and the date the specification was made available to the public be indicated on the copies provided by the country of origin.

Examiners can order copies of any foreign patent documents from the Foreign Patent Branch. If examiners so choose, they can make copies themselves. The most current patent documents are accessible

through the USPTO's automated search systems, which allows public and USPTO users to look up, view, and print foreign documents. Older documents can be found on microfilm in the Microfilm Room or in the paper collection in the stacks. Examiners may place a photocopy or translation in the shoes of the class which he or she examines if the patents are particularly relevant. See MPEP § 903.03.

901.05(d) Translation

Examiners may consult the translators in the Translation Branch of the Scientific and Technical Information Center (STIC) for oral assistance in translating foreign patents or literature that are possible references for an application being examined. Examiners may also request written translations of pertinent portions of references being considered for citation or already cited in applications. See MPEP § 901.06(a), STIC Services - Translations, and MPEP § 903.03, Availability of Foreign Patents.

Examiners may request written translations at any point in the examination process, at the discretion of the individual examiner, but are encouraged to use oral assistance and/or language reference resources as much as possible in the early phases of examination.

Equivalent versions of foreign specifications, that is, members of the same patent family, are often available in English or other languages known to the examiner. In addition, copies of previously translated documents are stored in the Translation Branch. Before any translation request is processed, the staff of the Translation Branch checks for equivalents or previous translations. The staff of STIC's Foreign Patents Branch or the Translation Branch can assist examiners in locating equivalents or abstracts. See MPEP § 901.06(a), STIC Services - Foreign Patent Services.

901.06 Nonpatent Publications

All printed publications may be used as references, the date to be cited being the publication date. See MPEP § 2128 - § 2128.02.

There are some publications kept or circulated in every Technology Center (TC) and each examiner should ascertain which are available in his or her TC and whether or not any of them is likely to bear on any assigned class. See MPEP § 707.05(e) for information on how to cite such publications.

901.06(a) Scientific and Technical Information Center (STIC)

The Scientific and Technical Information Center (STIC), formerly known as the Scientific Library, is located at CP3/4, Room 2C01. STIC maintains three additional satellite information centers: the Biotechnology/Chemical Library in CM1, Room 1C19, the Electronic Information Center in CPK2, Room 4B40, and the Lutrelle F. Parker, Sr. Memorial Law Library in CP 3/4, Room 3D62.

35 U.S.C. 7. Library.

The Director shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent and Trademark Office to aid the officers in the discharge of their duties.

Technical literature, foreign patent documents, and reference and online search services available in STIC are all important resources for the patent examiner to utilize. These resources provide material which must be known or searched to determine whether claims of applications are directly anticipated and therefore unpatentable under the provisions of 35 U.S.C. 102. STIC handbooks, textbooks, periodicals, reports, and other materials assist examiners in deciding the question of patentable invention in cases in which the primary search indicates that there is some novelty as compared to any single reference in the art (35 U.S.C. 103). These resources enable the examiner to determine whether the features novel in the particular combination searched would be obvious to a person skilled in the art from the general state of knowledge as reflected in the technical literature.

I. STIC COLLECTIONS

A. Books

STIC carefully selects and purchases primarily English-language publications in all fields of applied technology. There is a modest collection in French and German, mostly in the field of chemistry. Collections of books and trade catalogs are also purchased by STIC for permanent location in specific Technology Centers (TCs). For instance, the Design Patent Art Units have a great many manufacturer's catalogs. Books may be ordered by examiners for location in the TCs by addressing a memorandum to the Manager of STIC via the TC Director. STIC is also

developing a collection of materials in electronic formats (i.e., CD-ROM) in order to provide more timely delivery of requested references. The locations of all acquired publications are recorded in STIC so that users will know where to look for a particular publication, be it in the Information Center or in a TC. All publications, regardless of location, are processed in STIC's Technical Services Branch.

Reference works including encyclopedias, dictionaries, handbooks, and abstracting and indexing services are also available in the Information Center to assist examiners in finding information pertinent to the subject matter of a patent application. STIC does not circulate reference materials. Books in the reference collection are so labeled.

The staff of STIC makes every effort to obtain current, useful publications. However, all suggestions for additional purchases that come in from the Examining Corps are welcomed.

B. Periodicals

Approximately 1,300 technical periodical titles are received in STIC, including publications of many important scientific and technical societies. Incorporated into the collection are a number of titles pertinent to the examination of design patent applications and titles of interest to nonexamining areas of the U.S. Patent and Trademark Office (USPTO). Many of the periodical holdings in STIC are in microfilm or CD-ROM formats.

Requests for the purchase of new subscription titles are accepted at any time throughout the year, with subsequent purchase dependent on demonstrated need and availability of funds. STIC staff is alert to new periodical titles and often acquires sample copies which are sent to appropriate TCs for review and recommendation.

Current issues of periodicals are arranged alphabetically and located on shelves near the reference collection. Bound periodicals are interfiled with the book collection by their library classification numbers. Periodicals on microfilm and CD-ROM are housed in cabinets. A list of periodicals is available in STIC.

C. Foreign Patent Documents

The USPTO receives foreign patent documents through exchange agreements with almost all countries that print or otherwise publish their patent docu-

ments. This makes STIC's collection of foreign patent documents the most comprehensive in the United States.

The collection is located in the Foreign Documents Division. The most current part of the collection is made available to examiners and the public through the USPTO's automated search tools which allow users to look up, view and print documents. The documents from the major industrial countries for the period 1969 to 1990 are found on 16 mm microfilm in the Microfilm Room. The earliest patent documents, back as far as 1617, and documents from smaller countries are found in the paper collection in the stacks or at remote sites.

Most foreign countries issue official patent and trademark journals corresponding to the *Official Gazette of the United States Patent and Trademark Office*. These journals are shelved under country name. Most countries issue name indexes; some also issue classified indexes. Indexes are shelved with the journals. Much of the index information is also available on FPAS.

The official journals of a few countries include abstracts of the disclosures of the patents announced or applications published.

In addition, the Foreign Patents Branch acquires English language abstracts of foreign patent documents for selected countries published by Derwent. Holdings are in 16mm format from 1972 to date. Earlier holdings are in paper. The Branch also has unexamined Japanese patent applications abstracted by the Japanese Patent Office, the Patent Abstracts of Japan, from 1977 to date in paper.

Many countries, e.g., China, are providing abstracts of their patent documents on CD-ROM and other electronic media. These abstracts will also be accessible through FPAS.

Many technical abstracting publications include patent literature; the most notable of these is *Chemical Abstracts*. The annual indexes of *Chemical Abstracts* include, in addition to the subject matter index, an author index in which the patentee's and inventor's names appear, and patent number lists; corresponding patents of different countries are identified. Specifications of unprinted, or as yet unprinted, patents may be included in some of these abstracting services.

D. Special Collections

Biotechnology/Chemical

With the formulation of a new biotechnology examining group in 1988 came a mandate to improve STIC resources in this area. The former Chemical Library, located with the biotechnology and chemical examining groups, was replaced by the Biotech/Chemical Library. The library staff has been developing a collection to reflect the needs of the examiners in the biotechnology and chemical arts. Besides the usual journals and books in print, the library has been collecting backfiles of journals in microfilm and in CD-ROM format.

Government Publications

In 1986, STIC was designated a Federal Depository Library which means that it now receives a selected number of documents published by various U.S. government agencies. Many of these publications are on microfiche or CD-ROM. The primary search aids are the *Monthly Catalog of U.S. Government Publications* and the *List of Classes*. All the documents received in the STIC have been cataloged into the STIC's online catalog system and interfiled with the main collection.

Project XL Materials

This collection of books, games, puzzles, and manipulatives relate to the teaching of thinking skills whether they are classified as creative thinking, critical thinking, decision making, innovation and invention, or problem-solving skills. The collection is primarily aimed at, but not limited to, elementary education and is a result of a USPTO initiative in the mid-1980's to emphasize the importance of encouraging creativity in America's youth. Access to the collection is through STIC's online catalog. All Project XL materials are available for loan.

II. HOW TO LOCATE MATERIALS IN STIC

The STIC Online Catalog

The primary vehicle for locating books and other materials is the STIC online catalog. The online catalog contains a record of all materials held by the STIC collections, including location, call number, and avail-

ability. Workstations for accessing the online catalog are located in the STIC branches.

Materials acquired by the STIC are classified according to the Library of Congress classification system, which employs a combination of letters and numbers. Books and bound periodicals are inter-shelved in the stacks according to this classification system. New unbound periodical issues are shelved in a separate area of each branch, in alphabetical order by title.

III. LOAN POLICY

All STIC materials except noncirculating items may be charged out at the Circulation Desk. (Noncirculating material includes reference publications, foreign patent documents, and microfilm.) Books circulate for a period of 4 weeks and can be renewed on request. Extended loan periods are available on request. Examiners may use the Department of Commerce Libraries as well as other Federal Government libraries in the area. STIC's staff can answer questions regarding the accessibility and lending practices of other libraries. If books are needed from another library for official use, the request should go through the Scientific and Technical Information Center by means of an interlibrary loan request. (See "Interlibrary Loans" under STIC SERVICES.)

IV. STIC SERVICES

A. Reference Services

The staff of the Scientific Reference Branch, the Electronic Information Center, the Lutrelle F. Parker, Sr. Memorial Law Library, and the Biotechnology/Chemical Information Branch assist examiners in the use of the STIC. Upon request, they provide guidance on finding information in the collection. If any problems are encountered in locating materials, using the catalogs or indexing services, or finding answers to informational needs, please check with the staff. They are ready and willing to assist. Queries may be made in person or by telephone.

B. Online Searching

Online computer data base searching is provided by the Scientific Reference Branch, the Electronic Information Center, the Lutrelle F. Parker, Sr. Law Library, and the Biotechnology/Chemical Information Branch.

All branches have access via modems or the in-house system to a number of vendors' commercial data base search systems. These vendors' databases extensively cover the field of knowledge and make it possible for online searchers to retrieve bibliographic information with abstracts, chemical structures, DNA sequences, and sometimes the full text of the articles, depending on the database. This online search service provides a valuable screen of the nonpatent literature for the examiner intending to make a search of the secondary sources of his/her area of interest.

Vendors accessed by STIC staff include DIALOG, ORBIT, DOE/RECON, Chemical Abstracts Services (STN), INPADOC, DataTimes, DATASTAR, DTIC/DROLS, IntelliGenetics, and Mead Data Central. When they are identified as meeting the needs and requirements of the Office, new database vendors are added. A list of the databases offered by each vendor is available in the vendors' manuals located in each STIC branch. Examiners may request a computer search by submitting a request form to the appropriate branch. Searches are usually completed and ready for pickup within 1-2 days.

Examiners are allowed to conduct searches of online commercial databases independently of STIC staff. Training is provided through the Patent Academy and individual assistance is available from the STIC staff, especially for searching chemical structures and DNA sequences.

Online searching of nucleic and amino acid sequences is conducted by the staff of the Biotechnology/Chemical Information Branch through the use of an in-house computer network developed for this purpose. Examiners who wish to access the Automated Biotechnology Sequence Search (ABSS) system located in TC 1600 must apply through their SPE to the Biotechnology/Chemical System Branch for an ID and password. On an as needed basis, introductory classes are conducted by STIC staff to assist examiners in understanding the sequence search results.

C. Foreign Patent Services

The staff of the Foreign Patents Branch of the Foreign Document Division is available to assist with any problem or informational need regarding foreign patent searching or foreign patent documents.

Online search services on Orbit/Questel and Dialog (on the basis of Derwent databases) or INPADOC are

performed for patent examiners by the Foreign Patents Branch. The services provided include: identification of English-language or preferred-language equivalents; determination of priority dates and publication dates; searches by inventor name or abstract number; other patent family and bibliographic searches; and foreign classification information.

Examiners who choose to perform their own patent searches after receiving appropriate training through the Patent Academy can consult foreign patent experts for difficult searches. In choosing the Derwent or the INPADOC database, examiners should be aware that the systems overlap in coverage and have other similarities, but also differ in format, kinds of searches that can be performed, and patent document and country coverage. Derwent maintains superior coverage of chemical patent documents, while INPADOC includes earlier documents and more countries and has more extensive coverage of mechanical and electrical patent documents than Derwent databases.

The staff of the Foreign Patents Branch can supplement the online searching effort with manual searches of foreign patent journals, including *Official Gazette(s)*, patent concordances, and/or indexes. The staff also provides training in the use of the Foreign Patents Access System (FPAS) and information of use of the foreign patent collections.

SPECIAL NOTE: Members of the public can order copies of foreign patent documents. Procedures are outlined in a brochure entitled, "Foreign Patent Document Copy Orders" available in STIC.

D. Translations

Examiners may consult the translators in the Translations Branch of STIC's Foreign Document Division for oral assistance in translating foreign language patents and other literature sources that are possible references for applications being examined. Oral translations are performed for the major European languages and for Japanese. Examiners may also request written translations of pertinent portions of references being considered for citation or already cited in applications. Full translations are also made upon request. Written translations can be made from virtually all foreign languages into English.

There is a computerized database located in the Translations Branch listing all translations which have been made by the Branch, and a few others gathered

from miscellaneous sources. This database lists over 30,000 translations of foreign patents and articles, all of which are located in the Translations Branch. Patent translations are indexed by country and patent number; articles are indexed by language and author or title. Any copies of translations coming to examiners from outside the Office should be furnished to the Translations Branch so that it may make copies for its files.

E. Interlibrary Loans

When needed for official business purposes, STIC will borrow from other libraries materials not available in-house. Requests are initially submitted to the Reference Fulfillment Branch. Those that can be filled by libraries in the metropolitan area are handled by staff who go out on a daily basis to retrieve requested materials. Those that must be filled by libraries elsewhere in the country are requested electronically via numerous networks and commercial vendors. Law books cannot be borrowed by STIC for use by examiners in connection with law courses.

When a book or periodical is borrowed from another library, and cited in an Office action, a photocopy of the portion cited should be placed in an appropriate class and subclass. This class and subclass should be cited in the Office action.

STIC also loans its materials to other libraries around the country so that occasionally an examiner may find that the item he/she desires is unavailable. Materials which are out on interlibrary loan may be recalled for the examiner if required for immediate use.

F. On-Site Photocopying

For the convenience of the Examining Corps, photocopy machines are available for employee use in STIC. These are to be used for photocopying STIC materials which do not circulate, or for materials which examiners do not wish to checkout.

G. Obtaining Publication Dates

Requests pertaining to the earliest date of publication or first distribution to the public of publications should be made to the Scientific Reference Branch or the Biotechnology/Chemical Information Branch. For U.S. publications, the staff can obtain the day and month of publication claimed by the copyright owner.

The same information can be obtained for foreign publications through correspondence although it will take a little longer.

H. Tours

Special tours of the STIC can be arranged for examiners or for outside groups. Contact the Scientific Reference Branch.

I. STIC Brochure

A brochure detailing location, hours, holdings, telephone numbers, and services of the Scientific and Technical Information Center is available from STIC.

901.06(b) Borrowed Publications

See MPEP § 901.06(a), STIC Services - Interlibrary Loans.

901.06(c) Alien Property Custodian Publications

Applications vested in the Alien Property Custodian during World War II were published in 1943 even though they had not become patents.

Care must be taken not to refer to these publications as patents; they should be designated as A.P.C. published applications.

An A.P.C. published application may be used by the examiner as a basis for rejection only as a printed publication effective from the date of publication, which is printed on each copy.

The manner of citing one of these publications is as follows: A.P.C. Application of, Ser. No., Published

The Patent Search Room contains a complete set of A.P.C. published applications arranged numerically in bound volumes.

901.06(d) Abstracts, Abbreviations, and Defensive Publications

Abstracts and Abbreviations are U.S. Patent and Trademark Office publications of abandoned applications. Defensive Publications (the O.G. defensive publication and search copy) are U.S. Patent and Trademark Office publications of provisionally abandoned applications wherein the applicant retains his or her rights to an interference for a limited time period of 5 years from the earliest effective U.S. filing

date. On May 8, 1985, the U.S. Patent and Trademark Office stopped accepting Defensive Publication requests and began accepting applications for Statutory Invention Registrations (SIRs), although there was an overlap period where both Defensive Publications and Statutory Invention Registrations were processed; see MPEP § 711.06 and § 711.06(a). Statutory Invention Registrations have now replaced the Defensive Publication program. Statutory Invention Registrations are numbered with document category "H," beginning with "H1." Defensive Publications and Statutory Invention Registrations are included in subclass lists and subscription orders.

Distinct numbers are assigned to all Defensive Publications published December 16, 1969 through October 1980.

T 869 001
 └───┬───┬───
 │ └───┬─── Number series, 001–999 available monthly
 │ └─── O.G. volume number
 └────────┬─── Document category "T" denotes Technical
 └─── Disclosure.

For Defensive Publications published on and after November 4, 1980, a different numbering system is used.

T XXXX XX
 └───┬───┬───
 │ └───┬─── Sequential Document Number
 │ └─── O.G. volume number
 └────────┬─── Document category "T" denotes
 └─── Technical Disclosure

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687. The distinct numbers are used for all official reference and document copy requirements.

901.07 Arrangement of Art in Technology Centers

In the Technology Centers (TCs), the U.S. patents are arranged in shoes bearing appropriate labels, each showing the class, subclass, and usually the lowest and highest numbered patents put in the respective shoe. The patents are arranged in numerical order.

White labels denote U.S. patents, pink labels denote foreign patents filed according to U.S. classifications, blue labels denote non-patent literature, and yellow labels denote foreign patents filed according to IPC classifications.

One copy of a U.S. patent is designated as "original" and is classified in a specific subclass, based on the controlling claim. Other copies may be placed in other subclasses as cross-references, based on additional claimed inventions and/or pertinent unclaimed disclosure. Cross-reference copies are filed in numerical order along with the copies of original patents to simplify the tasks of searching and filing.

Copies of foreign patents are usually kept in shoes separate from and immediately following the U.S. patents.

All foreign patent documents (patents and published applications) involved in a reclassification project issued between January 1, 1974 and October 1, 1995 are filed by a computer-generated sequence number within each subclass. Each such foreign patent document has the year of publication indicated in the upper right-hand corner of the front page.

Nonpatent publications or photocopies thereof containing disclosures for particular subclasses, if numerous, should be filed in shoes following the foreign patents; otherwise, they should be filed at the bottom of the last shoe of foreign patents.

In most reclassification projects undertaken after October 1, 1995, foreign patents associated with the reclassified art have not been reclassified into the new classification schedule created for the U.S. patents. Foreign patents in this category are available for searching in a "foreign patent art collection," which appears at the end of the class which includes the newly created classification schedule. The first subgrouping of art within the "foreign patent art collection" following a given class is identified as "FOR 000" and is titled "CLASS-RELATED FOREIGN DOCUMENTS." The "FOR 000" subclass is a "class-level" collection of foreign patents that concord to the class but not to any particular subclass within the class. The "FOR 000" subclass does not have a definition.

Other subclasses appearing in the "foreign patent art collection" for a given class are characterized by the prefix "FOR" followed immediately by a three-digit number. These "FOR" subclasses maintain the

foreign patents classified in the former classification schedule, i.e., the schedule that was the subject of the reclassification project. In certain instances, one or more unnumbered titles precede these "FOR" subclasses to show the proper hierarchical relationship for the indented foreign art collections. At the end of each "FOR" subclass in the "foreign patent art collection," there appears in parentheses the subclass number under which the foreign patents had been classified prior to the reclassification project. Subclass definitions for the "foreign patent art collection," exactly corresponding to those of said former classification schedule, are maintained.

901.08 Borrowing References

The search files in each TC should at all times be complete. Where they are incomplete, the examiners using such files and relying on their completeness may miss valuable references. References removed from the files whether for use in the TC or otherwise should, of course, be promptly returned.

901.09 Missing Copies — Replacement

To expedite the handling of requests for replacement copies and thereby ensure the quickest response, the following routing procedures should be adhered to:

(A) Use designated collection drops within each TC for copy orders.

(B) Contract inspectors will visit designated collection drops at least twice each week to pick up PTO-14C orders.

Alternatively, the orders may be mailed or otherwise delivered to the Contract Support Unit, currently located in Crystal Park, Building 2, Room 105.

The attorneys' drop slot at the Public Service Window should not be used nor should the forms be mailed to Copy Fulfillment Services as consequent rerouting to Contract Support for processing will result in unnecessary delay.

All replacement copies ordered through the PTO-14C program are returned to the requesting examiner as notification of order fulfillment. The examiner should then place the copies in the designated file drop location for filing by the contractor in the search file.

C	PATENT NUMBER	NO. OF COPIES 1
	USE A SEPARATE FORM FOR ORDERING EACH MISSING COPY	
EXAMINER'S NAME		ART UNIT
DATE OF ORDER		
TO REPLACE MISSING COPY IN		
CLASS		SUBCLASS OR DIGEST
CHECK ONE BOX ONLY		
<input type="checkbox"/> OR <input type="checkbox"/> XR <input type="checkbox"/> UNKNOWN		
PTO-14C (REV. 5-76)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE
EXAMINER'S ORDER FOR REPLACEMENT COPY		

902 Search Tools and Classification Information

902.01 Manual of Classification

The Manual of Classification is the key to the U.S. Patent Classification System. It is usually published in full as the Basic Manual every 2 years. Basic Manuals reflect current classifications as of December of even-numbered years. Revisions to the Basic Manual occur at 6-month intervals. Pages of the Manual revisions are inserted as replacements to update the previous versions.

There are over 400 classes in the U.S. Patent Classification System, each having a title descriptive of its subject matter and each being identified by a class number. Each class is subdivided into a number of subclasses. Each subclass bears a descriptive title and is identified by a subclass number. The subclass number may be an integral number or may contain a decimal portion and/or alpha characters. A complete identification of a subclass requires both the class and subclass number and any alpha or decimal designations; e.g., 417/161.1A identifies Class 417, Subclass 161.1A.

The Manual of Classification contains ordered arrangements of the class and subclass titles, referred to as class schedules. These titles are necessarily brief, although they are intended to be as suggestive as possible of subject matter included. Therefore, it is best not to depend exclusively upon titles to delineate

the subject matter encompassed by a class or subclass. Reference to respective definitions and notes is essential. If a search is to be expeditious, accurate, and complete, the Manual of Classification should be used only as a key to the class or subclass definition and appended notes.

The Manual of Classification has the following parts:

(A) A list of classes revised in the most recent revision to the Manual and the reason for the revision to each class.

(B) A list of the contents of the Manual showing the current page date for each class and the year in which the class was originally established.

(C) Overview of the classification system.

(D) A hierarchical arrangement of class titles organized into four main groups by related subject matter. It should be noted that this hierarchy is to be used to determine document placement only as a last resort, i.e., when none of the other classification criteria, such as comprehensiveness, etc., allow placement. This part also includes an exact hierarchical listing of the synthetic resin and chemical compound classes.

(E) A list, in numerical order, by art unit indicating the classification(s) assigned to each.

(F) A list of classifications in numerical order by class number giving the class title, the art unit to which the art is assigned, and the examiner search room in which the art can be found.

(G) A list of classes in alphabetical order by class title with associated class numbers.

(H) The class schedule for PLANTS.

(I) Class schedules for utility patent classes arranged in numerical sequence by class number.

(J) The class schedules for the Design classes.

The Manual of Classification is available to USPTO personnel online from the Classification Data System (CDS) Intranet Homepage which is accessible from the "Patent Examiner's Toolkit" toolbar.

902.01(a) Index to the U.S. Patent Classification System

The Index to the U.S. Patent Classification System is an alphabetic listing of technical and common terms referring to specific classes and subclasses of the U.S. Patent Classification System. It is intended as an initial entry into the system and should not be con-

sidered exhaustive. All appropriate class schedules should be scanned for specifically related subclasses and the definitions and associated notes of the pertinent classifications must also be reviewed, even when the citation found in the Index appears to be restricted to a specific subject matter area.

The Index is published every year reflecting classification as of December of the year. Suggestions or changes to the Index are encouraged and should be directed to the Classification Units in the Technology Centers.

The Index is available to USPTO personnel online from the Classification Data System (CDS) Intranet Homepage which is accessible from the "Patent Examiner's Toolkit" toolbar.

902.02 Class and Subclass Definitions

All of the utility classes (i.e., classes devoted to technology), and the plant class, have definitions. All design classes will also eventually have definitions.

Definitions state the subject matter of the classes and subclasses much more explicitly than it is possible to state in short class and subclass titles. A study of the definitions is essential to determine the proper classification of subject matter within the U.S. Patent Classification System.

A complete, printable set of definitions of all classes and subclasses in the U.S. Classification System is available to USPTO personnel online from the Classification Data System (CDS) Intranet Homepage which is accessible from the "Patent Examiner's Toolkit" toolbar. These definitions are revised every June and every December.

It should be noted that classification orders frequently affect existing definitions. Personal sets of definitions used by examiners should be periodically revised to reflect changes.

902.02(a) Definition Notes

Many of the definitions have accompanying notes. These notes are of two types: (A) notes that supplement definitions by explaining terms or giving examples, and (B) notes referring to related disclosures located in other classes or subclasses.

These latter notes are termed "See or Search" notes and are helpful in explaining the limits of a class or subclass. They generally state the relationship to, and difference from, other identified subject matter

collections. It is intended that each note should help a user reach a decision either to include or exclude an area containing relevant subject matter.

Search notes are not exhaustive and should be regarded as suggestive of additional fields of search, but not as limiting the search. Additionally, since a search note which applies to a particular subclass is rarely repeated for subclasses indented thereunder, it is advisable to review the search notes of all parent subclasses.

902.02(b) Search Cards

Many older subclasses have "search cards" containing the subclass definition in the first shoe of each defined subclass in both the Technology Center and the Patent Search Room.

902.03 Classification Information

Current classification information for U.S. patents is available from the sources indicated below.

902.03(a) Patent Classification Home Page on the Internet

The new Patent Classification Home Page address on the Internet is <http://www.uspto.gov/classification>. The site is the clearinghouse for classification information published in hyper-text mark-up language (HTML) and Adobe Acrobat Portable Document Format (PDF) by the U.S. Patent and Trademark Office (USPTO). The site currently includes the Index to the U.S. Patent Classification (USPC) system, USPC Manual of Classification (classification schedules) and Classification Definitions in HTML and PDF formats. The site integrates with the Patents-on-the-web site by allowing a search of a subclass by clicking on a patent icon in the classification schedules and definitions which in turn generates a search result in the Patents-on-the-web. Patents-on-the-web provides full-text of all US patents issued since January 1, 1976, and full-page images of each page of every US patent issued since 1790. Therefore it is possible to see every patent in a subclass by browsing the classification schedules using the Classification Home Page in combination with Patents-on-the-web.

902.03(b) Patent Classification Home Page on the USPTO Intranet

The address for the Patent Classification Home Page on the USPTO Intranet is <http://ptoweb/patents/siradmin/class/>. The Classification Home Page is also accessible from the "Patent Examiner's Toolkit" toolbar. The site is the intranet clearinghouse for classification information published in hyper-text mark-up language (HTML) and Adobe Acrobat Portable Document Format (PDF) by the U.S. Patent and Trademark Office (USPTO). The site currently links to the classification Internet clearinghouse for the Index to the U.S. Patent Classification (USPC) system, USPC Manual of Classification (classification schedules) and Classification Definitions in HTML and PDF formats. See MPEP 902.03(a). Examiners and the public are provided with access to identical information for the Index, Schedules and Definitions.

The classification intranet site also includes links to information such as USPC-to-IPC(7) Concordance, IPC (7) and IPC (6) Schedules, IPC(7) Guide, WIPO Handbook on Industrial Property Information and Documentation, Classification System Overview, Classification Bulletins, and the Patent Classification Retrieval system (PCRS).

The PCRS provides Original (OR) and Cross-Reference (XR) classification information for individual patents and listings of patents contained in subclasses. This data is updated bimonthly with new issues, withdrawn patents and reclassifications.

902.03(c) Classification Insight on USPTO Local Area Network (LAN)

The Classification Insight product on the USPTO LAN site is a custom browser containing the following documents in a full-text searchable hyperlinked format. It is accessed from the Patent Examiners Toolkit on their desktop workstation computers.

(A) Index to the U.S. Patent Classification (USPC) system

(B) USPC Manual of Classification (classification schedules) in hyperlinked and PDF formats.

(C) Classification Definitions in hyperlinked and PDF formats.

- (D) USPC-to-IPC(7) Concordance,
- (E) USPC-to-LOCARNO Concordance
- (F) IPC (7) Schedules,
- (G) IPC(7) Catchword Index

The product also includes shortcuts to the Classification Schedules and the Classification Definitions in Adobe Acrobat Portable Document Format (PDF).

902.03(d) Patent Information and Search Tools: the Cassis CD-ROM Series

Access to a great deal of patent information as well as various search tools is available in the Cassis CD-ROM series. These include:

(A) Patents CLASS: Provides a list of all classifications of a patent number and a list of all patent numbers in a classification, showing ORs and XRs.

(B) Patents BIB: Bibliographic information for utility patents issued since 1969 (other patents, since 1977), including issue date, title, current classifications, assignee at time of issue, status (withdrawn, reexamined, extended term, certificate of correction issued or expired due to nonpayment of maintenance fee), and abstracts for the most recent 2 1/2 - 3 years depending on disc space.

(C) Patents ASSIGN: Shows assignment of patent rights recorded at the USPTO from August 1980 to present.

(D) Patents ASSIST: This disc provides a variety of files: Manual of Classification; Manual of Patent Examining Procedure; Index to the U.S. Patent Classification System; Attorneys and Agents Registered to Practice before the U.S. Patent and Trademark Office; Classification Orders Index showing Classes/subclasses abolished or established since 1976; IPC-USPC Concordance; Classification, Art Unit, Supervisory Patent Examiner and Telephone Number (CAST) showing which Art Units examine which art according to classification; Classification Definitions; and Patentee-Assignee File showing assignment of patent rights at time of issue since 1969 for utility patents (other patents, since 1977), and inventor names since 1975.

The above CD-ROMs are text-searchable. Search results can be viewed on-screen, printed, or downloaded to diskette. Patents CLASS and Patents BIB

are updated with new information every two months; Patents ASSIGN and Patents ASSIST are updated every three months.

In addition to the text-searchable discs, USAPat offers full facsimile images on CD-ROM of U.S. patents issued weekly. The backfile includes patents issued since January 1994. Intended as a document delivery system, USAPat allows retrieval of patents by document number only. Excellent printed copies can be obtained using a laser printer.

902.03(e) Automated Search Tools: EAST and WEST

The automated search tools on examiners' desktop computers include the Examiner's Automated Search Tool (EAST), the Web-Based Examiner Search Tool (WEST), and the Foreign Patent Access System (FPAS). EAST and WEST provide examiners with access to the full text of U.S. patents granted since 1970. Additionally, EAST and WEST each provide current classification information and images for all U.S. patents. Images are available for foreign patent documents back to about 1920 and English language abstracts are available for many foreign patent documents published since 1978 using the automated search tools. Specific instructions for gaining access to the various documents available using the automated search tools can be found in the "Patent Automation" folder in Microsoft Outlook on the examiners' desktop computers.

The EAST and WEST products are also available to users in the Patent Search Room at the USPTO.

902.04 Classification Orders

Classification orders issue once a month, each order detailing the changes resulting from a classification project effected that month.

Since classification projects issue monthly throughout the year, orders are used to bridge the gap between the time a project issues and the time the other search tools (Manual of Classification, Index to the USPCS, Classification Definitions) are updated.

The order includes the following:

- (A) Either the new class schedules or changes to existing class schedules necessitated by the project;
- (B) The changes to the definitions necessary to support the changes in (A), above;

(C) Source and disposition lists showing how the old art has been distributed into the newly established subclasses; and

(D) A revised concordance showing the relationship between the newly established subclasses and their International Patent Classification (IPC) counterparts.

Classification orders are distributed to classifiers and examiners associated with the reclassification project of the order, to Patent Depository Libraries, and to the Patent Search Room. Copies can be obtained through a post classifier within the Technology Center or from the Office of Classification Support.

Much of the information contained in a Classification Order is available to USPTO personnel online from the Classification Home Page, which is accessible from the "Patent Examiner's Toolkit" toolbar.

902.04(a) Reclassification Alert Report

The Reclassification Alert Report is updated quarterly and is available to USPTO personnel online from the Classification Home Page, which is accessible from the "Patent Examiner's Toolkit" toolbar. The report numerically lists the classes and subclasses affected by classification orders which issued during the quarter, indicating if the classifications were established, abolished, or had definition changes.

Copies of definitions of any newly established subclasses, definition changes to existing subclasses, or entire classification orders are available from the Office of Classification Support.

903 Classification

903.01 Statutory Authority

The statutory authority for establishing and maintaining a classification system is given in the following statute, which states:

35 U.S.C. 8. *Classification of patents.*

The Director may revise and maintain the classification by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

903.02 Basis and Principles of Classification

The basis of classification used in the U.S. Patent and Trademark Office, the principles followed, and the reasons why such principles were adopted are set forth in the booklet, *Development and Use of Patent Classification Systems*, which is available in each art unit. An electronic text file of this booklet is available from the Editorial Division of the Office of Classification Support. Since classification is the basic tool of every examiner, this booklet, particularly as it relates to the present classification system, should be carefully studied. Also available is the "Examiner Handbook to the U.S. Patent Classification System" which can be accessed from either the Classification Data Systems (CDS) Intranet Home Page or the USPTO Home Page.

903.02(a) New and Revised Classes

The establishment of new classes or subclasses and the revision of old classes are done under the supervision of a patent classifier.

The classifier performing the reclassification is provided with a set of patent copies of the present classification. With these copies, by study and successive groupings, he or she develops an arrangement of the patents which is satisfactory for searching. Usually expert examiner opinion is sought.

The definition of the new class or revised class is written or modified, the lines between the class and other classes are drawn up, and the subclass definitions are established.

The Index to the U.S. Classification System and the Classification Data System files are also updated.

Notification of the new class or subclass is published in a classification order, and supplementary sheets necessary to correct the looseleaf Manual of Classification are published.

Definitions of all revised classes and subclasses are included in classification orders.

903.02(b) Scope of a Class

In using any classification system, it is necessary to analyze the organization of the class or classes to be included in the search.

The initial analysis should determine which one or ones of the several types of subject matter (manufacture, art, apparatus, or stock material) are contained in the class being considered.

Further, relative to each type of subject matter, it is necessary to consider each of the various combinations and subcombinations set out below:

Basic Subject Matter Combined with Feature for Some Additional Purpose. The added purpose is in excess of the scope of the subject matter for the class, as defined in the class definition; e.g., adding a sifter to a stone crusher which gives the added function of separating the crushed stone.

Basic Subject Matter Combined with Perfecting Feature. Features may be added to the basic subject matter which do not change the character thereof, but do perfect it for its intended purpose; e.g., an overload release means tends to perfect a stonecrusher by providing means to stop it on overload and thus prevent ruining the machine. However, this perfecting combined feature adds nothing to the basic character of the machine.

Basic Subject Matter. The combination of features necessary and essential to the fundamental character of the subject matter treated; e.g., a stonecrusher requires a minimum number of features as essential before it can function as such.

Subcombinations Specialized to Basic Subject Matter. Each type of basic subject matter may have subcombinations specialized to use therewith; e.g., the crushing element of a stonecrusher.

Subcombinations of General Utility. Each type of basic subject matter may have subcombinations which have utility with other and different types of subject matter; e.g., the machine elements of a stonecrusher. Subcombinations of this character usually are provided for in some general class so that the examiner should determine in each instance where they are classified.

903.02(c) Establishing Subclasses and Cross-Reference Art Collections

When an examiner finds it desirable to create a new subclass or cross-reference art collection, the appropriate post classifier must be consulted before work is begun. The post classifier will assist the examiner in establishing any new subclass or cross-reference art

collection by providing appropriate instructions on how to transfer patents from an existing subclass to a new subclass, obtaining any additional cross-reference copies that might be needed, determining the title of the newly established subclass or cross-reference art collection, and assigning the numeric designation to be placed on the new subclass or cross-reference art collection.

All newly created subclasses will be made official so as to be a part of the defined classification system and will thus appear in both the examiners' and Patent Search Room paper files. The intent is to accomplish this with a minimum amount of disruption to the examiners. Any examiner having the Technology Center (TC) Director's approval to create new subclasses should contact the post classifier for his or her technology. As workload permits, a classifier will be assigned to cooperate with the examiner on the arrangement of the subclasses he or she wishes to establish and the definitions thereof. Then, the examiner will provide a marked-up computer printout of the patents in the subclass or subclasses being affected. On a time available basis, the examiner may be aided in this task by classification personnel.

When all documents have been assigned the appropriate classification, arrangements will be made for contractor processing of first the Patent Search Room copies, then the examiners' copies of the affected patents. New classification data will be added to the Subclass Data File (SDF) and Master Classification File (MCF) as appropriate, patent copies will be relabeled with the new classification information, and the documents will be refiled in the new classification array. Concurrently, all automated classification indices and systems, including the EAST and WEST search tools, will be updated to reflect the new classification changes.

903.03 Availability of Foreign Patents

All foreign patent documents received in the Office before October 1, 1995 were placed in the shoes in the Technology Center (TCs), according to either the United States Patent Classification System or, in relatively few instances, an IPC classification. Foreign patents received by the Office after October 1, 1995 are available on the USPTO's automated search systems and through the Foreign Patent Access System (FPAS).

If the examiner desires to update the classification of a foreign patent by changing, canceling, or adding copies, he or she should forward the patent to his or her post classifier with a request for the desired transaction attached.

The Scientific and Technical Information Center (STIC) retains copies of foreign patents (see MPEP § 901.06(a)) so that foreign patents, known by country, number, and publication date, can be inspected in STIC and so that photocopies can be ordered.

Examiners confronted with language problems in classifying foreign-language patents may call upon the Translation Branch of STIC for assistance (see MPEP § 901.06(a)).

903.05 Transfer of U.S. Patents

The transfer of official copies of U.S. patents, either original or cross-reference, from one class or subclass to another requires the approval of a classifier.

Examiners must submit to their Technology Center (TC) post classifier all questions of transfer of patents.

When an examiner desires to transfer official copies of domestic patents to a different class or subclass, he or she should prepare a memorandum list prepared for signature of the primary examiner identifying the numbers of all patents which are to be transferred indicating only the class and subclass into which each is to be placed. Both originals and properly identified official cross-references may be included in the same list and these may involve transfers to or from any number of different classes or subclasses. Additional cross-reference copies of any listed patent may also be requested by merely indicating where the cross reference copies should be placed. The memorandum list with the examiner's copies of the patents is forwarded through each TC involved for its prompt approval or comment and then, upon approval, to the classification unit of each of the TCs involved.

In those instances where a transfer is approved by a patent classifier, the class and subclass designations on both the examiner and Patent Search Room copies of the patents are changed and the classification data files are altered to agree with the new classification. When the transfer is not approved, the copies of the patents will be returned with a notification thereof.

Unauthorized transfers render the subclasses in the Patent Search Room no longer duplicates of those in the examiners' rooms, and also render incorrect the classification data files.

The procedure for transferring an entire class or subclass from one Technology Center to another is given in the Manual of Clerical Operations.

903.06 Practice To Be Followed in Ordering Official Cross-References

Patents which are useful as references may be found either in the course of a search or from inspection of the *Official Gazette* each week. All patent copies in official subclasses, cross-reference art collections, and digests are now recorded on the Master Classification File (MCF). In order that the search file be complete as to patent copies and to ensure the accuracy of the MCF, it is necessary that each patent copy subsequently added to the search file be recorded.

The informal placement of cross-references as "Unofficial Patents" into the examiner's search file is prohibited. All patent copies now placed in the examiner's search file are official cross-references. Requests for additional cross-references will be used by the support contractor to ensure the placement of labeled copies in the examiner's search file and the Public Search Room.

To order new or additional cross-references, the examiner should submit a pink-colored form, PTO-14B, completed as follows:

(A) Enter the "DATE OF ORDER," "PATENT NUMBER," "EXAMINER'S NAME," and "ART UNIT" in the appropriate boxes.

(B) Enter the "CLASS" and "SUBCLASS/DIGEST" information for each location where a copy of the requested patent should be placed.

(C) Enter the number of "TOTAL COPIES" requested. This number is determined by multiplying the total number of unique classifications listed times two. This ensures a sufficient number of copies will be obtained to place a labeled copy in both the Examiner Search File and the Public Search Room.

When cross-references for more than three different patent numbers are desired, the examiner can prepare a list of the patent numbers and their associated classi-


fications. One copy of form PTO-14B should be completed to reflect the Date of Order, Art Unit, and Examiner's Name and should be attached to the list.

To expedite the handling of requests for additional cross-references and thereby ensure the quickest response, the following routing procedures should be adhered to:

(A) Designated collection drops within each Technology Center for copy orders should be used. Contract inspectors will visit designated collection drops at least twice each week to pick up PTO-14 orders.

(B) Alternatively, the orders may be mailed or otherwise delivered to the Contract Support Unit, currently located in Crystal Park, Building 2, Room 105.

The attorneys' drop slot at the Public Service Window should not be used, nor should the forms be mailed to Copy Fulfillment Services as consequent rerouting to Contract Support for processing will result in unnecessary delay.

B	DATE OF ORDER	PATENT NUMBER
	1-5-83	3,456,789
USE A SEPARATE ORDER FORM FOR EACH PATENT NUMBER		
EXAMINER'S NAME AND ART UNIT	EXAMINER: Use this space to order two copies for each classification below:	TOTAL COPIES
Catherine Timm Art Unit 1307		6
ONLY ONE CLASSIFICATION PER LINE		
EXAMINER'S NOTES	CLASS	SUBCLASS/DIGEST
	1 364	200
	2 377	1
	3 377	14
	4	
5		
PTO-14B (REV. 5-76)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE
EXAMINER'S ORDER — CROSS-REFERENCES FOR SEARCH FILES		

903.07 Classifying and Cross-Referencing at Allowance

It is the duty of each primary examiner to personally review the original classification and cross-referencing made by his or her assistants in the issuing classification boxes on the face of the file wrapper, or

on the blue issue classification slip for series 08/ and earlier applications, of every application passed for issue. Both the blue issue classification slip (PTO-270) and the file wrapper provide space for the full name of the "Primary Examiner" to show that the review has been made.

An examiner with full signatory authority who acts personally on an application and sends it to issue should stamp and sign his or her name on the file wrapper ONLY in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" space on the file wrapper or blue issue slip, as appropriate, to make it clear that the absence of information in the box was not an oversight.

The initial classification of pending applications and the drawings thereof will have been indicated in pencil by the supervisory patent examiner. See MPEP § 903.08(b).

However, an application, properly classified at the start of examination, may be classified differently when it is ready for allowance. The allowed claims should be reviewed in order to determine the subject matter covered thereby. It is the disclosed subject matter covered by the allowed claims that determines the original and any mandatory cross-reference classification of U.S. patents.

The procedure for determining the classification of an issuing application is as follows: every claim, whether independent or dependent, must be considered separately for classification. A separate mandatory classification is required for each claim which is classifiable in a different class or subclass; some claims, particularly in chemical areas, may require plural classifications. After all mandatory classifications have been determined, the classification to be designated as the original (OR) is determined. If all mandatory classifications are in the same class, the mandatory classification that appears first (highest) in the class schedule is the original classification; in certain circumstances (e.g., the genus-species array), however, modifications of this rule may apply. See the "Examiner Handbook to the U.S. Patent Classification System" for an explanation of genus-species classification.

If the mandatory classifications are in different classes, the original classification is determined by considering, in turn, the following criteria:

(A) selection based on the most comprehensive claim,

(B) selection based on priority of statutory category of invention,

(C) selection based on superiority of types of subject matter, and

(D) selection among classes in the "related subject" listing at the front of the manual of classification.

It should be noted that the criteria, *supra*, may be superseded by

(A) special circumstances, e.g., superconductor technology and biotechnology are superior to all other subject matter,

(B) prior placement of patents for a particular body of art, or

(C) particular class lines and class notes.

Once the controlling class is determined, classification within the class is determined by the hierarchy of the class.

For a more complete discussion of this subject, see the "Plan and Use of the Manual of Classification" on page I-1 *et seq.* of the Manual of Classification, or the "Examiner Handbook to the U.S. Patent Classification System."

Once the original classification is determined, all remaining mandatory classifications are designated as cross-references, as are any additional discretionary classifications that the examiner wishes to apply to the patent.

Only the correct original classification should be left on the file of each application when passed for issue.

The examiner must legibly fill out the issuing classification boxes on the face of the file wrapper (or a blue issue classification slip (PTO-270) for series 08/ and earlier applications) to indicate the class and subclass in which the patent should be classified as an original and also the classifications in which it should appear as a cross-reference. In those unusual cases involving more than 31 cross references, an addendum issue slip will be used and attached to the left inside of the file wrapper. The examiner should be certain that all subclasses into which cross-references are placed are still valid.

All examiners must include alpha subclass designators in the issuing classification boxes on the file

wrapper or on the blue issue slips (PTO-270) at the time of issue when appropriate. This applies to both the original classification and the cross-reference classification. Any time that a patent is being issued in or cross-referenced to a subclass containing alpha subclasses, the alpha designation for the proper alpha subclass must be included. No other designation is permissible. Inclusion of only the numeric designation of a subclass which includes an alpha subclass designation is an incomplete and improper entry. A numeric subclass from which alpha subclasses have been created is designated with an "R" (denoting residual) and if the patent does not fit an indented alpha subclass, the "R" designation must be included. It is permissible to place multiple copies of a patent into a single set of alpha subclasses.

Digests and cross-reference art collections should also be included in the issuing classification boxes on the face of the file wrapper or on the blue issue slip, but the original classification must never be a digest or cross-reference art collection. The indication for a copy of a patent in a digest or cross-reference art collection must be in the cross-reference area of the issuing classification boxes. A digest must be identified by class number, alpha characters DIG, and appropriate digest number.

U.S. patents cannot be classified in subclasses beginning with "FOR," since these are exclusively for foreign patents. See also MPEP § 901.07.

APPLICATIONS IN ISSUE

Where an official classification order affects an application already passed to issue, Classification Operations makes any necessary changes on the file wrapper or the blue slip for series 08/ and earlier applications. Patents issuing from applications which already have been sent to the printer will be reclassified by Classification Operations at the time the patent issues.

903.07(a) Cross-Referencing — Keep Systematic Notes During Prosecution

Throughout the examination of an application, systematic notes should be kept as to cross-references needed either due to claimed or unclaimed disclosure. Examiners handling related subject matter should be

consulted during prosecution (whether they handle larger unclaimed combinations or claimed or unclaimed, but disclosed, subcombinations), and asked if cross-references are needed.

Each consultation involving a question of the propriety of the classification of subject matter and/or the need for a cross-reference must be recorded in the SEARCH NOTES box on the file wrapper and must include: the name of each examiner consulted, the date that the consultation took place, and the results of the consultation including the consulted examiners' or examiner's indication of where claimed subject matter is properly classified and where subject matter disclosed but unclaimed is properly classified and whether or not a cross-reference is needed.

A cross-reference **MUST** be provided for all CLAIMED disclosure where possible and inserted in the issuing classification boxes at time of issue.

903.07(b) Issuing in Another Technology Center Without Transfer

When an examiner issues a prospective patent in another Technology Center (TC), he or she notes in the space provided on the issuing classification area on the face of the file wrapper (or on the blue issue classification slip in series 08/ and earlier applications), *in red ink*, the class and subclass of the other TC, and in parentheses the number of the other TC. A concurring primary examiner from the other TC must initial the area to the right of the original classification. When the primary examiners from the two TCs disagree on the proper original classification of the allowed claims, the application should be submitted for resolution to the post classifier having jurisdiction over the art area to which the application is presently assigned. The post classifier shall give the application a high priority.

Only when both examiners concur in the proposed classification of the patent, or where there has been a ruling by a patent classifier, may patent applications sent to issue from one TC be assigned to classes in another TC. In the latter case, the patent classifier must initial the area to the right of the original classification.

903.08 Applications: Assignment and Transfer

The titles "supervisory patent examiner" and "primary examiner," as used in this Chapter 900, include in their definition any person designated by them to act on their behalf. It is recognized that authority to accept or refuse the transfer of an application may be delegated when such authority is deserved.

The Technology Center (TC) to which an application is assigned is responsible for its examination until such time as the application is officially transferred to another TC.

The primary examiners have full authority to accept any application submitted to them that they believe is properly classifiable in a class in their art unit.

Applicants may be advised of expected application transfers by using Form Paragraph 5.03.

¶ 5.03 Reassignment Affecting Application Location

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit [1].

Examiner Note:

This paragraph should be used in all Office actions when the location of an application is changed due to a reassignment of the art, transfer of the application to a different Art Unit, or transfer of an examiner and the examiner's docket.

903.08(a) New Applications

New nonprovisional applications are assigned to the various Technology Centers (TCs) in the first instance by the Office of Initial Patent Examination (OIPE). Upon receiving an application from the OIPE, the technical support staff in charge of processing new applications should wand the application on the PALM bar code reader to the art unit to which it has been assigned and date stamp the file wrapper on the day the file is to be delivered to the supervisory patent examiner. The complete application (file and drawing) are then given to the appropriate supervisory patent examiner. The technical support staff should not permit these cases to remain overnight before distributing.

The supervisory patent examiner or his/her designee reviews the application to determine whether it properly belongs in his or her art unit. If it does

belong in the art unit, it is processed as a new receipt. See MPEP § 903.08(b).

When a new application is received which, in the opinion of the primary examiner, does not belong to his or her TC, he or she may request transfer of it to another TC. See MPEP § 903.08(d).

Form PTO-447A, "Transfer Request" consists of two copies and is used as a transmittal and notification form.

If the search in connection with the first action develops art showing proper classification elsewhere, the transfer is usually initiated before the first action is prepared and mailed.

903.08(b) Classification and Assignment to Examiner

Every nonprovisional application, new or amended, and including the drawings, if any, when first assigned to a Technology Center (TC) must be classified and assigned to an examiner for examination. The supervisory patent examiner normally assigns the application, noting in lead pencil in the space provided on the face of the file the assigned class and subclass and also the name of the examiner. The application file is then turned over to the technical support staff for processing. Provisional applications are not classified or assigned since they are not examined.

If an examiner other than the supervisory patent examiner is given the responsibility of assigning applications, time so spent may, at the TC Director's discretion, be charged to "Assisting SPE."

CLASSIFICATION AND ASSIGNMENT OF APPLICATIONS FILED UNDER THE PATENT COOPERATION TREATY (PCT)

Applications filed under the Patent Cooperation Treaty (PCT) are normally classified on the basis of the first claimed invention in the application. The following special situations, however, apply:

(A) if a U.S. national application has been acted upon by an examiner to whom the national application was assigned on the basis of the controlling (not necessarily the first) claim, a subsequent PCT application claiming priority of the national application will normally be assigned to the same examiner, or to the examiner's art unit in his/her absence;

(B) in all other situations where a U.S. national application and a corresponding PCT application are copending, irrespective of which application was filed first, every effort should be made to ensure that both applications are assigned for search and examination to the examiner to whom the PCT application would normally be assigned on the basis of the first claimed invention, or to the examiner's art unit in his/her absence;

(C) if a PCT application has been the subject of international search and possibly international preliminary examination outside the U.S., a U.S. national phase application or a U.S. national application claiming benefit of the PCT application will be assigned like any other application, i.e., on the basis of the controlling claim.

The object of having the U.S. national and PCT applications assigned to the same examiner is to promote consistent search and examination results.

Should a PCT application be submitted to a classification unit for resolution of an assignment dispute, the PCT application must:

(A) be hand-carried throughout the dispute resolution process; and

(B) be returned to an examining unit within three working days of receipt in the classification unit.

See MPEP § 903.08(d) for a discussion of transfer procedures.

903.08(c) Immediate Inspection of Amendments

Upon the receipt of an amendment which makes a transfer proper, steps should be taken promptly in accordance with the transfer procedure outlined in MPEP § 903.08(d).

903.08(d) Transfer Procedure

TRANSFER BETWEEN ART UNITS WITHIN THE SAME TECHNOLOGY CENTER

All transfers within one Technology Center (TC) must be called to the attention of the technical support staff so that the PALM system may be updated to correctly indicate the assignment of the nonprovisional application.

Where there is a difference of opinion among the supervisory patent examiners as to assignment within the same TC, the matter may be submitted to the post classifier assigned to that TC for resolution.

TRANSFERS BETWEEN DIFFERENT TECHNOLOGY CENTERS

Where a supervisory patent examiner (SPE) believes an application, either new or amended, does not belong in his or her art unit, he or she may use form PTO-447A to request transfer of the application from his or her art unit (the "originating" art unit) to another art unit of a different TC (the "receiving" art unit). The supervisory patent examiner of the originating art unit dates and completes Section I of the PTO-447A, giving a full explanation of the reasons for classification in the other art unit.

In the space provided on the form, at least one of the following must be included:

- (A) Identification of the controlling claim examinable in another TC;
- (B) Identification of any existing informal transfer agreement; or
- (C) Other reasons - with full explanation.

Each application must be fully reviewed before it is sent to the receiving art unit of a different TC or a post classifier. In order to ensure that the application has been thoroughly reviewed by the originating TC prior to the transfer, the SPE of the originating art unit requesting the transfer of the application must send the application to an individual designated by his or her TC for review of the application before the application leaves the originating TC. The designated individual will be responsible for ensuring that the written record is clear and that all appropriate areas in the originating TC have been considered with respect to the classification of the application. If the designated individual determines that another area within the TC should be considered before it is sent out of the TC, the application should be forwarded to that area for consideration. Otherwise, the designated individual should initial in the "gatekeeper review" section of the PTO 447A, and forward the application to the appropriate art unit in another TC. The designated individual also reviews applications for patterns of errors in initial patent application routing. If such patterns are found, the patent application assistants in the

Office of Initial Patent Examination (OIPE) should be informed.

In all cases when transfer is initiated, the application must be sent to another art unit. It cannot be sent directly to a classification unit. Even if the application is informal, confusing, or contains unfamiliar subject matter, the examiner must make his or her best judgment as to where the application should be classified and attempt to transfer it there.

Where an application's claims include a combination of limitations for plural disciplines (chemical, electrical, or mechanical), a primary examiner may request transfer to another discipline, notwithstanding the fact that the controlling claims are properly classified in his or her art unit, on the ground that the application is "best examinable" in the other discipline. In this instance, the examiner requesting transfer should cite art showing the limitations classifiable in his or her discipline. For discussion of the situations in which assignment of an application on a "best examinable" basis may be proper, see MPEP § 903.08(e).

PROCESS FOR TRANSFER

When the supervisory patent examiner or primary examiner determines that transfer is proper, he or she staples the form PTO-447A to the face of the file and gives it to the technical support staff for forwarding for review.

If the receiving examiner agrees to accept the application, he or she classifies and assigns the application and initials the form PTO-447A. The transfer is effected by the technical support staff in the TC which accepts the application for transfer.

If the receiving art unit refuses to accept the application, the reasons for refusal, the date, and the examiner's name are placed on the form PTO-447A in Section II "DISPOSITION BY RECEIVING TC." Where an application is refused by the receiving art unit based upon the classification of any claim, the application will be forwarded to a post classifier in the receiving TC for resolution of any classification issues. The post classifier will consider the statements and evidence of both the originating and receiving art units and will assign the application to the art unit which has jurisdiction over the art in which the controlling claims of the application are properly classified. This may be the originating, receiving, or another art unit as appropriate. The post classifier

writes the assigned class and art unit number and his or her initials on the face of the file wrapper or PALM bibliographic data sheet and on form PTO-447A, briefly giving reasons for assignment of the application in the space of the form.

In order for the post classifiers to assign an application outside of their TC, a concurring signature of an SPE or designated examiner or classifier for the particular class or art unit where the application is being assigned will be required. Generally, decisions by post classifiers are final; no reconsiderations are permitted.

Under certain circumstances, a post classifier may, contrary to controlling classification rules, assign an application to a class or TC which in his or her judgment is better equipped to examine the application. This is fully described in paragraphs 6 and 9 of MPEP § 903.08(e).

Any application assignment disputes that cannot be resolved by post classifiers in the TCs will be resolved by a panel which consists of designated representatives from each TC. Where an application assignment dispute cannot be resolved by a post classifier, the post classifier will check the appropriate box on the form PTO-447A and forward the application to a designated panel member of the TC for decision. The decisions of the panel will be final. Request for reconsideration of the decision of the panel will be considered **ONLY** in the event that a TC has not had the opportunity to review the application prior to the decision from the panel. Reconsideration must be requested within 2 calendar weeks of the receipt in an art unit of a decision of the panel.

Every application, no matter how peculiar or confusing, must be assigned somewhere for examination. Thus, in contesting the assignment of an application, an examiner should point out another class that is thought to be a better place to classify the application, rather than simply arguing that the application does not fit the examiner's class.

Where an application is refused by the receiving art unit solely for reasons within the purview of the examining corps, e.g., propriety of a restriction requirement, timeliness of transfer, etc., and there is no dispute as to the classification of any claim, the application should be returned directly to the art unit that raised the issue using the appropriate line in Section II of the PTO-447A.

If an application contains both classification issues and examining corps issues, e.g., a dispute both as to the classification of claims and the propriety of restriction, the examining issues should be resolved first. If thereafter classification issues still need to be addressed, use of Form PTO-447A, as above, is appropriate. For the procedure in the classification groups for applications which contain examining corps issues, see MPEP § 903.08(e), paragraph 13.

The time limits for requesting or refusing transfer are as follows:

(A) In a new application, transfer must be requested within 2 calendar weeks of the TC receipt date of the application.

(B) In an amended application transfer must be requested within 2 calendar weeks of the TC receipt date of the amendment upon which the request for transfer is based.

(C) The time limit for refusal of a transfer request is 2 calendar weeks from the receipt of the transfer request in the receiving art unit.

Exceptions to these time limits are:

(A) All new applications (docketed and undocketed) transferred purely for security reasons.

(B) New reissue applications should be retained in the TC indicated by the notice of filing in the *Official Gazette* for 2 months following the notice before transfer.

(C) PCT applications and other special applications for which a different time limit is set by competent authority.

Failure to fill in the date on the form by either the originating examiner or the receiving examiner may result in the assignment of the application to his or her art unit.

If a request for transfer is not made or refused within the 2-week time limit, the art unit having physical possession of the application must keep it for purposes of examination. However, if the TC Directors having authority over the art units involved agree that strict adherence to the 2-week time limit would not provide the best examination for the application, they may waive the requirement.

The question of need for a restriction requirement does not influence the determination of transfer.

The regular messenger service may be used to effect the transfer of applications, except that applications filed under the Patent Cooperation Treaty and such other special applications designated by competent authority must be hand-carried throughout

the transfer process unless an established practice is in place for expediting the delivery of these applications. If an application is hand-carried at any stage of the transfer process, care must be taken to update the location of the application on the PALM system each time the application is moved.

FORM PTO-447A
(Rev. 3-98)

Staple to face of Application

U.S. DEPARTMENT OF COMMERCE
PATENT & TRADEMARK OFFICE**APPLICATION TRANSFER REQUEST FOR S.N.** _____**Section I. TRANSFER REQUEST BY** (PRINT NAME) _____

Date _____

TO: Art Unit _____

Class/sub _____

From: A.U. _____

Class _____

REASON:

Gatekeeper concurrence _____

Hand carried: Personally accepted by _____

Section II. DISPOSITION BY RECEIVING TC

A.U. _____

Date _____

☐ ACCEPTED BY RECEIVING T.C.**NOT ACCEPTED**☐ Forward to Post Classifier☐ Return to Originating Technology Center /AU _____**REASON:****DISPOSITION BY RECEIVING TC POST CLASSIFIER**☐ This dispute was resolved. Forward to Class/Sub _____ TC/AU _____ Post Classifier _____ Date _____

Concurring _____ Date _____

☐ This dispute was not resolved, forward to DISPUTE RESOLUTION PANEL**Post Classifier Assessment:**

Gatekeeper Concurrence _____

Section III. DISPOSITION BY DISPUTE RESOLUTION PANEL

Date _____

Panel Decision: Forward to Technology Center / Art Unit _____

Class/sub _____

REASON:

Panel Member _____

Concurring Panel Member _____

☐ This application **MAY** be returned to the dispute resolution panel if reconsideration is desired (use form 447R).☐ This application **MAY NOT** be returned to the dispute resolution panel. **THIS IS A FINAL DISPOSITION.**

903.08(e) General Guidelines Governing the Assignment of Non-provisional Applications for Examination

This section applies only to nonprovisional applications. It does not apply to provisional applications since such applications are not examined.

The following are only general guides, and exceptions frequently arise because of some unusual condition. Post classifiers as well as the patent examiners are confronted with an already existing classification made up of newly revised classes, those revised years ago and which have somewhat outgrown their definitions and limits, and still others made a generation ago and never changed. Also, these classes are based on different theories and plans, some on art, some on structure, some on functions, some on the material worked upon, and some apparently on no theory or plan at all. The post classifiers cannot change this existing condition as each application comes up for assignment, but must seek to place the cases into this patchwork and try to get the applications where they will be best handled. An application will be assigned as follows:

(A) The assignment of nonprovisional applications follows, as far as possible, the rules or principles governing the classification of patents. Applications are assigned, as far as possible, on the basis of the original classification of the application.

(B) The criteria by which the original classification is determined are set forth in MPEP § 903.07.

(C) The claims and statement of invention are generally taken as they read; however, claims must be read in light of the disclosure (claimed disclosure). Any attempt of a post classifier to go behind the record and decide the case upon what is deemed the "real invention" would, it is believed, introduce more errors than such action would cure. The post classifiers cannot possess the specific knowledge of the state of the art in all the classes that the patent examiners collectively possess. Further, such questions are matters of merit for the examiners to determine and are often open to argument and are subject for appeal.

(D) Within a class, the first coordinate subclass that will take any claim controls classification.

(E) As stated in MPEP § 903.07, the location of the United States patents constituting the prior art is generally controlling over all else. (Note: Where time permits, obvious misplacements of the patents constituting the prior art are corrected, but to straighten all lines as the cases come up for assignment would require the time of several people and would often involve a reclassification of an entire class.)

(F) Ordinarily, an application cannot be assigned to a class which includes one element or part only of several claimed in combination. The claim is treated in its entirety. The question of aggregation is not reviewed by the post classifiers.

(G) The post classifiers are authorized in all cases, where they evaluate the facts as warranting it, to assign applications for examination to the Technology Center (TC) best able to examine the same. Since assignment for examination on this basis will at times be contrary to classification of patents containing the same character of claims, the post classifiers will indicate the proper classification of the patent, if such claims are allowed.

Thus, in cases where there is a claim drawn to hybrid or mixed subject matter and the supervisory patent examiner in one discipline feels that the application requires consideration by, or may be best examined by, a TC in one of the other technical disciplines, chemical, electrical, or mechanical, he or she may submit the application to his or her post classifier who *may* assign the application on a "best examinable" basis, in accordance with this subsection.

Some examples of applications which may be thus submitted include the following:

(1) An application containing a hybrid claim wherein, for instance, a product is defined merely in terms of the process for producing it. See MPEP § 705.01(e), situation (A).

(2) Where an application properly assigned to a mechanical or electrical class contains at least one claim to mixed subject matter, a part of which is chemical, the application *may* be assigned to the appropriate chemical art unit for examination; or where the application is properly assigned to a mechanical class and a claim therein contains electrical subject matter, the application *may* be assigned to the appropriate electrical art unit for examination.

As indicated earlier, when an application which had been assigned for examination in accordance with this subsection ultimately is allowed, it will be classified according to the controlling claim. In effect, assignment for examination may be on a "best examinable" basis, but the patent will issue and be classified according to the rules of superiority in classification; thus, the search file will have a constant set of rules governing placement of patents therein.

Where an application is being reassigned from one examining discipline to another, under the provisions of the "best examinable" practice, the post classifiers are authorized to require the first or transferring examiner to cite references pertinent to the claimed features falling under the jurisdiction of the art within his or her discipline. In those cases wherein the application of the reference(s) is not evident or clear, the transferring examiner should include a brief statement explaining the relation and possible application of the reference(s) to the claim(s); in case of dispute as to the necessity of this procedure, the post classifier has power to require the statement.

(H) See MPEP § 903.08(b) for a discussion of how to properly assign PCT international applications and U.S. national applications associated therewith.

(I) When an application has been taken up by an examiner for action and a requirement to restrict is found necessary, a part of the claims being directed to matter classifiable in the TC where the case is being examined, an action requiring restriction should be made without seeking a transfer of the case to another TC. The action of the applicant in reply to the requirement for restriction may result in making a transfer of the application unnecessary.

(J) Ordinarily, where all the claims of an application are for an article made of a specific composition or alloy with no other structure of the article recited, the application will be assigned to the composition or alloy class.

(K) A class of cases exists in which either no art or a divided art is found and in which no rule or principle is involved. Such cases are placed where, in the judgment of the post classifiers, they will be best searched and adjudicated. It is often impossible to so explain a decision in this class of cases as to satisfy, or in any way aid, the examiners interested. Indeed, the reasons for or against sending such cases one place or

another may be so evenly balanced that no reason of any value can be given.

(L) An examiner seeking the transfer of a case may make a search, both of his or her own class and the class to which he or she thinks the case should be transferred, and the examiner in charge of the art unit should exhibit the result of such search to the appropriate Classification Unit. This is the way the expert knowledge of the examiners involved is utilized.

(M) When an application is received in the Classification Unit in which there is a matter under dispute which is not related to the classification of a claim but which is in the purview of the examining corps, e.g., propriety of a restriction requirement, timeliness of submission for transfer, etc., as well as a dispute over the classification of claims, the application will be treated as follows.

The classifier will check the appropriate box on the PTO-447A indicating that the application is being returned (but not assigned) to the TC that originated the transfer in order to resolve the nonclassifying issues involved. The classifier will indicate on the PTO-447A the proper classification of any claims under dispute. If any claims under dispute are outside the jurisdiction of the classifier associated with the originating TC, that classifier will obtain concurrence of an SPE or designated examiner/classifier having jurisdiction of the claims in question, who will sign the PTO-447A as the concurring classifier. Multiple concurrences may be required for an application with claims classifiable in different art areas.

It is important that newly received applications be immediately screened for these situations so that, if necessary, the applications may be promptly returned to the originating TC.

If after resolution of the nonclassifying issues there is still a dispute as to which TC should examine the application, the originating application may be returned to classification for assignment.

903.08(f) Post Classifier's Decision

A post classifier decides the question of the proper classification of the application, and either (1) returns the application to the TC which submitted it if he or she denied the transfer request, or (2) forwards the application to the TC to which it is transferred. See also MPEP § 903.10.

903.08(g) Transfer to Another Technology Center After Decision

If the application is to remain in the Technology Center (TC) which submitted it for classification, no further procedure is necessary. If the application is assigned to another TC, the Classification Unit processes the application as described in the Manual of Clerical Procedures.

If the application is one which has been taken up for action by an examiner according to its effective filing date, it should be treated as special by any examiner, Art Unit, or TC to which it is transferred. See MPEP § 708.01.

903.09 International Classification of Patents for Inventions

In accordance with the Strasbourg Agreement Concerning the International Patent Classification, the United States is required to indicate on its issuing documents the classification symbols of the International Patent Classification 1999 (Seventh Edition), hereinafter referred to as "Int. Cl.⁷."

The complete Int. Cl.⁷ symbols must be placed in the indicated space on the face of the file wrapper (or on the Issue Classification Slip (form PTO-270) for series 08/ and earlier applications) when an application is issued.

INT. Cl.⁷ LAYOUT

The layout of the Int. Cl.⁷ is explained below with reference to the sample page.

Section

The Classification represents the whole body of knowledge which may be regarded as proper to the field of patents for invention, divided into eight sections.

(A) *Section Symbol* — Each section is designated by one of the capital letters A through H.

(B) *Section Title* — The section title is to be considered as a very broad indication of the contents of the section. The eight sections are entitled as follows:

- A. Human Necessities
- B. Performing Operations; Transporting
- C. Chemistry; Metallurgy
- D. Textiles; Paper
- E. Fixed Constructions
- F. Mechanical Engineering; Lighting; Heating; Weapons; Blasting
- G. Physics
- H. Electricity

(C) *Contents of Section* — Each section title is followed by a summary of the titles of its main subdivisions.

(D) *Subsection* — Within sections, informative headings form subsections, which are titles without classification symbols.

Example: Agriculture

Class

Each section is subdivided into classes.

(A) *Class Symbol* — Each class symbol consists of the section symbol followed by a two digit number.

Example: A 01

(B) *Class Title* — The class title gives an indication of the content of the class.

Example: A 01 Agriculture; Forestry; Animal Husbandry; Hunting; Trapping; Fishing

Subclass

Each class comprises one or more subclasses.

(A) *Subclass Symbol* — Each subclass symbol consists of the class symbol followed by a capital letter.

Example: A 01 B

(B) *Subclass Title* — The subclass title indicates as precisely as possible the content of the subclass.

Example: A 01 B Soil Working in Agriculture or Forestry; Parts, Details, or Accessories of Agricultural Machines or Implements, in General

(C) *Subclass Index* — Some subclasses have an index which is merely an informative summary giving a broad survey of the content of the subclass.

Group

Each subclass is broken down into subdivisions referred to as "groups," which are either main groups or subgroups.

(A) *Group Symbol* — Each group symbol consists of the subclass symbol followed by two numbers separated by an oblique stroke.

(B) *Main Group Symbol* — Each main group symbol consists of the subclass symbol followed by a one to three digit number, the oblique stroke, and the number 00.

Example: A 01 B 1/00

(C) *Main Group Title* — The main group title defines a field of subject matter considered to be useful in searching for inventions.

Example: A 01 B 1/00 Hand tools

(D) *Subgroup Symbol* — Subgroups form subdivisions under the main groups. Each subgroup symbol consists of the subclass symbol followed by the one to three digit number of its main group, the oblique stroke, and a number of at least two digits other than 00.

Example: A 01 B 1/02

Any third or fourth digit after the oblique stroke is to be read as a decimal subdivision of the second or third digit, respectively; e.g. 3/426 is to be read as "three slash forty-two point six", not three slash four hundred and twenty six and is to be found after 3/42 and before 3/43, and 5/1185 is to be read as "five slash eleven point eight five," and is to be found after 5/118 and before 5/119.

(E) *Subgroup Title* — The subgroup title defines a field of subject matter within the scope of its main group considered to be useful in searching for inventions. The title is preceded by one or more dots indicating the hierarchical position of the subgroup, i.e., indicating that each subgroup forms a subdivision of the nearest group above it having one dot less. The subgroup title is often a complete expression, in which case it begins with a capital letter. A subgroup title begins with a lower case letter if it reads as a continuation of the title of the next higher, less-indented group, i.e., having one dot less. **In all cases, the subgroup title must be read as being dependent upon,**

and restricted by, the title of the group under which it is indented.

Examples

A 01 B 1/00 1/24	Hand tools for treating meadows or lawns (The title of 1/24 is to be read as: Hand tools for treating meadows or lawns.)
A 01 B 1/00 1/16	Hand tools Tools for uprooting weeds (The title of 1/16 is a complete expression, but owing to its hierarchical position, the tools for uprooting weeds are restricted to hand tools.)

Complete Classification Symbol

A complete classification symbol comprises the combined symbols representing the section, class, subclass, and main group or subgroup.

Example:				
A	01	B	1/00	Main group
Section	Class		or	
		Subclass	1/16	Subgroup
				Group

Guide Headings

The main groups in each subclass are arranged in a sequence intended to assist the user. It has not however, been found practicable to standardize the sequence. Where several successive main groups relate to common subject matter, it is usual to provide before the first of such main groups a "guide heading" which is underlined, indicating this subject matter (see, for example, the guide heading "Ploughs" before group A 01 B 3/00). The series of groups covered by such a heading extends to the next guide heading or to a line in heavy type extending across the column, which is used when the following group or groups relate to different subject matter for which no

guide heading is provided. (See, for example, the line after A 01 B 75/00.)

CLASSIFYING IN THE INT. CL.⁷ SYSTEM

A. *Selecting Subclasses Corresponding to U.S. Classes*

The effective scope of a subclass is defined by the following, taken together:

(A) The subclass title which describes, as precisely as is possible in a small number of words, the main characteristic of a portion of the whole body of knowledge covered by the Classification, this portion being the field of the subclass to which all its groups relate;

(B) Any references which follow the subclass title or the hierarchically higher class title. These references often indicate certain parts of the field described by the title which are covered by other subclasses and are therefore excluded. These parts may constitute a substantial part of the field described by the title and, thus, the references are in some respects as important as the title itself. For example, in subclass A 47 D — FURNITURE SPECIALLY ADAPTED FOR CHILDREN — a considerable part, namely school benches or desks, of the subject matter covered by the title is excluded in view of a reference to particular groups of subclass A 47 B, thus considerably altering the scope of subclass A 47 D;

(C) Any references which appear in groups or guide headings of a subclass and which refer subject matter to another class or subclass may also affect the scope of the subclass in question. For example, in subclass B 43 K — INSTRUMENTS FOR WRITING; DRAWING-PENS — writing points for indicating or recording apparatus are referred out of group 1/00 to group 15/16 of subclass G 01 D, thereby reducing the scope of the subject matter covered by the title of subclass B 43 K;

(D) Any notes or definitions appearing under the subclass title or its class, subsection or section title. Such notes or definitions may define terms or expressions used in the title, or elsewhere, or clarify the rela-

tion between the subclass and other places. Examples are

(1) Note (1) appearing under the title of the subsection "ENGINES OR PUMPS," embracing classes F 01 to F 04, which notes define the terms used throughout the subsection,

(2) the notes appearing under the title of subclass F 01 B, which define its scope in relation to subclasses F 01 C to F 01 P, and

(3) the note following the title of section C which defines groups of elements.

B. *Selecting Main Groups Corresponding to U.S. Mainline Subclasses*

The scope of a main group is to be interpreted only within the effective scope of its subclass (as indicated above). Subject to this, the effective scope of a main group is determined by its title as modified by any relevant references or notes associated with the main group or with any guide heading covering it. For example, a group for "bearings" in a subclass whose title is limited to a particular apparatus must be read as covering only features of bearings peculiar to that apparatus, e.g., the arrangement of bearings in the apparatus. Guide headings are intended to be only informative and, as a rule, do not modify the scope of the groups covered by them, except where it is otherwise clear from the context. By contrast, references in the guide headings modify the scope of the associated groups.

C. *Selecting Subgroups Corresponding to U.S. Indented Subclasses*

The scope of a subgroup is likewise to be interpreted only within the effective scope of its main group and of any subgroup under which it is indented. Subject to this, the scope of a subgroup is determined by its title as modified by any relevant references or notes associated therewith.

See volume 9 of the International Patent Classification, entitled "Guide, Survey of Classes and Summary of Main Groups" for detailed procedures for classifying into and searching Int. Cl.⁷.

	A 01 B	SAMPLE PAGE		
		AGRICULTURE		Subsection title
Class symbol	A 01	AGRICULTURE; FORESTRY; ANIMAL HUSBANDRY; HUNTING; TRAPPING; FISHING		Class title
Subclass symbol	A 01 B	SOIL WORKING IN AGRICULTURE OR FORESTRY; PARTS, DETAILS, OR ACCESSORIES OF AGRICULTURAL MACHINES OR IMPLEMENTS, IN GENERAL (making or covering furrows or holes for sowing, planting or manuring A 01 C 3/00; machines for harvesting root crops A 01 D; snows or convertible to soil working apparatus or capable of soil working A 01 D 42/04; mowers combined with soil working implements A 01 D 43/12; soil working for engineering purposes E 01, E 02, E 21)		Subclass title
		Subclass Index		References following subclass title
Subclass index		<p>HAND TOOLS 1/00</p> <p>PLOUGHS</p> <p>General construction 3/00, 5/00, 9/00, 11/00</p> <p>Special adaptations 13/00, 17/00</p> <p>Details 15/00</p> <p>HARROWS</p> <p>General construction 19/00, 21/00</p> <p>Special applications 25/00</p> <p>Details 23/00</p>	<p>IMPLEMENTS USABLE EITHER AS PLOUGHS OR AS HARROWS OR THE LIKE 7/00</p> <p>OTHER MACHINES 27/00 to 45/00, 49/00, 77/00</p> <p>ELEMENTS OR PARTS OF MACHINES OR IMPLEMENTS 59/00 to 71/00</p> <p>TRANSPORT IN AGRICULTURE 51/00, 73/00, 75/00</p> <p>PARTICULAR METHODS FOR WORKING SOIL 47/00, 79/00</p>	
Main group title				Reference following main group title
Main group symbol	1/00	Hand tools (edge trimmers for lawns A 01 G 3/06)	3/24	Tractor-drawn ploughs (3/04 takes precedence)
	1/02	Spades; Shovels	3/26	without alternating possibility
	1/04	with teeth	3/28	Alternating ploughs
	1/06	Hoes; Hand cultivators	3/30	Turn-wrest ploughs
	1/08	with a single blade	3/32	Balance ploughs
	1/10	with two or more blades	3/34	with parallel plough units used alternately
	1/12	with blades provided with teeth	3/36	Ploughs mounted on tractors
	1/14	with teeth only	3/38	without alternating possibility
Subgroup symbols	1/16	Tools for uprooting weeds	3/40	Alternating ploughs
Subgroup title	1/18	Long-like tools	3/42	Turn-wrest ploughs
	1/20	Combinations of different kinds of hand tools	3/421	with a headstock frame made in one piece [2]
	1/22	Attaching the blades or the like to handles (handles for tools, or their attachment, in general B 25 G); interchangeable or adjustable blades	3/426	with a headstock frame made of two or more parts [2]
	1/24	for treating meadows or lawns [2]	3/44	with parallel plough units used alternately
Guide heading		Ploughs	3/46	Ploughs supported partly by tractor and partly by their own wheels
	3/00	Ploughs with fixed plough-shares	3/50	Self-propelled ploughs
	3/02	Man-driven ploughs	3/52	with three or more wheels, or endless tracks
	3/04	Animal-drawn ploughs	3/54	without alternating possibility
	3/06	without alternating possibility, i.e. incapable of making an adjacent furrow on return journey	3/56	Alternating ploughs
	3/08	Swing ploughs	3/58	with two wheels
Subgroup title with two-part wording	3/10	Trussed-beam ploughs; Single-wheel ploughs	3/60	Alternating ploughs
	3/12	Two-wheel beam ploughs	3/62	Balance ploughs
	3/14	Frame ploughs	3/64	Cable ploughs; Indicating or signalling devices for cable plough systems
	3/16	Alternating ploughs, i.e. capable of making an adjacent furrow on return journey	3/66	with motor-driven winding apparatus mounted on the plough
	3/18	Turn-wrest ploughs	3/68	Cable systems with one or two engines
	3/20	Balance ploughs	3/70	Systems with one engine for working uphill
	3/22	with parallel plough units used alternately	3/72	Means for anchoring the cables
			3/74	Use of electric power for propelling ploughs (electric current collectors B 60 L 5/00)
				Reference following subgroup title

U.S. INT. CL.⁷ CONCORDANCE, 1999

The Office of International Patent Classification has prepared a revised Concordance between the U.S. classes and subclasses and the Int. Cl.⁷. In many areas, the two systems are conceptually different. With this in mind, it will be seen that a complete one-to-one correspondence between the two systems cannot be attained. An indication in the Concordance may refer to only one relevant group and not necessarily the only group in which the patent can or should be classified. For some inventions, the Concordance may not indicate any truly relevant group. Accordingly, the Concordance must be recognized as a *guide* to be used in conjunction with the Int. Cl.⁷, and *not* as a translation list.

The printed version of the 1999 Concordance includes all changes in the International Classification corresponding to changes in the United States Classification through August 1999. The electronic Concordance is updated monthly, and is available to USPTO personnel online from the "Patent Examiner's Toolkit" toolbar.

The Concordance may be incomplete or contain errors in some areas. Therefore, if corrections need to be made in the Concordance, members of the examining corps are requested to e-mail suggested changes to the International Liaison Staff (ILS) via their SPE.

903.09(a) Locarno Classification Designations

U.S. design patents prepared for issue after June 30, 1996 include a Locarno International Classification designation as part of the bibliographic data. The purpose of the international design classification designation is to enhance accessibility of design patents in foreign design search files as well as commercial databases.

The Locarno International Classification system was developed by members of the Paris Convention for the Protection of Industrial Property and is administered by the International Bureau of the World Intellectual Property Office (WIPO).

A Locarno International Classification designation consists of two pairs of numbers separated by a hyphen. The first pair of numbers designates a design class; the second pair of numbers indicates a particular subclass within the design class. The Locarno

Classification manual, available from WIPO, delineates the individual classes and subclasses and includes: (1) a general list of classes of industrial designs divided into broad subclasses; and (2) an alphabetical list of specific industrial designs with an indication of the classes and subclasses into which they should be classified.

The Locarno designation included with design patent bibliographic data indicates the original classification of the patented design only. There is no provision for cross-reference designations within the Locarno system.

Locarno International Classifications are periodically revised by the Committee of Experts of the World Intellectual Property Organization. The present (seventh) edition of the system which incorporates all the revisions in and before November 1998 became effective on January 1, 1999.

The design patent issue slip (PTO-328) includes an area with the heading "International Classification". A Locarno International Classification designation must be included on the issue slip when a design application is prepared for issue. The Locarno designation is printed on the design patent preceded by INID code [51] in compliance with ST.9 of the International Bureau. The abbreviation "LOC (7) CL." follows INID code [51] and complies with the recommended abbreviation by the International Bureau.

An example Locarno designation as it appears on a U.S. Design Patent is as follows:

[51] LOC (7) CL. 02-02

The Office of International Patent Classification has prepared a Concordance between the U.S. Design Classification classes and subclasses and the seventh edition of the Locarno International Classification. In many areas of design subject matter, the U.S. Design Classification and Locarno Classification systems are parallel. In others, the two systems are conceptually different. For example, there is no specific provision within the Locarno system for designs which are simulative of other objects. The International Classification is generally based on the nature of the design rather than ornamental appearance. Accordingly, a one-to-one relationship between the two classification systems is not always possible.

Each suggested designation in the Concordance refers to a single Locarno International class and sub-

class. This designation, however, is not necessarily the only pertinent class and subclass in which the design could be properly classified since for some U.S. Design Classification designations, there is no direct parallel within the Locarno system.

903.10 Duties of the Post Classifier

Examiners should contact their post classifier on all classification problems.

A post classifier is responsible for:

(A) The technical accuracy, adequacy, and completeness of all search systems in his or her group including the monitoring of any need for major and minor reclassification projects including mechanized systems.

(B) The full range of classification administration functions, including the resolution of classification disputes on pending applications, guidance on classification matters to both examiners and the public, outlining fields of search, and answering examiners' requests for advice as to the proper classification of allowed applications.

(C) The inspection of issuing applications to determine the accuracy and adequacy of original and cross-reference classification, including working closely with the supervisory patent examiners and Technology Center (TC) Directors to ensure feedback to correct problem areas.

(D) Determination of the training needs of the personnel in his or her assigned group relative to principles of classification and supplying this training through formal and informal channels.

Generally, the post classifiers are to aid the examiners in the use, maintenance, and perfection of the classification system.

904 How to Search

The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art as disclosed in patents and other published documents, i.e., nonpatent literature (NPL). Any document used in the rejection of a claim is called a reference.

In all continuing applications, the parent applications should be reviewed by the examiner for pertinent prior art. Where the cited prior art of a parent application has been reviewed, this fact should be made of record in accordance with the procedure set forth at paragraph II.(E) of MPEP § 719.05.

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

In the first action on the merits of an application, the examiner shall make an initial endorsement in black ink, in the space provided on the right outside panel of the file wrapper, of the classes and subclasses of domestic and foreign patents, abstract collections, and publications in which the search for prior art was made. Other information collections and sources in which the search for prior art was made must also be identified by the examiner. The examiner must also indicate the date(s) on which the search was conducted. Note MPEP § 719.05.

In subsequent actions, where the search is brought up to date and/or where a further search is made, the examiner must endorse and initial on the file wrapper that the search has been updated and/or identify the additional field of search. See MPEP § 719.05. Any search updates should include all of the databases and the search queries and classifications employed in the original search.

904.01 Analysis of Claims

The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do *not* call for, as well as what they do require. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 2111 - § 2116.01 for case law pertinent to claim analysis.

904.01(a) Variant Embodiments Within Scope of Claim

Substantially, every claim includes within its breadth or scope one or more variant embodiments that are not disclosed in the application, but which would anticipate the claimed invention if found in a reference. The claim must be so analyzed and any such variant encountered during the search should be recognized.

In each type of subject matter capable of such treatment (e.g., a machine or other apparatus), the subject matter as defined by the claim may be sketched or diagrammed in order to clearly delineate the limitations of the claim. Two or more sketches, each of which is as divergent from the particular disclosure as is permitted by claim recitation, will assist the examiner in determining the claim's actual breadth or scope. However, an applicant will not be required to submit such sketches of claim structure. *In re Application filed November 16, 1945*, 89 USPQ 280, 1951 C.D. 1, 646 O.G. 5 (Comm'r Pat. 1951).

904.01(b) Equivalents

All subject matter that is the equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. See MPEP § 2181 - § 2184 for a discussion of equivalents when a claim employs means or step plus function terminology.

904.01(c) Analogous Arts

Not only must the art be searched within which the invention claimed is classifiable, but also all analogous arts regardless of where classified.

The determination of what arts are analogous to a particular claimed invention is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called by the applicant.

For example, for search purposes, a tea mixer and a concrete mixer may both be regarded as relating to the mixing art, this being the necessary function of each. Similarly a brick-cutting machine and a biscuit cutting machine may be considered as having the same necessary function. See MPEP § 2141.01(a) for a discussion of analogous and nonanalogous art in the con-

text of establishing a *prima facie* case of obviousness under 35 U.S.C. 103. See MPEP § 2131.05 for a discussion of analogous and nonanalogous art in the context of 35 U.S.C. 102.

904.02 General Search Guidelines

In the examination of an application for patent, an examiner must conduct a thorough search of the prior art. Planning a thorough search of the prior art requires three distinct steps by the examiner: (A) identifying the field of search; (B) selecting the proper tool(s) to perform the search; and (C) determining the appropriate search strategy for each search tool selected. Each step is critical for a complete and thorough search.

When determining the field of search, three reference sources must be considered - domestic patents (including patent application publications), foreign patent documents, and nonpatent literature (NPL). None of these sources can be eliminated from the search unless the examiner has and can justify a reasonable certainty that no references, more pertinent than those already identified, are likely to be found in the source(s) eliminated. The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed. The field of search should be prioritized, starting with the area(s) where the invention would most likely be found in the prior art.

Having determined the field of search, the examiner should then determine what search tools should be employed in conducting the search. Examiners are provided access to a wide variety of both manual and automated search tools. Choice of search tools is a key factor in ensuring that the most relevant prior art is found during the search. The choice of search tools to be used is based on the examiner's knowledge of the coverage, strengths and weaknesses of the available search tools that are appropriate for use in an examiner's assigned art. For example, a search tool may cover foreign patent documents; but, if that coverage does not meet the examiner's current search needs, this should be taken into consideration by the examiner who will take recourse to employ other search tools in order to remedy the deficiency.

Search tool knowledge is particularly important for examiners in arts (e.g., very active, high technology) where patent documents may seriously lag invention

and, consequently, represent a reference source of limited value. These examiners must take special care to ensure that their searches include consideration of NPL and employ the effective use of tools specialized to cover NPL pertinent to their search needs.

Search needs in some technologies, e.g., chemical structures, DNA sequences, are very specialized and can only be met through use of specific search tools specially constructed and maintained to respond to those needs. These tools cover all three reference sources - domestic patents (including patent application publications), foreign patent documents, and NPL - and their use may be deemed sufficient for search of claimed inventions in such technologies.

In recognition that there are many available NPL search tools and their use is often complex, examiners have been provided and are encouraged to use the services of trained professional on-line search personnel located in the Technology Centers (Information Technology Resource Person (ITRP)) and in the Scientific and Technical Information Center (STIC) for NPL searching. See MPEP § 901.06(a) for services available in STIC.

In crowded, highly developed arts where most claimed inventions are directed to improvements, patent documents, including patent application publications, may serve as the primary reference source. Search tool selection in such arts may focus heavily on those providing patent document coverage.

Automated search tools covering patent documents usually provide both a classified and text search capability. Text search can be powerful, especially where the art includes well-established terminology and the search need can be expressed with reasonable accuracy in textual terms. However, it is rare that a text search alone will constitute a thorough search of patent documents. Some combination of text search with other criteria, in particular classification, would be a normal expectation in most technologies.

Examiners will recognize that it is sometimes difficult to express search needs accurately in textual terms. This occurs often, though not exclusively, in mechanical arts where, for example, spatial relationships or shapes of mechanical components constitute important aspects of the claimed invention. In such situations, text searching can still be useful by employing broader text terms, with or without classification parameters. The traditional method of brows-

ing all patent documents in one or more classifications will continue to be an important part of the search strategy when it is difficult to express search needs in textual terms.

Having determined what search tool(s) should be used to conduct the search, the examiner should then determine the appropriate search strategy for each search tool selected. The appropriate search strategy should be determined by the examiner on a case-by-case basis along with consultation with other examiners and/or supervisory patent examiners, where appropriate.

In order for examiners to acquire specialized skills needed to determine an appropriate field of search in their specific arts, each Technology Center may develop supplemental specific guidance and training for its examiners. This training will augment general training and information on search tools that is normally provided through the Patent Academy and Search and Information Resources Administration.

904.02(a) Classified Search

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified. It is not necessary to search areas in which it could reasonably have been determined that there was a low probability of finding the best reference(s).

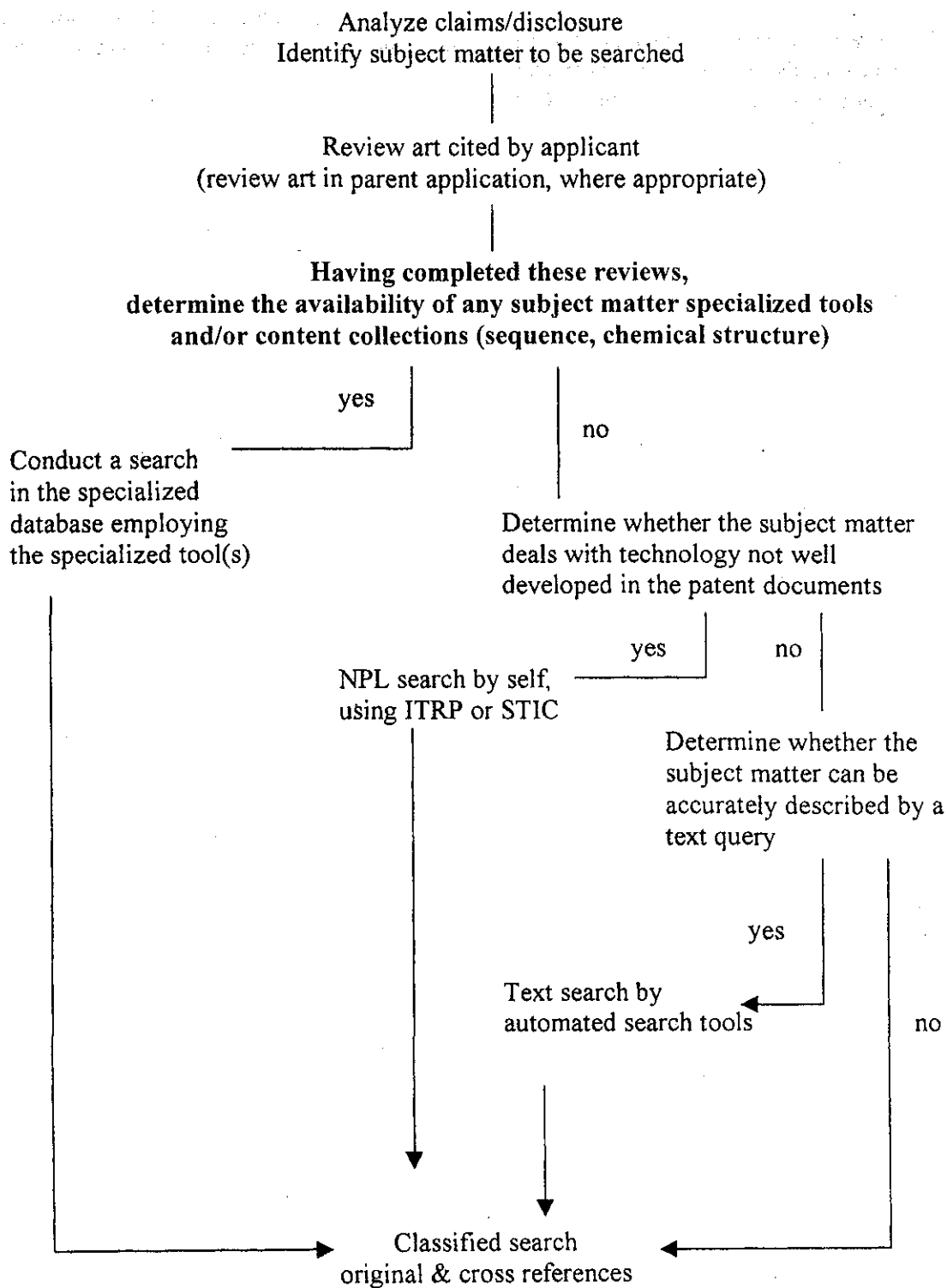
In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross-reference art collection pertinent to each type of invention claimed should be included, from the largest combination through the various subcombinations to the most elementary part. The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed. The examiner should consult with other examiners and/or supervisory patent examiners, especially with regard to applications covering subject matter unfamiliar to the examiner.

The areas to be searched should be prioritized so that the most likely areas of finding relevant prior art are searched first.

904.02(b) Search Tool Selection

Detailed guidance on the choice and use of specific search tools can be established only within the context of the special requirements of each Technology Cen-

ter (TC). However, a general methodology following a "decision tree" process, set forth below, for making broad decisions in search tool selection is suggested.



904.02(c) Internet Searching

The Office published a Patent Internet Usage Policy to establish a policy for use of the Internet by the Patent Examining Corps and other organizations within the USPTO. See *Internet Usage Policy*, 64 F.R. 33056 (June 21, 1999). The Articles of the Patent Internet Usage Policy pertinent to Internet searching and documenting search strategies are reproduced below. See MPEP § 707.05(e) for information pertaining to the citation of electronic documents and MPEP § 502.03 for information pertaining to communications via electronic mail.

INTERNET SEARCHING (ARTICLE 9)

The ultimate responsibility for formulating individual search strategies lies with individual Patent Examiners, Scientific and Technical Information Center (STIC) staff, and anyone charged with protecting proprietary application data. When the Internet is used to search, browse, or retrieve information relating to a patent application which has not been published, other than a reissue application or reexamination proceeding, Patent Organization users **MUST** restrict search queries to the general state of the art unless the Office has established a secure link over the Internet with a specific vendor to maintain the confidentiality of the unpublished patent application. Non-secure Internet search, browse, or retrieval activities that could disclose proprietary information directed to a specific application which has not been published, other than a reissue application or reexamination proceeding, are **NOT** permitted.

This policy also applies to use of the Internet as a communications medium for connecting to commercial database providers.

DOCUMENTING SEARCH STRATEGIES (ARTICLE 10)

All Patent Organization users of the Internet for patent application searches shall document their search strategies in accordance with established practices and procedures as set forth in MPEP § 719.05 II.(F).

904.03 Conducting the Search

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an

application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious.

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The examiner is not called upon to cite *all* references that may be available, but only the "best." (37 CFR 1.104(c).) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided. The examiner must fully consider all the prior art references cited in the application, including those cited by the applicant in a properly submitted Information Disclosure Statement.

The best reference should always be the one used. Sometimes the best reference will have a publication date less than a year prior to the application filing date, hence it will be open to being overcome under 37 CFR 1.131. In these cases, if a second reference exists which cannot be so overcome and which, though inferior, is an adequate basis for rejection, the claims should be *additionally* rejected thereon.

In all references considered, including nonpatent, foreign patents, and domestic patents, the examiner should study the specification or description suffi-

ciently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

905 Miscellaneous

905.02 Soft Copy Orders

Soft copies of U.S. patents for the examiner's personal use may be ordered by the examiner on blue-colored order form PTO-14A. These copies are not to be placed in the official search file. To complete the form PTO-14A, the examiner should indicate the number of copies desired in the box marked "NO. OF COPIES" and should also complete the "PATENT NUMBER," "EXAMINER'S NAME," "ART UNIT," and "DATE OF ORDER" boxes.

When soft copies for more than three different patent numbers are desired, the examiner can prepare a list of the patent numbers and attach it to one copy of Form PTO-14A which has been completed to reflect the Examiner's Name, Art Unit, and Date of Order.

To expedite the handling of requests for personal copies and thereby ensure the quickest response, the following routing procedures should be adhered to:

(A) Designated collection drops within each Technology Center (TC) for copy orders should be used.

(B) Clerical personnel from the Office of Classification Support (OCS) will visit designated collection drops at least twice each week to pick up PTO-14 orders.

Alternatively, the orders may be mailed or otherwise delivered to the Contract Support Unit, currently located in Crystal Park, Building 2, Room 105.

The attorneys' drop slot at the Customer Service Window should not be used nor should the forms be mailed to Copy Fulfillment Services as consequent rerouting to the Office of Classification Support for processing will result in unnecessary delay.

Copies provided for personal use will be stamped "DO NOT PLACE IN SEARCH FILE;" any such copy found in the search file will be removed by refiling personnel. Because of the cost of printing copies of patents, economy should be exercised in their use. Personal use soft copies no longer desired by examiners should be destroyed.

In view of the high cost of printing patents with color drawings, orders by examiners for plant patents and other patents with color drawings for personal use will normally not be filled.

A	PATENT NUMBER	NO. OF COPIES
	2,345,678	1
USE A SEPARATE ORDER FORM FOR EACH PATENT NUMBER		
EXAMINER'S NAME	ART UNIT	DATE OF ORDER
HENRY GREEN	3502	10-15-78
EXAMINER'S NOTES		
<div style="display: flex; justify-content: space-between; font-size: small;"> PTO-14A (REV. 5-76) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE </div>		
PATENT ORDER FOR EXAMINER'S USE ONLY		

905.03 Ordering of Patented and Abandoned Provisional and Nonprovisional Application Files

In the examination of an application it is sometimes necessary to inspect the application papers of some previously abandoned application (provisional or non-provisional) or granted patent. This is always true in the case of a reissue application and reexamination proceeding.

Patented and abandoned files are stored at the Files Repository located near the other USPTO buildings in Crystal City (Arlington, Virginia). Older files are housed in remote warehouses located in Maryland and Virginia.

Patented and abandoned files are ordered by means of a PALM video display or PALM intranet site transaction. To place such an order, the examiner is required to input his/her PALM location code, employee number, and patent number(s) and/or application number(s) of the file(s) that are needed. After transmission of the request transaction by the examiner, a "response" screen appears on the video display terminal or workstation browser which informs

him/her of the status of the request for each file. The examiner is informed that the request

(A) is accepted;

(B) is accepted, but for which the file is located at a remote warehouse (in which case delivery time is increased);

(C) is not accepted because the file is not located at the repository or warehouse;

(D) is not accepted because a previous request for the file has not yet been filled; or

(E) is not accepted because the patent or application number inputted is not valid.

Periodically each day, personnel at the Files Repository perform a PALM print transaction which produces a list of all accepted requests in patent number order and, for requests for abandoned files, in application number order. The printed record of each request is detached from the list when its associated file is found. It is then stapled to it. Throughout the day, periodic deliveries of files are made directly to the offices of their requesters by Files Repository personnel. Upon delivery of files at the various locations, files that are ready to be returned to the repository are picked up.

With the exception of certain older files, the drawings of patented and abandoned files, if any, are now stored within their respective application file wrappers. Since it is desired not to separate one from the other, both the file and its drawings are delivered when a file is ordered.

905.04 Marking Examiners' Copies of Patents

When the examiners' copies of patents are sent to their respective art units to be filed, they should be routed across the appropriate examiners' desks prior to placement in the shoes. The assistant examiners who examined the application should mark in pencil on the face of the drawings, or the specifications where there are no drawings, such features as may be deemed advantageous in aiding understanding of the patents in future searches.

905.05 Application File Location

All files should be returned promptly to their proper location.

Whenever an application file is moved from one PALM location to another; e.g., removed from a Technology Center's (TC) central files or moved from one examiner to another, the PALM record should be updated with its current location. The appropriate bar code transaction should be performed. For example, if the examiner to whom the application is docketed obtains it, he/she should perform PALM transaction 1023 by pressing the F2 key on the bar code reader (BCR) and scanning the bar code label of the file with the light wand of the BCR. If an examiner other than the one to whom the application is docketed obtains the file, he/she should perform transaction 1036 which requires the input of his/her art unit number and his/her employee number before the label is scanned. All files should be returned promptly to their proper location.

905.06 Patent Family Information

Patent family information is available at the U.S. Patent and Trademark Office (Office) primarily through commercial databases. See MPEP § 901.05 regarding patent family. Examiners have access to this information either directly through the automated search tools such as the Examiner's Automated Search Tool (EAST) and the Web-based Examiner Search Tool (WEST) or indirectly through the search services of the Scientific and Technical Information Center (STIC).

AVAILABLE DATABASES

Derwent's World Patents Index (WPI) and International Patent Documentation Center (INPADOC) are two databases used for retrieving foreign patent information.

The WPI database is loaded in-house at the Office and is integrated with the Office's automated search system. WPI in-house is used whenever abstracts are needed or when searches in addition to publication date or patent family are required, such as searches on inventor name or IPC (International Patent Classification). WPI in-house is also the first choice for searches for publication dates or patent families because of its ease of use and low cost.

INPADOC is used for quick searches for publication dates or patent families. The Office enjoys cost effective rates for INPADOC due to an agreement between the Office and the International Patent Documentation Center (now part of the European Patent Office) negotiated several years ago. The agreement applies only to INPADOC as accessed directly on the INPADOC computer in Austria, not to INPADOC as available on other commercial database systems such as ORBIT, DIALOG, or STN.

ACCESS TO FOREIGN PATENT INFORMATION

Patent examiners may directly search WPI in-house or INPADOC or both.

Examiners may also request foreign patent searches through STIC. Trained searchers in both the Reference and Foreign Patents sections of STIC perform patent family searches on demand, with a short turnaround time. The Foreign Patents section can also help examiners get copies of foreign patents found through online searching.



Chapter 1000 Matters Decided by Various U.S. Patent and Trademark Office Officials

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1001.01 Modes of Exercising Authority

1002 Petitions to the Commissioner

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1002.02(s) Petitions and Matters Decided by the Special Program Examiners in the Technology Centers

1003 Matters Submitted to Technology Center Directors

1004 Actions Which Require the Attention of a Primary Examiner

1005 Exceptions to Partial Signatory Authority

1001 Statutory Authority of Commissioner

35 U.S.C. 2. Powers and duties.

(a) IN GENERAL.— The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

(1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and

(2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) SPECIFIC POWERS.— The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5, United States Code;

(C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1) of this title; and

(F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness;

(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)(A) may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provi-

sions of the Federal Property and Administrative Services Act of 1949 (40 U.S.C. 471 et seq.), the Public Buildings Act (40 U.S.C. 601 et seq.), and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.); and

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44, United States Code;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world;

(12)(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed \$100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies

and programs for advancing international cooperation concerning patents, trademarks, and other matters.

(c) CLARIFICATION OF SPECIFIC POWERS.—

(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

(d) CONSTRUCTION.— Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

35 U.S.C. 3. *Officers and employees.*

(a) UNDER SECRETARY AND DIRECTOR.—

(1) IN GENERAL.— The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) IN GENERAL.— The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES.— The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, United States Code, as the case may be.

(3) OATH.— The Director shall, before taking office, take an oath to discharge faithfully the duties of the Office.

(4) REMOVAL.— The Director may be removed from office by the President. The President shall provide notification of any such removal to both Houses of Congress.

(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

(1) DEPUTY UNDER SECRETARY AND DEPUTY DIRECTOR.— The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.

(2) COMMISSIONERS.—

(A) APPOINTMENT AND DUTIES.— The Secretary of Commerce shall appoint a Commissioner for Patents and a Commissioner for Trademarks, without regard to chapter 33, 51, or 53 of title 5, United States Code. The Commissioner for Patents shall be a citizen of the United States with demonstrated management ability and professional background and experience in patent law and serve for a term of 5 years. The Commissioner for Trademarks shall be a citizen of the United States with demonstrated management ability and professional background and experience in trademark law and serve for a term of 5 years. The Commissioner for Patents and the Commissioner for Trademarks shall serve as the chief operating officers for the operations of the Office relating to patents and trademarks, respectively, and shall be responsible for the management and direction of all aspects of the activities of the Office that affect the administration of patent and trademark operations, respectively. The Secretary may reappoint a Commissioner to subsequent terms of 5 years as long as the performance of the Commissioner as set forth in the performance agreement in subparagraph (B) is satisfactory.

(B) SALARY AND PERFORMANCE AGREEMENT.— The Commissioners shall be paid an annual rate of basic pay not to exceed the maximum rate of basic pay for the Senior Executive Service established under section 5382 of title 5, United States Code, including any applicable locality-based comparability payment that may be authorized under section 5304(h)(2)(C) of title 5, United States Code. The compensation of the Commissioners shall be considered, for purposes of section 207(c)(2)(A) of title 18, United States Code, to be the equivalent of that described under clause (ii) of section 207(c)(2)(A) of title 18, United States Code. In addition, the Commissioners may receive a bonus in an amount of up to, but not in excess of, 50 percent of the Commissioners' annual rate of basic pay, based upon an evaluation by the Secretary of Commerce, acting through the Director, of the Commissioners' performance as defined in an annual performance agreement between the Commissioners and the Secretary. The annual performance agreements shall incorporate measurable organization and individual goals in key operational areas as delineated in an annual performance plan agreed to by the Commissioners and the Secretary. Payment of a bonus under this subparagraph may be made to the Commissioners only to the extent that such payment does not cause the Commission-

ers' total aggregate compensation in a calendar year to equal or exceed the amount of the salary of the Vice President under section 104 of title 3, United States Code.

(C) REMOVAL.— The Commissioners may be removed from office by the Secretary for misconduct or unsatisfactory performance under the performance agreement described in subparagraph (B), without regard to the provisions of title 5, United States Code. The Secretary shall provide notification of any such removal to both Houses of Congress.

(3) OTHER OFFICERS AND EMPLOYEES.— The Director shall—

(A) appoint such officers, employees (including attorneys), and agents of the Office as the Director considers necessary to carry out the functions of the Office; and

(B) define the title, authority, and duties of such officers and employees and delegate to them such of the powers vested in the Office as the Director may determine.

The Office shall not be subject to any administratively or statutorily imposed limitation on positions or personnel, and no positions or personnel of the Office shall be taken into account for purposes of applying any such limitation

(4) TRAINING OF EXAMINERS.— The Office shall submit to the Congress a proposal to provide an incentive program to retain as employees patent and trademark examiners of the primary examiner grade or higher who are eligible for retirement, for the sole purpose of training patent and trademark examiners.

(5) NATIONAL SECURITY POSITIONS.— The Director, in consultation with the Director of the Office of Personnel Management, shall maintain a program for identifying national security positions and providing for appropriate security clearances, in order to maintain the secrecy of certain inventions, as described in section 181, and to prevent disclosure of sensitive and strategic information in the interest of national security.

1001.01 Modes of Exercising Authority

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of orders, notices and memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants; and by the designation of particular cases which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present Chapter deals with the latter two items.

37 CFR 1.181(g) states, "The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

The various delegations to various Office officials are set forth in this Chapter.

The delegations set forth in this Chapter do not confer a right to have a matter decided by a

specific Office official, rather, such delegations aid in the efficient treatment of petitions by the Office. A delegation of supervisory or higher level review authority over a matter carries with it the authority to decide the matter *ab initio*.

1002 Petitions to the Commissioner

37 CFR 1.181. Petition to the Commissioner.

(a) Petition may be taken to the Commissioner:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Commissioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.182. Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any

petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.183. Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

Petitions on appealable matters ordinarily are not entertained. See MPEP § 1201.

The mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings (37 CFR 1.181(f)). For example, if a petition to vacate a final rejection as premature is filed within 2 months from the date of the final rejection, the period for reply to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full reply to the rejection *within the period for reply*, the case is not abandoned.

37 CFR 1.181(f) provides that any petition under that rule which is not filed "within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely." Often, the "action or notice from which relief is requested," for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a 3-month period for reply. Under such circumstances, if applicant requests reconsideration, under 37 CFR 1.111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the 2-month period for filing the petition. The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period. The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided. A number of sections (e.g., 37 CFR 1.377, 37 CFR 1.378, 37 CFR 1.644, and 37 CFR 1.740) specify the time period within which a petition must be filed (or may be dismissed as untimely). The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not

specify the time period within which a petition must be filed. The 2-month period is not extendible under 37 CFR 1.136(a) since the time is within the discretion of the Commissioner.

Form paragraph 10.20 may be used where an insufficient fee was filed with a petition or a request.

¶ 10.20 Petition or Request Dismissed, Proper Fee Not Submitted

Applicant's petition or request under 37 CFR [1] filed [2] is DISMISSED because the proper petition or processing fee of [3] required under 37 CFR 1.17 has not been submitted.

Examiner Note:

1. Requests under 37 CFR 1.48 for correcting inventorship require a fee as set forth in 37 CFR 1.17(i).
2. Petitions to suspend action under 37 CFR 1.103(a), and to withdraw an application from issue under 37 CFR 1.313, require a fee as set forth in 37 CFR 1.17(h).
3. Petitions for an extension of time under 37 CFR 1.136(a) require varying fees. See 37 CFR 1.17(a)(1)-(5).
4. Requests to suspend action under 37 CFR 1.103(b) or (c) require a fee set forth in 37 CFR 1.17(i).
5. Requests to defer examination under 37 CFR 1.103(d) require a fee set forth in 37 CFR 1.17(i) and publication fee set forth in 37 CFR 1.18(d).

1002.01 Procedure

Petitions, together with the respective application files, are sent to the official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under 37 CFR 1.181(c) or for an informal memorandum. See MPEP § 711.03(d).

Where a formal statement under 37 CFR 1.181(c) is made, a copy thereof is mailed to the petitioner by the examiner unless the examiner is otherwise directed, and the application file and petition, accompanied by the original copy of his or her statement, are returned to the official handling the petition. If an informal memorandum is requested, no copy thereof is mailed to the petitioner by the examiner.

After the decision has been rendered, the decision is entered on the "Contents" of the application file wrapper which is then returned to the primary examiner, who will act in accordance with the decision.

1002.02 Delegation of Authority To Decide Petitions

Petitions to the Commissioner are decided in accordance with the following delegation of authority.

In any case in which the authority to decide the petition has been delegated as indicated in MPEP §§ 1002.02 (b), (f), (g), (j) and (o), a denial of a petition may be viewed as a final agency decision. A dismissal of a petition, a denial of a petition without prejudice, and other interlocutory orders are not final agency decisions.

In accordance with 37 CFR 1.181(g), the authority to decide petitions to the Commissioner, not otherwise delegated, has been delegated to various Office officials. Generally, these officials will decide petitions as specified in the following sections for the effective operation of the Office. Also listed are certain petitions which are not, strictly speaking, to the Commissioner but have been committed by statute or rule to the designated officials.

The delegation of specific petitions and/or matters identified in the sections below to personnel within the Technology Centers is at the discretion of the Technology Center Director. Any petition and/or matter so delegated may be decided by the Technology Center Director.

Authority not herein delegated has been reserved to the Commissioner and may be delegated to appropriate officials on an ad hoc basis.

1002.02(b) Petitions and Requests Decided by the Office of the Deputy Commissioner for Patent Examination Policy

All petitions decided by the Office of the Deputy Commissioner for Patent Examination Policy other than by the PCT Legal Administration (see MPEP § 1002.02(p)), and inquiries relating thereto, should be directed to "Box DAC, Assistant Commissioner for Patents, Washington, DC 20231," except as otherwise provided. For example, applications for patent term extension under 35 U.S.C. 156 should be directed to Box Patent Ext.

1. Petitions to revive an abandoned national, non-provisional or provisional patent application, 37 CFR 1.137 (both unavoidable delay and unintentional delay), MPEP § 711.03(c).

2. Petitions under 37 CFR 1.183 for waiver or suspension of rules not otherwise provided for.

3. Petitions to invoke the supervisory authority of the Commissioner under 37 CFR 1.181 in matters not otherwise provided for.

4. For utility and plant applications filed on or after November 29, 2000, petitions for an unintentionally delayed foreign priority claim, 37 CFR 1.55(c), MPEP § 201.14(a).

5. For utility and plant applications filed on or after November 29, 2000, petitions for an unintentionally delayed domestic priority claim, 37 CFR 1.78(a)(3) and (a)(6), MPEP § 201.11.

6. Petitions for deferment of issuance of patents, 37 CFR 1.314, MPEP § 1306.01.

7. Petitions for express abandonment of patent applications after payment of the issue fee, MPEP § 711.01 and MPEP § 1308.

8. Petitions relating to assignments and issuance of patents not otherwise provided for.

9. Petitions relating to public use proceedings, 37 CFR 1.292.

10. Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in proceedings before the Office of the Deputy Commissioner for Patent Examination Policy.

11. Petitions under 37 CFR 1.182 in matters not otherwise provided for.

12. Requests by the examiner to the Board of Patent Appeals and Interferences for reconsideration of a decision, MPEP § 1214.04.

13. Petitions to review refusal to accept and record maintenance fee payment filed prior to the expiration of a patent, 37 CFR 1.377, MPEP § 2580.

14. Petitions to accept delayed payment of maintenance fee in an expired patent, 37 CFR 1.378, MPEP § 2590.

15. Petitions to review a decision of Technology Center Director, 37 CFR 1.181.

16. Petitions to withdraw a holding of abandonment not otherwise delegated, 37 CFR 1.181.

17. Requests to order a Commissioner initiated reexamination proceeding, 37 CFR 1.520.

18. Petitions to accept late papers in a reexamination proceeding based upon unavoidable or unintentional delay, 35 U.S.C. 133 and 35 U.S.C. 41(a)(7).

19. Petitions for access to patent applications under 37 CFR 1.14 with the exception of applications

involved in or related to a proceeding before the Board of Patent Appeals and Interferences, MPEP § 103, § 104, and § 1901.05.

20. Petitions relating to reexamination proceedings and/or reissue proceedings under 37 CFR 1.182 and 1.183.

21. Petitions relating to merger of reexamination and reissue proceedings.

22. Petitions for acceptance of national applications without participation of one or more inventors under 37 CFR 1.47, MPEP § 409.03.

23. Petitions relating to patent term extension 37 CFR 1.710-1.785.

24. Petitions under 37 CFR 1.181 to review a determination of the length of the patent term extension under 37 CFR 1.701.

25. Requests for reconsideration of the patent term adjustment indicated in the notice of allowance or in the patent, under 37 CFR 1.705.

26. Requests for reinstatement of the period of patent term adjustment reduced pursuant to 37 CFR 1.704(b), under 37 CFR 1.705(c).

27. Petitions relating to the filing date of patent applications under 37 CFR 1.53 and former 37 CFR 1.60 and 1.62, MPEP § 506.02.

28. Petitions relating to filing and/or issuance of divisional reissue applications, 37 CFR 1.177, MPEP § 1451.

29. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b) to a provisional application under 37 CFR 1.53(c) where the nonprovisional application is before the Office of Petitions or the Office of Patent Legal Administration.

30. Requests to convert a provisional application filed under 37 CFR 1.53(c) to a nonprovisional application under 37 CFR 1.53(b) where the provisional application is before the Office of Petitions or the Office of Patent Legal Administration.

31. Petitions for extensions of time under 37 CFR 1.136(b) in applications before the Office of Petitions or the Office of Patent Legal Administration.

32. Petitions, or requests at the initiative of the PTO by someone other than a Technology Center Director, to withdraw patent applications from issue after payment of the issue fee under 37 CFR 1.313(b) and (c), MPEP § 1308.

1002.02(c) Petitions and Requests Decided by the Technology Center Directors

1. Petitions or requests to reopen prosecution of patent applications after decision by the Board of Patent Appeals and Interferences under 37 CFR 1.198, where no court action has been filed, MPEP § 1214.04 and § 1214.07.

2. Petitions from a final decision of examiner requiring restriction in patent applications, 37 CFR 1.144, MPEP § 818.03(c), or holding lack of unity of invention in an international application, 37 CFR 1.477 and 1.489, MPEP § 1875.02.

3. Petitions invoking the supervisory authority of the Commissioner under 37 CFR 1.181 involving any *ex parte* action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.191) and not otherwise provided for, as for example:

(a) prematurity of final rejection, MPEP § 706.07(c);

(b) holding of abandonment, MPEP § 711.03(c);

(c) requirement to cancel "new matter" from specification, MPEP § 608.04(c);

(d) relative to formal sufficiency and propriety of affidavits under 37 CFR 1.131 (MPEP § 715.08), 1.132 (MPEP § 716) and 1.608, MPEP § 2308 - § 2308.02;

(e) refusal to initiate an interference under 37 CFR 1.601(i), MPEP § 2306;

(f) refusal to enter an amendment under 37 CFR 1.312, MPEP § 714.16(d);

(g) refusal to enter an amendment, 37 CFR 1.127, MPEP § 714.19;

(h) refusal to enter an amendment under 37 CFR 1.111 or 37 CFR 1.115, MPEP § 714.03(a);

(i) resetting period for reply, MPEP § 710.06; and

(j) requirement for information under 37 CFR 1.105, MPEP § 704.11.

4. Petitions under 37 CFR 1.113 relating to objections or requirements made by the examiners.

5. Petitions for return of original oaths of patent applications, MPEP § 604.04(a).

6. Requests for extensions of a set shortened statutory period under 37 CFR 1.136(b) in applications pending in the examining group, MPEP § 710.02(e).

7. Petitions under 37 CFR 1.193(a) relating to the form of the appeal.

8. Petitions concerning appealed patent applications or *ex parte* reexamination proceedings before transfer of jurisdiction to the Board of Patent Appeals and Interferences (e.g., extension of time under 37 CFR 1.136(b) or 37 CFR 1.550(c) for filing an appeal brief), MPEP § 1206.

9. Request by applicant for a second or subsequent suspension of action in patent applications under 37 CFR 1.103, MPEP § 709.

10. Petitions from refusal to issue a Certificate of Correction for a patent not involved in an interference, 37 CFR 1.181, MPEP § 1480 - § 1485.

11. Petitions to reinstate appeals dismissed in the Technology Center.

12. Petitions from the denial of a request for reexamination, 37 CFR 1.515, MPEP § 2248.

13. Requests for extension of time in reexamination proceedings pending in the Technology Center, 37 CFR 1.550 (c).

14. Petitions under 37 CFR 1.129(b)(2) traversing a restriction requirement made in an application which is subject to the transitional restriction provisions, MPEP § 803.03.

15. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b) to a provisional application under 37 CFR 1.53(c) where the nonprovisional application is before the Technology Center.

16. Requests for interviews with examiner after a patent application has been sent to issue (Notice of Allowability mailed), MPEP § 713.10, or after transfer of jurisdiction to the Board of Patent Appeals and Interferences.

17. Petitions to expunge papers from patent application files or patent files, 37 CFR 1.59.

18. Petitions, or requests at the initiative of the USPTO, to withdraw patent applications from issue before payment of the issue fee, 37 CFR 1.313(a).

19. Requests at the initiative of the USPTO to withdraw patent applications from issue after payment of the issue fee under 37 CFR 1.313(b), MPEP § 1308.

1002.02(c)(1) Petitions Decided by the Director of Technology Center 3640

In addition to the items delegated to all Directors under MPEP § 1002.02(c), authority to decide the following is delegated to the Director of Technology Center 3640:

1. All petitions filed under 35 U.S.C. 267 to extend the time for taking action in United States-owned applications wherein the invention is important to the armament or defense of the United States.

2. All petitions under 37 CFR 1.103(f) to suspend action in United States-owned applications wherein the publication of the invention might be detrimental to the public safety or defense.

Any petitions filed under 35 U.S.C. 267 and/or 37 CFR 1.103(f) in any area of the Office must be forwarded to the Director of Technology Center 3640 for decision thereon.

3. Petitions under 37 CFR 5.12(a) for foreign license to file patent applications in foreign countries, MPEP § 140.

4. Petitions for rescission of secrecy order, 37 CFR 5.4, MPEP § 120.

5. Petitions to permit disclosure of subject matter under a secrecy order, 37 CFR 5.5(b), MPEP § 120.

6. Petitions for modification of secrecy order, 37 CFR 5.5(c), MPEP § 120.

7. Petitions for retroactive foreign filing license, 37 CFR 5.25, MPEP § 140.

8. Petitions relating to refusal of request for publication of a Statutory Invention Registration, 37 CFR 1.295, MPEP § 1105.

9. Petitions relating to request for withdrawal of request for publication of a Statutory Invention Registration, 37 CFR 1.296, MPEP § 1109.

10. Petitions relating to DOE property rights statements under 42 U.S.C. 2182.

11. Petitions relating to NASA property rights statements under 42 U.S.C. 2457.

12. Petitions relating to foreign filing licenses under 35 U.S.C. 184.

13. Petitions concerning review of security or government interest matters not otherwise provided for.

14. Petitions relating to any application under a secrecy order pursuant to 35 U.S.C. 181, including

petitions to expunge subject matter from the application to overcome the secrecy order.

1002.02(c)(2) Petitions Decided by the Director of Technology Center 1600

In addition to the items delegated to all Group Directors under MPEP § 1002.02(c), authority to decide the following is delegated to the Director of Technology Center 1600:

1. Petitions regarding sequence rules, 37 CFR 1.821-1.825.

2. Petitions to make biotechnology applications special where applicant is a small entity, MPEP § 708.02, item XII.

1002.02(c)(3) Petitions Decided by the Director of Technology Center 2900

In addition to the items delegated to all Technology Center Directors under MPEP § 1002.02(c), authority to decide the following petitions and requests filed in design applications is delegated to the Director of Technology Center 2900:

1. Petitions to revive an abandoned national application, 37 CFR 1.137 (both unavoidable delay and unintentional delay), MPEP § 711.03(c).

2. Petitions relating to the filing date of patent applications under 37 CFR 1.53 and former 37 CFR 1.60 and 1.62, MPEP § 506.02.

3. Requests for expedited examination of design applications under 37 CFR 1.155, MPEP § 1504.30.

1002.02(d) Petitions and Matters Decided by Supervisory Patent Examiners

1. Entry of amendments under 37 CFR 1.312 which embody more than merely the correction of formal matters without changing the scope of any claim, MPEP § 714.16, § 714.16(d).

2. Approval of reopening prosecution after the filing of an appeal brief in order to incorporate any new ground of rejection, MPEP § 1208.01.

3. Requests for a Certificate of Correction submitted under 37 CFR 1.322 or 1.323 unless the error is

clearly minor, clerical or typographical, in which case it is handled by the Certificate of Correction Branch.

4. Requests for a Certificate of Correction to correct a claim even if the request is submitted under 37 CFR 1.322.

5. Petitions under 37 CFR 1.324 to correct errors in joining inventors in a patent that is not involved in an interference, MPEP § 1481.

6. Disapproval of preliminary amendments under 37 CFR 1.115 or second (or subsequent) supplemental amendments (3rd reply) under 37 CFR 1.111, MPEP § 714.03(a).

7. Letters to an applicant suggesting claims for purposes of interference, or the submission of Form PTO-850, where one or more claims of one application would differ from corresponding claims of another application. See 37 CFR 1.603 and MPEP § 2303.

8. Amendments presented after decision in an appeal by the Board of Patent Appeals and Interferences as to which the primary examiner recommends entry as placing the application in condition for allowance. See MPEP § 1214.07.

9. Requests for second or subsequent change of inventorship in application under 37 CFR 1.48. See MPEP § 201.03.

10. Petitions under 37 CFR 1.84 to accept photographs or color drawings in patent applications.

11. Withdrawal from appeal of an application remanded by the Board of Patent Appeals and Interferences. See MPEP § 1211.

12. Requests for deferral of examination under 37 CFR 1.103(d), MPEP § 709.

1002.02(e) Requests Decided by Primary Examiners

Requests under 37 CFR 1.48 for correction of inventorship in applications.

1002.02(f) Petitions and Matters Decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences

The Chief Administrative Patent Judge is authorized to redelegate authority to decide any of these petitions or matters to the Vice Chief Administrative

Patent Judge of the Board of Patent Appeals and Interferences.

1. Designation of members of the Board of Patent Appeals and Interferences to hear appeals and decide interferences, both initially and on request for reconsideration. 35 U.S.C. 6.

2. Designation of members of the Board of Patent Appeals and Interferences to conduct proceedings in an interference. 37 CFR 1.610(a).

3. Designation of members of the Board of Patent Appeals and Interferences to decide requests for reconsideration. 37 CFR 1.640(c).

4. Requests related to superintending the functions of the Board of Patent Appeals and Interferences, including:

a. Petitions under 37 CFR 1.644 in interferences.

b. Petitions under 37 CFR 1.181, 1.182, and 1.183 from actions of the Board of Patent Appeals and Interferences or of personnel at the Board of Patent Appeals and Interferences.

c. Petitions from a decision under 37 CFR 1.612(a) granting or denying access by a party to an interference to pending and abandoned patent applications. MPEP § 103.

d. Petitions for an extension of time for seeking rehearing in an *ex parte* case before the Board of Patent Appeals and Interferences.

e. Petitions from a decision under 37 CFR 1.615(b) authorizing or declining to authorize continued concurrent prosecution of an application involved in an interference proceeding.

f. Petitions from a decision under 37 CFR 1.613(d) declining to authorize a withdrawal of an attorney or agent from representing a party involved in an interference.

g. Petitions from a decision granting or denying a request for a certificate of correction under 37 CFR 1.322 and 1.323 for a patent involved in an interference.

h. Petitions seeking disqualification of an attorney or agent under 37 CFR 10.130(b) in an *inter partes* case pending before the Board of Patent Appeals and Interferences.

5. Petitions under 35 U.S.C. 135(c):

a. Petitions under 35 U.S.C. 135(c) and 37 CFR 1.666(c) to permit the filing of an agreement or understanding during the 6-month period subsequent to termination of an interference.

b. Petitions under 37 CFR 1.666(b) for access to copies of an interference agreement or understanding filed under 35 U.S.C. 135(c).

1002.02(g) Petitions Decided by the Administrative Patent Judges

1. Petitions for access to unopened preliminary statements under 37 CFR 1.631.

2. Petitions under 37 CFR 1.615 for concurrent *ex parte* and *inter partes* prosecution of patent applications, MPEP § 2315.

3. Petitions for the withdrawal of attorney under 37 CFR 1.36 in patent applications involved in interference proceedings under 37 CFR 1.601 - 1.688 before the Board of Patent Appeals and Interferences, 37 CFR 1.613(d).

4. A request for a Certificate of Correction for a patent that is involved in an interference conducted under 37 CFR 1.601 - 1.688 presented via a motion under 37 CFR 1.635.

5. Motions to correct errors in joining inventors in proceedings under 37 CFR 1.601 - 1.688, 37 CFR 1.634.

See also MPEP § 1002.02(j).

1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks

Petitions relating to Trademarks are covered in Chapter 1700 of the Trademark Manual of Examining Procedure.

1002.02(j) Petitions Decided by the Board of Patent Appeals and Interferences

Requests under 37 CFR 1.197(b) for a rehearing of a decision of the Board of Patent Appeals and Interferences. MPEP § 1214.03.

1002.02(k)(1) Requests Decided by the General Counsel

Requests for confidentiality waiver under 35 U.S.C. 122.

1002.02(k)(2) Requests Decided by the Office of General Law

1. Requests filed under the Freedom of Information Act.

2. Petitions requesting review of the FOIA Officer's decision.

1002.02(k)(3) Petitions Decided by the Solicitor

1. Petitions for extension of time in court matters 35 U.S.C. 142, 145, and 146.

2. Petitions relating to *ex parte* questions in cases before the Court of Appeals for the Federal Circuit.

The Office of the Solicitor is available to render legal advice to any deciding official in connection with any petition.

1002.02(l) Requests Decided by the Certificates of Correction Branch

1. Requests for Certificates of Correction under 37 CFR 1.322 or 37 CFR 1.323 except for denials on grounds requiring consideration by the Chief Administrative Patent Judge or the supervisory patent examiners otherwise provided for, MPEP § 1480 - § 1485.

2. Petitions to issue corrected patent, 37 CFR 1.322(b).

3. Request to change inventorship pursuant to court order, 37 CFR 1.324, MPEP § 1481.

1002.02(m) Petitions Decided by the Director of Enrollment and Discipline

1. Petitions relating to registration.

2. Requests for limited recognition under 37 CFR 10.9.

3. Petitions for exceptions to undertakings under 37 CFR 10.10(b)(2), MPEP § 1702.

4. Petitions for regrading of registration examinations under 37 CFR 10.7(c).

5. Petitions for reinstatement under 37 CFR 10.160.

6. Petitions to suspend the rules under 37 CFR 10.170.

**1002.02(o) Petitions and Other Matters
Decided by the Deputy
Commissioner of Patents
and Trademarks**

The authority to take the following actions has been delegated to the Deputy Commissioner of Patents and Trademarks.

1. Decide petitions to the Commissioner in patent interference proceedings under 37 CFR 1.644.
2. Decide petitions to the Commissioner from actions taken by the Board of Patent Appeals and Interferences.
3. Decide petitions (under 37 CFR 1.304(a)(3) or 37 CFR 2.145(d)) seeking to extend the time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action seeking judicial review of a decision of the Board of Patent Appeals and Interferences or the Trademark Trial and Appeal Board.
4. Decide petitions under 37 CFR 10.2(c) from a final decision of the Director of Enrollment and Discipline.
5. Render final decisions in proceedings under 35 U.S.C. 32 in which the Director of Enrollment and Discipline seeks to exclude or suspend a practitioner from practice before the Patent and Trademark Office.
6. Render final decisions in proceedings under 35 U.S.C. 32 seeking to disqualify a practitioner and/or the practitioner's firm in all cases in the Patent and Trademark Office.

If there is a vacancy in the position of Deputy Commissioner for Patents and Trademarks, decisions on petitions in patent interference cases will be signed by the Commissioner of Patents and Trademarks.

Upon receipt of a petition and without waiting for any opposition, the entire interference file is to be forwarded to the Office of the Solicitor. The Solicitor is directed to promptly cause a review to be made of the petition and to prepare a draft decision for the Deputy Commissioner or Commissioner as may be appropriate. The Solicitor is authorized to take any interlocutory action, i.e., extending times for filing oppositions and seeking judicial review, obtaining agreement on facts from the parties, etc., as may be necessary to promptly dispose of the petition.

**1002.02(p) Petitions and Matters
Decided by the PCT
Legal Administrator**

1. Petitions to withdraw the Notice of Acceptance and/or filing receipt and indication of the steps necessary for completion of the national stage in a national application requesting treatment under 35 U.S.C. 371.

2. Petitions for withdrawal of attorney or agent of record in proceedings before PCT Operations and/or the Office of the PCT Legal Administrator, 37 CFR 1.36, MPEP § 402.06.

3. Petitions for access to an international application or a national application (i.e., a national stage application or a national application which is continuing from an international application) pending in PCT Operations and/or the Office of the PCT Legal Administrator.

4. Requests under 37 CFR 1.26 or 1.446 for refund of fees paid in an international application or in a national application (i.e., a national stage application or a national application which is continuing from an international application) before PCT Operations and/or the Office of the PCT Legal Administrator.

5. Petitions under 37 CFR 1.182 to convert a national application which was filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a) or to convert a national application which was filed under 35 U.S.C. 111(a) to an application filed under 35 U.S.C. 371.

6. Petitions under 37 CFR 1.181 to withdraw the holding of abandonment where the holding was made in PCT Operations or in the PCT Legal Office.

7. Petitions under 37 CFR 1.181 to invoke the supervisory authority of the Commissioner in circumstances arising in PCT Operations and/or the Office of the PCT Legal Administrator other than the circumstances set forth in paragraph 6, above.

8. Petitions under 37 CFR 1.137 (both unavoidable delay and unintentional delay) to revive an application filed under the Patent Cooperation Treaty (PCT).

9. Petitions under 37 CFR 1.425 to accept the signature in an international application on behalf of an applicant.

10. Petitions under 37 CFR 1.47 or a submission under 37 CFR 1.42 or 1.44 to accept the signature in a national stage application on behalf of an applicant.

11. Requests under 37 CFR 1.48 or a submission under 37 CFR 1.28 (change of inventorship and small entity status, respectively) in a national stage application prior to entry into the national stage.

12. Petitions under 37 CFR 1.182 or 1.183 filed in an international application relating to filing date matters, drawing problems, priority claim issues, Express Mail problems, Chapter II Demand problems, issues relating to obvious error and issues relating to withdrawal.

13. Petitions under 37 CFR 1.182 or 1.183 dealing with circumstances other than those set forth in paragraph 12, but relating to issues under the PCT.

14. Decisions withdrawing an examiner's office action in an application where the application is not in compliance with the PCT provisions of the Treaty, U.S. Law or the Regulations.

15. Petitions dealing with PCT related issues in an application filed under 35 U.S.C. 111(a) (such as applications where there is a potential claim for benefit under 35 U.S.C. 365).

16. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b) to a provisional application under 37 CFR 1.53(c) where the nonprovisional application is before PCT Operations and/or the Office of the PCT Legal Administrator.

17. Petitions relating to international applications filed under the Patent Cooperation Treaty not otherwise provided for.

1002.02(q) Petitions and Requests Decided by the Director of Office of Initial Patent Examination

1. Requests under 37 CFR 1.48(d) to add the name of an inventor in a provisional application.

2. Requests under 37 CFR 1.48(e) to delete the name of the person erroneously named as an inventor in a provisional application.

3. Petitions to convert a nonprovisional application filed under 37 CFR 1.53(b) to a provisional application under 37 CFR 1.53(c) where the nonprovisional application is before the Office of Initial Patent Examination or where the nonprovisional application is before the Office of Publications.

4. Requests to convert a provisional application filed under 37 CFR 1.53(c) to a nonprovisional application under 37 CFR 1.53(b) where the provisional

application is before the Office of Initial Patent Examination.

5. Petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and be accorded a filing date as of the date of such submission, or to accept drawings for purposes of a patent application publication.

6. Petitions to withdraw holding of abandonment where notices of abandonment were mailed by the Office of Initial Patent Examination.

7. Petitions for extension of time under 37 CFR 1.136(b) in applications before the Office of Initial Patent Examination.

1002.02(r) Petitions Decided by the Director of Office of Patent Publication

1. Petitions to withdraw holding of abandonment where notices of abandonment were mailed by the Office of Patent Publication.

2. Petitions for express abandonment to avoid publication of the application (should be directed to BOX PGPUB-ABN), 37 CFR 1.138(c), MPEP § 711.01.

3. Requests to issue patent in name of the assignee after payment of the issue fee, 37 CFR 3.81(b), MPEP § 307.

1002.02(s) Petitions and Matters Decided by the Special Program Examiners in the Technology Centers

1. Petitions to make patent applications special under 37 CFR 1.102, MPEP § 708.02:

(a) on the ground of applicant's age or state of health, MPEP § 708.02, item III & IV;

(b) a continuation-in-part of an earlier application;

(c) under the Environmental Quality Program, MPEP § 708.02, item V;

(d) under the Energy Program, MPEP § 708.02, item VI;

(e) because the application invokes safety of research in the field of Recombinant DNA, MPEP § 708.02, item VII;

(f) under the Special Examining Procedure for certain new applications - accelerated examination, MPEP § 708.02, item VIII;

(g) superconductivity, MPEP § 708.02, item IX;

(h) inventions relating to HIV/AIDS and cancer, MPEP § 708.02, item X;

(i) relating to inventions for countering terrorism, MPEP § 708.02, item XI;

(j) on the ground of prospective manufacture, MPEP § 708.02, item I;

(k) on the ground of infringement, MPEP § 708.02, item II; and

(l) for reasons not otherwise provided for.

2. Petitions for withdrawal of attorney from application pending in the Technology Centers, 37 CFR 1.36.

1003 Matters Submitted to Technology Center Directors

The following is a list of matters which are submitted to the appropriate Technology Center Director, together with a reference to any section of this manual where such matters are more fully treated.

1. Requests for a Certificate of Correction in which the:

i. request raises a novel issue or about which there is some question;

ii. request is for a patent known to be in litigation; or

iii. request deals with a legal matter (e.g., the insertion of foreign priority data or cross referencing to prior U.S. patent applications) unless the file reflects that the examiner has already ruled on the matter and that failure to print the material was clearly an Office error, in which case it will be handled by the Certificate of Corrections Branch.

2. Return of papers entered on the "Contents" of the file wrapper. See MPEP § 201.14(c), § 604.04(a) and § 719.01.

3. Return of papers containing discourteous remarks. See MPEP § 714.19 and § 714.25.

4. Certain rejections on double patenting of divisional (or parent) case when restriction or election of species has previously been required, MPEP § 804.04.

5. Request for patentability report, MPEP § 705.01(e).

6. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee, MPEP § 2307.02.

7. Interferences between applications neither of which is in condition for allowance, MPEP § 2303.

8. Letters requesting jurisdiction from Board of Patent Appeals and Interferences of applications involved in appeal or interference.

9. Letters to an applicant suggesting claims for purposes of interference, the adoption of which by the applicant would result in the withdrawal of an application from issue, MPEP § 2305.04.

10. Examiner's answers containing a new interpretation of law. See MPEP § 1208.

11. Proposed interferences between applications whose effective filing dates differ by more than 6 months. See MPEP § 2303.

12. Protests filed against issuance of a patent. See MPEP § 1901.06.

13. Letters suggesting claims to an application in issue for purposes of interference with a patent. See MPEP § 2305.04.

14. Requests by the examiner to the Board for reconsideration of a decision before forwarding to the Office of Petitions, MPEP § 1214.04.

15. Second or subsequent suspension of action in patent application under 37 CFR 1.103 on examiner's initiative. MPEP § 709.

16. Request by the examiner to withdraw an application from issue.

17. An unusual fact situation in a patent that establishes:

i. there is a "compelling reason" to order reexamination, and

ii. at least one claim in the patent is *prima facie* unpatentable over prior patents and/or printed publications. See 37 CFR 1.520, MPEP § 2239.

18. Applications containing examiner's answers lacking the appropriate indication that an appeal conference was held. See MPEP § 1208.

All unusual questions of practice may be referred to the Technology Center Directors.

1004 Actions Which Require the Attention of a Primary Examiner

There are some questions which existing practice requires the primary examiner to be personally responsible for. The following actions fall in this category:

Final rejection (MPEP § 706.07).

Proposing an interference (MPEP § 2309).

Disposition of an amendment in an application in interference looking to the formation of another interference involving that application (MPEP § 2364.01).

Calling Administrative Patent Judge's attention to a discovered reference which makes a claim corresponding to a count unpatentable (37 CFR 1.641, MPEP § 2341).

Rejection of a previously allowed claim (MPEP § 706.04).

Classification of allowed cases (MPEP § 903.07).

Holding of abandonment for insufficient reply (MPEP § 711.03(a)).

Suspension of examiner's action (MPEP § 709).

Treatment of newly filed application which obviously fails to comply with 35 U.S.C. 112 (MPEP § 702.01).

Consideration of the advisability of a patentability report (MPEP § 705.01(a)).

Withdrawal of final rejection (MPEP § 706.07(d) and § 706.07(e)).

All examiner's answers on appeal (MPEP § 1208).

Decision on reissue oath or declaration (MPEP § 1414).

Decision on affidavits or declarations under 37 CFR 1.131 (MPEP § 715.08) and under 37 CFR 1.132 (MPEP § 716).

Decision as to acceptance of amendments, statements, and oaths or declarations filed under 37 CFR 1.48 (MPEP § 201.03).

International Preliminary Examination Reports (MPEP § 1879).

For a list of actions that are to be submitted to the Technology Center Directors, see MPEP § 1002.02(c) and § 1003.

1005 Exceptions to Partial Signatory Authority

Examiners who are delegated partial signatory authority are expected to sign their own actions with the exception of the following actions which require the signature of the primary examiner:

Allowances (MPEP § 1302.13).

Examiner's amendments (MPEP § 1302.04).

Quayle actions (MPEP § 714.14).

Final rejections (MPEP § 706.07 and § 803.01).

Actions on amendments submitted after final rejection (MPEP § 714.12).

Examiner's answers on appeal (MPEP § 1208).

Initiation of an interference (MPEP § 2309).

Actions suggesting claims for interference purposes (MPEP § 2305).

Actions involving copied patent claims (MPEP § 2307).

Actions reopening prosecution (MPEP § 1214.07). Requests for withdrawal from issue (MPEP § 1308).

37 CFR 1.312 amendments (MPEP § 714.16).

Rejection of previously allowed claim (MPEP § 706.04).

Final holding of abandonment for insufficient reply (MPEP § 711.03(a)).

Actions based on affidavit or declaration evidence (37 CFR 1.131 and 1.132 (MPEP § 715.08 and § 716)).

Suspension of examiner's action (MPEP § 709).

Reissue applications (decisions on reissue oath or declaration) (MPEP § 1444).

Requests for an extension of time under 37 CFR 1.136(b) (MPEP § 710.02(e)).

Reexamination proceedings (MPEP § 2236).

International Preliminary Examination Reports (MPEP § 1879).



Chapter 1100 Statutory Invention Registration (SIR)

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1101 Request for Statutory Invention Registration (SIR)

35 U.S.C. 157. Statutory invention registration.

(a) Notwithstanding any other provision of this title, the Director is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant —

- (1) meets the requirements of section 112 of this title;
- (2) has complied with the requirements for printing, as set forth in regulations of the Director;
- (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Director; and
- (4) pays application, publication, and other processing fees established by the Director.

If an interference is declared with respect to such an application, a statutory invention registration may not be published unless the issue of priority of invention is finally determined in favor of the applicant.

(b) The waiver under subsection (a)(3) of this section by an applicant shall take effect upon publication of the statutory invention registration.

(c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. A statutory invention registration published pursuant to this section shall give appropriate notice to the public, pursuant to regulations which the Director shall issue, of the preceding provisions of this subsection. The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

(d) The Director shall report to the Congress annually on the use of statutory invention registrations. Such report shall include an assessment of the degree to which agencies of the federal government are making use of the statutory invention registration system, the degree to which it aids the management of federally developed technology, and an assessment of the cost savings to the Federal Government of the uses of such procedures.

37 CFR 1.293. Statutory invention registration.

(a) An applicant for an original patent may request, at any time during the pendency of applicant's pending complete application, that the specification and drawings be published as a statutory invention registration. Any such request must be signed by

(1) the applicant and any assignee of record or (2) an attorney or agent of record in the application.

(b) Any request for publication of a statutory invention registration must include the following parts:

(1) A waiver of the applicant's right to receive a patent on the invention claimed effective upon the date of publication of the statutory invention registration;

(2) The required fee for filing a request for publication of a statutory invention registration as provided for in § 1.17(n) or (o);

(3) A statement that, in the opinion of the requester, the application to which the request is directed meets the requirements of 35 U.S.C. 112; and

(4) A statement that, in the opinion of the requester, the application to which the request is directed complies with the formal requirements of this part for printing as a patent.

(c) A waiver filed with a request for a statutory invention registration will be effective, upon publication of the statutory invention registration, to waive the inventor's right to receive a patent on the invention claimed in the statutory invention registration, in any application for an original patent which is pending on, or filed after, the date of publication of the statutory invention registration. A waiver filed with a request for a statutory invention registration will not affect the rights of any other inventor even if the subject matter of the statutory invention registration and an application of another inventor are commonly owned. A waiver filed with a request for a statutory invention registration will not affect any rights in a patent to the inventor which issued prior to the date of publication of the statutory invention registration unless a reissue application is filed seeking to enlarge the scope of the claims of the patent. See also § 1.104(c)(5).

A request for a statutory invention registration (SIR) may be filed at the time of filing a nonprovisional application for patent, or may be filed later during pendency of a nonprovisional application. The fee required (37 CFR 1.17(n) or (o)) depends on when the request is filed. The application to be published as a SIR must be complete as set forth in 37 CFR 1.51(b) including a specification with a claim or claims, an oath or declaration, and drawings when necessary. Applicants should use the format set forth in form PTO/SB/94, Request for Statutory Invention Registration. Form PTO/SB/94 is available from the USPTO website (www.uspto.gov), and it is reproduced immediately following this section.

A provisional application cannot include a request for a SIR.

Requests for statutory invention registrations, including those submitted in utility, plant, and design applications, are handled in art units 3641 and 3662 of Technology Center (TC) 3600. Accordingly, incoming new applications which include a request for a SIR will be processed like other new applications in

the Office of Initial Patent Examination (OIPE) and then forwarded to TC 3600. TC 3600 may be assisted by other Technology Centers when the subject matter of the application makes it necessary or desirable. For example, TC 1600 may handle issues under 35 U.S.C. 112 in applications involving biotechnology.

Applications not already assigned to art unit 3641 or 3662 which receive a request for a SIR (or any other indication that they are to be published as a SIR) should be forwarded with a brief explanation to one of these art units via the technical support staff of the TC to which the application is assigned. The forwarding TC should first determine whether an Office action has been mailed in the application and issue proper SIR disposal credit to the examiner who prepared any such action where appropriate. Art unit 3662 handles applications including a request for a SIR that are electrical in nature and those that are related to computer science. Accordingly, applications from TCs 2100, 2600, and 2800 should be forwarded to art unit 3662. All other applications including a request for a

SIR should be forwarded to art unit 3641. An examiner in art unit 3641 or 3662 will determine whether the request for a SIR is proper. An examiner who is not in one of these two art units should make no comment to the applicant regarding what effect the filing of a request for a SIR may have had on any outstanding rejection.

It should be noted that 37 CFR 1.211 requires the publication of most nonprovisional applications (other than for a design patent filed under 35 U.S.C. 171 and reissue applications filed under 35 U.S.C. 251) filed on or after November 29, 2000. Exceptions to publication are set forth in 35 U.S.C. 122(b)(2) and 37 CFR 1.211. Further, voluntary publication may be requested under 37 CFR 1.221(a) for applications filed before, but pending on, November 29, 2000. An applicant may find publication of an application to be a desirable alternative to requesting a SIR since publication of the application is achieved without any waiver of patent rights.

PTO/SB/94 (10-00)

Approved for use through 03/31/2003. OMB 0651-0036
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Request for Statutory Invention RegistrationApplication Number _____, or ☐ attached hereto

Filed: _____

Title: _____

Applicant(s): _____

A. In the above identified patent application, I hereby:

1. Request and authorize the Commissioner of Patents and Trademarks to publish the above identified regularly filed patent application as a Statutory Invention Registration. (35 U.S.C. 157)
2. Waive the right to receive a United States patent on the same invention claimed in the above identified patent application. These rights, which are waived, include those specified in 35 U.S.C. 183 and 271 through 289 as well as all attributes specified for patents in any other provisions of law other than title 35, United States Code. The waiver includes, but is not limited to, the remedies under 19 U.S.C. 1337 and 1337a, 22 U.S.C. 2356 and 28 U.S.C. 1498. (35 U.S.C. 157(c))
3. Understand that the above waiver will be effective pursuant to 37 CFR 1.293 upon publication of the Statutory Invention Registration to waive the inventor's right to receive a United States patent on the invention claimed in the Statutory Invention Registration. (37 CFR 1.293(b)(1))
4. State that, in my opinion, the disclosure and claims of the above identified patent application meet the requirements of 35 U.S.C. 112. (37 CFR 1.293(b)(3))
5. State that, in my opinion, the above identified patent application complies with the requirements for printing as set forth in the Rules of Practice for Patent Cases, 37 CFR Part 1. (37 CFR 1.293(b)(4))
6. Enclose the fee* set forth in 37 CFR 1.17(n) or (o) for requesting publication of a Statutory Invention Registration:

☐ A first Office Action has not been mailed in the above application, 37 CFR 1.17(n)..... \$ _____☐ A first Office Action has been mailed in the above application, 37 CFR 1.17(o)..... \$ _____

Request fee \$ _____

MINUS BASIC FILING FEE, IF PREVIOUSLY PAID☐ Basic filing fee for utility patent application set forth in 37 CFR 1.16(a); or☐ Basic filing fee for design patent application set forth in 37 CFR 1.16(f); or☐ Basic filing fee for plant patent application set forth in 37 CFR 1.16(g)

Minus basic filing fee \$ _____

Amount due \$ _____

Payment charged to credit card _____ Form PTO-2038 is attached.

Amount enclosed by check or money order _____

Please charge Deposit Account No. _____ the amount of \$ _____

If payment of any additional fee is required for publication of the Statutory Invention Registration, charge such amount to Deposit Account No. _____

* Where this request is submitted at the time the application is filed, the filing fee is included in the fee.

{Page 1 of 2}

This collection of information is required by 35 USC 157. This information is used by the public to request (and by the U.S. PTO to process) a statutory invention registration. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the statutory invention registration. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231.

PTO/SB/94 (10-00)

Approved for use through 03/31/2003. OMB 0651-0036

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

B. For printing of the Statutory Invention Registration front page, if desired, list below the name(s) of not more than 3 registered patent attorneys and agents OR alternatively, the name of a firm having as a member a registered patent attorney or agent. If no name is listed below, no name will be printed on the Statutory Invention Registration.

C. Name of assignee, if any, for printing on the Statutory Invention Registration _____
Address (City and State or Country) _____
State of incorporation, if assignee is a corporation _____

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature(s) (37 CFR 1.293(a))



attorney or agent of record



applicant(s) and any assignee

1103 Examination of a SIR

37 CFR 1.294. Examination of request for publication of a statutory invention registration and patent application to which the request is directed.

(a) Any request for a statutory invention registration will be examined to determine if the requirements of § 1.293 have been met. The application to which the request is directed will be examined to determine (1) if the subject matter of the application is appropriate for publication, (2) if the requirements for publication are met, and (3) if the requirements of 35 U.S.C. 112 and § 1.293 of this part are met.

(b) Applicant will be notified of the results of the examination set forth in paragraph (a) of this section. If the requirements of § 1.293 and this section are not met by the request filed, the notification to applicant will set a period of time within which to comply with the requirements in order to avoid abandonment of the application. If the application does not meet the requirements of 35 U.S.C. 112, the notification to applicant will include a rejection under the appropriate provisions of 35 U.S.C. 112. The periods for reply established pursuant to this section are subject to the extension of time provisions of § 1.136. After reply by the applicant, the application will again be considered for publication of a statutory invention registration. If the requirements of § 1.293 and this section are not timely met, the refusal to publish will be made final. If the requirements of 35 U.S.C. 112 are not met, the rejection pursuant to 35 U.S.C. 112 will be made final.

(c) If the examination pursuant to this section results in approval of the request for a statutory invention registration the applicant will be notified of the intent to publish a statutory invention registration.

An examiner in Art Unit 3641 or 3662, where appropriate, will determine whether the application in which a request for a statutory invention registration has been filed is a pending nonprovisional application. If the application was abandoned at the time the request was filed, has been patented, or has been allowed and the issue fee paid, the examiner should return the SIR request to the requester accompanied by a Return of Statutory Invention Registration Request to Requester notice (form PTOL-442).

If the application is pending, the examiner should ascertain whether an Office action with a rejection under 35 U.S.C. 112 has been issued and not replied to. If so, and if there remains any time to reply to the rejection, the examiner should send the applicant a courtesy notice requiring a timely reply. If no time for reply remains, the application is abandoned and the examiner should inform the applicant of this fact.

After the examiner handling the SIR has ascertained that all outstanding rejections under 35 U.S.C. 112 have been replied to, the examiner should verify

that the request for a SIR meets the requirements of 37 CFR 1.293. First, applicant should be notified of any defects in the signature on the SIR request or of any inadequacy of the SIR fee. A 1-month time period should be set for applicant to correct the signature or fee before any further consideration of the SIR request is given. Form PTOL-444 may be used for this purpose. Next, applicant should be given 1 month to correct any other informalities in the SIR request under 37 CFR 1.293 and any informalities in the application under 37 CFR 1.294 using a Notice of Informal Statutory Invention Registration (SIR) Request, form PTOL-445. The examiner should also determine whether the application complies with 35 U.S.C. 112. If not, a rejection with a 3-month shortened statutory period for reply should be made using a Notice of Noncompliance with 35 U.S.C. 112 of application having SIR Request, form PTOL-448. Both form PTOL-445 and form PTOL-448 can be mailed at the same time. If they are, applicant should be given a 3-month shortened statutory period to reply to both forms.

If applicant's reply to form PTOL-445 does not correct the defects, the SIR request should be finally refused using a Notice of Final Refusal of Informal Statutory Invention Registration (SIR) Request, form PTOL-446. If applicant's reply to the rejection set forth on form PTOL-448 does not bring the application into compliance with 35 U.S.C. 112, the rejection should be made final.

After the application complies with 37 CFR 1.293, 37 CFR 1.294, and 35 U.S.C. 112, the examiner should determine whether the application is involved in a pending interference. If so, applicant should be notified, using form PTOL-449, that no decision will be made on the SIR request until the interference proceedings are concluded.

If the applicant has lost priority of any claims due to a concluded interference, applicant should be given 1 month, using form PTOL-449, to cancel the lost claims (if a statutory invention registration is still desired with claims on which priority was not lost) or to request withdrawal of the request for statutory invention registration (if further prosecution as to patentability is desired). See MPEP § 1109. If none of the claims in the application was lost in interference, and if the application complies with 37 CFR 1.293, 37 CFR 1.294, and 35 U.S.C. 112, then the applica-

tion is in condition to be prepared for publication. See MPEP § 1107.

An application under secrecy order will be withheld from publication during such period as the national interest requires, and the applicant should be informed of this fact by using a Notice of Statutory Invention Registration (SIR) Acceptance (Form D-11), form PTOL-452.

1105 Review of Final Refusal to Publish SIR

37 CFR 1.295. Review of decision finally refusing to publish a statutory invention registration.

(a) Any requester who is dissatisfied with the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 may obtain review of the refusal to publish the statutory invention registration by filing a petition to the Commissioner accompanied by the fee set forth in § 1.17(h) within one month or such other time as is set in the decision refusing publication. Any such petition should comply with the requirements of § 1.181(b). The petition may include a request that the petition fee be refunded if the final refusal to publish a statutory invention registration for reasons other than compliance with 35 U.S.C. 112 is determined to result from an error by the Patent and Trademark Office.

(b) Any requester who is dissatisfied with a decision finally rejecting claims pursuant to 35 U.S.C. 112 may obtain review of the decision by filing an appeal to the Board of Patent Appeals and Interferences pursuant to § 1.191. If the decision rejecting claims pursuant to 35 U.S.C. 112 is reversed, the request for a statutory invention registration will be approved and the registration published if all of the other provisions of § 1.293 and this section are met.

An applicant who is dissatisfied with a final refusal to publish a SIR for reasons other than compliance with 35 U.S.C. 112 may obtain review by filing a petition as set forth in 37 CFR 1.295(a). The petition should be directed to the TC Director responsible for the art unit handling the SIR.

An applicant who is dissatisfied with a decision finally rejecting claims under 35 U.S.C. 112 may obtain review by filing an appeal with the Board of Patent Appeals and Interferences as set forth in 37 CFR 1.295(b).

1107 Preparing a SIR for Publication

In preparing a nonprovisional application with a SIR request for publication, the examiner should fill out the face of the application file wrapper in the same manner as in a non-SIR application. Additionally, the

examiner should add the notation "OK for SIR" in the space provided for the primary examiner's signature and "SIR" should be indicated next to the space for the patent number. A form PTO-1547 is attached to the "LABEL AREA" on the face of the file wrapper to indicate that the application is for a statutory invention registration. An issue classification slip (form PTO-270 or PTO-328) is filled out and attached inside the file wrapper for series 08/ and earlier applications in the normal manner with the additional notation of "SIR" added to the left side of the space allocated for the patent number. The index of claims inside the left flap of the file wrapper is filled out, with the notation "*" indicating the claims to be published in the SIR. The final official classification of the application and the figure to be published in the *Official Gazette* are indicated, as in non-SIR applications, on the front of the file wrapper.

A Notice of Intent to Publish Statutory Invention Registration, form PTOL-451, is prepared and sent to the applicant. Requirements for corrected or formal drawings and examiner's amendments may be attached to the Notice of Intent to Publish Statutory Invention Registration as needed. If corrected drawings are required, the examiner should set a 3 month shortened statutory period for submission of the drawings and indicate that the shortened statutory period is not extendable under 37 CFR 1.136(a) or 37 CFR 1.136(b). After the form PTOL-451 has been mailed, the application is forwarded to the Office of Patent Publication.

1109 Withdrawal of SIR Request

37 CFR 1.296. Withdrawal of request for publication of statutory invention registration.

A request for a statutory invention registration, which has been filed, may be withdrawn prior to the date of the notice of the intent to publish a statutory invention registration issued pursuant to § 1.294(c) by filing a request to withdraw the request for publication of a statutory invention registration. The request to withdraw may also include a request for a refund of any amount paid in excess of the application filing fee and a handling fee of \$130.00 which will be retained. Any request to withdraw the request for publication of a statutory invention registration filed on or after the date of the notice of intent to publish issued pursuant to § 1.294(c) must be in the form of a petition pursuant to § 1.183 accompanied by the fee set forth in § 1.17(h).

If a request to withdraw a SIR is filed in a nonprovisional application which contains a SIR request before a Notice of Intent to Publish Statutory Inven-

tion Registration has been mailed, the examiner handling the SIR should ascertain whether any outstanding rejection under 35 U.S.C. 112 is present in the application. If so, the examiner should require a timely reply to the rejection using a Response to Request to Withdraw Request for a Statutory Invention Registration, form PTOL-450. After a timely reply to the rejection is received, the request to withdraw the SIR request will ordinarily be granted and the application forwarded for further examination to whichever art unit would ordinarily examine the art area in which the application is classifiable.

Any request to withdraw a SIR filed after the mailing date of the Notice of Intent to Publish Statutory Invention Registration must be in the form of a petition pursuant to 37 CFR 1.183 accompanied by the fee set forth in 37 CFR 1.17(h). The TC Director responsible for the art unit handling the SIR will inform the applicant of the decision on the petition via a form PTOL-450 or Response to Petition under 37 CFR 1.295(a), form PTOL-447.

Note that an original SIR application can be abandoned in favor of a continuing application for a patent, claiming the filing date of the earlier filed application, by filing an express abandonment of the original application and a timely request or petition to withdraw the request for a SIR prior to publication of the SIR.

1111 SIR Publication and Effect

37 CFR 1.297. *Publication of statutory invention registration.*

(a) If the request for a statutory invention registration is approved the statutory invention registration will be published. The statutory invention registration will be mailed to the requester at the correspondence address as provided for in § 1.33(a). A notice of the publication of each statutory invention registration will be published in the *Official Gazette*.

(b) Each statutory invention registration published will include a statement relating to the attributes of a statutory invention registration. The statement will read as follows:

A statutory invention registration is not a patent. It has the defensive attributes of a patent but does not have the enforceable attributes of a patent. No article or advertisement or the like may use the term patent, or any term suggestive of a patent, when referring to a statutory invention registration. For more specific information on the rights associated with a statutory invention registration see 35 U.S.C. 157.

Published SIRs are sequentially numbered in a separate "H" series, starting with number "H1". For a description of the "kind codes" used on other documents published by the U.S. Patent and Trademark Office, see MPEP § 901.04(a).

In accordance with 35 U.S.C. 157(c), a published SIR will be treated the same as a U.S. patent for all defensive purposes, usable as a reference as of its filing date in the same manner as a patent. A SIR is a "constructive reduction to practice" under 35 U.S.C. 102(g) and "prior art" under all applicable sections of 35 U.S.C. 102 including section 102(e). SIRs are classified, cross-referenced, and placed in the search files, disseminated to foreign patent offices, stored in U.S. Patent and Trademark Office computer tapes, made available in commercial data bases, and announced in the *Official Gazette*.

The waiver of patent rights to the subject matter claimed in a statutory invention registration takes effect on publication (37 CFR 1.293(c)) and may affect the patentability of claims in related applications without SIR requests, such as divisional or other continuing applications, since the waiver of patent rights is effective for all inventions claimed in the SIR and would effectively waive the right of the inventor to obtain a patent on the invention claimed in the same application or on the same invention claimed in any other application not issued before the publication date of the SIR. If an application containing generic claims is published as a SIR, the waiver in that application applies to any other related applications to the extent that the same invention claimed in the SIR is claimed in the other application. Examiners should apply standards similar to those applied in making "same invention" double patenting determinations to determine whether a waiver by an inventor to claims in a SIR precludes patenting by the same inventor to subject matter in any related application. If the same subject matter is claimed in an application and in a published statutory invention registration naming a common inventor, the claims in the application should be rejected as being precluded by the waiver in the statutory invention registration. See 37 CFR 1.104(c)(5). A rejection as being precluded by a waiver in a SIR cannot be overcome by a terminal disclaimer.

The holder of a SIR will not be able to file a reissue application to recapture the rights, including the right to exclude others from making, using, selling, offer-

ing to sell, or importing the invention, that were waived by the initial publication of the SIR.

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Chapter 1200 Appeal

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1201 Introduction

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by

prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

1203 Composition of Board

35 U.S.C. 6 provides for a Board of Patent Appeals and Interferences as follows:

35 U.S.C. 6. Board of Patent Appeals and Interferences.

(a) ESTABLISHMENT AND COMPOSITION.— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.

(b) DUTIES.— The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

If subsequent to the hearing, but prior to the decision, an administrative patent judge who heard the appeal becomes unable to participate in the decision or any subsequent action for some reason, the Chief Administrative Patent Judge of the Board, at his or her

discretion, may without a rehearing substitute a different Board member for the one who is unavailable, or may offer the appellant the opportunity for a rehearing. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Should a member die or otherwise become unavailable (for example, retirement) to reconsider a decision, normally another member will be designated by the Chief Administrative Patent Judge as a substitute for the absent member.

1204 Administrative Handling

Ex parte appeals to the Board, and all papers relating thereto, are forwarded to the Technology Center (TC) for docketing. All appeal papers, such as the notice of appeal, appeal brief, and request for extension of time to file the brief, are processed by the appropriate TC.

To ensure that all records are current, memorandum form PTO-262 is attached to the file wrapper when it is remanded by the Board. It is important that this memorandum be promptly completed and forwarded by the TC if the application is allowed, the prosecution is reopened, a continuation application is filed, or if the appeal is discontinued for any other reason.

If the brief is not filed within the time designated by 37 CFR 1.192, the applicant will be notified that the appeal stands dismissed.

"SPECIAL CASE"

Subject alone to diligent prosecution by the applicant, an application for patent that once has been made special and advanced out of turn by the United States Patent and Trademark Office (Office) for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. See MPEP § 708.02.

A petition to make an application special after the appeal has been forwarded to the Board may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Commissioner under 37 CFR 1.102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

1205 Notice of Appeal

35 U.S.C. 134. Appeal to the Board of Patent Appeals and Interferences.

(a) **PATENT APPLICANT.**— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) **PATENT OWNER.**— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) **THIRD-PARTY.**— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the administrative patent judge favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal. The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.

35 U.S.C. 41. Patent fees; patent and trademark search systems

(a) The Director shall charge the following fees:

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300.

(B) In addition, on filing a brief in support of the appeal, \$300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$260.

37 CFR 1.191. Appeal to Board of Patent Appeals and Interferences.

(a) Every applicant for a patent or for reissue of a patent, and every owner of a patent under *ex parte* reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

(b) The signature requirement of § 1.33 does not apply to a notice of appeal filed under this section.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the

merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in §§ 1.193, 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136(b) for patent applications or § 1.550(c) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Commissioner may *sua sponte* order the application remanded to the examiner.

APPEAL BY PATENT APPLICANT

Under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

Although the rules no longer require that the notice of appeal identify the rejected claim(s) appealed, or be signed, applicants should continue to file notices of appeal which identify the appealed claims and are signed. The requirement was eliminated from 37 CFR 1.191 as being redundant of the requirements of 37 CFR 1.192 and to avoid the delay and expense to both applicant and the United States Patent and Trademark Office (Office) which is involved in treating a defective notice of appeal. It should be noted that the elimination of the requirement to sign a notice of appeal does not affect the requirements for other papers (such as an amendment under 37 CFR 1.116) submitted with the notice, or for other actions contained within the notice, e.g., an authorization to

charge fees to a deposit account or to a credit card. See MPEP § 509. Thus, failure to sign the notice of appeal may have unintended adverse consequences; for example, if an unsigned notice of appeal contains an (unsigned) authorization to charge the appeal fee to a deposit account, the notice of appeal will be unacceptable because the appeal fee is lacking.

The notice of appeal must be filed within the period for reply set in the last Office action, which is normally 3 months for applications. See MPEP § 714.13. Failure to remove all grounds of rejection and otherwise place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed, except where claims suggested for interference have been copied. The notice of appeal and appropriate fee may be filed up to 6 months from the date of the final rejection, so long as an appropriate petition and fee for an extension of time is filed either prior to or with the notice of appeal.

APPEAL BY PATENT OWNER

37 CFR 1.191 provides for appeal to the Board by the patent owner from any decision in an *ex parte* reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306 and 35 U.S.C. 134. See also MPEP § 2273.

In an *ex parte* reexamination of a patent that issued from an original application filed before November 29, 1999, the patent owner may appeal to the Board either (A) after final rejection of the claims, or (B) after the second rejection of the claims. This is based on the version of 35 U.S.C. 134 in existence prior to the amendment of the reexamination statute on November 29, 1999 by Public Law 106-113.

In an *ex parte* reexamination of a patent that issued from an original application filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of one or more claims in the particular reexamination proceeding for which appeal is sought. See the current version of 35 U.S.C. 134.

The fee for filing the notice of appeal by a patent owner is set forth in 37 CFR 1.17(b), and the time period to pay the fee is determined as provided in 37 CFR 1.134 and 37 CFR 1.136.

Failure to file an appeal in an *ex parte* reexamination proceeding will result in issuance of the reexamination certificate under 37 CFR 1.570.

Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under 35 U.S.C. 311 are governed by 37 CFR

1.959 through 1.981. 37 CFR 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 may be used for filing a notice of appeal.

PTO/SB/31 (02-01)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional): _____					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Assistant Commissioner for Patents, Washington D.C. 20231" on _____ Signature _____ Typed or printed name _____		In re Application of _____ <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Application Number</td> <td style="width: 50%; padding: 2px;">Filed</td> </tr> </table> For _____ <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Group Art Unit</td> <td style="width: 50%; padding: 2px;">Examiner</td> </tr> </table>		Application Number	Filed	Group Art Unit	Examiner
Application Number	Filed						
Group Art Unit	Examiner						
<p>Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.</p> <p>The fee for this Notice of Appeal is (37 CFR 1.17(b)) \$_____.</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$_____.</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.</p> <p><input type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.</p> <p><input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.</p> <p>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record.</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a): _____</p> <div style="text-align: right; margin-top: 10px;"> Signature _____ Typed or printed name _____ Date _____ </div> <p><small>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</small></p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>							

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

MATTERS HANDLED CONCURRENTLY WITH APPEAL

The Office does not acknowledge receipt of a notice of appeal by separate letter. However, if a self-addressed postcard is included with the notice of appeal, it will be date stamped and mailed.

Form paragraphs 12.01-12.04 may be used to indicate defects in a notice of appeal.

¶ 12.01 Notice of Appeal Unacceptable - Fee Unpaid

The notice of appeal filed on [1] is not acceptable because the appeal fee required under 37 CFR 1.17(b) was not filed, or was not timely filed.

Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the appropriate appeal fee. The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.02 Notice of Appeal Unacceptable - No 2nd Rejection

The notice of appeal filed on [1] is not acceptable under 37 CFR 1.191(a) because [2].

Examiner Note:

In bracket 2, insert the following wording, as appropriate:

--there has been no second or final rejection in this patent application--;

--there has been no second or final rejection in this *ex parte* reexamination proceeding on a patent that issued from an original application filed in the United States before November 29, 1999--; or

--there has been no final rejection (37 CFR 1.113) of the claims in this *ex parte* reexamination proceeding on a patent that issued from an original application filed in the United States on or after November 29, 1999--.

¶ 12.03 Notice of Appeal Unacceptable - Not Timely Filed

The notice of appeal filed on [1] is not acceptable because it was filed after the expiration of the period set in the prior Office action. This application will become abandoned unless applicant obtains an extension under 37 CFR 1.136(a). The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.04 Notice of Appeal Unacceptable - Claims Allowed

The notice of appeal filed on [1] is not acceptable because a notice of allowability was mailed by the Office on [2].

1206 Appeal Brief

37 CFR 1.192. Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* A statement of the status of all the claims, pending or cancelled, and identifying the claims appealed.

(4) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review.

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) Describe the subject matter defined by each of the rejected claims,

(B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the application in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal

brief. Amendments should be filed as separate papers. See MPEP § 1207, § 1215.01, and § 1215.02.

TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief. In an *ex parte* reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the Technology Center (TC), requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference is declared, appellant's brief need not be filed while the interference is pending, unless the administrative patent judge has consented to prosecution of the application concurrently with the interference. See MPEP § 2315. Absent such concurrent prosecution, the examiner may, after the interference has terminated and the files have been returned to him or her, (A) set a 2-month period for filing the brief, or (B) withdraw the final rejection of the appealed claims in order to enter an additional rejection on a ground arising out of the interference. See, for example, MPEP § 2363.03. Also, if the appellant was the losing party in the interference, claims which were designated as

corresponding to the lost count or counts will stand finally disposed of under 37 CFR 1.663.

When an application is revived after abandonment for failure on the part of the appellant to take appropriate action after final rejection, and the petition to revive was accompanied by a notice of appeal, appellant has 2 months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under 37 CFR 1.136.

With the exception of a declaration of an interference or suggestion of claims for an interference and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by 37 CFR 1.192(a) or within such additional time as may be properly extended.

A brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(A) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(B) the filing of a petition to invoke the supervisory authority of the Commissioner under 37 CFR 1.181;

(C) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(D) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner withdrawing the final rejection from which appeal has been taken or suggesting claims for an interference, and without an administrative patent judge declaring an interference with the subject application.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. If there are no allowed claims, the applica-

tion is abandoned as of the date the brief was due. Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(c) is required when the brief is filed. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

APPEAL BRIEF CONTENT

The brief, as well as every other paper relating to an appeal, should indicate the number of the Technology Center (TC) to which the application or patent under reexamination is assigned and the application or reexamination control number. When the brief is received, it is forwarded to the TC where it is entered in the file, and referred to the examiner.

An appellant's brief must be responsive to every ground of rejection stated by the examiner.

Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c). See 37 CFR 1.192(d). Form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used to notify the appellant of the deficiency. Oral argument at a hearing will not remedy such deficiency of a brief. The fact that appellant may consider a ground to be clearly improper does not justify a failure to point out to the Board the reasons for that belief.

The mere filing of paper entitled as a brief will not necessarily be considered to be in compliance with 37 CFR 1.192(c). The rule requires that the brief must set forth the authorities and arguments relied upon. Since it is essential that the Board should be provided with a brief fully stating the position of the appellant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position, 37 CFR 1.192(c) requires that the brief contain specific items, as discussed below.

An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a *pro se* appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, notification of a defective appeal brief is in order, while in the latter case, the application or reexamination is forwarded to the Board for a decision on the merits. As noted above, the examiner may use form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective.

If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with three copies of it.

The specific items required by 37 CFR 1.192(c) are:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest. If appellant does not name a real party in interest, the examiner will assume that the party named in the cap-

tion of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

The identification of the real party in interest will allow members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest. See MPEP § 1210.01.

(2) *Related appeals and interferences.* A statement identifying by application number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. The appeal or interference number should also be listed. The statement is not limited to copending applications. If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case. See MPEP § 1210.01.

(3) *Status of Claims.* A statement of the status of all the claims in the application, or patent under reexamination, i.e., for each claim in the case, appellant must state whether it is cancelled, allowed, rejected, etc. Each claim on appeal must be identified.

(4) *Status of Amendments.* A statement of the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, denied entry, or entered in part. This statement should be of the status of the amendment as understood by the appellant.

Items (3) and (4) are included in 37 CFR 1.192(c) to avoid confusion as to which claims are on appeal, and the precise wording of those claims, particularly where the appellant has sought to amend claims after final rejection. The inclusion of items (3) and (4) in the brief will advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any

disagreement on these questions to be resolved before the appeal is taken up for decision by the Board.

(5) *Summary of Invention.* A concise explanation of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. Where applicable, it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

(6) *Issues.* A concise statement of the issues presented for review. Each stated issue should correspond to a separate ground of rejection which appellant wishes the Board of Patent Appeals and Interferences to review. While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. For example, the statement of an issue as "Whether claims 1 and 2 are unpatentable" would not comply with 37 CFR 1.192(c)(6). Rather, the basis of the alleged unpatentability would have to be stated, e.g., "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," or "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure." The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues.

(7) *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone, unless a statement is included that the claims of the group do not stand or fall together and, in the argument section of the brief (37 CFR 1.192(c)(8)), appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(7) requires appellant to state that the claims

do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable.

The absence of such a statement and argument is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them. 37 CFR 1.192(c)(7) is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); and *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). 37 CFR 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c)(8)(iii)).

In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as "ABCDE" and "ABCDEF." The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7).

It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection

tion are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

(8) *Argument*. The appellant's contentions with respect to each of the issues presented for review in 37 CFR 1.192(c) (6), and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section.

Included in this paragraph are five subparagraphs, (i) to (v). Subparagraphs (i) to (iv) concern the grounds of rejection most commonly involved in *ex parte* appeals, namely, 35 U.S.C. 112, first and second paragraphs, 35 U.S.C. 102, and 35 U.S.C. 103. Subparagraph (v) is a general provision concerning grounds of rejection not covered by subparagraphs (i) to (iv).

The purpose of subparagraphs (i) to (iv) is to ensure that the appellant's argument concerning each appealed ground of rejection will include a discussion of the questions relevant to that ground. Compliance with the requirements of the particular subparagraphs which are pertinent to the grounds of rejection involved in an appeal will be beneficial both to the U. S. Patent and Trademark Office and appellants. It will not only facilitate a decision by the Board of Patent Appeals and Interferences by enabling the Board to determine more quickly and precisely the appellant's position on the relevant issues, but also will help appellants to focus their arguments on those issues.

For each rejection not falling under subparagraphs (i) to (iv), subparagraph (v) provides that the argument should specify the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error. This language recognizes that for some grounds of rejection, it may not be

necessary to specify particular claim limitations, for example, a rejection under 35 U.S.C. 101, on the ground that the claims are directed to nonstatutory subject matter, as in *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Inter. 1985).

37 CFR 1.192(a) contains the following sentence:

Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief. It should be noted that arguments not presented in the brief and made for the first time at the oral hearing are not normally entitled to consideration. *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm'r Pat. 1983).

37 CFR 1.192(a) is not intended to preclude the filing of a supplemental paper if new authority should become available or relevant after the brief was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief was filed.

(9) *Appendix*. An appendix containing a copy of the claims involved in the appeal.

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any markings such as brackets or underlining. See MPEP § 1454 for the presentation of the copy of the claims in a reissue application.

The copy of the claims should be double spaced and the appendix should start on a new page.

37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end).

REVIEW OF BRIEF BY EXAMINER

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner. 37 CFR 1.192(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given the long-

est of any of the following time periods to correct the defect(s):

(A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer;

(B) within the time period for reply to the action from which appeal has been taken; or

(C) within 2 months from the date of the notice of appeal under 37 CFR 1.191.

Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The examiner may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

Under 37 CFR 1.192(d), the appellant may file an amended brief to correct any deficiencies in the original brief. Moreover, if appellant disagrees with the examiner's holding of noncompliance, a petition under 37 CFR 1.181 may be filed.

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work an unusual hardship on the appellant.

For a reply brief, see MPEP § 1208.03.

Form paragraphs 12.08-12.13, 12.16, 12.17, and 12.69-12.78, or Form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used concerning the appeal brief.

¶ 12.08 Appeal Dismissed - Brief Fee Unpaid, No Allowed Claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the brief, as required under 37 CFR 1.17(c) was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.

As a result of this dismissal, the application is ABANDONED since there are no allowed claims.

Examiner Note:

Claims which have been indicated as containing allowable subject matter, but are objected to as being dependent upon a rejected claim, are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.09 Appeal Dismissed - Brief Fee Unpaid, Allowed Claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the appeal brief, as required under 37 CFR 1.17(c), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.

As a result of this dismissal, the application will be further processed by the examiner since it contains allowed claims. Prosecution on the merits remains CLOSED.

Examiner Note:

Claims which have been indicated as containing allowable subject matter, but are objected to as being dependent upon a rejected claim, are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.09.01 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192(a), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(c).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP § 1215.04.
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.10 Extension To File Brief - Granted

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 1.192 filed on [1] has been **approved** for [2].

Examiner Note:

This form paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.11 Extension To File Brief - Denied

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 1.192 filed on [1] has been **disapproved** because no sufficient cause for the extension has been shown.

Examiner Note:

This form paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.12 Brief Defective - Unsigned

The appeal brief filed on [1] is defective because it is unsigned. 37 CFR 1.133. A ratification properly signed is required.

To avoid dismissal of the appeal, appellant must ratify the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing of this communication, whichever is longer; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 12.13 Brief Defective - Three Copies Lacking

The appeal brief filed on [1] is defective because the three copies of the Brief required under 37 CFR 1.192(a) have not been submitted.

To avoid dismissal of the appeal, appellant must submit the necessary additional copies of the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or, (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 12.16 Brief Unacceptable - Fee Unpaid

The appeal brief filed on [1] is unacceptable because the fee required under 37 CFR 1.17(c) was not timely filed.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a) and files the required appeal brief fee. The date on which the brief, the fee for filing the brief, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal brief.

¶ 12.17 Brief Unacceptable - Not Timely Filed

The appeal brief filed on [1] is unacceptable because it was filed after the expiration of the required period for reply.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a). The date on which the appeal brief, the fee for filing the brief, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal brief.

Form paragraph 12.69, followed by one or more of from paragraphs 12.69.01-12.78 may be used for noting noncompliance with 37 CFR 1.192(c).

¶ 12.69 Heading for Notice Under 37 CFR 1.192(c)

NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)

Examiner Note:

Use form PTOL-90 and follow with one or more of form paragraphs 12.69.01 to 12.77 and conclude with form paragraph 12.78.

¶ 12.69.01 Statement in Brief That Claims Do Not Stand or Fall Together - Supporting Reasons Lacking

The brief includes a statement that claims [1] do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

Examiner Note:

1. This form paragraph should be used only when no supporting reasons are presented in the brief. If reasons are presented, even if they are not agreed with, use form paragraph 12.55.02 instead of this form paragraph. Reasons for disagreement are discussed in either the "Grounds of Rejection" or in the "Response to Argument" portion of the Examiner's Answer.

2. If the brief contains neither a statement that claims do not stand or fall together nor reasons in support thereof, use form paragraph 12.55.01 in the Examiner's Answer.

¶ 12.70 Missing Section Headings

The brief does not contain the items of the brief required by 37 CFR 1.192(c) under the appropriate headings and/or in the order indicated. [1]

Examiner Note:

In bracket 1, insert an indication of the missing headings or errors in the order of items.

¶ 12.70.01 Defect in Statement of Real Party in Interest

The brief does not contain a heading identifying the real party in interest as required by 37 CFR 1.192(c)(1).

¶ 12.70.02 Defect in Statement of Related Appeals and Interferences

The brief does not contain a heading identifying the related appeals and interferences directly affected by or having a bearing on the decision in the pending appeal as required by 37 CFR 1.192(c)(2).

¶ 12.71 Defect in Statement of Status of Claims

The brief does not contain a statement of the status of all the claims, pending or canceled, and identify the claims appealed as required by 37 CFR 1.192(c)(3). [1]

Examiner Note:

In bracket 1, insert an indication of the missing claim status information.

¶ 12.72 Defect in Statement of Status of Amendment Filed After Final Rejection

The brief does not contain a statement of the status of an amendment filed subsequent to the final rejection as required by 37 CFR 1.192(c)(4). [1]

Examiner Note:

In bracket 1, insert an identification of the amendment for which the status is missing.

¶ 12.73 Defect in Explanation of the Invention

The brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(5). [1]

Examiner Note:

In bracket 1, insert an indication of the missing explanation.

¶ 12.74 Defect in Statement of the Issues

The brief does not contain a concise statement of the issues presented for review as required by 37 CFR 1.192(c)(6). [1]

Examiner Note:

In bracket 1, insert an indication of the missing concise statement of the issues presented for review.

¶ 12.76 Defect in the Arguments of the Appellant

The brief does not contain arguments of the appellant with respect to each of the issues presented for review in 37 CFR 1.192(c)(6), and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR 1.192(c)(8).

Examiner Note:

Include one or more of form paragraphs 12.76.01 to 12.76.06 which apply.

¶ 12.76.01 Separate Heading for Each Issue

Each issue should be treated under a separate heading.

¶ 12.76.02 Defect in 112, First Paragraph, Rejection Argument

The brief does not contain, for each rejection under 35 U.S.C. 112 (first paragraph), an argument which specifies the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including how the specification and drawings, if any, [1].

Examiner Note:

In bracket 1, insert the following wording, as appropriate:

- (a)—describe the subject matter defined by each of the rejected claims--;
- (b)—enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims--; or
- (c)—set forth the best mode contemplated by the inventor of carrying out his/her invention--.

¶ 12.76.03 Defect in 112, Second Paragraph, Rejection Argument

The brief does not contain, for each rejection under 35 U.S.C. 112 (second paragraph), an argument which specifies the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

¶ 12.76.04 Defect in 102 Rejection Argument

The brief does not contain, for each rejection under 35 U.S.C. 102, an argument which specifies the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.05 Defect in 103 Rejection Argument

The brief does not contain, for each rejection under 35 U.S.C. 103, an argument which specifies the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection, and an explanation how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument must explain why the references, taken as a whole do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not be properly combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(8)(iv).

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.06 For Any Rejection Other Than Those Referred to in Paragraphs (c)(8)(i) to (iv) of 37 CFR 1.192 for Which No Argument or Error Was Specified

The brief does not contain an argument which specifies the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

Examiner Note:

Specify claim(s) for which for which no argument of error was specified.

¶ 12.77 No Copy of Appealed Claims in Appendix

The brief does not contain a copy of the claims involved in the appeal in the Appendix.

¶ 12.78 Period For Response Under 37 CFR 1.192(d)

Appellant is required to comply with provisions of 37 CFR 1.192(c). To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which

appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

Examiner Note:

This paragraph has limited application. To notify applicant of non-compliance with 37 CFR 1.192(c) examiner must use form PTOL-462.

1207 Amendment Filed With or After Appeal

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection, but before jurisdiction has passed to the Board (see MPEP § 1210), may be entered upon or after filing of an appeal brief provided that the amendment conforms to the requirements of 37 CFR 1.116. For example, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without cancelling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered. A new amendment, new affidavit, or other new evidence must be submitted in a paper separate from the appeal brief. Entry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right. The entry of an amendment (which may or may not include a new affidavit, declaration, or exhibit) submitted in an application on appeal continues to be governed by 37 CFR 1.116, and the entry of a new affidavit or other new evidence in an application on appeal is governed by 37 CFR 1.195. Examiners must respond to all nonentered amendments after final rejection, and indicate the status of each claim of record or proposed, including the designation of claims that would be entered on the filing of an appeal if filed in a separate paper. If the examiner indicates (in the advisory action) that a proposed amendment of the claim(s) would be entered for purposes of appeal, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be used to reject the added or amended claim(s) in the examiner's answer. See 37 CFR 1.193(a)(2) and MPEP § 1208.01. Except where an amendment merely cancels claims and/or adopts examiner suggestions, removes issues from appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37

CFR 1.116 will be expected of all amendments after final rejection.

If, after appeal has been taken, a paper is presented which *on its face* clearly places the application in condition for allowance, such paper should be entered and a Notice of Allowability form PTOL-37 promptly sent to applicant.

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been previously proposed and entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. Note MPEP § 1208.02. No new ground of rejection, however, is permitted in an examiner's answer. 37 CFR 1.193(a)(2). See MPEP § 714.13 for procedure on handling amendments filed after final action and before appeal.

An amendment received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded by the Board for such purpose. See MPEP § 1210 and § 1211.01.

Note that 37 CFR 1.192(c)(4) requires a statement as to the status of any amendment filed subsequent to the final rejection. See also MPEP § 1206.

1208 Examiner's Answer

37 CFR 1.193. Examiner's answer and reply brief.

(a)(1) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the

amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

APPEAL CONFERENCE

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1206) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary.

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, consideration should be given to the possibility of dropping cumula-

tive art rejections and eliminating technical rejections of doubtful value.

The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference. If it is determined that the rejection(s) should be maintained, the examiner responsible for preparing the examiner's answer will prepare the examiner's answer.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held.

Upon receipt of the appeal case by the Board of Patent Appeals and Interferences (Board), the Board should review the application prior to assigning an appeal number to determine whether an appeal conference has been held. If the examiner's answer does not contain the appropriate indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Board should return the application directly to the appropriate Technology Center (TC) Director for corrective action. This return procedure by the Board should not be considered as a remand of the application. This procedure applies to all examiner's answers received by the Board on or after November 1, 2000.

Before preparing the answer, the examiner should make certain that all amendments approved for entry have in fact been physically entered. The Clerk of the Board will return to the TC any application in which approved amendments have not been entered.

ANSWER

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

The answer should contain a response to the allegations or arguments in the brief and should call attention to any errors in appellant's copy of the claims. If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under "Issues." Grounds of rejection not argued in the

examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so. The examiner should treat affidavits, declarations, or exhibits filed with or after the notice of appeal in accordance with 37 CFR 1.195. If an affidavit, declaration, or exhibit was refused entry under 37 CFR 1.195, the examiner should not comment on it in the examiner's answer. Likewise, it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was refused entry, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, he or she should file a timely petition seeking supervisory review of the non-entry. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either 37 CFR 1.131 or 37 CFR 1.608(b).

If the brief fails to address any or all grounds of rejection advanced by the examiner, or comply with 37 CFR 1.192(c), the indicated procedure for handling such briefs set forth in MPEP § 1206 under "Review of Brief by Examiner" should be followed.

Because of the practice of the U.S. Patent and Trademark Office in entering amendments after final action under justifiable circumstances for purposes of appeal, many cases coming before the Board for consideration contain claims which are not the claims treated in the examiner's final rejection. They are either entirely new claims or amended versions of the finally rejected claims or both. Where an amendment under 37 CFR 1.116 would be entered for appeal purposes, the examiner must identify (in an advisory action) how one or more individual rejections set forth in the final rejection would be used to reject the added or amended claim(s). See 37 CFR 1.193(a)(2) and MPEP § 1208.01. It is important to note that if more than a mere reference to one or more individual rejections set forth in the final rejection is necessary to explain how the added or amended claims would be rejected, then the amendment should not be entered because it raises new issues requiring further consideration and/or search. Furthermore, the mere fact that an amendment under 37 CFR 1.116 could fall within the operation of 37 CFR 1.193(a)(2) does not mean that the amendment must be entered by the examiner. That is, the provisions of 37 CFR 1.116 (and not 37 CFR 1.193(a)(2)) control as to whether an amendment under 37 CFR 1.116 is entitled to entry.

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 1.193 by taking any of the following steps:

(A) Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be *quoted* in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified. Of course, if the examiner feels that some further explanation of the rejection is necessary, he or she should include it in the answer but ordinarily he or she may avoid another recital of the issues and another elaboration of the grounds of rejection. The answer should also include any necessary rebuttal of arguments presented in the appellant's brief if the final action does not adequately meet the arguments.

(B) If the appellant fails to describe the invention, as required by 37 CFR 1.192, the examiner is not required to provide these omissions under 37 CFR 1.192(d). The examiner should, however, clarify the description and explanation in the answer if he or she feels it necessary to present properly and effectively his or her case to the Board.

The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to, especially if the rejection was made in an action which is incorporated by reference. This should be done even though any rejection not repeated and

discussed in the answer may be taken by the Board as having been withdrawn. *Ex parte Emm*, 118 USPQ 180 (Bd. App. 1957).

A new ground of rejection is no longer permitted in an examiner's answer. For a discussion of what constitutes a new ground of rejection, see MPEP § 1208.01. If a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the supervisory patent examiner prior to reopening prosecution after an appeal. See MPEP § 1002.02(d).

All correspondence with the Board, whether by the examiner or the appellant, must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122(a) can be cited by the examiner or the appellant except that either the examiner or the appellant has the right to cite an unpublished decision in an application having common ownership with the application on appeal.

When files are forwarded, soft copies and prints of references therein should remain in the file wrapper.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.

Briefs must comply with 37 CFR 1.192, and all examiner's answers filed in response to such briefs must comply with the guidelines set forth below.

(A) REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(1) *Real Party in Interest*. A statement acknowledging the identification of the real party in financial interest or indicating that the party named in the caption of the brief is the real party in interest, or if the brief contains a proper heading but no real party in interest is identified, a statement that it is presumed that the party named in the caption of the brief is the real party in interest. While the examiner will make this presumption, the Board has discretion to require an explicit statement on this item from appellant.

(2) *Related Appeals and Interferences*. A statement acknowledging appellant's identification of related cases which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal, or if the appellant sets forth the required heading but does not identify any related appeals or interferences, a statement that it is presumed that there are none. While the examiner will make this presumption, the Board has discretion to require an explicit statement on this item from appellant.

(3) *Status of Claims*. A statement of whether the examiner agrees or disagrees with the statement of the status of claims contained in the brief and a correct statement of the status of all the claims pending or cancelled, if necessary. If the examiner considers that some or all of the finally rejected claims are allowable, see MPEP § 1208.02.

(4) *Status of Amendments*. A statement of whether the examiner disagrees with the statement of the status of amendments contained in the brief, and an explanation of any disagreement.

(5) *Summary of Invention*. A statement of whether the examiner disagrees with the summary of invention contained in the brief, an explanation of why the examiner disagrees, and a correct summary of invention, if necessary.

(6) *Issues*. A statement of whether the examiner disagrees with the statement of the issues in the brief and an explanation of why the examiner disagrees, including:

(a) identification of any issues which are petitionable rather than appealable, and

(b) identification of any issues or grounds of rejection on appeal which the examiner no longer considers applicable.

(7) *Grouping of Claims*. A statement of whether the examiner disagrees with any statement in the brief that certain claims do not stand or fall together, and, if the examiner disagrees, an explanation as to why those claims are not separately patentable.

(8) *Claims Appealed*. A statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

(9) *References of Record.* A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

(10) *Grounds of Rejection.* For each ground of rejection applicable to the appealed claims, an explanation of the ground of rejection, or reference to a final rejection or other single prior action for a clear exposition of the rejection.

(a) For each rejection under 35 U.S.C. 112, first paragraph, the examiner's answer, or the single prior action, shall explain how the first paragraph of 35 U.S.C. 112 is not complied with, including, as appropriate, how the specification and drawings, if any,

(i) do not describe the subject matter defined by each of the rejected claims,

(ii) would not enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims without undue experimentation, and (c) do not set forth the best mode contemplated by the appellant of carrying out his or her invention.

(b) For each rejection under 35 U.S.C. 112, second paragraph, the examiner's answer, or single prior action, shall explain how the claims do not particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(c) For each rejection under 35 U.S.C. 102, the examiner's answer, or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

(d) For each rejection under 35 U.S.C. 103, the examiner's answer, or single prior action, shall:

(i) state the ground of rejection and point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection,

(ii) identify any difference between the rejected claims and the prior art relied on, and

(iii) explain how and why the claimed subject matter is rendered unpatentable over the prior art. If the rejection is based upon a combination of references, the examiner's answer, or single prior action, shall explain the rationale for making the combination.

(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate.

(f) For each rejection, other than those referred to in paragraphs (a) to (e) of this section, the examiner's answer, or single prior action, shall specifically explain the basis for the particular rejection.

(11) *Response to Argument.* A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. If any ground of rejection is not argued and replied to by appellant, the response shall point out each claim affected.

(B) **FORM PARAGRAPHS.** A form suitable for the examiner's answer is as follows:

¶ 12.49 Examiner's Answer Cover Sheet

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. [1]

Application Number: [2]

Filing Date: [3]

Appellant(s): [4]

[5]

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed [6].

Examiner Note:

1. This form paragraph includes the USPTO Letterhead and should be used only if typing your own action. Answers prepared in draft form for typing by a typist should use form paragraph 12.50.
2. In bracket 1, insert the Paper No. of the examiner's answer.
3. In bracket 2, insert the application number of the appealed application.
4. In bracket 3, insert the filing date of the appealed application.
5. In bracket 4, insert the name(s) of the appellant.
6. In bracket 5, insert the name of the registered representative of the appellant.

7. In bracket 6, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.
8. Form paragraph 12.50 should NOT follow use of this form paragraph as it is already incorporated herein.

¶ *12.50 Heading For Examiner's Answer*

This is in response to the brief on appeal filed [1].

Examiner Note:

1. Use this form paragraph only when having the Examiner's Answer prepared without using form paragraph 12.49.
2. In bracket 1, indicate the date on which the brief was filed, and also indicate if any supplemental appeal brief was filed, as well as the date on which the supplemental appeal brief was filed.

¶ *12.50.01 Real Party in Interest*

(1) *Real Party in Interest*

Examiner Note:

Follow this form paragraph with form paragraph 12.50.02 or 12.50.03.

¶ *12.50.02 Acknowledgment of Appellant's Identification of a Real Party in Interest in the Brief*

A statement identifying the real party in interest is contained in the brief.

¶ *12.50.03 No Identification of a Real Party in Interest in the Brief*

The brief does not contain a statement identifying the Real Party in Interest. Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

¶ *12.50.04 Related Appeals and Interferences*

(2) *Related Appeals and Interferences*

Examiner Note:

Follow this form paragraph with form paragraph 12.50.05 or 12.50.06.

¶ *12.50.05 Acknowledgment of Appellant's Statement Identifying the Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

¶ *12.50.06 No Related Appeals and Interferences Identified*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal. Therefore, it is presumed that there are none. The Board may, however, exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

¶ *12.51 Status of Claims*

(3) *Status of Claims*

Examiner Note:

Follow this form paragraph with one or more of form paragraphs 12.51.01 to 12.51.10.

¶ *12.51.01 Agreement With Statement of Status of Claims*

The statement of the status of claims contained in the brief is correct.

¶ *12.51.02 Disagreement With Statement of Status of Claims*

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Examiner Note:

1. Indicate the area of disagreement and the reasons for the disagreement.
2. One or more of form paragraphs 12.51.03 to 12.51.10 must follow this paragraph.

¶ *12.51.03 Claims On Appeal*

This appeal involves claim [1].

Examiner Note:

1. In bracket 1, all the claims still on appeal should be specified. Do not list claims which are no longer rejected.
2. Also use form paragraphs 12.51.04 to 12.51.06 when appropriate to clarify the status of the claims on appeal that were incorrectly listed in the brief.

¶ *12.51.04 Status of Claims on Appeal - Substituted*

Claim [1] been substituted for the finally rejected claims.

Examiner Note:

All substituted claims on appeal must be identified if the brief incorrectly lists any substituted claims. In bracket 1, insert the claim number(s) corresponding to the substitute claims, followed by --has-- or --have--, as appropriate.

¶ *12.51.05 Status of Claims on Appeal - Amended*

Claim [1] been amended subsequent to the final rejection.

Examiner Note:

All claims amended after final rejection must be identified if the brief incorrectly lists any claims amended after final rejection. In bracket 1, identify the claim number(s) corresponding to the claim(s) which have been amended, followed by --has-- or --have-- , as appropriate.

¶ *12.51.07 Claims Allowed*

Claim [1] allowed.

Examiner Note:

All allowed claims must be identified if the brief incorrectly lists any allowed claims.

¶ 12.51.08 Claims Objected To

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner Note:

All objected to claims must be identified if the brief incorrectly lists any claims objected to.

¶ 12.51.09 Claims Withdrawn From Consideration

Claim [1] withdrawn from consideration as not directed to the elected [2].

Examiner Note:

All withdrawn claims must be identified if the brief incorrectly lists any withdrawn claims.

¶ 12.51.10 Claims Canceled

Claim [1] been canceled.

Examiner Note:

All canceled claims must be identified if the brief incorrectly lists any canceled claims.

¶ 12.52 Status of Amendments After Final

(4) Status of Amendments After Final

Examiner Note:

Identify status of all amendments submitted after final rejection. Use one or more of form paragraphs 12.52.01 to 12.52.04, if appropriate.

¶ 12.52.01 Agreement With Appellant's Statement of the Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

¶ 12.52.02 Disagreement With Appellant's Statement of the Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

Examiner Note:

Form paragraphs 12.52.03 and/or 12.52.04 must follow this form paragraph to explain the reasons for disagreeing with appellant's statement of the status of the amendments.

¶ 12.52.03 Amendment After Final Entered

The amendment after final rejection filed on [1] has been entered.

Examiner Note:

1. In bracket 1, insert the filing date of any entered after final amendment.
2. Use this form paragraph for each after final amendment which has been entered.

¶ 12.52.04 Amendment After Final Not Entered

The amendment after final rejection filed on [1] has not been entered.

Examiner Note:

1. In bracket 1, insert the date of any after final amendment denied entry.
2. Use this form paragraph for each after final amendment which has been denied entry.

¶ 12.52.05 No Amendments After Final

No amendment after final has been filed.

¶ 12.53 Summary of Invention

(5) Summary of Invention

Examiner Note:

Follow this form paragraph with either of form paragraphs 12.53.01 or 12.53.02.

¶ 12.53.01 Agreement With the Summary of Invention

The summary of invention contained in the brief is correct.

¶ 12.53.02 Disagreement With the Summary of Invention

The summary of invention contained in the brief is deficient because [1].

Examiner Note:

In bracket 1, explain the deficiency of the appellant's summary of the invention. Include a correct summary of the invention if necessary for a clear understanding of the claimed invention.

¶ 12.54 Issues

(6) Issues

Examiner Note:

Follow this form paragraph with form paragraphs 12.54.01, 12.54.02, or 12.54.03.

¶ 12.54.01 Agreement With Appellant's Statement of the Issues

The appellant's statement of the issues in the brief is correct.

¶ 12.54.02 Disagreement With Appellant's Statement of the Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: [1]

Examiner Note:

In bracket 1, explain the changes with respect to the appellant's statement of the issues in the brief including:

- (i) an identification of any issues which are petitionable rather than appealable, and/or
- (ii) an identification of any issues or grounds of rejection on appeal which the examiner no longer considers applicable, and/or
- (iii) any change not covered in (i) or (ii).

¶ 12.54.03 Non-Appealable Issue in Brief

Appellant's brief presents arguments relating to [1]. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

¶ 12.55 Grouping of Claims

(7) Grouping of Claims

Examiner Note:

Follow this form paragraph with either form paragraph 12.55.01, 12.55.02 or 12.55.04 for each grouping of claims (i.e., each ground of rejection which appellant contests).

¶ 12.55.01 No Statement and Reasons in Brief That Claims Do Not Stand or Fall Together

The rejection of claims [1] stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Examiner Note:

1. Use this form paragraph for each grouping of claims (i.e., ground of rejection which appellant contests) wherein the brief includes neither a statement that a grouping of claims does not stand or fall together nor reasons in support thereof.
2. If the brief includes a statement that a grouping of claims does not stand or fall together but does not provide reasons, as set forth in 37 CFR 1.192(c)(7), notify appellant of the non-compliance using form paragraphs 12.69, 12.69.01 and 12.78.

¶ 12.55.02 No Agreement With Brief Why Claims Do Not Stand or Fall Together

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because [1].

Examiner Note:

In bracket 1, explain why the claim grouping listed in the brief is not agreed with by the examiner and why, if appropriate, e.g., the claims as listed by the appellant are not separately patentable.

¶ 12.55.04 Brief Gives Reasons Why Claims Do Not Stand or Fall Together

Appellant's brief includes a statement that claims [1] do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

¶ 12.56 Claims Appealed

(8) Claims Appealed

Examiner Note:

Follow this form paragraph with form paragraph 12.56.01, 12.56.02 or 12.56.03.

¶ 12.56.01 Copy of the Appealed Claims in Appendix Is Correct

The copy of the appealed claims contained in the Appendix to the brief is correct.

¶ 12.56.02 Copy of the Appealed Claims in Appendix Is Substantially Correct

A substantially correct copy of appealed claim [1] appears on page [2] of the Appendix to the appellant's brief. The minor errors are as follows: [3]

Examiner Note:

1. In bracket 1, indicate the claim or claims with small errors.
2. In bracket 3, indicate the nature of the errors.

¶ 12.56.03 Copy of the Appealed Claims in Appendix Contain Substantial Errors

Claim [1] contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim [2] correctly written in the Appendix to the Examiner's Answer.

Examiner Note:

1. Appellant should include a correct copy of all appealed claims in the Appendix to the brief. See 37 CFR 1.192(c)(9).
2. Attach a correct copy of any incorrect claims as an Appendix to the Examiner's Answer and draw a diagonal line in pencil through the incorrect claim in the Appendix of the appellant's appeal brief.
3. Rather than using this form paragraph, if the errors in the claim(s) are significant, appellant should be required to submit a corrected brief using form paragraphs 12.69, 12.77 and 12.78, as well as any other paragraphs 12.70 to 12.76 as may be appropriate. Where the brief includes arguments directed toward the errors, a corrected brief should always be required.

¶ 12.57 Prior Art of Record

(9) Prior Art of Record

Examiner Note:

Follow this form paragraph with either form paragraph 12.57.01 or 12.57.02.

¶ 12.57.01 No Prior Art Relied Upon

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

¶ 12.57.02 Listing of the Prior Art of Record Relied Upon

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Examiner Note:

1. Use the following format for providing information on each reference cited:
Number Name Date
2,717,847 VERAINE 9-1955
1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963
(Figure 2 labeled as Prior Art in this document)
2. The following are example formats for listing reference citations:
2,717,847 VERAINE 9-1955
1,345,890 MUTHER (Fed. Rep. of Germany) 7-1963
(Figure 2 labeled as Prior Art in this document)
3. See MPEP § 707.05(e) for additional examples.

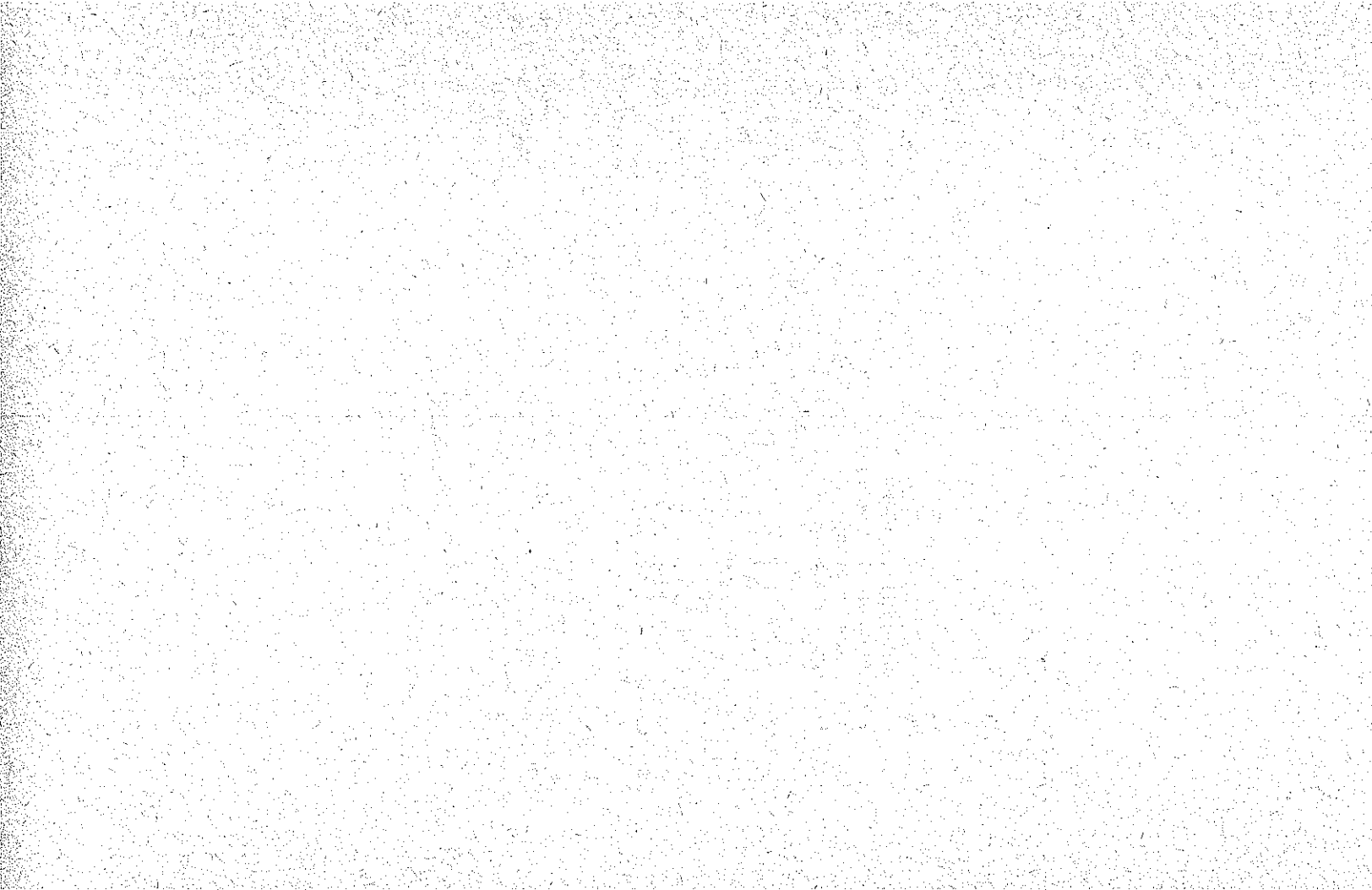
¶ 12.59 Grounds of Rejection

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Examiner Note:

Explain each ground of rejection or refer to the single prior Office action which clearly sets forth the rejection and complies with appropriate paragraphs i - vi below:



examiner should include a statement that he/she will attend the hearing: (A) as the last paragraph of the examiner's answer, if appellant's request for an oral hearing has been made before or with the brief, or (B) in an acknowledgement of the reply brief or in a separate letter on form PTOL-90, if appellant's request for an oral hearing has been made after the examiner's answer. Also, the examiner should make a notation "Examiner will attend (but not participate in) hearing" on the face of the file wrapper below the box for the examiner's name.

1208.01 Prohibition Against Entry of New Ground of Rejection in Examiner's Answer

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

37 CFR 1.193(a)(2) also provides that if:

(A) an amendment under 37 CFR 1.116 proposes to add or amend one or more claims;

(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal

has been taken would be used to reject the added or amended claims, then

(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and

(2) the examiner's answer may include the rejection(s) of the added or amended claims.

The filing of such an amendment represents appellant's consent to proceed with the appeal process. For example, when an amendment under 37 CFR 1.116 cancels a claim (the "canceled claim") and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the "appealed claim"), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a "new ground of rejection" within the meaning of 37 CFR 1.193(a)(2).

The phrase "individual rejections" in 37 CFR 1.193(a)(2) addresses situations such as the following: the action contains a rejection of claim 1 under 35 U.S.C. 102 on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C. In this situation, the action contains the following "individual rejections": (1) 35 U.S.C. 102 on the basis of Reference A; (2) 35 U.S.C. 103 on the basis of Reference A in view of Reference B; and (3) 35 U.S.C. 103 on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1 and 2 together into new claim 4 (or add the limitations of claim 2 to claim 1), 37 CFR 1.193(a)(2) would authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B, provided the applicant was advised that this rejection would be applied to claim 4 (or amended claim 1). Likewise, if an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1 and 3 together into new claim 4 (or add the limitations of claim 3 to claim 1),

37 CFR 1.193(a)(2) would authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C, provided the applicant was advised that this rejection would be applied to claim 4 (or amended claim 1). If, however, an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1, 2, and 3 together into new claim 4 (or add the limitations of claims 2 and 3 to claim 1), 37 CFR 1.193(a)(2) would **not** authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C, even if the applicant is advised that this rejection would be applied to claim 4 (or amended claim 1). Of course, as a claim including the limitations of both claim 2 and claim 3 is a newly proposed claim in the application raising a new issue (*i.e.*, a new ground of rejection), such an amendment under 37 CFR 1.116 may properly be refused entry as raising new issues.

It must be emphasized that amended 37 CFR 1.193(a)(2) does not change the existing practice with respect to amendment after final rejection practice (37 CFR 1.116). The fact that 37 CFR 1.193(a)(2) would authorize the rejection in an examiner's answer of a claim sought to be added or amended in an amendment under 37 CFR 1.116 has no effect on whether the amendment under 37 CFR 1.116 is entitled to entry. The provisions of 37 CFR 1.116 control whether an amendment under 37 CFR 1.116 is entitled to entry; the provisions of 37 CFR 1.193(a)(2) control the rejections to which a claim added or amended in an amendment under 37 CFR 1.116 may be subject in an examiner's answer.

A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). However, where a newly cited reference is added merely as evidence of the prior well known statement made by the examiner, the citation of the reference in the examiner's answer would not consti-

tute a new ground of rejection within the meaning of 37 CFR 1.192(a)(2). See also MPEP § 2144.03.

Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a).

1208.02 Reopening of Prosecution After Appeal

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

Form paragraph 12.81 may be used when reopening prosecution:

¶ 12.81 Reopening of Prosecution - New Ground of Rejection After Appeal or Examiner's Rebuttal of Reply Brief

In view of the [1] filed on [2], PROSECUTION IS HEREBY REOPENED. [3] set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Examiner Note:

1. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims or to enter a rebuttal to the reply brief. The finality or non-finality of an Office action following a reopening of prosecution depends on whether the action could have been properly made final had it been entered prior to the appeal.
2. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.
3. In bracket 2, insert the date on which the brief was filed.
4. In bracket 3, insert --A new ground of rejection is--, --New grounds of rejection are-- or --A rebuttal to the Reply Brief is--.

After reopening of prosecution, appellant must exercise one of the following options to avoid abandonment of the application:

- (A) file a reply under 37 CFR 1.111, if the Office action is non-final;
- (B) file a reply under 37 CFR 1.113, if the Office action is final; or
- (C) request reinstatement of the appeal.

See 37 CFR 1.193(b)(2). Whether appellant elects to continue prosecution or to request reinstatement of the appeal, if prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the notice of appeal, appeal brief, and request for oral hearing (if applicable) will be applied to a later appeal on the same application.

If reinstatement of the appeal is requested, the request must be accompanied by a supplemental appeal brief; however, no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132), or other evidence is permitted. The supplemental appeal brief must comply with the requirements of 37 CFR 1.192(c), but in doing so may incorporate by reference such parts of the previously-filed brief as may still be applicable. The arguments presented in the supplemental appeal brief need only be those relevant to the new ground(s) of rejection raised in the Office action that reopened prosecution, but the appellant should also identify all previously-raised issues and/or arguments which are still considered to be relevant. If the examiner does not consider that the supplemental appeal brief complies with the foregoing requirements, appellant should be given a 1-month time period within which to file an amended supplemental brief under 37 CFR 1.192(d). See MPEP § 1206.

After the supplemental appeal brief is filed, the examiner may issue an answer thereto, and appellant may file a reply brief. It is also possible that, after reading the brief, the examiner may be convinced that some or all of the finally rejected claims are allowable. Where the examiner is of the opinion that some of the claims are allowable, he or she should so specify in the examiner's answer and confine the arguments to the remaining rejected claims. If the examiner finds, upon reconsideration, that all the rejected claims are allowable, or where the appellant in the brief withdraws the appeal as to some of the

rejected claims by submitting an appropriate amendment and the examiner finds the remaining claims to be allowable, the examiner should allow the application.

In applications where an interference has resulted from the applicant provoking an interference with the patent which provided the basis for final rejection, the rejection based on that patent should be withdrawn and the appeal dismissed as to the involved claims.

1208.03 Reply Brief

37 CFR 1.193. Examiner's answer and reply brief.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

- (i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or
- (ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

Under 37 CFR 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. Extensions of time to file the reply brief may be granted pursuant to 37 CFR 1.136(b) or 1.550(c). The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02. A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such purpose.

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

While 37 CFR 1.193(b)(1) prohibits a supplemental examiner's answer (in the absence of a remand from the Board of Patent Appeals and Interference for such purpose), an examiner may (with supervisory patent examiner approval) respond to a reply brief by reopening prosecution. The acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) is an indication by the examiner that no further response by the examiner is deemed necessary. Thus, a remand by the Board of Patent Appeals and Interference under 37 CFR 1.193(b)(1) in an application containing an acknowledgment of receipt and entry of a reply brief under 37 CFR 1.193(b)(1) for the express purpose of a response by the examiner to the reply brief (a supplemental examiner's answer) should rarely, if ever, be necessary.

It should also be noted that an indication of a change in status of claims (e.g., that certain rejections have been withdrawn as a result of the reply brief) is not a supplemental examiner's answer and is of course permitted. Such an indication of a change in status of claims may be made on form PTOL-90.

For procedure where prosecution is reopened after a reply brief has been filed, see MPEP § 1208.02.

Form paragraph 12.47 may be used to acknowledge receipt and entry of a reply brief.

¶ 12.47 Acknowledgment of Reply Brief

Application No. [1]

Art Unit [2]

The reply brief filed [3] has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Examiner Note:

1. This form paragraph is to be printed on a blank page for attachment to a PTOL-90 or PTO-90C.
2. If an amendment, an affidavit and/or a declaration has/have been filed with the reply brief, the examiner must notify the appellant in writing whether it has been entered. Unless the amendment, affidavit, and/or declaration place(s) the application in condition for allowance, entry should not be permitted. See 37 CFR 1.116 and 37 CFR 1.195. This is particularly important since a supplemental examiner's answer is not permitted, unless

the application has been remanded by the Board of Patent Appeals and Interferences for such purpose. See 37 CFR 1.193(b)(1).

1209 Oral Hearing

37 CFR 1.194. Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. If the Board decides that a hearing is not necessary, the Board will so notify appellant.

37 CFR 1.194(b) provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper, a written request therefor, accompanied by the appropriate fee set forth in 37 CFR 1.17(d), within 2 months after the date of the examiner's answer. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves an *ex parte* reexamination proceeding, under 37 CFR 1.550(c).

A notice of hearing, stating the date, the time, and the docket, is forwarded to the appellant in due course. If appellant fails to confirm within the time required in the notice of hearing, the appeal will be removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal will be decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board's resources, appellant should inform the Board

of a change in plans at the earliest possible opportunity. If the Board determines that a hearing is not necessary (e.g., a remand to the examiner is necessary or it is clear that the rejection(s) cannot be sustained), appellant will be notified.

If appellant has any special request, such as for a particular date or day of the week, this will be taken into consideration in setting the hearing, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case and does not place an undue administrative burden on the Board.

The appellant may also file a request, in a paper addressed to the Chief Clerk of the Board, to present his/her arguments via telephone. The appellant making the request will be required to bear the cost of the telephone call.

If the time set in the notice of hearing conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request. However, in view of the administrative burden involved in rescheduling hearings and the potential delay which may result in the issuance of any patent based on the application on appeal, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

Normally, 20 minutes are allowed for appellant to explain his or her position. If appellant believes that additional time will be necessary, a request for such time should be made well in advance and will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

PARTICIPATION BY EXAMINER

If the appellant has requested an oral hearing and the primary examiner wishes to appear and present an oral argument before the Board, a request to present oral argument must be included as the last paragraph of the examiner's answer, using form paragraph 12.63. See MPEP § 1208. If the appellant's request for a hearing is filed after the examiner's answer, then the examiner's request must be in an acknowledgment of reply brief, if applicable, or in a separate letter on form PTOL-90. In either case, the examiner should also make a notation "Examiner Requests an

Oral Hearing" on the face of the file wrapper below the box for the examiner's name.

In those appeals in which an oral hearing has been confirmed and either the primary examiner or the Board has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not appellant appears.

After the oral hearing has been confirmed and the date set as provided in 37 CFR 1.194(c), the application file will be delivered to the examiner via the appropriate Technology Center Director at least 2 weeks prior to the date of the hearing and the examiner will be notified of the date of the hearing. In those cases where the Board requests the presentation of an oral argument by or on behalf of the primary examiner, the Board's request may, where appropriate, indicate specific points or questions to which the argument should be particularly directed. The application file must be returned to the Board at least 2 working days before the hearing.

In any appeal where oral argument is to be presented by, or on behalf of, the primary examiner, the appellant will be given due notice of that fact.

At the hearing, after the appellant has made his or her presentation, the examiner will be allowed 15 minutes to reply as well as to present a statement which clearly sets forth his or her position with respect to the issues and rejections of record. Appellant may utilize any allotted time not used in the initial presentation for rebuttal.

If the examiner wishes to attend the oral hearing as an observer but not to present oral argument, see MPEP § 1208.

1210 Actions Subsequent to Examiner's Answer but Before Board's Decision

JURISDICTION OF BOARD

The application file and jurisdiction of the application are normally transferred from the Technology Centers to the Board at one of the following times:

(A) After 2 months from the examiner's answer, plus mail room time, if no reply brief has been timely filed.

(B) After a supplemental examiner's answer, pursuant to a remand from the Board, has been mailed.

(C) After the examiner has notified the appellant by written communication that the reply brief has been entered and considered and that the application will be forwarded to the Board (for example, by mailing a PTOL-90 with form paragraph 12.47, as described in MPEP § 1208.03).

Any amendment, affidavit, or other paper relating to the appeal, filed thereafter but prior to the decision of the Board, may be considered by the examiner only in the event the case is remanded by the Board for that purpose.

DIVIDED JURISDICTION

Where appeal is taken from the second or final rejection only of one or more claims presented for the purpose of provoking an interference, jurisdiction of the rest of the case remains with the examiner, and prosecution of the remaining claims may proceed as though the entire case was under his or her jurisdiction. Also, where the examiner certifies in writing that there is no conflict of subject matter and the administrative patent judge in charge of the interference approves, an appeal to the Board may proceed concurrently with an interference. See MPEP § 2315.

ABANDONMENT OF APPEAL: APPLICATION REFILED OR ABANDONED

To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, appellants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

See MPEP § 1215.01 - § 1215.03 concerning the withdrawal of appeals.

1210.01 Order for Compliance

While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, the Board may require

the appellant to explicitly name the real party in interest. Likewise, while the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, the Board may require the appellant to explicitly identify any related case. When the Board elects to require an explicit statement, an order for compliance with the rule will be entered setting a 1 - month period for reply to the Board's requirement (37 CFR 1.192(d)). Extensions of time are only available under 37 CFR 1.136(b). An entire new brief need not, and should not, be filed. Rather, a simple paper identifying the real party in interest or explicitly stating that the appellant is the real party in interest will suffice. Failure to timely respond to the Board's requirement may result in dismissal of the appeal. See MPEP § 1215.04 and MPEP § 711.02(b).

1211 Remand by Board

The Board has authority to remand a case to the examiner when it deems it necessary. For example, the Board may remand for a fuller description of the claimed invention and, in the case of a machine, a statement of its mode of operation. In certain cases where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. In the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground. The Board may also remand a case to the examiner for further search where it feels that the most pertinent art has not been cited, or to consider an amendment, affidavit, or declaration. See MPEP § 1211.01, § 1211.02, and § 1211.03. Furthermore, the Board may remand an application to the examiner to prepare a supplemental examiner's answer in response to a reply brief. The following form paragraph may be used in preparing the supplemental examiner's answer after a remand from the Board:

¶ 12.80 Supplemental Examiner's Answer - On Remand

Pursuant to the Remand under 37 CFR 1.193(b)(1) by the Board of Patent Appeals and Interferences on [1], a supplemental Examiner's Answer is set forth below: [2].

Examiner Note:

1. Insert the date of the Remand.
2. Provide reasons supporting the rejections set forth in the supplemental Examiner's Answer.

The supervisory patent examiner should approve and the Board should be notified whenever a remanded application is withdrawn from appeal under any circumstance. See MPEP § 706.07(e) and § 1002.02(d).

1211.01 Remand by Board To Consider Amendment

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. *In re Sweet*, 136 F.2d 722, 58 USPQ 327 (CCPA 1943). However, a proposed amendment, affidavit, declaration, or other paper may be remanded for such consideration as the examiner may see fit to give. Such an amendment will be treated as an amendment filed after appeal. See MPEP § 1207.

If the proposed amendment is in effect an abandonment of the appeal, e.g., by canceling the appealed claims, the amendment should be entered and the clerk of the Board notified in order that the case may be removed from the Board's docket.

1211.02 Remand by Board To Consider Affidavits or Declarations

37 CFR 1.195. Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

Affidavits or declarations filed with or after the filing of a notice of appeal but before jurisdiction passes to the Board (see MPEP § 1210) will be considered for entry only if the appellant makes the necessary showing under 37 CFR 1.195 as to why they were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations. Affidavits or declarations filed after a final rejection and prior to a notice of appeal are handled as provided in MPEP § 715.09, § 716, and § 716.01.

In the case of affidavits or declarations filed after the application has been forwarded to the Board, but before a decision thereon by the Board, the examiner is without authority to consider the same in the absence of a remand by the Board. When an application is remanded to the examiner for the consideration of such affidavits or declarations, the examiner, after having given such consideration as the facts in the

case require, will return the application to the Board with his or her supplemental examiner's answer on remand, a copy of which should be forwarded to the appellant. If such an affidavit or declaration is not accompanied by the showing required under 37 CFR 1.195, the examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the examiner will admit the same and consider its merits.

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for rehearing of its decision where no rejection has been made under 37 CFR 1.196(b). Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. *In re Martin*, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

For remand to the examiner to consider appellant's response relating to a 37 CFR 1.196(b) rejection, see MPEP § 1214.01.

1211.03 Remand by Board for Further Search

It should be rare for the Board to remand a case to the examiner for further search. A remand to the examiner extends the total pendency of an application and may necessitate an extension of the patent term under 35 U.S.C. 154(b). See MPEP § 2710. When such a remand is necessary, the Board should conduct a search (on-line or otherwise) of at least one subclass and cite art from that subclass to demonstrate the basis on which it concludes that a search of this area would be productive. The art cited need not be art upon which a rejection can be made.

1212 Board Requires Appellant to Address Matter

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

(d) The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

37 CFR 1.196(d) authorizes the Board to require an appellant to clarify the record by addressing any matter deemed appropriate for a reasoned decision on the appeal. This may include, for example: (A) the applicability of particular case law that has not been previously identified as relevant to an issue in the appeal; or (B) the applicability of prior art that has not been made of record.

The rule further provides that the appellant will be given a non-extendable time period within which to respond to the requirement. Failure to respond within the time period set by the Board will result in dismissal of the appeal.

The making of a requirement under 37 CFR 1.196(d) is discretionary with the Board. The authority granted in 37 CFR 1.196(d) does not affect the Board's authority to remand a case to the examiner in a situation where the Board considers action by the examiner in the first instance to be necessary or desirable. See MPEP § 1211. Also, after an appellant has replied to a requirement under 37 CFR 1.196(d), a remand to the examiner may be deemed to be appropriate.

1213 Decision by Board

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner or remand the application to the examiner for further consideration. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(e) Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

After consideration of the record including appellant's brief and the examiner's answer, the Board

writes its decision, affirming the examiner in whole or in part, or reversing the examiner's decision, sometimes also setting forth a new ground of rejection.

37 CFR 1.196(e) provides that a decision of the Board which includes a remand will not be considered as a final decision in the case. The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available to an appellant following a decision by the Board.

On occasion, the Board has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the Court of Appeals for the Federal Circuit involving issues identical with and/or similar to those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice. An appellant is not entitled, after obtaining a final decision by the U.S. Patent and Trademark Office on an issue in a case, to utilize the prolonged pendency of a court proceeding as a means for avoiding *res judicata* while relitigating the same or substantially the same issue in another application.

An applicant may request that the decision be withheld to permit the refiling of the application at any time prior to the mailing of the decision. Up to 30 days may be granted, although the time is usually limited as much as possible. The Board will be more prone to entertain the applicant's request where the request is filed early, obviating the necessity for an oral hearing or even for the setting of the oral hearing date. If the case has already been set for oral hearing, the petition should include a request to vacate the hearing date, *not* to postpone it.

In a situation where a withdrawal of the appeal is filed on the same day that the decision is mailed, a petition to vacate the decision will be denied.

See MPEP § 1214.01 concerning the procedure following a new ground of rejection by the Board under 37 CFR 1.196(b).

1213.01 Statement of Allowability by Board

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement, which shall be binding on the examiner in the absence of new references or grounds of rejection.

If the Board's decision includes an explicit statement that a claim may be allowed in amended form, appellant may amend the claim in conformity with the statement and the statement would be binding on the examiner in the absence of new prior art references or grounds of rejection. The examiner should make certain that the amendment does in fact conform to the statement in the Board's decision.

The making of a statement under 37 CFR 1.196(c) is discretionary with the Board. In the absence of an express statement, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913).

Appellant's right to amend in conformity with the statement under 37 CFR 1.196(c) may only be exercised within the period allowed for seeking court review under 37 CFR 1.304. See MPEP § 1216.

1213.02 New Grounds of Rejection by Board

37 CFR 1.196. Decision by the Board of Patent Appeals and Interferences.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection shall not be considered final for purposes of judicial review. When the Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two

months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal pursuant to §§ 1.191 through 1.195 to the Board of Patent Appeals and Interferences.

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for rehearing must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. Where request for such rehearing is made, the Board of Patent Appeals and Interferences shall rehear the new ground of rejection and, if necessary, render a new decision which shall include all grounds of rejection upon which a patent is refused. The decision on rehearing is deemed to incorporate the earlier decision for purposes of appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision.

(f) See § 1.136(b) for extensions of time to take action under this section in a patent application and § 1.550(c) for extensions of time in a reexamination proceeding.

Under 37 CFR 1.196(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.

While 37 CFR 1.196(b) now authorizes the Board to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. Since the exercise of authority under 37 CFR 1.196(b) is discretionary, no inference should be drawn from a failure to exercise that discretion.

See MPEP § 1214.01 for the procedure following a new ground of rejection under 37 CFR 1.196(b).

1213.03 Publication of Board Decision

Decisions of the Board may be published at the discretion of the Commissioner. Requests by members of the public or applicants to publish a decision of the Board should be referred to the Office of the Solicitor. A decision in a pending or abandoned application will be published in accordance with 37 CFR 1.14(g).

Decisions of the Board which are open to the public are available in electronic form on the USPTO website (<http://www.uspto.gov>).

1214 Procedure Following Decision by Board

37 CFR 1.197. Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application may require, to carry into effect the decision.

After an appeal to the Board has been decided, a copy of the decision is mailed to the appellant and the original placed in the file. The clerk of the Board notes the decision on the file wrapper and in the record of appeals, and then forwards the file to the examiner through the office of the Technology Center Director immediately if all rejections are reversed, and after about 10 weeks if any rejection is affirmed or after a decision on a request for rehearing is rendered.

1214.01 Procedure Following New Ground of Rejection by Board

When the Board makes a new rejection under 37 CFR 1.196(b), the appellant, as to each claim so rejected, has the option of:

- (A) submitting an appropriate amendment and/or a showing of facts (37 CFR 1.196(b)(1)); or
- (B) requesting rehearing (37 CFR 1.196(b)(2)).

The amendment and/or showing of facts under 37 CFR 1.196(b)(1), or the request for rehearing under 37 CFR 1.196(b)(2), must be filed within 2 months from the date of the Board's decision. In

accordance with 37 CFR 1.196(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or showing of facts (see paragraph I below) as to less than all of the claims rejected by the Board under 37 CFR 1.196(b), and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or showing of facts as to those claims will be treated as a request for rehearing as to those claims.

I. SUBMISSION OF AMENDMENT OR SHOWING OF FACTS

37 CFR 1.196(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or a showing of facts relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR 1.196(b)(2), if it contains any argument concerning the Board's rejection. The "showing of facts" under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or a showing of facts as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 1.196(b)(2).

The new ground of rejection raised by the Board does not reopen the prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 1.196(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 1.196(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under 37 CFR 1.196(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 1.196(b) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 1.196(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216.

If the examiner does not consider that the amendment and/or showing of facts overcomes the rejection, he or she will again reject the claims. If appropriate, the rejection will be made final.

An applicant in whose application such a final rejection has been made by the examiner may mistake

only believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 1.196(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

II. REQUEST FOR REHEARING

Instead of filing an amendment and/or showing of facts under 37 CFR 1.196(b)(1), an appellant may elect to proceed under 37 CFR 1.196(b)(2) and file a request for rehearing of the Board's new rejection. The rule requires that the request for rehearing "must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." By proceeding in this manner, the appellant waives his or her right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). A request for rehearing accompanied by an appropriate amendment of the claims rejected by the Board, and/or by an affidavit or declaration containing a showing of facts, does not constitute a proper request for rehearing under 37 CFR 1.196(b)(2), and will be treated as a submission under 37 CFR 1.196(b)(1).

If the Board's decision also includes an affirmance of the examiner's rejection, a request for rehearing of the affirmance (see MPEP § 1214.03 and MPEP § 1214.06, paragraph IV) should be filed in a separate paper to facilitate consideration.

1214.03 Rehearing

37 CFR 1.197. Action following decision.

(b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See

§ 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

The term "rehearing" is used in 37 CFR 1.197(b) for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing. *Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev'd. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

37 CFR 1.197(b) provides that any request for rehearing must specifically state the points believed to have been misapprehended or overlooked in the Board's decision. Experience has shown that many requests for rehearing are nothing more than reargument of appellant's position on appeal. In response, the rule was revised to limit requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board.

The 2-month period provided by 37 CFR 1.197(b) for filing a request for rehearing can only be extended under the provisions of 37 CFR 1.136(b) or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

All copies of references in the file wrapper should be retained therein.

For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR 1.304(a), see MPEP § 1216 and § 1002.02(o).

For requests for reconsideration by the examiner, see MPEP § 1214.04.

1214.04 Examiner Reversed

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 1.196(b)), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request should set a period of 1 month for the appellant to file a reply.

If approved, the Office of the Deputy Commissioner for Patent Examination Policy will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board.

1214.05 Cancellation of Withdrawn Claims

Where an appellant withdraws some of the appealed claims, and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the appellant of the cancellation of the withdrawn claims.

1214.06 Examiner Sustained in Whole or in Part

37 CFR 1.197. Action following decision.

(c) Termination of proceedings. Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except: (1) Where claims stand allowed in an application or (2) Where the nature of the decision requires further action by the examiner. The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§ 1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is received by the Office. A civil action is terminated when the time to appeal the judgment expires.

The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Commissioner. See MPEP § 1216. When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve one or more of the following circumstances:

I. NO CLAIMS STAND ALLOWED

The proceedings in an application or *ex parte* reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. In an *ex parte* reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570.

Claims indicated as allowable prior to appeal except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) If claims 1-2 are pending, and the Board affirms a rejection of claim 1 and claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1, the examiner should hold the application abandoned.

(B) If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, the examiner, after expiration of the period for further appeal, should proceed in one of two ways:

(1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or

(2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under 37 CFR 1.136(a) will not be permitted. If no timely reply is received, the examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.

The following language may be used where appropriate:

Claim(s) _____ is/are incomplete because the claim(s) on which it/they depend(s) from has/have been cancelled by the examiner in accordance with MPEP § 1214.06. Applicant is given a ONE MONTH TIME LIMIT from the date of this letter in which to present claim(s) _____ in independent form. NO EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) WILL BE GRANTED. Failure to comply with this deadline will result in cancellation of claim(s) _____ and this application will be:

i. allowed with claim(s) _____ (if other claims are allowed), or

ii. abandoned (if there are no allowed claims).

II. CLAIMS STAND ALLOWED

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. A red-ink line should be drawn through the refused claims and the notion "Board Decision" written in the margin in red ink.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and

independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

If uncorrected matters of form which cannot be handled without written correspondence remain in the application, the examiner should take appropriate action but prosecution is otherwise closed. Note paragraph I of this section for handling of claims dependent on rejected claims. A letter such as that set forth in form paragraph 12.20 is suggested:

¶ 12.20 Period For Seeking Court Review Has Lapsed

The period for seeking court review of the decision by the Board of Patent Appeals and Interferences rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see 37 CFR 1.197(c).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. In bracket 1, enter the date of the decision.
2. In bracket 2, identify the allowed claims.
3. In bracket 3, identify the formal matters that need correction.

III. CLAIMS REQUIRE ACTION

If the decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in an application or *ex parte* reexamination proceeding containing claims to nonelected species not previously acted upon, the examiner will take up the application or reexamination proceeding for appropriate action on the matters thus brought up. However, the application or reexamination proceeding is not considered open to further prosecution except as to such matters.

IV. 37 CFR 1.196(b) REJECTION

Where the Board makes a new rejection under 37 CFR 1.196(b) and no action is taken with reference thereto by appellant within 2 months, the examiner should proceed in the manner indicated in paragraphs

I-III of this section as appropriate. See MPEP § 1214.01.

If the Board affirms the examiner's rejection, but also enters a new ground of rejection under 37 CFR 1.196(b), the subsequent procedure depends upon the action taken by the appellant with respect to the 37 CFR 1.196(b) rejection.

(A) If the appellant elects to proceed before the examiner with regard to the new rejection (see MPEP § 1214.01, paragraph I) the Board's affirmance will be treated as nonfinal, and no request for rehearing of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 1.196(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 1.196(b) rejection. If an application becomes allowed, it should not be returned to the Board. Likewise, if an application is abandoned for any reason, it should not be returned to the Board. If the rejection under 37 CFR 1.196(b) is not overcome, the applicant (or patent owner in an *ex parte* reexamination proceeding) can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 1.196(b) rejection and may not include the affirmed rejection. If an application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 1.196(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered. Similarly, the file of any *ex parte* reexamination proceeding including rejections affirmed by the Board but made nonfinal for purposes of judicial review must be returned to the Board so that the affirmance can be made final by the Board. The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216.

(B) If the appellant elects to request rehearing of the new rejection (see MPEP § 1214.01, paragraph II), the request for rehearing of the new rejection and of the affirmance must be filed within 2 months from the date of the Board's decision.

V. APPEAL DISMISSED

Where the appeal has been dismissed for failure to argue a ground of rejection involving all the appealed claims, see MPEP § 1215.04.

The practice under the situations identified in paragraphs I-III of this section is similar to the practice after a decision of the court outlined in MPEP § 1216.01.

In view of the above practice, examiners must be very careful that case files which come back from the Board are not overlooked because every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. Consequently, when a file is received after decision by the Board, it must be examined and appropriate precautions taken to indicate the presence of allowed claims, if any. This may be done by writing the notation "Allowed Claims" or "Rejection Reversed" on the "Contents" page of the file wrapper immediately below the endorsement "Decision by Board."

See MPEP § 1216.01 and § 1216.02 for procedure where court review is sought.

1214.07 Reopening of Prosecution

37 CFR 1.198. Reopening after decision.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Sometimes an amendment is filed after the Board's decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that the prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), the prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph I. If the amendment obviously

places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be admitted, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note MPEP § 1002.02(d).

Where the amendment cannot be entered, the examiner should write to the appellant indicating that the amendment cannot be entered and stating the reason why. The refusal may not be arbitrary or capricious.

Form paragraph 12.19 should be used:

¶ 12.19 Amendment After Board Decision, Entry Refused

The amendment filed [1] after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed claim(s) raise new issues which require further consideration or search (37 CFR 1.116(c)). See also 37 CFR 1.198.

[2]

Examiner Note:

1. In bracket 2, identify the new issues.
2. This form paragraph is not to be used where a 37 CFR 1.196 (b) rejection has been made by the Board of Patent Appeals and Interferences.

In the event that claims stand allowed in the application under the conditions set forth in MPEP § 1214.06, paragraph II, the application should be passed to issue.

Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, MPEP § 1002.02(c).

The Commissioner also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

(B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

(C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Such petitions will not be ordinarily entertained after the filing of the Commissioner's brief in cases in which review has been sought under 35 U.S.C. 141, or after trial in a 35 U.S.C. 145 case.

In the case of an appeal under 35 U.S.C. 141, if the petition is granted, steps will be taken to request the court to remand the case to the U. S. Patent and Trademark Office. If so remanded, the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board in the first instance or by the examiner as may be appropriate. In the case of civil action under 35 U.S.C. 145, steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals.

1215 Withdrawal or Dismissal of Appeal

1215.01 Withdrawal of Appeal

Except in those instances where a withdrawal of an appeal would result in abandonment of an application, an attorney not of record in an application or reexamination proceeding may file a paper under 37 CFR 1.34(a) withdrawing an appeal. In instances where no allowable claims appear in an application, the withdrawal of an appeal is in fact an express abandonment that does not comply with 37 CFR 1.138 except where a continuing application is being filed on the same date.

Where, after an appeal has been filed and before decision by the Board, an applicant withdraws the appeal after the period for reply to the final rejection has expired, the application is to be considered abandoned as of the date on which the appeal was withdrawn unless there are allowed claims in the case.

Where a letter abandoning the application is filed in accordance with 37 CFR 1.138, the effective date of

abandonment is the date of recognition of the letter by an appropriate official of the Office or a different date, if so specified in the letter itself. See MPEP § 711.01.

If a brief has been filed within the time permitted by 37 CFR 1.192 (or any extension thereof) and an answer mailed and appellant withdraws the appeal, the application is returned to the examiner.

Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen the prosecution of the application, applicant can file a request for continued examination (RCE) under 37 CFR 1.114, accompanied by a submission (i.e., a reply responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action) and the RCE fee set forth under 37 CFR 1.17(e). Note that the RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. See 37 CFR 1.114(d) and MPEP § 706.07(h), paragraph X, for more details. An appeal brief or reply brief (or related papers) is not a submission under 37 CFR 1.114, unless the transmittal letter of the RCE contains a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. See MPEP § 706.07(h), paragraph II. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether the RCE includes the appropriate fee or a submission. Therefore, when an RCE is filed without the appropriate fee or a submission in an application that has no allowed claims, the application will be considered abandoned. To avoid abandonment, the RCE should be filed in compliance with 37 CFR 1.114. See MPEP § 706.07(h), paragraphs I-II.

To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated

as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

In an *ex parte* reexamination proceeding, an *ex parte* reexamination certificate should be issued under 37 CFR 1.570.

1215.02 Claims Standing Allowed

If an application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal.

1215.03 Partial Withdrawal

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the conclusion of the appeal proceedings, if necessary (e.g., the examiner is reversed as to the rejection of the remaining claims on appeal), without further action by the applicant.

1215.04 Dismissal of Appeal

If no brief is filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed by operation of the rule. Form PTOL-461 "Notification of

Defective Notice of Appeal or Defective Brief," or form paragraph 12.17 notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed, an application is considered as abandoned on the date the brief was due. If claims stand allowed in an application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months under 37 CFR 1.136(a)) to file the brief has expired.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application with claim 3 only.

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a shortened period for reply, but the application or reexamination proceeding is to be considered closed to further prosecution except as to such matters. Form paragraph 12.09.01 may be used for this purpose. See MPEP § 1206.

An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 1.192(c). See MPEP § 1206 and 37 CFR 1.192(d). As in examples (B)-(C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the

notice was due. The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal. If the appeal is dismissed, but allowed claims remain in the application, as in examples (A) and (D) above, the application is not abandoned; to reinstate the claims cancelled by the examiner because of the dismissal, the applicant must petition to reinstate the claims and the appeal, but a showing equivalent to a petition to revive under 37 CFR 1.137 is required. In either event, a proper reply to the notice of noncompliance must be filed before the petition will be considered on its merits.

1216 Judicial Review

35 U.S.C. 141. *Appeal to the Court of Appeals for the Federal Circuit.*

An applicant dissatisfied with the decision in an appeal to the Board of Patent Appeals and Interferences under section 134 of this title may appeal the decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal the applicant waives his or her right to proceed under section 145 of this title. A patent owner in any reexamination proceeding dissatisfied with the final decision in an appeal to the Board of Patent Appeals and Interferences under section 134 may appeal the decision only to the United States Court of Appeals for the Federal Circuit. A party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences on the interference may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal in accordance with section 142 of this title, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146 of this title. If the appellant does not, within thirty days after filing of such notice by the adverse party, file a civil action under section 146, the decision appealed from shall govern the further proceedings in the case.

35 U.S.C. 145. *Civil action to obtain patent.*

An applicant dissatisfied with the decision of the Board of Patent Appeals and Interferences in an appeal under section 134(a) of this title may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Patent Appeals and Interferences, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

35 U.S.C. 146. *Civil action in case of interference.*

Any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Appeals for the Federal Circuit, and such appeal is pending or has been decided. In such suits the record in the Patent and Trademark Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Director shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Director to issue such patent on the filing in the Patent and Trademark Office of a certified copy of the judgment and on compliance with the requirements of law.

35 U.S.C. 306. *Appeal.*

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of section 134 of this title, and may seek court review under the provisions of sections 141 to 145 of this title, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

37 CFR 1.301. *Appeal to U.S. Court of Appeals for the Federal Circuit.*

Any applicant or any owner of a patent involved in any *ex parte* reexamination proceeding filed under § 1.510, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences, may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal: In the U.S. Patent and Trademark Office, file a written notice of appeal directed to the Commissioner (see §§ 1.302 and 1.304); and in the Court, file a copy of the notice of appeal and pay the fee for appeal as provided by the rules of the Court. For *inter partes* reexamination proceedings filed under § 1.913, § 1.983 is controlling.

37 CFR 1.303. Civil action under 35 U.S.C. 145, 146, 306.

(a) Any applicant or any owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, dissatisfied with the decision of the Board of Patent Appeals and Interferences, and any party to an interference dissatisfied with the decision of the Board of Patent Appeals and Interferences may, instead of appealing to the U.S. Court of Appeals for the Federal Circuit (§ 1.301), have remedy by civil action under 35 U.S.C. 145 or 146, as appropriate. Such civil action must be commenced within the time specified in § 1.304.

(b) If an applicant in an *ex parte* case or an owner of a patent involved in an *ex parte* reexamination proceeding filed under §1.510 for a patent that issues from an original application filed in the United States before November 29, 1999, has taken an appeal to the U.S. Court of Appeals for the Federal Circuit, he or she thereby waives his or her right to proceed under 35 U.S.C. 145.

(c) If any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an interference proceeding files notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (§ 1.302), that he or she elects to have all further proceedings conducted as provided in 35 U.S.C. 146, the notice of election must be served as provided in § 1.646.

(d) For an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issues from an original application filed in the United States on or after November 29, 1999, and for an *inter partes* reexamination proceeding filed under § 1.913, no remedy by civil action under 35 U.S.C. 145 is available.

37 CFR 1.304. Time for appeal or civil action.

(a)(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 1.197(b), § 1.658(b), or § 1.979(a), the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In interferences the time for filing a cross-appeal or cross-action expires:

(i) Fourteen days after service of the notice of appeal or the summons and complaint; or

(ii) Two months after the date of decision of the Board of Patent Appeals and Interferences, whichever is later.

(2) The time periods set forth in this section are not subject to the provisions of § 1.136, § 1.550(c), § 1.956, or § 1.645(a) or (b).

(3) The Commissioner may extend the time for filing an appeal or commencing a civil action:

(i) For good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or

(ii) Upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

(b) The times specified in this section in days are calendar days. The time specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(c) If a defeated party to an interference has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under 35 U.S.C. 141 electing to have all further proceedings conducted under 35 U.S.C. 146 (§ 1.303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141. The time for filing a cross-action expires 14 days after service of the summons and complaint.

JUDICIAL REVIEW OF PATENT APPLICATIONS

An applicant for a patent who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the U.S. Court of Appeals for the Federal Circuit (35 U.S.C. 141 and 37 CFR 1.301) or by a civil action in the U.S. District Court for the District of Columbia (35 U.S.C. 145 and 37 CFR 1.303(a)). By filing an appeal to the Federal Circuit, the applicant waives the right to seek judicial review by a civil action under 35 U.S.C. 145. See 35 U.S.C. 141 and 37 CFR 1.303(b).

JUDICIAL REVIEW OF EX PARTE REEXAMINATION PROCEEDINGS

A patent owner involved in an *ex parte* reexamination proceeding filed under 35 U.S.C. 302 for a patent that issued from an original application filed in the United States before November 29, 1999 (or from an international application designating the United States filed before November 29, 1999) who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the U.S. Court of Appeals for the Federal Circuit or by a civil action in the U.S. District Court for the District of Columbia.

Public Law 106-113, enacted on November 29, 1999, amended 35 U.S.C. 141 and 35 U.S.C. 145 to read as they have been reproduced above. However, former versions of 35 U.S.C. 141 and 145 remain applicable in the case of an *ex parte* reexamination proceeding for a patent that issued from an original application filed before November 29, 1999. The former statutes provided for appeal to the Court of Appeals for the Federal Circuit (35 U.S.C. 141), or

alternatively, for a civil action against the Commissioner in the United States District Court for the District of Columbia (35 U.S.C. 145). Former 35 U.S.C. 141 further provided that by filing an appeal to the Court of Appeals for the Federal Circuit under 35 U.S.C. 141, a patent owner waived his/her right to proceed to file a civil action under 35 U.S.C. 145. See 37 CFR 1.303(a)-(b).

The amended versions of 35 U.S.C. 141 and 145 that went into effect on November 29, 1999 provide that a patent owner may appeal only to the United States Court of Appeals for the Federal Circuit. Accordingly, a patent owner involved in the *ex parte* reexamination of a patent that issued from an original application filed in the United States on or after November 29, 1999 (or from an international application designating the United States filed on or after November 29, 1999) may seek judicial review only in the United States Court of Appeals for the Federal Circuit. See 37 CFR 1.303(d).

For judicial review of an *inter partes* reexamination proceeding, see 35 U.S.C. 315. Because *inter partes* reexamination procedures are found in Chapter 31 (and not in Chapter 30) of Title 35 of the United States Code, 35 U.S.C. 306 does not apply to an *inter partes* reexamination proceeding.

JUDICIAL REVIEW OF INTERFERENCE PROCEEDINGS

Any party to an interference who is dissatisfied with a decision of the Board may seek judicial review either by an appeal to the Federal Circuit (35 U.S.C. 141; 37 CFR 1.301) or, if no 35 U.S.C. 141 appeal is pending or has been decided, by a civil action in an appropriate district court (35 U.S.C. 146; 37 CFR 1.303(a)). Furthermore, a 35 U.S.C. 141 appeal to the Federal Circuit by a dissatisfied party in an interference will be dismissed if any adverse party in the interference, within 20 days after the appellant has filed a notice of appeal according to 35 U.S.C. 142, files notice with the Commissioner that such adverse party elects to have all further proceedings conducted in accordance with 35 U.S.C. 146. See 35 U.S.C. 141; 37 CFR 1.303(c). If, within 30 days after filing of such notice of election by an adverse party, the appellant does not file a civil action under 35 U.S.C. 146, the decision appealed from shall govern the further proceedings in the case. 35 U.S.C. 141. Copies of

such notice of election, which must be served as provided in 37 CFR 1.646, will be transmitted by the Solicitor to the Federal Circuit for such action as may be necessary (37 CFR 1.303(c)).

TIME FOR FILING NOTICE OF APPEAL OR COMMENCING CIVIL ACTION

The time for filing a notice of a 35 U.S.C. 141 appeal to the Federal Circuit or for commencing a civil action under 35 U.S.C. 145 or 146 is within 2 months of the Board's decision. 37 CFR 1.304(a). However, if a request for rehearing or reconsideration of the Board's decision is filed within the time provided under 37 CFR 1.197(b) (*ex parte* appeals) or 37 CFR 1.658(b) (*inter partes* appeals), the time for filing a notice of appeal to the Federal Circuit or for commencing a civil action expires 2 months after a decision on a request for rehearing or reconsideration (37 CFR 1.304(a)).

These 2-month periods meet the 60-day requirement of 35 U.S.C. 142, 145, and 146 except for time periods which include February 28. In order to comply with the 60-day requirement, 37 CFR 1.304(b) provides that an additional day shall be added to any 2-month period for initiating review which includes February 28. Appeals will always be timely if the judicial review is initiated within 2 months of the final decision.

The times specified in 37 CFR 1.304 are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday, or a Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday, nor a Federal holiday (37 CFR 1.304(b)).

TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

37 CFR 1.304(a) specifies that the time for filing a cross-appeal or a cross-action expires (A) 14 days after service of the notice of appeal or the summons and complaint or (B) 2 months after the decision to be reviewed, whichever is later.

37 CFR 1.304(a) provides that the time for filing a cross-action expires 14 days after service of the summons and complaint. The district court will determine whether any cross-action was timely filed since

neither the complaint nor cross-action is filed in the U.S. Patent and Trademark Office.

EXTENSION OF TIME TO SEEK JUDICIAL REVIEW

In 37 CFR 1.304(a), the Office has adopted a standard which is similar to the standard used in the Federal courts for granting extensions. Under the rule, the Commissioner may extend the time (A) for good cause if requested before the expiration of the time provided for initiating judicial review or (B) upon a showing of excusable neglect in failing to initiate judicial review if requested after the expiration of the time period. This standard is applicable once the "last" decision has been entered, i.e., either the decision (in circumstances where no timely rehearing or reconsideration is sought), the decision on rehearing of the Board in an *ex parte* appeal, or the decision on reconsideration of the Board in an interference. Extensions of time under 37 CFR 1.136(b) and 1.550(c) and fee extensions under 37 CFR 1.136(a) are not available to extend the time for the purpose of judicial review once a decision or a decision on rehearing or reconsideration has been entered. 37 CFR 1.304(a)(2) states that the provisions of 37 CFR 1.136 and 1.550(c) are not available to extend the time to initiate judicial review.

Requests for extension of time to seek judicial review under 37 CFR 1.304 should be addressed as follows:

Box 8
Commissioner of Patents and Trademarks
Washington, DC 20231
Attention: Office of The Solicitor

Requests may also be hand-carried to the Office of the Solicitor.

APPLICATION UNDER JUDICIAL REVIEW

The administrative file of an application under judicial review, even though carried to a court, will not be opened to the public by the U.S. Patent and Trademark Office, unless it is otherwise available to the public under 37 CFR 1.11.

During judicial review, the involved application or reexamination is not under the jurisdiction of the examiner or the Board, unless remanded to the U.S. Patent and Trademark Office by the court. Any

amendment, such as one copying claims from a patent for interference purposes, can be admitted only under the provisions of 37 CFR 1.198. See MPEP § 1214.07.

SERVICE OF COURT PAPERS ON THE COMMISSIONER

Rule 5(b) of the Federal Rules of Civil Procedure provides in pertinent part:

Whenever under these rules service is required or permitted to be made upon a party represented by an attorney the service shall be made upon the attorney unless service upon the party is ordered by the court. Service upon the attorney . . . shall be made by delivering a copy to the attorney or party or by mailing it to the attorney or party at the attorney's or party's last known address

Similarly, Rule 25(b) of the Federal Rules of Appellate Procedure provides that "[s]ervice on a party represented by counsel must be made on the party's counsel."

Accordingly, all service copies of papers filed in court proceedings in which the Commissioner of Patents and Trademarks is a party must be served on the Solicitor of the Patent and Trademark Office. Service on the Solicitor may be effected in either of the following ways:

(A) By hand between 8:30 A.M. and 5:00 P.M. EST at the Office of the Solicitor

(B) By mail in an envelope addressed as follows:

Office of the Solicitor
P.O. Box 15667
Arlington, VA 22215

While the above mail service address may be supplemented to include the name of the particular attorney assigned to the court case, it must not be supplemented to refer to either the Commissioner of Patents and Trademarks or the U.S. Patent and Trademark Office.

Any court papers mailed to an address other than the above mail service address or delivered by hand to the U.S. Patent and Trademark Office are deemed to have been served on the Commissioner when actually received in the Office of the Solicitor.

The above mail service address should not be used for filing a notice of appeal to the Federal Circuit. See

MPEP § 1216.01. Nor should the above mail service address be used for noncourt papers, i.e., papers which are intended to be filed in the U.S. Patent and Trademark Office in connection with an application or other proceeding pending in the U.S. Patent and Trademark Office. ANY NONCOURT PAPERS WHICH ARE MAILED TO THE ABOVE MAIL SERVICE ADDRESS WILL BE RETURNED TO THE SENDER. NO EXCEPTIONS WILL BE MADE TO THIS POLICY.

1216.01 Appeals to the Federal Circuit

35 U.S.C. 142. Notice of appeal.

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

35 U.S.C. 143. Proceedings on appeal.

With respect to an appeal described in section 142 of this title, the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during the pendency of the appeal. In any reexamination case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

35 U.S.C. 144. Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

37 CFR 1.302. Notice of appeal.

(a) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof to the Commissioner within the time specified in § 1.304.

(b) In interferences, the notice must be served as provided in § 1.646.

(c) A notice of appeal, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

Filing an appeal to the Federal Circuit requires that the applicant, the owner of a patent involved in a reexamination proceeding, or a party to an interference

proceeding: (A) file in the U.S. Patent and Trademark Office a written notice of appeal (35 U.S.C. 142) directed to the Commissioner and (B) file with the Clerk of the Federal Circuit a copy of the notice of appeal and pay the docket fee for the appeal, as provided by Federal Circuit Rule 52. 37 CFR 1.301.

For a notice of appeal to be considered timely filed in the U.S. Patent and Trademark Office, it must: (A) actually reach the U.S. Patent and Trademark Office within the time specified in 37 CFR 1.304 (including any extensions) or (B) be mailed within the time specified in 37 CFR 1.304 (including any extensions) by "Express Mail" in accordance with 37 CFR 1.10.

A Notice of Appeal to the Federal Circuit should not be mailed to the Commissioner, the Board or the examiner. Nor should it be mailed to the Solicitor's mail service address for court papers given in MPEP § 1216. Instead, it should be filed in the U.S. Patent and Trademark Office in any one of the following ways:

(A) By mail addressed as follows, in which case the notice of appeal must actually reach the U.S. Patent and Trademark Office by the due date:

Commissioner of Patents and Trademarks
Box 8
Washington, DC 20231
Attention: Office of the Solicitor

(B) By "Express Mail" (U.S. Postal Service only) under 37 CFR 1.10 addressed as follows, in which case the notice of appeal is deemed filed on the "date-in" on the "Express Mail" mailing label:

Commissioner of Patents and Trademarks
Box 8
Washington, DC 20231
Attention: Office of the Solicitor

(C) By hand to the Office of the Solicitor, 2121 Crystal Drive, Suite 714, Arlington, VA 22202.

A copy of the notice of appeal and the docket fee should be filed with the Clerk of the Federal Circuit, whose mailing and actual address is:

U.S. Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, DC 20439

The Solicitor, prior to a decision by the Federal Circuit, may request that the case be remanded to the U.S. Patent and Trademark Office and prosecution reopened. See MPEP § 1214.07.

STANDARDS OF REVIEW BY THE FEDERAL CIRCUIT

In light of the Supreme Court decision in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999), holding that the Federal Circuit must apply one of the standards set forth in the Administrative Procedure Act ("APA"), the Federal Circuit adopted the "substantial evidence" standard for reviewing fact-finding by the Board of Patent Appeals and Interferences. *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). The "substantial evidence" standard asks whether the agency action, findings, and conclusions were supported by substantial evidence, or, in other words, whether a reasonable factfinder could have arrived at the agency's decision. The Supreme Court has described "substantial evidence" as "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence." *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229-30 (1938)(citations omitted).

The Federal Circuit uses the *de novo* standard for reviewing questions of law. See e.g., *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998).

When the issue to be decided is a question of law based on underlying findings of fact (e.g., obviousness under 35 U.S.C. 103, enablement under 35 U.S.C. 112, first paragraph, or conception of an invention for purposes of 35 U.S.C. 102(g)), the Board's legal conclusion is reviewed without formal deference, while the subsidiary factual findings are reviewed for substantial evidence.

OFFICE PROCEDURE FOLLOWING DECISION BY THE FEDERAL CIRCUIT

After the Federal Circuit has heard and decided the appeal, an uncertified copy of the decision is sent to the U.S. Patent and Trademark Office and to the appellant and appellee (if any).

In due course, the Clerk of the Federal Circuit forwards to the U.S. Patent and Trademark Office a certi-

fied copy of the court's decision. This certified copy is known as the "mandate." The mandate is entered in the file of the application, reexamination or interference which was the subject of the appeal. The date of receipt of the mandate by the U.S. Patent and Trademark Office marks the conclusion of the appeal, i.e., the termination of proceedings as that term is used in 35 U.S.C. 120. See 37 CFR 1.197(c), or "termination of the interference" as that term is used in 35 U.S.C. 135(c).

The Federal Circuit's opinion may or may not be precedential. Whether or not the opinion is precedential, the U.S. Patent and Trademark Office will not give the public access to the administrative record of an involved application, or to the file of an interference, unless it is otherwise available to the public under 37 CFR 1.11. However, since the court record in a 35 U.S.C. 141 appeal generally includes a copy of at least part of the application, such may be inspected at the Federal Circuit. *In re Mosher*, 248 F.2d 956, 115 USPQ 140 (CCPA 1957).

In an *ex parte* appeal, after the mandate is entered in the application or reexamination file, the file is then returned to the appropriate U.S. Patent and Trademark Office official for further proceedings consistent with the mandate. See MPEP § 1214.06 for handling of claims dependent on rejected claims.

A. All Claims Rejected

If all claims in the case stand rejected, proceedings in the case are considered terminated on the date of receipt of the Federal Circuit's mandate. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. *Continental Can Company v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). However, exceptions may occur where the mandate clearly indicates that further action in the U.S. Patent and Trademark Office is to be taken in accordance with the Federal Circuit's opinion.

B. Some Claims Allowed

Where the case includes one or more allowed claims, including claims allowed by the examiner prior to appeal and claims whose rejections were reversed by either the Board or the court, the proceedings are considered terminated only as to any claims which still stand rejected. It is not necessary for the

applicant or patent owner to cancel the rejected claims, since they may be canceled by the examiner in an examiner's amendment or by an appropriate notation in the margin of the claims, to avoid confusion to the printer. Thus, if no formal matters remain to be attended to, the examiner will pass the application to issue forthwith on the allowed claims or, in the case of a reexamination, will issue a "Notice of Intent to Issue a Reexamination Certificate and/or Examiner's Amendment." See MPEP § 2287. The examiner should set forth the reasons for allowance, referring to and incorporating a copy of the appellate brief and the court decision. See MPEP § 1302.14.

If formal matters remain to be attended to, the examiner promptly should take appropriate action on such matters, such as by an examiner's amendment or by an Office action setting a 1-month (but not less than 30-day) shortened statutory period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

C. Remand

Where the decision of the court brings up for action on the merits claims which were not previously considered on the merits (such as a decision reversing a rejection of generic claims in an application containing claims to nonelected species), the examiner will take the case up for appropriate action on the matters thus brought up.

D. Reopening of Prosecution

In rare situations it may be necessary to reopen prosecution of an application after a decision by the Federal Circuit. Any Office action proposing to reopen prosecution after a decision by the Federal Circuit must be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for written approval, which will be indicated on the Office action.

DISMISSAL OF APPEAL

After an appeal is docketed in the Federal Circuit, failure to prosecute the appeal, such as by appellant's failure to file a brief, may result in dismissal of the appeal by the court. Under particular circumstances, the appeal also may be dismissed by the court on motion of the appellant and/or the Commissioner.

The court proceedings are considered terminated as of the date of the mandate. After dismissal, the action taken by the examiner will be the same as set forth above under the heading "Office Procedure Following Decision by the Federal Circuit."

In the event of a dismissal for a reason other than failure to prosecute the appeal, the status of the application, reexamination proceeding or interference must be determined according to the circumstances leading to the dismissal.

1216.02 Civil Suits Under 35 U.S.C. 145

A 35 U.S.C. 145 civil action is commenced by filing a complaint in the U.S. District Court for the District of Columbia within the time specified in 37 CFR 1.304 (see MPEP § 1216). Furthermore, copies of the complaint and summons must be served in a timely manner on the Solicitor, the U.S. Attorney for the District of Columbia, and the Attorney General in the manner set forth in Rule 4(i) of the Federal Rules of Civil Procedure. Regarding timely service, see *Walsdorf v. Comm'r*, 229 USPQ 559 (D.D.C. 1986) and *Hodge v. Rostker*, 501 F. Supp. 332 (D.D.C. 1980). When a 35 U.S.C. 145 civil action is filed, a notice thereof is placed in the application or reexamination file, which ordinarily will be kept in the Solicitor's Office pending termination of the civil action.

In an action under 35 U.S.C. 145, the plaintiff may introduce evidence not previously presented to the U.S. Patent and Trademark Office. However, plaintiff will be precluded from presenting new issues, at least in the absence of some reason of justice put forward for failure to present the issue to the U.S. Patent and Trademark Office. *DeSeversky v. Brenner*, 424 F.2d 857, 858, 164 USPQ 495, 496 (D.C. Cir. 1970); *MacKay v. Quigg*, 641 F. Supp. 567, 570, 231 USPQ 907, 908 (D.D.C. 1986). Furthermore, new evidence is not admissible in district court where it was available to the parties but was withheld from the U.S. Patent and Trademark Office as a result of fraud, bad faith, or gross negligence. *DeSeversky*, 424 F.2d at 858 n.5, 164 USPQ at 496 n.5; *California Research Corp. v. Ladd*, 356 F.2d 813, 821 n.18, 148 USPQ 404, 473 n.18 (D.C. Cir. 1966); *MacKay*, 641 F. Supp. at 570, 231 USPQ at 908; *Monsanto Company v. Kamp*, 269 F. Supp. 818, 822, 154 USPQ 259, 260 (D.D.C. 1967); *Killian v. Watson*, 121 USPQ 507, 507 (D.D.C. 1958).

Chapter 1300 Allowance and Issue

1301 Substantially Allowable Application, Special

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1301 Substantially Allowable Application, Special

When an application is in condition for allowance, except as to matters of form, the application will be considered special and prompt action taken to require correction of formal matters. See MPEP § 710.02(b).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole application meets all formal and substantive (i.e., statutory) requirements and that the language of the claims is enabled by, and finds adequate descriptive support in, the application disclosure as originally filed. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently, the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case, the examiner should require the applicant to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented (see 37 CFR 1.71 and 1.73). Of course, enough background should be included to make the invention clearly understandable. See MPEP § 608.01(c) and § 608.01(d). Form paragraphs 13.07 and 13.08 may be used.

¶ 13.07 Disclosure To Be Limited to Claimed Invention

Applicant is required to modify the brief summary of the invention and to restrict the descriptive matter so that they are confined to and in harmony with the invention to which the allowed claims are directed. See MPEP § 1302.01. For example, [1].

Examiner Note:

An example should be given as to the specific sheets or drawing figures and portions of the specification which should be cancelled. If drawing figures are to be cancelled, applicant should be reminded that subsequent figures must be renumbered.

¶ 13.08 Disclosed Subject Matter Outside the Bounds of the Claims

The application contains disclosure entirely outside the bounds of the allowed claims. Applicant is required to modify the brief summary of the invention and restrict the descriptive matter so as to be in harmony with the claims (MPEP § 1302.01).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually, the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See MPEP § 608.01(o). It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification.

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or has become abandoned, and "now abandoned" or the patent number should be added to the specification.

The claims should be renumbered as required by 37 CFR 1.126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. An examiner's amendment should be prepared if the order of the claims is changed. See MPEP § 608.01(j), § 608.01(n), and § 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosed invention. See MPEP § 608.01(b). The length of the abstract should be limited to 150 words.

The title should also be checked. It should be as short and specific as possible. However, the title should be descriptive of the invention claimed, even though a longer title may result. If a satisfactory title is not supplied by the applicant, the examiner may

change the title on or after allowance. See MPEP § 606 and § 606.01.

No pencil notes should be made in the application file by the examiner. Any notes in the file must be erased when the application is passed to issue.

All amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the application to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

Form paragraph 13.01 should be used when making such a requirement.

¶ 13.01 Requirement for Rewritten Specification

The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

Examiner Note:

1. Specific discussion of the sections of the specification or claims required to be rewritten must be set forth.
2. See form paragraph 6.28.01 for a substitute specification.

1302.03 Notice of Allowability

A Notice of Allowability form PTOL-37 is used whenever an application has been placed in condition for allowance. The date of any communication and/or interview which resulted in the allowance should be included in the notice.

In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of allowability of the claims by a Notice of Allowability PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Interview Summary PTO-413 should be mailed. Prompt notice to applicant is important

because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment.

1302.04 Examiner's Amendments and Changes

Except by formal examiner's amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See 37 CFR 1.121.)

An informal examiner's amendment may be used for the correction of the following obvious errors and omissions only in the body of the written portions of the specification and may only be made with pen by the examiner of the application who will then initial in the margin and assume full responsibility for the change:

- (A) Misspelled words.
- (B) Disagreement of a noun with its verb.
- (C) Inconsistent "case" of a pronoun.

(D) Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.

(E) Entry of "Patent No....." to identify a patent which has been granted on a U.S. application referred to by application number in the specification if the priority reference is not in an application data sheet.

(F) Entry of "abandoned" if a U.S. patent application referred to by application number in the specification, or in the application data sheet has become abandoned.

(G) Correction of reversed figure numbers. *Garratt v. Cox*, 233 F.2d 343, 345, 110 USPQ 52, 54 (CCPA 1956).

(H) Entry of "Patent Application No." to identify a patent application in an otherwise allowable application filed under former 37 CFR 1.60 or 37 CFR 1.62 (see MPEP § 201.11).

(I) Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.

(J) Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

For applications filed under former 37 CFR 1.60 or 1.62, where a reference to the parent application has been inadvertently omitted by the applicant, the reference to the parent application may be added by an informal examiner's amendment when the application is in condition for allowance since such an application must claim priority to the prior application. For continuing applications filed under 37 CFR 1.53(b), where a reference to the parent application has been inadvertently omitted by the applicant, an examiner should not add a reference to the prior application without the approval of the applicant and a formal examiner's amendment since applicant may decide to delete the priority claim in the application filed under 37 CFR 1.53(b). Note that the specification or application data sheet of an application filed under 37 CFR 1.76 should not contain a reference to the parent application. See MPEP § 201.06(d).

When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

A formal examiner's amendment may be used to correct all other informalities in the body of the written portions of the specification as well as all errors and omissions in the claims, but such corrections must be made by a formal examiner's amendment, signed by the primary examiner, placed in the file and a copy sent to applicant. The changes specified in the amendment are entered by the technical support staff in the regular way. A formal examiner's amendment should include form paragraph 13.02 and form paragraph 13.02.01. Form paragraph 13.02.02 should be used if an extension of time is required.

¶ 13.02 Formal Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Examiner Note:

This form paragraph is NOT to be used in a reexamination proceeding (use form paragraph 22.06 instead).

¶ 13.02.01 Examiner's Amendment Authorized

Authorization for this examiner's amendment was given in a telephone interview with [1] on [2].

¶ 13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this appli-

cation in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Commissioner to charge Deposit Account No. [4] the required fee of \$ [5] for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See MPEP § 706.07(f), item (J) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

Although 37 CFR 1.121 has been amended to require amendments to the specification/claims to be made by replacement paragraphs/claims, 37 CFR 1.121(g) permits the Office to make amendments to the specification, including the claims, by examiner's amendments without paragraph/section/claim replacement in the interest of expediting prosecution and reducing cycle time. Examiners may continue to make additions or deletions of subject matter in the specification, including the claims, in examiner's amendments by instructions to make the change at a precise location in the specification and/or the claims.

As an alternative, the examiner's amendment utilizing paragraph/claim replacement can be created by the examiner with authorization from the applicant. The examiner's amendment can also be created from a facsimile transmission or e-mailed amendment received by the examiner and referenced in the examiner's amendment and attached thereto. Any subject matter, in clean version form (containing no brackets or underlining), to be added to the specification/claims should be set forth separately by applicant in the e-mail or facsimile submission apart from the remainder of the submission. A clean version of a paragraph/claim, or portion of a paragraph/claim, submitted by applicant in a fax or e-mail, should be printed and attached to the examiner's amendment and may be relied on as part of the examiner's amendment. The examiner should mark "requested" on the entire attachment to indicate that the fax or e-mail was requested by the examiner, so as to not lead to a reduction in patent term adjustment (37 CFR 1.704(c)(8)). As the attachment is made part of the examiner's amendment, it does not get a separate PALM code and will not trigger any reduction in patent term adjustment. A paper copy of the entire e-

mail or facsimile submission should be entered in the application file. Examiners are not required to electronically save any e-mails once any e-mails or attachments thereto are printed and become part of an application file record. The e-mail practice that is an exception for examiner's amendments is restricted to e-mails to the examiner from the applicant and should not be generated by the examiner to the applicant unless such e-mails are in compliance with all of the requirements set out in MPEP § 502.03.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his/her attorney or agent) in a telephone or personal interview. The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts or credit cards under special conditions.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to expedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared, the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (additional claims, etc.), and the deposit account number.

Charges can also be made against a credit card in an examiner's amendment. Once the examiner has informed applicant of the required charges, applicant must submit by facsimile, a properly completed and signed PTO-2038, authorizing the necessary charges. After completion of processing in the Office of Finance, form PTO-2038 will be removed from the record. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process or trademark process fee (as opposed to information product or service fees) to a credit card. Further identifying data, if deemed necessary and requested by the applicant, should also be included in the examiner's amendment.

Form paragraph 13.06 may be used to charge an extension of time fee in an examiner's amendment.

¶ 13.06 Extension of Time by Examiner's Amendment

An extension of time under 37 CFR 1.136(a) is required to place this application in condition for allowance. During a telephone conversation conducted on [1], [2] requested an extension of time for [3] MONTH(S) and authorized the Commissioner to charge Deposit Account No. [4] the required fee of \$ [5] for this extension.

Examiner Note:

1. See MPEP § 706.07(f), item 10 which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.
2. When an examiner's amendment is also authorized, use form paragraph 13.02.02 instead.

A change in the abstract may be made by examiner's amendment.

The fact that applicant is entitled to an earlier U.S. effective filing date under 35 U.S.C. 120, 121, or 365(c) or 35 U.S.C. 119(e) is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Number -/---, filed ---" should appear as the first sentence of the description, or in an application data sheet of applications other than CPAs claiming priority under 35 U.S.C. 120, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. The request for a CPA filed under 37 CFR 1.53(d) is itself the specific reference, as required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2), to every application assigned the same application number identified in the request. In the case of an application filed under 37 CFR 1.53(b) as a division, continuation or continuation-in-part of a CPA, there would be only one reference to the series of applications assigned the same application number with the filing date cited being that of the original non-continued application. In applications claiming priority under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/ - --, filed - --" should appear as the first sentence of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 08/ - --, filed - --, now abandoned, which claims the benefit of U.S. Provi-

sional Application No. 60/ - --, filed - --." The status (whether patented or abandoned) of the nonprovisional application(s) for which priority is claimed should also be included. Any such statements appearing elsewhere in the specification should be relocated or made in an application data sheet. The technical support staff indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PTO-892, a copy of which will be attached to the Notice of Allowability, form PTOL-37.

Where an application is ready for issue except for a slight defect in the drawing not involving a change in structure, the examiner will prepare a letter indicating the change to be made and note in pencil on the drawing the addition or alteration to be made. See MPEP § 608.02(w).

No other changes may be made by any person in any record of the U.S. Patent and Trademark office without the written approval of the Commissioner of Patents and Trademarks.

In reviewing the application, all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time an application is being prepared for issue by the examiner. However, the need for such may not be noted until after the proof of the patent is read and the application is sent to the examiner with a "printer waiting" slip (form PTO-97). A copy of any formal examiner's amendment is sent to applicant even if the application is already in the printer's hands. See MPEP § 1309.02.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed. See generally *In re Willingham*, 282 F.2d 353, 356, 127 USPQ 211, 215 (CCPA 1960).

In all instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of a

Notice of Allowability (PTOL-37). See MPEP § 714.13 and § 1302.03.

If after reviewing, screening, or surveying an allowed application in the Office of Patent Quality Review, an error or omission of the type noted in items (A) through (I) under the second paragraph of this section is noted, the error or omission may be corrected by the Patentability Review Examiner in the same manner as set forth in the second paragraph. Since all other obvious informalities may only be corrected by a formal examiner's amendment, if the Office of Patent Quality Review discovers any such informality, the Patentability Review Examiner will return the application to the Technology Center (TC) personnel via the TC Director suggesting, as appropriate, specific changes for approval and correction by the examiner through the use of an examiner's amendment.

1302.04(a) Title of Invention

Where the title of the invention is not specific to the invention as claimed, see MPEP § 606.01.

1302.04(b) Cancellation of Nonstatutory Claim

When a case is otherwise in condition for allowance the examiner may cancel an obviously nonstatutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Nonelected Invention

See MPEP § 821.01 and § 821.02.

1302.04(d) Cancellation of Claim Lost in Interference

See MPEP § 2363.03.

1302.04(e) Cancellation of Rejected Claims Following Appeal

See MPEP § 1214.06, § 1215.03, and § 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up-to-Date

Where a patent application which is ready for issue refers by application number to a U.S. nonprovisional application which has matured into a patent, the examiner is authorized to enter the patent number without a formal examiner's amendment. This entry should be in the following form: ", Patent No.". The entry is to be initialed and dated in the margin by the examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the nonprovisional application referred to has become abandoned, the entry "abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

1302.04(g) Identification of Claims

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

1302.05 Correction of Drawing

Where an application otherwise ready for issue requires correction of the drawing, the application is processed for allowance in the Technology Center and then forwarded to the Publishing Division. Any papers subsequently filed by the applicant, including corrected drawings, are forwarded to the Publishing Division in order to be matched with the application file.

1302.05(a) Original Drawings Cannot Be Located

When the original drawings cannot be located and the application is otherwise in condition for allowance, no "Official Search" need be undertaken. A replacement drawing should be obtained from the Office of Initial Patent Examination's records of the application as originally filed. If the reproduced drawings are not acceptable for publishing, applicant should be required to submit corrected drawings. An attachment to the Notice of Allowability should

explain the problem and require the corrected drawings.

1302.06 Prior Foreign Application

See MPEP § 201.14(c) and § 202.03.

1302.07 Use of Retention Labels to Preserve Abandoned Companion Applications

Related applications referred to in patent specifications are preserved from destruction by a retention label (form PTO-150) which is attached to the outside of the file wrapper. The technical support staff of the Technology Center (TC) prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification, oath, or declaration of the application ready for allowance (or in any Office letter therein).

If the application referred to is:

(A) Still pending: Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

(B) Abandoned for failure to pay issue fee: If file has been forwarded to Files Repository, fill in label and send it to Files Repository for attachment to the wrapper. If not forwarded, treat the same as pending case.

(C) Abandoned: If file has been forwarded to the Files Repository, fill in label and send it to Files Repository for attachment to the wrapper. If not forwarded, treat the same as pending case. Add "abandoned" in red ink and initials to the allowable application.

(D) Already patented: No label is required. Insert patent number in specification if not already present. Formal examiner's amendment not necessary if this is only change.

(E) In issue: Fill in label. Make no change in the specification of the allowable application.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the application number cited thereon.

1302.08 Interference Search

Assuming that the application is ready for issue, the examiner makes an interference search and notes the date and class and subclasses searched in the file wrapper. To do this, the examiner inspects all the pending prints and drawings (or all the claims if the invention is not susceptible of illustration) in the interference files of the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his or her Technology Center (TC) or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or claims shows such a condition to be likely, the corresponding file is reviewed.

Note also MPEP § 2301.01(b).

If the search does not disclose any interfering application, the examiner should prepare the application for issue.

An interference search may be required in TC Working Group 3640. Inspection of pertinent prints, drawings, brief cards, and applications in TC Working Group 3640 will be done on request by an examiner in TC Working Group 3640.

1302.09 Notations on File Wrapper

The examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid the Publishing Division and the printers, examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral should be distinct and any decimal point should be shown clearly and in its proper position.

Spaces are provided on the file wrapper label or PALM bib-data sheet for identifying data of a prior abandoned application for which the instant application is a substitute, and of parent application(s) and prior provisional and foreign application(s). Examiners must review the data regarding prior U.S. applications to make sure that the information is correct when preparing the application for issue. If any claim to priority under 35 U.S.C. 120, 121, or 365(c) is added, deleted, and/or modified during prosecution of the application and such addition, deletion, and/or

modification has been approved, the examiner must make sure that the information on the file wrapper label or PALM bib-data sheet and in the PALM data base are current and up to date. If the PALM system has not been updated, the application must be forwarded to the Office of Initial Patent Examination Customer Corrections, accompanied by a completed Application Branch Data Base Routing Slip, with an explanation of the correction to be made. Examiners should also review the data regarding prior provisional and foreign applications for accuracy.

The class and subclass and the name of the examiner which are written in pencil on the file wrapper should correspond to the class and subclass in which the patent will issue and to the name of the examiner preparing the application for issue.

See MPEP § 202.02 for notation as to parent or prior U.S. application, including provisional application, to be placed on file wrapper.

See MPEP § 202.03 for notation as to foreign patent application to be placed on file wrapper.

See MPEP § 1302.13 for name of examiner.

Examiners, when preparing an application for issue, are to record the number of the claim selected for printing in the *Official Gazette* in the box labeled "PRINT CLAIM" on the face of the file wrapper.

The claim or claims should be selected in accordance with the following instructions:

- (A) The broadest claim should be selected.
- (B) Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.
- (C) A dependent claim should not be selected unless the independent claim on which it depends is also printed. In the case where a multiple dependent claim is selected, the entire chain of claims for one embodiment should be listed.
- (D) In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

- (A) Write the claim number clearly in black ink.
- (B) If multiple claims are selected, the claim numbers should be separated by commas.

(C) The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number.

Examiners, when preparing an application for issue, are to record the figure selected for printing in the *Official Gazette* in the box labeled "Print Fig." on the face of the file wrapper. It is no longer necessary for drawings to be stamped approved or for the examiner to write this information in the space provided by the Draftsperson's stamp on the margin of the sheet of drawing.

Ordinarily a single figure is selected for printing. This figure should be consistent with the claim to be printed in the *Official Gazette*. The figure to be printed in the *Official Gazette* must not be one that is labeled "prior art." If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written in the box labeled "Print Fig." on the face of the file wrapper.

1302.10 Issue Classification Notations

See MPEP § 903.07, § 903.07(b) and § 903.09 for notations to be applied in the issuing classification boxes on the face of the file wrapper, or on the blue issue classification slip for series 08/ and earlier applications.

In all reissue applications, the number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name.

1302.11 Reference to Assignment Division

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See MPEP § 303.

1302.12 Listing of References

All references which have been cited by the examiner during the prosecution, including those appearing in Board of Patent Appeals and Interferences decisions or listed in the reissue oath, must be listed on either a form PTO-892 or PTO-1449. All such reference citations will be printed in the patent. References listed by a patent examiner on a "Notice of References Cited," form PTO-892, will be indicated with an

asterisk in the "References Cited" section of the front page of a patent document. An example of how the "References Cited" section of the patent will appear is as follows:

[56] References Cited

U.S. PATENT DOCUMENTS

2,234,192 * 7/1955 Greene..... 75/507
 4,991,048 8/1990 Larkin.....206/207
 5,000,186 12/1991 Amis.....267/340
 5,000,993 * 12/1991 Thomas et al.....75/507

FOREIGN PATENT DOCUMENTS

9500000 * 6/1995 Belgium.....75/507
 200000 * 6/1990 Japan75/507
 9400000 9/1994 United Kingdom.

OTHER PUBLICATIONS

Hill, "Ferrous Precipitation," *Journal of the American Defenestration Association*, Jan. 1989, Pages 34-46.* Clymerhill-Irons, "Ferrous Ascension for the Eighties," *Proceedings of the International Ferrous Ascension Society*, Jan.- Mar. 1979, Pages 1111-1163.

* cited by examiner

Indication of whether a reference was listed by the examiner will be helpful in compiling statistical data related to prior art submissions so that the USPTO can better consider whether changes are required to the rules governing prior art statements.

Indication of a reference with an asterisk should not be considered to reflect any significance other than that the reference was listed on a "Notice of References Cited," form PTO-892. When an examiner lists references on a form PTO-892, the examiner lists references that are relied upon in a prior art rejection or mentioned as pertinent. See MPEP § 707.05(c). The examiner does not list references which were previously cited by the applicant (and initialed by an examiner) on an Information Disclosure Statement, for example, on a PTO-1449. See MPEP § 609 and § 707.05(b), (c) and (d). No distinction will be made in the "References Cited" section for other sources of references. Thus, references cited in a protest, by an attorney or agent not acting in a representative capacity but on behalf of a single inventor, and by the applicant will not be distinguished.

At time of allowance, the examiner may cite pertinent art in an examiner's amendment or statement of

reasons for allowance. Such pertinent art should be listed as usual on form PTO-892, a copy of which is attached to the Notice of Allowability form PTOL-37. Such pertinent art, other than foreign patent documents and nonpatent literature, is not sent to the applicant. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See MPEP § 707.05 and § 707.05(a).

When preparing an application for allowance, the technical support staff will verify that there is at least one list of references (PTO-892 or PTO-1449) in the application. All lists of references are maintained in the center section of the file wrapper.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which were pertinent to any preliminary motions and which were discussed in the decision on motion.

In any application, otherwise ready for issue, in which an erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner's amendment. See MPEP § 707.05(g).

Any new reference cited when the application is in issue, under the practice of MPEP § 1308.01, should be added by way of a PTO-892 or PTO-1449.

All copies of references placed in the file wrapper during prosecution should be retained therein when the allowed application is forwarded to the Publishing Division.

1302.13 Signing

The primary examiner and the assistant examiner involved in the allowance of an application will print or stamp their names on the file wrapper in the appropriate boxes. The assistant examiner shall place his or her initials after his or her printed or stamped name. The primary examiner will place his or her signature in the appropriate box on the file wrapper so that the stamped or printed name can still be easily read. A primary examiner who prepares an application for issue prints or stamp his or her name and signs the file wrapper *only* in the "Primary Examiner" box. A line should be drawn through the "Assistant Examiner"

box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the primary examiner and the assistant examiner appearing on the face of the application file wrapper will be listed in the printed patent.

1302.14 Reasons for Allowance

37 CFR 1.104. Nature of examination.

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

REASONS FOR ALLOWANCE

One of the primary purposes of 37 CFR 1.104(e) is to improve the quality and reliability of issued patents by providing a complete file history which should clearly reflect, as much as is reasonably possible, the reasons why the application was allowed. Such information facilitates evaluation of the scope and strength of a patent by the patentee and the public and may help avoid or simplify litigation of a patent.

The practice of stating the reasons for allowance is not new, and the rule merely formalizes the examiner's existing authority to do so and provides applicants or patent owners an opportunity to comment upon any such statement of the examiner.

It should be noted that the setting forth of reasons for allowance is not mandatory on the examiner's part. However, in meeting the need for the application file history to speak for itself, it is incumbent upon the examiner in exercising his or her responsibility to the public, to see that the file history is as complete as is reasonably possible.

When an application is finally acted upon and allowed, the examiner is expected to determine, at the same time, whether the reasons why the application is being allowed are evident from the record.

Prior to allowance, the examiner may also specify allowable subject matter and provide reasons for indi-

cating such allowable subject matter in an Office communication.

In determining whether reasons for allowance should be recorded, the primary consideration lies in the first sentence of 37 CFR 1.104(e) which states:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. (Emphasis added).

In most cases, the examiner's actions and the applicant's replies make evident the reasons for allowance, satisfying the "record as a whole" proviso of the rule. This is particularly true when applicant fully complies with 37 CFR 1.111 (b) and (c) and 37 CFR 1.133(b). Thus, where the examiner's actions clearly point out the reasons for rejection and the applicant's reply explicitly presents reasons why claims are patentable over the reference, the reasons for allowance are in all probability evident from the record and no statement should be necessary. Conversely, where the record is not explicit as to reasons, but allowance is in order, then a logical extension of 37 CFR 1.111 and 1.133 would dictate that the examiner should make reasons of record and such reasons should be specific.

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims. The examiner should keep in mind the possible misinterpretations of his or her statement that may be made and its possible estoppel effects. Each statement should include at least (1) the major difference in the claims not found in the prior art of record, and (2) the reasons why that difference is considered to define patentably over the prior art if either of these reasons for allowance is not clear in the record. The statement is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and should not be written to specifically or impliedly state that all the reasons for allowance are set forth. Where the examiner has a large number of reasons for allowing a claim, it may suffice to state only the major or important reasons, being careful to so couch the statement. For example, a statement might start: "The primary reason for the allowance of the claims is the inclusion of the limitation in all the claims which is not found in the prior

art references," with further amplification as necessary.

Stock paragraphs with meaningless or uninformative statements of the reasons for the allowance should not be used. The statement of reasons for allowance by the examiner is intended to provide information equivalent to that contained in a file in which the examiner's Office actions and the applicant's replies make evident the examiner's reasons for allowing claims.

Examiners are urged to carefully carry out their responsibilities to see that the application file contains a complete and accurate picture of the Office's consideration of the patentability of the application.

Under the rule, the examiner must make a judgment of the individual record to determine whether or not reasons for allowance should be set out in that record. These guidelines, then, are intended to aid the examiner in making that judgment. They comprise illustrative examples as to applicability and appropriate content. They are not intended to be exhaustive.

EXAMPLES OF WHEN IT IS LIKELY THAT A STATEMENT SHOULD BE ADDED TO THE RECORD

(A) Claims are allowed on the basis of one (or some) of a number of arguments and/or affidavits presented, and a statement is necessary to identify which of these were persuasive, for example:

(1) When the arguments are presented in an appeal brief.

(2) When the arguments are presented in an ordinary reply, with or without amendment of claims.

(3) When both an affidavit under 37 CFR 1.131 and arguments concerning rejections under 35 U.S.C. 102 and 103 are presented.

(B) First action issue:

(1) Of a noncontinuing application, wherein the claims are very close to the cited prior art and the differences have not been discussed elsewhere.

(2) Of a continuing application, wherein reasons for allowance are not apparent from the record in the parent case or clear from preliminary filed matters.

(C) Withdrawal of a rejection for reasons not suggested by applicant, for example:

(1) As a result of an appeal conference.

(2) When applicant's arguments have been misdirected or are not persuasive alone and the examiner comes to realize that a more cogent argument is available.

(3) When claims are amended to avoid a rejection under 35 U.S.C. 102, but arguments (if any) fail to address the question of obviousness.

(D) Allowance after remand from the Board of Patent Appeals and Interferences.

(E) Allowance coincident with the citation of newly found references that are very close to the claims, but claims are considered patentable thereover:

(1) When reference is found and cited (but not argued) by applicant.

(2) When reference is found and cited by examiner.

(F) Where the reasons for allowance are of record but, in the examiner's judgment, are unclear (e.g., spread throughout the file history) so that an unreasonable effort would be required to collect them.

(G) Allowance based on a claim interpretation which might not be readily apparent, for example:

(1) Article claims in which method limitations impart patentability.

(2) Method claims in which article limitations impart patentability.

(3) Claim is so drafted that "nonanalogous" art is not applicable.

(4) Preamble or functional language "breathes life" into claim.

(H) Allowance following decision by the United States Court of Appeals for the Federal Circuit or District Court of the District of Columbia.

The reasons for allowance should refer to and incorporate the briefs and the court decision.

EXAMPLES OF STATEMENTS OF SUITABLE CONTENT

(A) The primary reason for allowance of the claims is the inclusion of .03 to .05 percent nickel in all of the claims. Applicant's second affidavit in example 5 shows unexpected results from this restricted range.

(B) During two telephonic interviews with applicant's attorney, Mr. on 5/6 and 5/10/77, the examiner stated that applicant's remarks about the

placement of the primary teaching's grid member were persuasive, but he pointed out that applicant did not claim the member as being within the reactor. Thus, an amendment doing such was agreed to.

(C) The instant application is deemed to be directed to an nonobvious improvement over the invention patented in Pat. No. 3,953,224. The improvement comprises baffle means 12 whose effective length in the extraction tower may be varied so as to optimize and to control the extraction process.

(D) Upon reconsideration, this application has been awarded the effective filing date of application number -/---. Thus the rejection under 35 U.S.C. 102(d) and 103 over Belgium Patent No. 757,246 is withdrawn.

(E) The specific limitation as to the pressure used during compression was agreed to during the telephone interview with applicants' attorney. During said interview, it was noted that applicants contended in their amendment that a process of the combined applied teachings could not result in a successful article within a particular pressure range (see page 3, bottom, of applicant's amendment). The examiner agreed and allowed the application after incorporating the pressure range into the claim.

(F) In the examiner's opinion, it would not have been obvious to a person of ordinary skill in the art first to eliminate one of top members 4, second to eliminate plate 3, third to attach remaining member 4 directly to tube 2 and finally to substitute this modified handle for the handle 20 of Nania (see Fig. 1) especially in view of applicant's use of term "consisting."

(G) The application is allowable for the reasons set forth on page -- of the decision of the Court of Appeals for the Federal Circuit, which is hereby incorporated by reference. As noted therein, and as argued on page -- of Appellant's brief, the claimed invention requires a one piece tubular member whereas the closest prior art requires a multiple piece assembly which does not teach or suggest the claimed invention.

EXAMPLES OF STATEMENTS THAT ARE NOT SUITABLE AS TO CONTENT

(A) The 3-roll press couple has an upper roll 36 which is swingably adjustable to vary the pressure selectively against either of the two lower rolls.

(NOTE: The significance of this statement may not be clear if no further explanation is given.)

(B) The main reasons for allowance of these claims are applicant's remarks in the appeal brief and an agreement reached in the appeal conference.

(C) The instant composition is a precursor in the manufacture of melamine resins. A thorough search of the prior art did not bring forth any composition which corresponds to the instant composition. The examiner in the art also did not know of any art which could be used against the instant composition.

(D) Claims 1-6 have been allowed because they are believed to be both novel and nonobvious.

The examiner should *not* include in his or her statement any matter which does not relate directly to the reasons for allowance. For example:

(E) Claims 1 and 2 are allowed because they are patentable over the prior art. If applicants are aware of better art than that which has been cited, they are required to call such to the attention of the examiner.

(F) The reference Jones discloses and claims an invention similar to applicant's. However, a comparison of the claims, as set forth below, demonstrates the conclusion that the inventions are noninterfering.

Most instances when the examiner finds a need to place in the file a statement of the reasons for allowing a claim or claims will come at the time of allowance. In such cases, the examiner should (a) check the appropriate box on the form PTOL-37 and (b) attach thereto a paper containing the examiner's statement of reasons for allowance. Such a statement should be typewritten. The paper should identify the application number and be clearly labeled "Statement of Reasons for Allowance." It should also specify that comments may be filed by the applicant on the statement and should preferably be submitted with the payment of the issue fee so as not to delay processing of the application and in any event no later than payment of the issue fee.

Form paragraph 13.03 may be used for this purpose.

¶ 13.03 Reasons for Allowance

The following is an examiner's statement of reasons for allowance: [1]

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such

submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Examiner Note:

Do not use this form paragraph in reexamination proceedings, see form paragraph 22.16.

A statement may be sent to applicant with other communications, where appropriate, but should be clearly labeled as a "Statement of Reasons for Allowance" and contain the data indicated above.

Form paragraph 13.13.01 may be used to specify the reasons for indicating allowable subject matter in a communication prior to allowance.

¶ 13.03.01 Reasons for Indication of Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: [1]

Examiner Note:

1. This form paragraph is for use in an Office action prior to allowance of the application. Use form paragraph 13.03 in the Notice of Allowability.
2. In bracket 1, provide a detailed statement of the reason(s) certain claim(s) have been indicated as being allowable or as containing allowable subject matter.

APPLICANT'S COMMENTS ON THE REASONS FOR ALLOWANCE

The examiner's statement of reasons for allowance is an important source of prosecution file history. See *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996). The failure of an applicant to comment on reasons for allowance may give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom. Applicant may set forth his or her position if he or she disagrees with the examiner's reasons for allowance.

Comments filed by the applicant on the examiner's statement of reasons for allowance, should preferably be submitted no later than the payment of the issue fee, to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance." Comments will be entered in the application file by the Office of Publication with an appropriate notation on the "Contents" list on the file wrapper.

The application file generally will not be returned to the examiner after the entry of such comments made by applicant on the examiner's statement of reasons for allowance. Therefore, the absence of an examiner's response to applicant's comments does not mean that the examiner agrees with or acquiesces in the reasoning of such comments. See 37 CFR 1.104(e). While the examiner may review and comment upon such a submission, the examiner has no obligation to do so.

1303 Notice of Allowance

37 CFR 1.311. Notice of Allowance.

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fees:

- (1) An incorrect issue fee; or
- (2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

A Notice of Allowance is prepared and mailed, and the mailing date appearing thereon is recorded on the file wrapper.

The U.S. Patent and Trademark Office (USPTO) has indicated that if an application is subject to publication under 37 CFR 1.211, the Notice of Allowance will require both the issue fee and the publication fee. See 37 CFR 1.211(e). The USPTO plans to modify the Notice of Allowance to require both the issue fee and any required publication fee, but this will not be done until later in the year 2001. Until then, the USPTO will mail a separate Notice of Publication Fee Due in any application that has been assigned a projected publication date and which has been allowed. The Notice of Publication Fee Due requires payment of the publication fee within three months of the mail

date of the Notice of Publication Fee Due to avoid abandonment of the application. See "Interim Practice of Mailing a Notice of Publication Fee Due Separate

From the Notice of Allowance," 1246 O.G. 166 (July 31, 2001).



Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

APPLICATION NUMBER FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE

DATE MAILED:

NOTICE OF PUBLICATION FEE DUE

The above-identified application was filed (including as a Continued Prosecution Application) on or after November 29, 2000 and a non-publication request in compliance with 37 CFR 1.213 was not included with the application on filing. Since the application has been allowed, a publication fee is due.

The fee due is \$300.00. No small entity discount is available. See 37 CFR 1.18(d).

The reply to this notice should be mailed to Box ISSUE FEE, Commissioner for Patents, Washington D.C. 20231.

The publication fee must be submitted within **THREE MONTHS** from the mailing date of this notice or the application may be regarded as abandoned. No extensions of time under 37 CFR 1.136(a) or (b) are available. A reply must be filed to this notice, even if applicant does not anticipate that the application will be published (e.g., because the patent has issued and the projected publication date is more than a month after the issue date of the patent). A proper reply to this notice in such a situation would be a statement that no fee is now due, citing 37 CFR 1.211(e).

If publication of the application does not occur, any publication fee paid will be refunded, if applicant requests a refund. See 37 CFR 1.211(e).

Questions relating to this Notice should be directed to the Office of Patent Publication at (703) 305-8283.

A copy of this notice should be returned with any reply.

1303.01 Amendment Received After Allowance

If the amendment is filed under 37 CFR 1.312, see MPEP § 714.15 to § 714.16(e). If the amendment contains claims copied from a patent, see MPEP § 2307.03.

Reference to an Issue Batch Number is no longer necessary because the Office no longer stores and tracks applications according to issue batches.

Any paper filed after receiving the Issue Notification should include the indicated patent number.

1303.02 Undelivered

In case a Notice of Allowance is returned, and a new notice is sent (see MPEP § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing.

1303.03 Not Withheld Due to Death of Inventor

The Notice of Allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See MPEP § 409.01(f).

1304 Amendments After D-10 Notice

For amendments received after D-10 Notice, see MPEP § 130.

1304.01 Withholding From Issue of "Secrecy Order" Applications

"Secrecy Order" applications are not sent to issue even when all of the claims have been allowed. Instead of mailing a Notice of Allowance, a D-10 Notice is sent. See MPEP § 130.

If the "Secrecy Order" in an application is withdrawn after the D-10 notice is mailed, the application should then be treated like an ordinary application in condition for allowance.

1305 Jurisdiction

Jurisdiction of the application remains with the primary examiner until the Notice of Allowance is mailed. However, the examiner may make examiner's amendments correcting obvious errors, as when brought to the attention of the examiner by the printer,

and also may admit amendments under 37 CFR 1.312 which are confined to matters of form in the specification or claims, or to the cancellation of a claim or claims. The examiner's action on other amendments under 37 CFR 1.312 consists of a recommendation to the Commissioner.

To regain jurisdiction over the application, the examiner must write a letter to the Commissioner requesting it. See MPEP § 1308 and § 1308.02.

Once the patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

1306 Issue Fee

The issue fee is due 3 months from the date of the Notice of Allowance. The amount of the issue fee is shown on the Notice of Allowance. However, because the amount of the issue fee due is determined by the fees set forth in 37 CFR 1.18 which are in effect as of the date of submission of payment of the issue fee, the amount due may differ from the amount indicated on the Notice of Allowance. Accordingly, applicants are encouraged, at the time of submitting payment of the issue fee, to determine whether the amount of the issue fee due has changed. The amounts due under 35 U.S.C. 41(a) are reduced by 50 per centum for small entities.

Applicants and their attorneys or agents are urged to use the special fee transmittal form (PTOL-85B) provided with the Notice of Allowance when submitting their payments. The PTOL-85B, the issue fee, and all post allowance correspondence should be addressed using the mailing address labels provided with the PTOL-85, "Notice of Allowance and Issue Fee Due." If mailing address labels were not provided, all post allowance correspondence should be addressed "Box Issue Fee."

Applicants and their attorneys or agents may also fax post allowance correspondence to the correspondence branch in the Office of Patent Publications (See MPEP § 1730).

Technology Center personnel should forward all post allowance correspondence to the Production Control branch in the Office of Patent Publication. The papers received by the Publication Control Branch will be matched with the appropriate applica-

tion and the entire application will be forwarded to the appropriate Technology Center for processing.

The payment of the issue fee due may be simplified by using a U.S. Patent and Trademark Office Deposit Account or a credit card payment with form PTO-2038 for such a fee. See MPEP 509. However, any such payment must be specifically authorized by reference to the "issue fee" or "fees due under 37 CFR 1.18."

The issue fee will be accepted from the applicant, assignee, or a registered attorney or agent, either of record or under 37 CFR 1.34(a).

The Commissioner has no authority to extend the time for paying the issue fee. Intentional failure to pay the issue fee within the 3 months permitted by 35 U.S.C. 151 does not amount to unavoidable or unintentional delay in making payment.

1306.01 Deferring Issuance of a Patent

37 CFR 1.314. Issuance of patent.

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§ 1.313) or the Office defers issuances of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

There is a public policy that the patent will issue in regular course once the issue fee is timely paid. 37 CFR 1.314. It has been the policy of the U.S. Patent and Trademark Office to defer issuance of a patent, upon request, for a period of up to 1 month only, in the absence of extraordinary circumstances or requirement of the regulations (e.g., 37 CFR 1.177) which would dictate a longer period. Situations like negotiation of licenses, time for filing in foreign countries, collection of data for filing a continuation-in-part application, or a desire for simultaneous issuance of related applications are not considered to amount to extraordinary circumstances.

A petition to defer issuance of a patent is not appropriate until the issue fee is paid. Issuance of a patent cannot be deferred after an allowed application receives a patent number and issue date unless the application is withdrawn from issue under 37 CFR 1.313(b). The petition to defer is considered at the time the petition is correlated with the application file before the appropriate deciding official (MPEP § 1002.02(b)). In order to facilitate consideration of a

petition for deferment of issue, the petition should be firmly attached to the Issue Fee Transmittal form (PTOL-85B) and clearly labeled as a Petition to Defer Issue; Attention: Office of the Assistant Commissioner for Patents.

1306.02 Simultaneous Issuance of Patents

Where applications have been allowed and a Notice of Allowance and Issue Fee Due (PTOL-85) has been mailed in each application, a request for simultaneous issuance will be granted. Unless all the applications have reached this stage of processing, or a specific requirement of the regulations is involved (e.g., 37 CFR 1.177), a request for simultaneous issuance generally will not be granted.

Applicants and their attorneys who desire the simultaneous issue of allowed applications must submit the request to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, Attention: Office of Patent Publication.

The request must contain the following information about *each* allowed application for which simultaneous issue is requested:

- (A) Application number,
- (B) Filing date,
- (C) Name(s) of inventor(s),
- (D) Title of invention, and
- (E) Date of allowance.

Separate copies of the request must accompany *each* Issue Fee Transmittal (PTOL-85B).

1306.03 Practice After Payment of Issue Fee

Under the current publication process, utility and reissue patents are issued within about four weeks after the issue fee is received in the Office. A patent number and issue date will be assigned to an application and an Issue Notification will be mailed after the issue fee has been paid and processed by the USPTO. Because the Issue Notification may be mailed less than two weeks before the application is expected to issue as a patent, applicants are advised to file any continuing application before receiving the Issue Notification to avoid loss of copendency.

Since the Office cannot ensure that any paper filed after payment of the issue fee will reach the appropriate USPTO official before the date the application issues as a patent, applicants are also encouraged to file any necessary amendments, assignments, petitions, information disclosure statements, or other papers prior to the date of issue fee payment, preferably within one month after the Notice of Allowance has been mailed. See MPEP § 502 for post allowance correspondence.

In order to minimize disruptions and delays in the printing process, the application is **not** available after the Notice of Allowance has been mailed unless necessary for "Query Printer Waiting", amendments submitted under 37 CFR 1.312, information disclosure statements, and petitions. Corrected filing receipts will not be mailed after the date of mailing of the Notice of Allowance unless special circumstances exist. Duplicate filing of papers is not recommended. The same correspondence should not be mailed and faxed to the Office unless the duplication has been specifically required by the Office. See MPEP § 719.01(a).

ORDERING OF ALLOWED APPLICATIONS

Examining corps personnel must submit a request to the Office of Patent Publications Customer Service Center when ordering an allowed application file. The preferred procedure is to e-mail the request to the Office of Publications Customer Service Center (see MPEP § 1730) to ensure an auto-response e-mail will be sent to the appropriate person indicated in the original request. Allowed applications may also be requested by contacting the Office of Patent Publications Customer Service Center via telephone (see MPEP § 1730).

1307 Change in Classification of Cases Which Are in Issue

See MPEP § 903.07.

1308 Withdrawal From Issue

37 CFR 1.313. Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient

reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

- (1) Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
- (2) Consideration of a request for continued examination in compliance with § 1.114; or

WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE APPLICANT

Prior to the Payment of Issue Fee

If the applicant wishes to have an application withdrawn from issue, he or she must petition the Commissioner under 37 CFR 1.313(a) or file a request for continued examination (RCE) under 37 CFR 1.114 with a submission and the fee set forth in 37 CFR 1.17(e). A submission may be an information disclosure statement (37 CFR 1.97 and 1.98) or an amendment. The RCE practice does not apply to utility or plant applications filed before June 8, 1995 and design applications. See MPEP § 706.07(h), subsections I, II and IX. If an applicant files a RCE (with the fee and a submission), the applicant need not pay the issue fee to avoid abandonment of the application. Applicants are cautioned against filing a RCE prior to payment of the issue fee and subsequently paying the issue fee (before the Office acts on the RCE) because doing so may result in issuance of a patent without consideration of the RCE (if the RCE is not matched with the application before the application is processed into a patent).

Petitions under 37 CFR 1.313(a) to have an application withdrawn from issue should be directed to the Technology Center (TC) Director to which the application is assigned (see MPEP § 1002.02(c)). Unless

applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue fee must be timely submitted to avoid abandonment.

Applicant may also file a continuing application on or before the day the issue fee is due and permit the parent application to become abandoned for failure to pay the issue fee (35 U.S.C. 151).

After the Payment of Issue Fee

Once the issue fee is paid, withdrawal is permitted only for the reasons stated in 37 CFR 1.313(c). The status of the application at the time the petition is filed is determinative of whether the petition is considered under 37 CFR 1.313(a) or 37 CFR 1.313(c). Petitions under 37 CFR 1.313(c) to have an application withdrawn after payment of the issue fee should be directed to the Office of Petitions (see MPEP § 1002.02(b)).

In addition to the specific reasons identified in 37 CFR 1.313(c)(1)-(3) applicant should identify some specific and significant defect in the allowed application before the application will be withdrawn from issue. A petition under 37 CFR 1.313(c) based on the reason specified in 37 CFR 1.313(c)(2) can only be filed in utility or plant applications filed on or after June 8, 1995 because the request for continued examination (RCE) practice does not apply to these types of applications filed before June 8, 1995 and design applications. See MPEP § 706.07(h), subsections I and IX. Such a petition along with the petition fee set forth in 37 CFR 1.17(h) must include a request for continued examination in compliance with 37 CFR 1.114 (e.g., a submission and the fee set forth in 37 CFR 1.17(e)). The continued prosecution application (CPA) practice under 37 CFR 1.53(d) does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000. See MPEP § 201.06(d). To withdraw from issue a utility or plant application filed on or after May 29, 2000, an applicant may wish to file a petition under 37 CFR 1.313(c)(2) with a RCE or under 37 CFR 1.313(c)(3) for the express abandonment of the application in favor of a continuing application under 37 CFR 1.53(b), but not a CPA under 37 CFR 1.53(d).

Any petition filed under 37 CFR 1.313(b) to withdraw an application from issue after payment of the issue fee should be clearly marked "Petition under

37 CFR 1.313(b)" and be either submitted by facsimile or hand-carried to the Office of Petitions (see MPEP § 1730 for the facsimile number and location).

The Office cannot ensure that any petition under 37 CFR 1.313(c) will be acted upon prior to the date of patent grant. See *Filing of Continuing Applications, Amendments, or Petitions after Payment of Issue Fee*, Notice, 1221 Off. Gaz. Pat. Office 14 (April 6, 1999). Since a RCE (unlike a CPA under 37 CFR 1.53(d)) is not any type of new application filing, the Office cannot grant a petition to convert an untimely RCE to a continuing application under 37 CFR 1.53(b). Therefore, applicants are strongly cautioned to file any desired RCE prior to payment of issue fee. In addition, applicants considering filing a RCE after payment of the issue fee are strongly cautioned to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider (and grant) a petition under 37 CFR 1.313(c) and what steps are needed to ensure that a grantable petition under 37 CFR 1.313(c) is before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued.

WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE

The Commissioner may withdraw an application from issue under 37 CFR 1.313 on his or her own initiative. See *Harley v. Lehman*, 981 F. Supp. 9, 12, 44 USPQ2d 1699, 1702 (D.D.C. 1997)(adoption of 37 CFR 1.313(b) permitting applications to be withdrawn from issue under certain narrow circumstances not directly covered by the statute was not unreasonable). 35 U.S.C. 151 provides that upon payment of the issue fee, "the patent shall issue." Thus, an application cannot be withdrawn from issue after payment of the issue fee consistent with 35 U.S.C. 151 unless there has been a determination that at least one of the conditions specified at 37 CFR 1.313(b)(1) through (4) exist such that the applicant is no longer "entitled to a patent under the law" as provided in 35 U.S.C. 151. See *Harley v. Lehman*, 981 F. Supp. at 11-12, 44 USPQ2d at 1701-02 (D.D.C. 1997)(Commissioner may adopt rules permitting applications to be withdrawn from issue after payment of the issue fee in situations in which the applicant is not entitled to a patent under the law); and see *Sampson v. Dann*, 466

F. Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978)(Commissioner not authorized to withdraw an application from issue after payment of the issue fee on an *ad hoc* basis, but only in situations which meet the conditions of 37 CFR 1.313(b)).

The authority to withdraw an application from issue at the initiative of the USPTO after payment of the issue fee under 37 CFR 1.313(b) has been delegated to TC Directors (see MPEP § 1002.02(c)). The Office of Petitions has also been delegated the authority to withdraw an application from issue after payment of the issue fee in those situations in which the request for withdrawal from issue is at the initiative of the USPTO by someone other than a TC Director (see MPEP § 1002.02(b)).

35 U.S.C. 151 and 37 CFR 1.313(b) do not authorize the USPTO to withdraw an application from issue after payment of the issue fee for any reason **except**:

- (1) a mistake on the part of the Office;
- (2) a violation of 37 CFR 1.56 or illegality in the application;
- (3) unpatentability of one or more claims; or
- (4) for interference.

See 37 CFR 1.313(b).

Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee at the initiative of the Office are:

- (A) to permit the examiner to consider an information disclosure statement;
- (B) to permit the examiner to consider whether one or more claims are unpatentable; or
- (C) to permit the applicant to file a continuing application (including a CPA).

An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to permit the examiner to consider an information disclosure statement or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. If uncertainty exists as to whether prosecution will in fact be re-opened, the uncertainty must be resolved before the application is withdrawn from issue. If there is a question whether an application

must be withdrawn from issue and no TC Director is available to decide whether withdrawal from issue is appropriate and to sign the withdrawal Notice, the application should be hand-carried to the Office of Petitions for decision on whether withdrawal from issue is appropriate and to effect the withdrawal.

Any notice withdrawing an application from issue after payment of the issue fee must specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (4) exists and thus warrants withdrawal of the application from issue. Any petition under 37 CFR 1.181 to review the decision of a TC Director to withdraw an application from issue after payment of the issue fee will be decided by the Deputy Commissioner for Patent Examination Policy.

Procedure to be followed when an application is withdrawn from issue

The procedure set forth below is to be followed when a TC Director withdraws an application from issue. This processing is to be done in the Technology Center without the need to send the application to the Office of Patent Publication.

First, determine (via the CRT Screen on PALM) whether the issue fee has been paid, and whether the application has been assigned a patent number and issue date.

1. Withdrawal From Issue Before Payment of Issue Fee

If the issue fee **has not** been paid and the deadline for payment has not expired:

(A) Prepare, date stamp, and mail a "Withdrawal from Issue" letter signed by the TC Director to the applicant to effectuate the withdrawal from issue, using form paragraph 10.01. A copy of the "Withdrawal from Issue" letter should be sent to the Office of Patent Publication.

(B) Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action). Enter the Withdrawal from Issue letter in the application file and make it of record on the application file contents.

(C) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled in boxes on the file wrapper that contain issue information.

(D) Forward the application to the examiner for **prompt** appropriate action (*e.g.*, reopen prosecution, initiate interference proceedings).

¶ 10.01 Withdrawal From Issue, Fee Not Paid

Paper No. [1]

In re Application of [2] :
 Appl. No.: [3] : **WITHDRAWAL FROM ISSUE**
 Filed: [4] : *37 CFR 1.313*
 For: [5]

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

U.S. Patent and Trademark Office records reveal that the issue fee and the publication fee have not been paid. If the issue fee and the publication fee have been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue and Publication Fee Due, applicant may request that the previously submitted issue fee and publication fee be applied toward payment of the issue fee and publication fee in the amount identified on the new Notice of Allowance and Issue and Publication Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a specified Deposit Account.

The application is being forwarded to the examiner for action.

[6]

Director,

Technology Center

Patent Examining Technology Center [7]

[8]

Examiner Note:

1. This letter is printed with the USPTO letterhead and must be signed by the TC Director.
2. DO NOT use this form letter if the issue fee and publication fee have been paid.
3. In bracket 8, insert the correspondence address of record.

2. Withdrawal From Issue After Payment of Issue Fee

If the issue fee **has** been paid:

(A) Prepare, sign, date stamp, and mail a "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" to the applicant indicating that the application has been withdrawn from issue (using one of the form letters WDR-TCB1, WDR-TCB2, WDR-TCB3, or WDR-TCB4).

(B) If the application has been assigned a patent number and issue date:

(1) Prepare a "Withdrawal from Issue of" memorandum using the form memorandum WDR-MEMO. E-mail the memorandum to the Director of the Office of Patent Publication and the persons copied on the memorandum to inform them that the application has been withdrawn from issue.

(2) The "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" letter to applicant must be signed, date stamped, and mailed no later than the Monday before the issue date to be effective to withdraw the application from issue.

(3) Remove the patent number from the file wrapper.

(C) Change the status of the application to status code 066 (Previous Action Withdrawn - Awaiting Further Action) by using PALM transaction code 1040. Enter the "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" and the "Withdrawal from Issue of" memorandum, if applicable, in the application file and make it of record on the application file contents.

(D) Stick an Issue Information Label (Form 2016) on the file wrapper over the filled-in boxes on the file wrapper that contain issue information.

(E) Forward the application to the examiner for prompt appropriate action (*e.g.*, reopen prosecution, initiate interference proceedings).

1308.01 Rejection After Allowance

A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. See MPEP § 706.04.

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, a letter is addressed to the Technology Center (TC) Director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. The letter should be submitted with the reference and the file wrapper. If the examiner's proposed action is not approved, the letter requesting withdrawal from issue should not be placed in the file.

If the request to withdraw from issue is approved, the letter is taken to the Publishing Division and the

application is stamped "Withdrawn" over the name stamp and initials of the primary examiner. It is then returned to the TC from which it came; the withdrawal from issue is entered on the PALM system, and the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once prepares an Office action stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The action is given a paper number and placed in the file.

If the issue fee has already been paid and prosecution is reopened, the applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a deposit account.

If the issue fee has been paid, the examiner should forward the request to withdraw the application from issue to the Office of Patent Publication after the request is approved by the TC Director. The actual withdrawal will be handled by the Office of Patent Publication and then the application will be returned to the examiner for prompt action as noted above.

1308.02 For Interference Purposes

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed, see MPEP § 2305.04 and § 2307.03.

1308.03 Quality Review Program for Examined Patent Applications

The Office of Patent Quality Review administers a program for reviewing the quality of the examination of patent applications. The general purpose of the program is to improve patent quality and increase the likelihood of patents being found to be valid.

The quality review is conducted by Patentability Review Examiners on a randomly selected sample of allowed applications from each Art Unit. The sample is computer generated under the office-wide computer system (PALM), which selects a predetermined number of allowed applications from each Art Unit per

year for review only, and which selects from each Art Unit's sample a sub-sample of allowed applications for both review and full re-search. The only applications excluded from the sample are those in which there has been a decision by the Board of Patent Appeals and Interferences, or by a court.

The Patentability Review Examiner independently reviews each sampled application assigned to his or her docket to determine whether any claims may be unpatentable. The Patentability Review Examiner may consult with, discuss, or review an application with any other reviewer or professional in the examining corps, except the professional who acted on the application. The review will, with or without additional search, provide the examining corps personnel with information which will assist in improving the quality of issued applications. The program shall be used as an educational tool to aid in identifying problem areas in the examining Technology Centers (TCs).

Reviewed applications may be returned to the examining TCs for consideration of the reviewer's question(s) as to adequacy of the search and/or patentability of a claim(s).

If, during the quality review process, it is determined that one or more claims of a reviewed application are unpatentable, the prosecution of the application will be reopened. The Office action should contain, as an opening, form paragraph 13.04.

¶ 13.04 Reopen Prosecution - After Notice of Allowance

Prosecution on the merits of this application is reopened on claim [1] considered unpatentable for the reasons indicated below:

[2]

Examiner Note:

1. This paragraph should be used when a rejection is made on any previously allowed claim(s) which for one reason or another is considered unpatentable after the Notice of Allowance (PTOL-85) has been mailed.
2. Make appropriate rejection(s) as in any other action.
3. In bracket 1, identify claim(s) that are considered unpatentable.
4. In bracket 2, state all appropriate rejections for each claim considered unpatentable.

If the issue fee has already been paid in the application, the application must be withdrawn from issue by the Office of Patent Publication, and the action should contain not only the above quoted paragraph, but also form paragraph 13.05.

¶ 13.05 Reopen Prosecution - Vacate Notice of Allowance

Applicant is advised that the Notice of Allowance mailed [1] is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

Examiner Note:

1. This form paragraph must be used when the prosecution is reopened after the mailing of the Notice of Allowance.
2. In bracket 1, insert date of the Notice of Allowance.

Quality Review forms and papers are *not* to be included with Office actions, nor should such forms or papers be retained in the file of any reviewed application whether or not prosecution is to be reopened. The application record should *not* indicate that a review has been conducted by Quality Review.

Whenever an application has been returned to the TC under the Quality Review Program, the TC should promptly decide what action is to be taken in the application and inform the Office of Patent Quality Review of the nature of that action by use of the appropriate form. If prosecution is to be reopened or other corrective action taken, only the forms should be returned to the Office of Patent Quality Review initially, with the application being returned to the Office of Patent Quality Review when action is completed. In all other instances, both the application and the forms should be returned to the Office of Patent Quality Review.

1309 Issue of Patent

Under the current publication process, electronic capture of most of the information to be printed in a patent will begin as soon as an allowed application is received in the Office of Patent Publication, immediately after the Notice of Allowance has been mailed. The Office of Patent Publication forwards the allowed applications to the printer for Initial Data Capture (IDC). This IDC process takes approximately three weeks to accomplish and during this time the application is **not** available to examiners. However, in case of an emergency situation, an application may be requested through the Technology Center Director's office. After IDC is completed, the application is returned to the Office of Patent Publication.

When the issue fee is paid and all other requirements have been met (e.g., drawings) within the time allowed by law, the application is forwarded to the printer for Final Data Capture (FDC) and final issue preparation. At this point, the application can only be retrieved if it is withdrawn from issue. The application is assigned a patent number and issue date about ten days before the application issues as a patent, and an Issue Notification is mailed to inform the applicant of the patent number and issue date. A bond paper copy of the patent grant is ribboned, sealed and attested in the Publishing Division of the Office of Patent Publication.

All allowed applications ready for printing will be selected by chronological sequence based on the date the issue fee was paid. Special handling will be given to the following applications in these categories:

(A) Allowed cases which were made special by the Commissioner (including those under the Special Examining Procedure).

(B) Allowed cases that have a U.S. effective filing date more than 5 years old.

(C) Allowed reissue applications.

(D) Allowed applications having an effective filing date earlier than that required for declaring an interference with a copending application claiming the same subject matter.

(E) Allowed application of a party involved in a terminated interference.

To ensure that any application falling within the scope of the categories outlined above and identified by (A) to (E) receives special treatment, the examiner should staple on the file wrapper a tag entitled "Special in Publishing Division." The special tag, PTO-1101, may be obtained from the technical support staff. The examiner shall print directly on the tag the recitation "In Publishing Division" and the appropriate printing category outlined above. The application is then forwarded to Publishing Division.

35 U.S.C. 2. Powers and duties.

(b) SPECIFIC POWERS.— The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

Chapter 1400 Correction of Patents

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1400.01 Introduction

A patent may be corrected or amended in four ways, namely:

- (A) by reissue,
- (B) by the issuance of a certificate of correction which becomes a part of the patent,
- (C) by disclaimer, and
- (D) by reexamination.

The first three ways are discussed in this chapter while the fourth way (reexamination) is discussed in MPEP Chapter 2200.

1401 Reissue

35 U.S.C. 251. Reissue of defective patents.

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant,

and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The provisions of 35 U.S.C. 251 permit the reissue of a patent to correct an error in the patent made without any deceptive intention and provide criteria for the reissue. 37 CFR 1.171 through 1.179 are rules directed to reissue.

1402 Grounds for Filing

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under 35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

These corrections may be made via a certificate of correction; see MPEP § 1481.

The most common bases for filing a reissue application are:

- (A) the claims are too narrow or too broad;
- (B) the disclosure contains inaccuracies;
- (C) applicant failed to or incorrectly claimed foreign priority; and
- (D) applicant failed to make reference to or incorrectly made reference to prior pending applications.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814 (Bd. App. 1971). The Board of Appeals held in *Ex parte Scudder*, 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

Reissue may no longer be necessary under the facts in *Ex parte Scudder, supra*, in view of 35 U.S.C. 116 which provides, *inter alia*, that:

"Inventors may apply for a patent jointly even though . . .
(3) each did not make a contribution to the subject matter of every claim in the patent."

See also 37 CFR 1.45(b)(3).

If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of 35 U.S.C. 256 and 37 CFR 1.324. See MPEP § 1412.04 and § 1481. A Certificate of Correction will be issued if all parties are in agreement and the inventorship issue is not contested.

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted.

In *Brenner*, the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the utility or plant application which became

the patent to be reissued was filed on or after November 29, 2000, the reissue applicant will have to file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

Correction of failure to adequately claim priority under 35 U.S.C. 120 in an earlier filed copending U.S. Patent application was held a proper ground for reissue. *Sampson v. Comm'r Pat.*, 195 USPQ 136, 137 (D.D.C. 1976). If the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant will have to file a petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3) and (a)(6) in addition to filing a reissue application. See MPEP § 201.11.

The courts have not addressed the question of correction of the failure to adequately claim priority under 35 U.S.C. 119(e) in the application (which became the patent to be reissued) via reissue. If the application which became the patent to be reissued was filed prior to November 29, 2000, correction as to priority under 35 U.S.C. 119(e) would be permitted in a manner somewhat analogous to that of the priority correction discussed above. Under no circumstances, however, can a reissue be employed to correct an applicant's mistake by adding or correcting a priority 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.

Section 4503 of the American Inventor's Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section during the pendency of the application.

35 U.S.C. 119(e)(1), as amended by the AIPA, clearly prohibits the addition or correction of priority claims under 35 U.S.C. 119(e) when the application is no longer pending, e.g., an issued patent. Therefore, a reissue is not a valid mechanism for adding or correct-

ing a priority claim under 35 U.S.C. 119(e) after a patent has been granted.

A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978).

1403 Diligence in Filing

When a reissue application is filed within 2 years from the date of the original patent, a rejection on the grounds of lack of diligence or delay in filing the reissue should not normally be made. *Ex parte Lafferty*, 190 USPQ 202 (Bd. App. 1975); but see *Rohm & Haas Co. v. Roberts Chemical Inc.*, 142 F. Supp. 499, 110 USPQ 93 (S.W. Va. 1956), *rev'd on other grounds*, 245 F.2d 693, 113 USPQ 423 (4th Cir. 1957).

The fourth paragraph of 35 U.S.C. 251 states:

"No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

Where any broadening reissue application is filed within two years from the date of the original patent, 35 U.S.C. 251 presumes diligence, and the examiner should not inquire why applicant failed to file the reissue application earlier within the two year period.

See MPEP § 1412.03 for broadening reissue practice. See also *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997); *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985); *In re Fotland*, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985).

A reissue filed on the 2-year anniversary date is considered as filed within 2 years. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) (a similar rule in interferences).

A reissue application can be granted a filing date without an oath or declaration, or without the filing fee being present. See 37 CFR 1.53(f). Applicant will be given a period of time to provide the missing parts

and to pay the surcharge under 37 CFR 1.16(e). See MPEP § 1410.01.

1404 Submission of Papers Where Reissue Patent Is in Litigation

Applicants and protestors (see MPEP § 1901.03) submitting papers for entry in reissue applications of patents involved in litigation are requested to mark the outside envelope and the top right-hand portion of the papers with the words "REISSUE LITIGATION" and with the art unit or other area of the United States Patent and Trademark Office in which the reissue application is located, e.g., Commissioner for Patents, Board of Patent Appeals and Interferences, Office of Patent Legal Administration, Technology Center, Office of Patent Publication, etc. Protestor's participation, including the submission of papers, is limited in accordance with 37 CFR 1.291(c). Any "Reissue Litigation" papers mailed to the Office should be so marked. The markings preferably should be written in a bright color with a felt point marker. Papers marked "REISSUE LITIGATION" will be given special attention and expedited handling. See MPEP § 1442.01 through § 1442.04 for examination of litigation-related reissue applications.

1410 Content of Reissue Application

37 CFR 1.171. Application for reissue.

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in §

1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

The specification (including the claims and any drawings) of the reissue application is the copy of the printed patent for which reissue is requested that is submitted by applicant as part of the initial application papers. The copy of the printed patent must be submitted in double column format, each page of double column format being on only one side of the piece of paper. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. In addition, an applicant for reissue is required to file a reissue oath or declaration which, in addition to complying with 37 CFR 1.63, must comply with 37 CFR 1.175. Where the patent has been assigned, the reissue applicant must also provide a consent of assignee to the reissue and evidence of ownership. Where the patent has not been assigned, the reissue applicant should affirmatively state that the patent is not assigned.

An amendment may be submitted at the time of filing of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column; or

(B) providing a separate amendment paper with the reissue application.

In either case, the amendment must be made pursuant to 37 CFR 1.173(b) and must comply with all the provisions of 37 CFR 1.173(b)–(e) and (g).

Pursuant to 37 CFR 1.173(a)(1), applicant is required to include a copy of any disclaimer (37 CFR 1.321), certificate of correction (37 CFR 1.322 – 1.324), or reexamination certificate (37 CFR 1.520) issued in the patent for which reissue is requested. It

should also be noted that 37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigation (litigation covers any papers filed in the court or issued by the court, such as, for example, motions, pleadings, and court decisions including court orders) and the results of such proceedings. This duty to submit such information is a continuing duty, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

It is no longer required that the reissue applicant should file an offer to surrender the original patent, see MPEP § 1416; it is only necessary that the patent be surrendered before the application is allowed.

Where appropriate, the reissue applicant may provide a claim for priority under 35 U.S.C. 119 or 120, and may also file an Information Disclosure Statement.

The initial contents of a reissue application are discussed in detail in MPEP § 1410.01 through § 1418.

For expedited processing, new and continuing reissue application filings under 37 CFR 1.53(b) may be addressed to "Box REISSUE, Assistant Commissioner for Patents, Washington, D.C. 20231." Box REISSUE should only be used for the initial filing of reissue applications, and should not be used for any subsequently filed correspondence in reissue applications.

The oath or declaration, any matters ancillary thereto (such as the consent of assignee), and the filing fee may be submitted after the filing date pursuant to 37 CFR 1.53(f).

The requirement for the assignee to consent to filing a reissue no longer includes a requirement for applicant to order a title report with the filing of the reissue application. Rather, the assignee entity is established by a statement on behalf of all the assignees under 37 CFR 1.172(a) and 37 CFR 3.73(b). See MPEP § 1410.01.

Form PTO/SB/50, Reissue Patent Application Transmittal, may be used for filing reissue applications.

Please type a plus sign (+) inside this box → ☐

PTO/SB/50 (06-00)

Approved for use through 12/30/2000. OMB 0651-0033

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Assistant Commissioner for Patents Box Reissue Washington, DC 20231	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr><td style="padding: 2px;">Attorney Docket No.</td><td style="width: 100px;"></td></tr> <tr><td style="padding: 2px;">First Named Inventor</td><td></td></tr> <tr><td style="padding: 2px;">Original Patent Number</td><td></td></tr> <tr><td style="padding: 2px;">Original Patent Issue Date (Month/Day/Year)</td><td></td></tr> <tr><td style="padding: 2px;">Express Mail Label No.</td><td></td></tr> </table>	Attorney Docket No.		First Named Inventor		Original Patent Number		Original Patent Issue Date (Month/Day/Year)		Express Mail Label No.							
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APPLICATION ELEMENTS (37 CFR 1.173) 1. <input type="checkbox"/> Fee Transmittal Form (PTO/SB/56) <i>(Submit an original, and a duplicate for fee processing)</i> 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. 3. <input type="checkbox"/> Specification and Claims in double column copy of patent <i>format (amended, if appropriate)</i> 4. <input type="checkbox"/> Drawing(s) <i>(proposed amendments, if appropriate)</i> 5. <input type="checkbox"/> Reissue Oath/Declaration (original or copy) <i>(37 C.F.R. § 1.175) (PTO/SB/51 or 52)</i> 6. Original U.S. Patent currently assigned? <input type="checkbox"/> Yes <input type="checkbox"/> No <i>(If Yes, check applicable box(es))</i> <input type="checkbox"/> Written Consent of all Assignees (PTO/SB/53) <input type="checkbox"/> 37 C.F.R. § 3.73(b) Statement <input type="checkbox"/> Power of Attorney (PTO/SB/96)	ACCOMPANYING APPLICATION PARTS 7. <input type="checkbox"/> Statement of status/support for all changes to the claims. See 37 CFR 1.173 (c). 8. <input type="checkbox"/> Original U.S. Patent for surrender <input type="checkbox"/> Ribboned Original Patent Grant <input type="checkbox"/> Statement of Loss (PTO/SB/55) 9. <input type="checkbox"/> Foreign Priority Claim (35 U.S.C. 119) <i>(if applicable)</i> 10. <input type="checkbox"/> Information Disclosure Statement (IDS)/PTO-1449 <input type="checkbox"/> Copies of IDS Citations 11. <input type="checkbox"/> English Translation of Reissue Oath/Declaration <i>(if applicable)</i> 12. <input type="checkbox"/> Preliminary Amendment 13. <input type="checkbox"/> Return Receipt Postcard (MPEP 503) <i>(Should be specifically itemized)</i> 14. Other:																
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Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Reissue, Washington, DC 20231.**

1410.01 Reissue Applicant, Oath or Declaration, and Consent of all Assignees

37 CFR 1.172. Applicants, assignees.

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

37 CFR 3.73. Establishing right of assignee to take action.

(b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Commissioner. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

(1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.

(2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

The reissue oath must be signed and sworn to by all the inventors, or declaration made by all the inventors, except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 (see MPEP § 409). Pursuant to 37 CFR 1.172, where the reissue application does *not* seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to, or declaration made, by the assignee of the entire interest. Depending on the circumstances, either Form PTO/SB/51, Reissue Application Declaration by the Inventor, or Form PTO/SB/52, Reissue Application Declaration by the Assignee, may be used to prepare a declaration in a reissue application. These forms are reproduced in MPEP § 1414.

CONSENT TO THE REISSUE

Where no assignee exists, applicant should affirmatively state that fact. If the file record is silent as to the existence of an assignee, it will be presumed that *an assignee does exist*. This presumption should be set forth by the examiner in the first Office action alerting applicant to the requirement. It should be noted that the mere filing of a written assertion of small entity status in no way relieves applicant of the requirement to affirmatively state that no assignee exists.

Where a written assertion of small entity status, or other paper in file indicates that the application/patent is assigned, and there is no consent by the assignee named in the written assertion of small entity, the examiner should make inquiry into the matter in an Office action, even if the record otherwise indicates that the application/patent is not assigned.

The reissue oath or declaration must be accompanied by the written consent of all assignees. 35 U.S.C. 111(a) and 37 CFR 1.53(b) provide, however, for according an application a filing date if filed with a specification, including claim(s), and any required drawings. Thus, where an application is filed without an oath or declaration, or without the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will accord a filing date and send out a notice of missing parts setting a

period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(e). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

The consent of assignee must be signed by a party authorized to act on behalf of the assignee. See MPEP § 324 for a discussion of parties authorized to act on behalf of the assignee. The consent to the reissue application may use language such as:

The XYZ Corporation, assignee of U.S. Patent No. 9,999,999, consents to the filing of reissue application No. 09/999,999 (or the present application, if filed with the initial application papers) for the reissue of U.S. Patent No. 9,999,999.

Lilly M. Schor

Vice President,

XYZ Corporation

Where the written consent of all the assignees to the filing of the reissue application cannot be obtained, applicant may under appropriate circumstances petition to the Office of Petitions (MPEP § 1002.02(b)) for a waiver under 37 CFR 1.183 of the requirement of 37 CFR 1.172, to permit the acceptance of the filing of the reissue application. The petition fee under 37 CFR 1.17(h) must be included with the petition.

The reissue application can then be examined, but will not be allowed or issued without the consent of all the assignees as required by 37 CFR 1.172. *See N. B. Fassett*, 1877 C.D. 32, 11 O.G. 420 (Comm'r Pat. 1877); *James D. Wright*, 1876 C.D. 217, 10 O.G. 587 (Comm'r Pat. 1876).

Form paragraph 14.15 may be used to indicate that the consent of the assignee is lacking.

¶ 14.15 Consent of Assignee to Reissue Lacking

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.
2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

PROOF OF OWNERSHIP OF ASSIGNEE

The assignee that consents to the filing of the reissue application (as discussed above) must also establish that it is the assignee, *i.e.*, the owner, of the patent. See 37 CFR 1.172. *Accordingly, a 37 CFR 3.73(b) paper establishing the ownership of the assignee should be submitted at the time of filing the reissue application, in order to support the consent of the assignee.* The assignee must establish its ownership in accordance with 37 CFR 3.73(b) by:

(A) filing in the reissue application documentary evidence of a chain of title from the original owner to the assignee; or

(B) specifying in the record of the reissue application where such evidence is recorded in the Office (*e.g.*, reel and frame number, etc.).

Documents that are submitted to establish ownership may be required to be recorded. Compliance with 37 CFR 3.73(b) may be provided as part of the same paper in which the consent by assignee is provided.

Upon initial receipt of a reissue application, the examiner should inspect the application to determine whether the submission under 37 CFR 1.172 and 37 CFR 3.73(b) establishing the ownership of the assignee is present and sufficient.

If an assignment document is attached with the 37 CFR 3.73(b) submission, the assignment should be reviewed to ensure that the named assignee is the same for the assignment document and the 37 CFR 3.73(b) statement, and that the assignment document is an assignment of the patent to be reissued to the assignee. If an assignment document is not attached with the 37 CFR 3.73(b) statement, but rather the reel and frame number where the assignment document is recorded in the USPTO is referenced in the 37 CFR 3.73(b) statement, it will be presumed that the assignment recorded in the USPTO supports the statement identifying the assignee. It will not be necessary for the examiner to obtain a copy of the recorded assignment document. If the submission under 37 CFR 1.172 and 37 CFR 3.73(b) is not present,

form paragraph 14.16 may be used to indicate that the assignee has not provided evidence of ownership.

¶ 14.16 Failure of Assignee To Establish Ownership

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

Examiner Note:

1. This form paragraph may be used in an Office action which rejects any of the claims on other grounds.

2. If otherwise ready for allowance, this form paragraph should be followed by form paragraph 7.51 (insert the phrase --See above-- in bracket 1 of form paragraph 7.51).

Just as the consent of assignee must be signed by a party authorized to act on behalf of the assignee, the submission with respect to 37 CFR 3.73(b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. The signature of an attorney or agent registered to practice before the Office is not sufficient, unless that attorney or agent is authorized to act on behalf of the assignee.

If the submission under 37 CFR 3.73(b) to establish ownership is not signed by a party authorized to act on behalf of the assignee, the appropriate paragraphs of form paragraphs 14.16.01 through 14.16.06 may be used.

¶ 14.16.01 Establishment of Ownership Not Signed by Appropriate Party

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b)

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

Examiner Note:

1. This form paragraph should be followed: (a) by one of form paragraphs 14.16.02 through 14.16.04, (b) then by form paragraph 14.16.05, (c) then optionally by form paragraph 14.16.06.

2. See MPEP § 1410.01.

¶ 14.16.02 Failure To State Capacity To Sign

The person who signed the submission establishing ownership interest has failed to state his/her capacity to sign for the corporation or other business entity, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest does not state his/her capacity (e.g., as a recognized officer) to sign for the assignee, and is not established as being authorized to act on behalf of the assignee.

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.

¶ 14.16.03 Lack of Capacity To Sign

The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

¶ 14.16.04 Attorney/Agent of Record Signs

The submission establishing ownership interest was signed by applicant's [1]. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. See MPEP § 324.

Examiner Note:

1. This form paragraph is to be used when the person signing the submission establishing ownership interest is an attorney or agent of record who is not an authorized officer as defined in MPEP § 324 and has not been established as being authorized to act on behalf of the assignee.

2. Use form paragraph 14.16.06 to explain how an official, other than a recognized officer, may properly execute a submission establishing ownership interest.

3. In bracket 1, insert either --attorney-- or --agent--.

¶ 14.16.06 Criteria To Accept When Signed by a Non-Recognized Officer

It would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establish-

ing ownership interest and containing a proper empowerment statement would also be acceptable.

Examiner Note:

1. This form paragraph **MUST** be preceded by form paragraphs 14.16.02, 14.16.03 or 14.16.04.
2. When one of form paragraphs 14.16.02, 14.16.03 or 14.16.04 is used to indicate that a submission establishing ownership interest is not proper because it was not signed by a recognized officer, this form paragraph should be used to point out one way to correct the problem.
3. While an indication of the person's title is desirable, its inclusion is not mandatory when this option is employed.

Where the submission establishes the assignee's ownership as to the patent, ownership as to the reissue application will be presumed. Accordingly, a submission as to the ownership of the patent will be construed to satisfy the 37 CFR 1.172 (and 37 CFR 3.73(b)) requirements for establishing ownership of the application. Thus, a terminal disclaimer can be filed in a reissue application where ownership of the patent has been established without the need for a separate submission under 37 CFR 3.73(b) showing ownership of the reissue application.

Even if the submission states that it is establishing ownership of the reissue application (rather than the patent), the submission should be accepted by the examiner as also establishing ownership in the patent. The documentation in the submission establishing ownership of the reissue application must of necessity include chain of title as to the patent.

COMPARISON OF ASSIGNEE THAT CONSENTS TO ASSIGNEE SET FORTH IN SUBMISSION ESTABLISHING OWNERSHIP INTEREST

The examiner must inspect both the consent and documentary evidence of ownership to determine whether the requirements of 37 CFR 1.172 have been met. The assignee indicated by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also MPEP § 324.

The reissue patent will be granted to the original patentee, his or her legal representatives or assigns as the interest may appear.

1411 Form of Specification

37 CFR 1.173. Reissue specification, drawings, and amendments.

(a) *Contents of a reissue application.* An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application. No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent, pursuant to 35 U.S.C. 251.

(1) *Specification, including claims.* The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. If an amendment of the reissue application is to be included, it must be made pursuant to paragraph (b) of this section. The formal requirements for papers making up the reissue application other than those set forth in this section are set out in § 1.52. Additionally, a copy of any disclaimer (§ 1.321), certificate of correction (§§ 1.322 through 1.324), or reexamination certificate (§ 1.570) issued in the patent must be included. (See also § 1.178).

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

The file wrappers of all /08 and earlier series reissue applications are stamped "REISSUE" above the application number on the front of the file. "Reissue" also appears below the application number on the printed label on the file wrapper of the application with 08/ and earlier series.

Reissue applications filed after July of 1998 (09/ series and later) are placed in an orange and white striped file wrapper and can be easily identified as reissue applications.

Reissue applications filed prior to November 7, 2000 should be furnished in the form of cut-up soft copies of the original patent, with only a single column of the printed patent securely mounted on a separate sheet of paper.

For reissue applications filed on or after November 7, 2000, 37 CFR 1.173(a)(1) requires that the application specification, including the claims, be furnished in the form of a copy of the printed patent in double column format (so that the patent can be simply copied without cutting), with one page of the patent appearing on only one side of each individual page of the specification of the reissue application. It should be noted that a re-typed specification is not acceptable in a reissue application; the full copy of the printed patent must be used. 37 CFR 1.173(a)(2) sets forth the requirements for the drawings at the time the reissue application is filed. The application drawings must be furnished as a clean copy of the printed patent's drawing sheets. Any changes to the drawings must be made in accordance with 37 CFR 1.173(b)(3).

Pursuant to 37 CFR 1.173(b), amendments may be made at the time of filing of a reissue application. The amendment may be made either by:

(A) physically incorporating the changes within the specification by cutting the column of the printed patent and inserting the added material and rejoining the remainder of the column; or

(B) providing a preliminary amendment (a separate amendment paper) directing that specified changes be made to the copy of the printed patent.

The presentation of the insertions or deletions as part of the original reissue specification is an amendment under 37 CFR 1.173(b). An amendment of the reissue application made at the time of filing of the reissue application must be made in accordance with 37 CFR 1.173(b)-(e) and (g); see MPEP § 1453. Thus, as required by 37 CFR 1.173(c), an amendment of the claims made at the time of filing of a reissue application must include a separate paper setting forth the status of all claims (i.e., pending or canceled), and an explanation of the support in the disclosure of the patent for the changes made to the claims.

If a chart, table, or chemical formula is amended and it spans two columns of the patent, it should not be split. Rather, the chart, table, or chemical formula should be provided in its entirety *as part of the column of the patent to which it pertains*, in order to provide a continuity of the description. When doing so, the chart, table, or chemical formula may extend beyond the width of the column. Change in only a part

of a word or chemical formula is not permitted. Entire words or chemical formulas must be shown as being changed. Deletion of a chemical formula should be shown by brackets which are substantially larger and darker than any in the formula.

Twice reissued patent:

Examples of the form for a twice-reissued patent are found in Re. 23,558 and Re. 28,488. Double underlining and double bracketing are used in the second reissue application, while bold-faced type and double bracketing appear in the printed patent (the second reissue patent) to indicate further insertions and deletions, respectively, in the second reissue patent.

When a copy of a first reissue patent is used as the specification of a second reissue application (filed as a reissue of a reissue), additions made by the first reissue will already be printed in italics, and should remain in such format. Thus, applicants need only present additions to the specification/claims in the second reissue application as double underlined text. Subject matter to be deleted from the first reissue patent should be presented in the second reissue application within sets of double brackets.

1411.01 Certificate of Correction or Disclaimer in Original Patent

The applicant should include any changes, additions, or deletions that were made by a Certificate of Correction to the original patent grant in the reissue application without underlining or bracketing. The examiner should also make certain that all Certificate of Correction changes in the patent have been properly incorporated into the reissue application.

Certificate of Correction changes and disclaimer of claim(s) under 37 CFR 1.321(a) should be made without using underlining or brackets. Since these are part of the original patent and were made before the reissue was filed, they should show up in the printed reissue document as part of the original patent, i.e., not in italics or bracketed. If the changes are extensive and/or applicant has submitted them improperly with underlining and brackets, a clean copy of the specification with the Certificate of Correction changes in it may be requested by the examiner.

1411.02 New Matter

New matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.

The claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Any change in the patent made via the reissue application should be checked to ensure that it does not introduce new matter. Note that new matter may exist by virtue of the omission of a feature or of a step in a method. See *United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 53 USPQ 6 (1942).

Form paragraph 14.22.01 may be used where new matter has been added anywhere in "the application for reissue" as prohibited by 35 U.S.C. 251.

¶ 14.22.01 Rejection, 35 U.S.C. 251, New Matter

Claim [1] rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows: [2]

Examiner Note:

1. In bracket 2, fill in the applicable page and line numbers and provide an explanation of your position, as appropriate.
2. A rejection under 35 U.S.C. 112, first paragraph, should also be made if the new matter is added to the claims or is added to the specification and affects the claims. If new matter is added to the specification and does not affect the claims, an objection should be made based upon 35 U.S.C. 132 using form paragraph 7.28.

1412 Content of Claims

The content of claims in a reissue application is somewhat limited, as is indicated in MPEP § 1412.01 through MPEP § 1412.03.

1412.01 Reissue Claims Must Be for Same General Invention

The reissue claims must be for the same invention as that disclosed as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. The proper test as to whether reissue claims are for the same inven-

tion as that disclosed as being the invention in the original patent is "an essentially factual inquiry confined to the objective intent manifested by the **original patent**." *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1274 (Fed. Cir. 1991) (quoting *In re Rowand*, 526 F.2d 558, 560, 187 USPQ 487, 489 (CCPA 1975)) (emphasis added). See also *In re Mead*, 581 F.2d 257, 198 USPQ 412 (CCPA 1978). The "original patent" requirement of 35 U.S.C. 251 must be understood in light of *In re Amos*, *supra*, where the Court of Appeals for the Federal Circuit stated:

We conclude that, under both *Mead* and *Rowand*, a claim submitted in reissue may be rejected under the "original patent" clause if the original specification demonstrates, to one skilled in the art, an absence of disclosure sufficient to indicate that a patentee could have claimed the subject matter. Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an "intent," even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.

953 F.2d at 618-19, 21 USPQ2d at 1275. Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

Some disclosure (description and enablement) in the original patent should evidence that applicant intended to claim or that applicant considered the material now claimed to be his or her invention.

The original patent specification would indicate an intent not to claim the subject matter of the claims presented in the reissue application in a situation analogous to the following:

The original patent specification discloses that composition X is not suitable (or not satisfactory) for molding an item because composition X fails to provide quick drying. After the patent issues, it is found that composition X would be desirable for the molding in spite of the failure to provide quick drying, because of some other newly recognized benefit from composition X. A claim to composition X or a method of use thereof would not be permitted in a reissue application, because the original patent specification contained an explicit statement of intent *not* to claim composition X or a method of use thereof.

In most instances, however, the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would **not** be grounds for prohibiting a claim to that embodiment in the reissue.

1412.02 Recapture of Canceled Subject Matter

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

TWO STEP TEST FOR RECAPTURE:

In *Clement*, 131 F.3d at 1468-69, 45 USPQ2d at 1164, the Court of Appeals for the Federal Circuit set forth guidance for recapture as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect.... Under *Mentor* [*Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)], courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim."

Where a claim in a reissue application is in fact broadened, the examiner must next determine whether the broader aspects of that reissue claim relate to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination.

CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. See MPEP § 706.02(l)(1) with respect to amendments made to distinguish the claimed invention from 35 U.S.C. 102(e)/103 prior art which was commonly owned or assigned at the time the invention was made.

The examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. The record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered.

Example

(A) A limitation of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. The omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application. Thus, the omitted limitation relates to subject matter previously surrendered, in the original application.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general “boiler plate” sentence will not be sufficient to establish recapture. An example of one such “boiler plate” sentence is:

In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable.

This type of general “argument” will not, by itself, be sufficient to establish surrender and recapture.

Example

(B) The limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter.

Example

(C) The limitation A omitted in the reissue claims was present in the claims of the original application. The examiner’s reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner’s reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

ARGUMENT (WITHOUT AMENDMENT TO THE CLAIMS) IN THE ORIGINAL APPLICATION MAY BE SUFFICIENT TO ESTABLISH RECAPTURE:

In *Clement*, the recapture was directed to subject matter surrendered in the original application by changes made to the claims (i.e., amendment of the claims) in an effort to overcome a prior art rejection. The *Clement* Court, however, also stated that “[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” [Emphasis added] 131 F.3d at 1469, 45 USPQ2d at 1164. This statement in *Clement* was subsequently discussed in *Hester Indus., Inc. v. Stein, Inc.*, *supra*, where the Court observed that surrender of claimed subject matter may occur by *arguments* made during the prosecution of the original patent application *even where there was no claim change made*. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture “can occur through arguments alone.” 142 F.3d at 1482, 46 USPQ2d at 1649. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

REISSUE CLAIMS HAVE SAME OR BROADER SCOPE IN ALL ASPECTS:

The recapture rule bars the patentee from acquiring through reissue claims that are, in all aspects, of the same scope as, or are broader in scope than, those claims canceled from the original application to

obtain a patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295.

REISSUE CLAIMS ARE NARROWER IN SCOPE IN ALL ASPECTS:

The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims canceled from the original application to obtain a patent. If the reissue claims are narrower than the claims canceled from the original application, yet broader than the original patent claims, reissue must be sought within 2 years after the grant of the original patent. *Ball*, 729 F.2d at 1436, 221 USPQ at 295. See MPEP § 1412.03 as to broadening claims.

REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS:

Reissue claims that are broader in certain aspects and narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broaden-

ing aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]

Examiner Note:

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP § 1412.02.

1412.03 Broadening Reissue Claims

35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, *i.e.*, a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the "original patent" under 35 U.S.C. 251. The Court in *Vectra Fitness Inc. v. TNWK Corp.*, 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed.

A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in *at least*

one respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims. For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims. *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (Fed. Cir. 1987); *In re Ruth*, 278 F.2d 729, 730, 126 USPQ 155, 156 (CCPA 1960); *In re Rogoff*, 261 F.2d 601, 603, 120 USPQ 185, 186 (CCPA 1958). A claim which reads on something which the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement. Thus, where the original patent claims only the process, and the reissue application adds (for the first time) product claims, the scope of the claims has been broadened since a party could not be sued for infringement of the product based on the claims of the original patent.

The addition of combination claims in a reissue application where only subcombination claims were present in the original patent could be a broadening of the invention. The question which must be resolved in this case is whether the combination claims added in the reissue would be for "the invention as claimed" in the original patent. See *Ex parte Wikdahl*, 10 USPQ2d at 1549. The newly added combination claims should be analyzed to determine whether they contain every limitation of the subcombination of any claim of the original patent. If the combination claims (added in the reissue) contain every limitation of the subcombination (which was claimed in the original application), then infringement of the combination must also result in infringement of the subcombination. Accordingly, the patent owner could not, if a reissue patent issues with the combination claims, sue any new party for infringement who could not have been sued for infringement of the original patent. Therefore, broadening does not exist, in spite of the addition of the combination.

BROADENING-INDIRECT INFRINGEMENT*35 U.S.C. 271(g). Infringement of patent*

(g) Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after —

- (1) it is materially changed by subsequent processes; or
- (2) it becomes a trivial and nonessential component of another product.

An unusual type of broadening may arise where the patent owner adds, in the reissue, a limitation to the original patent claims which were drawn to a process of making an intermediate, so as to now claim in the reissue application a process of making a final product. In *Eli Lilly and Co. v. American Cyanamid Co.*, 82 F.3d 1568, 1577, 38 USPQ2d 1705, 1712 (Fed. Cir. 1996), the court noted that a patent holder having claims to preparing an intermediate compound is unable to successfully pursue an accused infringer who is importing for sale the final product, where the accused infringer has "materially changed" the intermediate by converting it into the final product. Thus, where a patent claims a method of making new intermediate product ABC, the patent owner will not be able to prevent a competitor from importing the final product ABCD for the purpose of selling it in the United States. If, however, the patent claims could be modified by reissue to include a claim to preparing the final product ABCD, then the patent owner would, in fact, be able to prevent a competitor from importing the final product ABCD because that importation would (indirectly) infringe the patent under 35 U.S.C. 271(g). The amendment of the patent claims in the reissue application to include a final step of converting the intermediate ABC to the final product ABCD would enable the patent owner to invoke the protection of 35 U.S.C. 271(g), thereby increasing the scope of protection of the patent claims so that a new set of infringers would be created.

As pointed out above, a reissue claim is broadened if it contains within its scope any conceivable invention which would not have infringed the patent, but will now infringe the reissue claim. Thus, when the new reissue claims drawn to producing the final product ABCD are subjected to the test for broadening, as set forth by the Court of Appeals for the Federal Circuit in *Tillotson, Ltd. v. Walbro Corp.*, 831 F.2d 1033, 1037 n.2, 4 USPQ2d 1450, 1453 n.2 (1987)(citing *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982); *In re Ruth*, 287 F.2d 729, 126 USPQ 155 (CCPA 1960)), they indeed provide the patent owner with expanded protection. If the reissue is granted, the patent owner would be able to exclude an infringer whom the patent owner was unable to exclude heretofore by relying on the claims in the original patent.

The inclusion of an additional step in a chemical process claim would generally appear to narrow the scope of that claim. A process claim having more steps is usually considered to be narrower than one reciting fewer steps. Accordingly, the addition of a process step to convert intermediate ABC into the final product ABCD might initially appear to be solely a narrowing of the claims. Through the provisions of 35 U.S.C. 271(g), however, what appears to be solely a narrowing limitation in actuality also provides an element of broadening to the claim because it provides an additional element of protection for the patent owner which did not exist prior to the insertion of the limitation.

In a chemical case where process claims are present, the examiner should be careful to check the claims for the presence of this unique type of broadening.

SCOPE OF DEPENDENT CLAIM ENLARGED-NOT BROADENING

As pointed out above, a claim will be considered a broadened reissue claim when it is greater in scope than **each and every** claim of the patent to be reissued. A corollary of this is that a claim which has been *broadened in a reissue as compared to its scope in the patent* is not a broadened reissue claim if it is narrower than, or equal in scope to, any other claim which appears in the patent. A common example of this is where dependent claim 2 is broadened via the reissue (other than the addition of a process step to convert an intermediate to a final product as discussed

in the preceding subsection), but independent claim 1 on which it is based is not broadened. Since a dependent claim is construed to contain all the limitations of the claim upon which it depends, claim 2 must be at least as narrow as claim 1 and is thus not a broadened reissue claim.

NEW CATEGORY OF INVENTION ADDED IN REISSUE - BROADENING

The addition of process claims as a new category of invention to be claimed in the patent (*i.e.*, where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989).

WHEN A BROADENED CLAIM CAN BE PRESENTED

A broadened claim can be presented within two years from the grant of the original patent in a reissue application. In addition, a broadened claim can be presented *after* two years from the grant of the original patent in a broadening reissue which was filed *within* two years from the grant. Where any intent to broaden is indicated in the reissue application within the two years from the patent grant, a broadened claim can subsequently be presented in the reissue after the two year period. Finally, if intent to broaden is indicated in a parent reissue application within the two years, a broadened claim can be presented in a continuing reissue application after the two year period. In any other situation, a broadened claim cannot be presented, and the examiner should check carefully for the improper presentation of broadened claims.

A reissue application filed on the 2-year anniversary date from the patent grant is considered to be filed within 2 years of the patent grant. See *Switzer v. Sockman*, 333 F.2d 935, 142 USPQ 226 (CCPA 1964) for a similar rule in interferences.

See also the following cases which pertain to broadened reissues:

In re Graff, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997) (Broadened claims in a continuing reissue application were properly rejected under 35 U.S.C. 251 because the proposal for broadened claims was not made (in the parent reissue application) within two years from the grant of the original

patent and the public was not notified that broadened claims were being sought until after the two-year period elapsed.);

In re Fotland, 779 F.2d 31, 228 USPQ 193 (Fed. Cir. 1985), *cert. denied*, 476 U.S. 1183 (1986) (The failure by an applicant to include *an oath or declaration indicating a desire to seek broadened claims* within two years of the patent grant will bar a subsequent attempt to broaden the claims after the two year limit. Under the former version of 37 CFR 1.175 (the former 37 CFR 1.175(a)(4)), applicant timely sought a "no-defect" reissue, but the Court did not permit an attempt made beyond the two year limit to convert the reissue into a broadening reissue. In this case, applicant did not indicate any intent to broaden within the two years.);

In re Bennett, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (*en banc*) (A reissue application with broadened claims was filed within two years of the patent grant; however, the declaration was executed by the assignee rather than the inventor. The Federal Circuit permitted correction of the improperly executed declaration to be made more than two years after the patent grant.);

In re Doll, 419 F.2d 925, 928, 164 USPQ 218, 220 (CCPA 1970) (If the reissue application is timely filed within two years of the original patent grant and the applicant indicates in the oath or declaration that the claims will be broadened, then applicant may subsequently broaden the claims in the pending reissue prosecution even if the additional broadening occurs beyond the two year limit.).

Form paragraphs 14.12 and 14.13 may be used in rejections based on improper broadened reissue claims.

¶ 14.12 Rejection, 35 U.S.C. 251, Broadened Claims After Two Years

Claim [1] rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.
[2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

¶ 14.13 Rejection, 35 U.S.C. 251, Broadened Claims Filed by Assignee

Claim [1] rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. [2] A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Examiner Note:

The claim limitations that broaden the scope should be identified and explained in bracket 2. See MPEP §§ 706.03(x) and 1412.03.

BROADENING REISSUE - OATH/DECLARATION REQUIREMENTS

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath or declaration must be signed by all of the inventors. See also MPEP § 1414. If a supplemental oath or declaration in a broadening reissue application is needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath or declaration must be signed by all of the inventors. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999) and MPEP § 1414.01.

1412.04 Correction of Inventorship

The correction of misjoinder of inventors has been held to be a ground for reissue. See *Ex parte Scudder*, 169 USPQ 814, 815 (Bd. App. 1971) wherein the Board held that 35 U.S.C. 251 authorizes reissue applications to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate. See also *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application. The court noted that reissue by itself is a vehicle for correcting inventorship in a patent.

CERTIFICATE OF CORRECTION AS A VEHICLE FOR CORRECTING INVENTORSHIP

While reissue is a vehicle for correcting inventorship in a patent, correction of inventorship should be effected under the provisions of 35 U.S.C. 256 and 37 CFR 1.324 by filing a request for a Certificate of Correction if:

(A) the only change being made in the patent is to correct the inventorship; and

(B) all parties are in agreement and the inventorship issue is not contested.

See MPEP § 1481 for the procedure to be followed to obtain a Certificate of Correction for correction of inventorship.

REISSUE AS A VEHICLE FOR CORRECTING INVENTORSHIP

Where the provisions of 35 U.S.C. 256 and 37 CFR 1.324 do not apply, a reissue application is the appropriate vehicle to correct inventorship. The failure to name the correct inventive entity is an error in the patent which is correctable under 35 U.S.C. 251. The reissue oath or declaration pursuant to 37 CFR 1.175 must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any deceptive intention on the part of the applicant. The reissue oath or declaration must, as stated in 37 CFR 1.175, also comply with 37 CFR 1.63.

The correction of inventorship does not enlarge the scope of the patent claims. Where a reissue application does not seek to enlarge the scope of the claims of the original patent, the reissue oath may be made and sworn to, or the declaration made, by the assignee of the entire interest under 37 CFR 1.172. An assignee of part interest may not file a reissue application to correct inventorship where the other co-owner did not join in the reissue application and has not consented to the reissue proceeding. See *Baker Hughes Inc. v. Kirk*, 921 F. Supp. 801, 809, 38 USPQ2d 1885, (D.D.C. 1995). See 35 U.S.C. 251, third paragraph. Thus, the signatures of the inventors are not needed on the reissue oath or declaration where the assignee of the entire interest signs the reissue oath/declaration. Accordingly, an assignee of the entire interest can add or delete an inventor by reissue (e.g., correct inventorship from inventor A to inventors A and B) without the original inventor's consent. See also 37 CFR 3.71(a) ("One or more assignees as defined in paragraph (b) of this section may, after becoming of record pursuant to paragraph (c) of this section, conduct prosecution of a national patent application or

reexamination proceeding to the exclusion of either the inventive entity, or the assignee(s) previously entitled to conduct prosecution.” Emphasis added). Thus, the assignee of the entire interest can file a reissue to change the inventorship to one which the assignee believes to be correct, even though an inventor might disagree. The protection of the assignee’s property rights in the application and patent are statutorily based in 35 U.S.C. 118.

Where a reissue to correct inventorship also changes the claims to enlarge the scope of the patent claims, the signature of all the inventors *is needed*. However, if an inventor refuses to sign the reissue oath or declaration because he or she believes the change in inventorship (to be effected) is not correct, the reissue application can still be filed with a petition under 37 CFR 1.47 without that inventor’s signature. It is the assignee who controls correction of inventorship.

The reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship. See *A.F. Stoddard & Co. v. Dann*, 564 F.2d at 567, 195 USPQ at 106. A request under 37 CFR 1.48 or a petition under 37 CFR 1.324 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. 251.

Where a reissue application seeks to correct inventorship in the patent and the inventors sign the reissue oath or declaration (rather than an assignee of the entire interest under 37 CFR 1.172), the correct inventive entity must sign the reissue oath or declaration. Where an inventor is being added in a reissue application to correct inventorship in a patent, the inventor being added must sign the reissue oath or declaration together with the inventors previously designated on the patent. For example, a reissue application is filed

to correct the inventorship from inventors A and B (listed as inventors on the patent) to inventors A, B, and C. Inventor C is the inventor being added. In such a case, A, B, and C are the correct inventors, and accordingly, each of A, B, and C must sign the reissue oath or declaration. Where an inventor is being deleted in a reissue application to correct inventorship in a patent, the inventor being deleted need not sign the reissue oath or declaration. The reissue oath or declaration must be signed by the correct inventive entity. For example, a reissue application is filed to correct inventorship from inventors A, B, and C (listed as inventors on the patent) to inventors A and B. Inventor C is being deleted as a named inventor. In such a case, A and B are the correct inventors, and accordingly, inventors A and B must sign the reissue oath or declaration but inventor C need not sign the reissue oath or declaration.

1413 Drawings

37 CFR 1.173. Reissue specification, drawings, and amendments.

(2) *Drawings.* Applicant must submit a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed. If such copy complies with § 1.84, no further drawings will be required. Where a drawing of the reissue application is to include any changes relative to the patent being reissued, the changes to the drawing must be made in accordance with paragraph (b)(3) of this section. The Office will not transfer the drawings from the patent file to the reissue application.

A clean copy (e.g., good quality photocopies free of any extraneous markings) of each drawing sheet of the printed patent must be supplied by the applicant at the time of filing of the reissue application. If the copies meet the requirements of 37 CFR 1.84, no further formal drawings will be required. New drawing sheets are not to be submitted, unless some change is made in the original patent drawings. Such changes must be made in accordance with 37 CFR 1.173(b)(3).

The prior reissue practice of transferring drawings from the patent file has been eliminated, since clean photocopies of the printed patent drawings are acceptable for use in the printing of the reissue patent.

AMENDMENT OF DRAWINGS

37 CFR 1.173. *Reissue specification, drawings, and amendments.*

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

The provisions of 37 CFR 1.173(b)(3) govern the manner of making amendments (changes) to the drawings in a reissue application. The following guidance is provided as to the procedure for amending drawings:

(A) Amending the original or printed patent drawing sheets by physically changing or altering them is not permitted. Any request to do so should be denied.

(B) Where a change to the drawings is desired, a request for the drawing change must be filed as a separate paper in the application. The request must include a sketch in permanent ink showing proposed changes in red and must include a request for approval of the changes by the examiner. The examiner should inspect the sketch for the presence of new matter, for conformance with the specification as to structure and numbering, and for anything else that could result in the refusal of the request for the drawing change.

(C) Where the drawing change request is approved, the examiner will require a formal copy of the drawing sheet(s) having the change(s). Each new drawing sheet must identify any changed figure as "amended" and any added figure as "new." If a drawing figure is to be deleted *in toto*, it must be enclosed in brackets and identified as "canceled." If any new drawing sheet does not comply with these requirements that drawing sheet will not be entered.

(D) For each proper new drawing sheet being added, the new sheet should be inserted after the existing drawing sheets. For each proper new drawing sheet which replaces an existing drawing sheet, the existing sheet should be canceled by placing the sheet face down in the file and placing a large "X" on the

back of the sheet. The new sheet should be inserted in place of the turned over existing sheet.

(E) If any drawing change request is not approved or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue applicant in the next Office action, and the examiner will set forth the reasons for same.

1414 Content of Reissue Oath/Declaration

37 CFR 1.175. *Reissue oath or declaration.*

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(e) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each

case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

Alternatively, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

Where the specification or drawing is defective and patentee claimed more or less than patentee had the right to claim in the patent, then *both* statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.

2. Form paragraph 14.14 must follow this form paragraph.

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the

oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, *in addition*, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), *cert. denied*, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

Form paragraph 14.01.01 may be used where the reissue oath/declaration does not identify an error.

¶ 14.01.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of a Specific Error

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath or declaration does not contain any statement of an error which is relied upon to support the reissue application.
2. This form paragraph can be used where the reissue oath or declaration does not even mention error. It can also be used

where the reissue oath or declaration contains some discussion of the concept of error but never in fact identifies a specific error to be relied upon. For example, it is not sufficient for an oath or declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure."

3. Form paragraph 14.14 must follow this form paragraph.

Where the reissue oath/declaration does identify an error or errors, the oath/declaration must be checked carefully to ensure that at least one of the errors identified is indeed an "error" which will support the filing of a reissue, i.e., an "error" that will provide grounds for reissue of the patent. See MPEP § 1402. If the error identified in the oath/declaration is not an appropriate error upon which a reissue can be based, then the oath/declaration must be indicated to be defective in the examiner's Office action.

Form paragraphs 14.01.02 and 14.01.03 may be used where the reissue oath/declaration fails to provide at least one error upon which a reissue can be based.

¶ 14.01.02 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1)-The Identified "Error" Is Not Appropriate Error

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies only one error which is relied upon to support the reissue application, and that one error is not an appropriate error upon which a reissue can be based.
2. Form paragraph 14.14 must follow this form paragraph.

¶ 14.01.03 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - Multiple Identified "Errors" Not Appropriate Errors

The reissue oath/declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration identifies more than one error relied upon to support the reissue application, and none of the errors are appropriate errors upon which a reissue can be based.
2. Note that if the reissue oath/declaration identifies more than one error relied upon, and at least one of the errors is an error upon which reissue can be based, this form paragraph should not be used, despite the additional reliance by applicant on "errors"

which do not support the reissue. Only one appropriate error is needed to support a reissue.

3. Form paragraph 14.14 must follow this form paragraph.

III. A STATEMENT THAT ALL ERRORS WHICH ARE BEING CORRECTED IN THE REISSUE APPLICATION UP TO THE TIME OF FILING OF THE OATH/DECLARATION AROSE WITHOUT ANY DECEPTIVE INTENTION ON THE PART OF THE APPLICANT.

In order to satisfy this requirement, the following statement may be included in an oath or declaration:

"All errors which are being corrected in the present reissue application up to the time of filing of this declaration arose without any deceptive intention on the part of the applicant."

Nothing more is required. The examiner will determine only whether the reissue oath/declaration contains the required averment; the examiner will not make any comment as to whether it appears that there was in fact deceptive intention (see MPEP § 2022.05).

Form paragraph 14.01.04 may be used where the reissue oath/declaration does not provide the required statement as to "without any deceptive intention on the part of the applicant."

¶ 14.01.04 Defective Reissue Oath/Declaration, 37 CFR 1.175- Lack of Statement of "Without Any Deceptive Intention"

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not contain the statement required by 37 CFR 1.175 that all errors being corrected in the reissue application arose without any deceptive intention on the part of the applicant.
2. This form paragraph is appropriate to use for a failure by applicant to comply with the requirement, as to any of 37 CFR 1.175(a)(2), 37 CFR 1.175(b)(1), or 37 CFR 1.175(b)(2).
3. Form paragraph 14.14 must follow.

IV. THE REISSUE OATH/DECLARATION MUST COMPLY WITH 37 CFR 1.63.

The reissue oath/declaration must include the averments required by 37 CFR 1.63(a) and (b), *e.g.*, that applicants for reissue

(A) have reviewed and understand the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath/declaration;

(B) believe the named inventor or inventors to be the original and the first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and

(C) acknowledge the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

See also the discussion regarding the requirements of an oath/declaration beginning at MPEP § 602.

The examiner should check carefully to ensure that all the requirements of 37 CFR 1.63 are met. Form paragraph 14.01.05 should be used in conjunction with the content of form paragraphs 6.03 through 6.09 as appropriate, where the reissue oath/declaration fails to comply with the requirements of 37 CFR 1.63.

¶ 14.01.05 Defective Reissue Oath/Declaration, 37 CFR 1.175 - General

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Examiner Note:

1. Use this form paragraph when the reissue oath/declaration does not comply with 37 CFR 1.175, and none of form paragraphs 14.01 - 14.01.04 or 14.05.02 apply.
2. This form paragraph must be followed by an explanation of why the reissue oath/declaration is defective.
3. Form paragraph 14.14 must follow the explanation of the defect.

See MPEP § 1414.01 for a discussion of the requirements for a supplemental reissue oath/declaration.

Depending on the circumstances, either form PTO/SB/51, Reissue Application Declaration By The Inventor, or form PTO/SB/52, Reissue Application Declaration By The Assignee may be used to prepare a declaration in a reissue application.

PTO/SB/51 (02-01)

Approved for use through 01/31/2004. OMB 0651-0033

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REISSUE APPLICATION DECLARATION BY THE INVENTOR

Docket Number (Optional)

As a below named inventor, I hereby declare that:

My residence, mailing address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number _____, granted _____, and for which a reissue patent is sought on the invention entitled _____

the specification of which

☐ is attached hereto.

☐ was filed on _____ as reissue application number _____ / _____
and was amended on _____
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.☐ by reason of the patentee claiming more or less than he had the right to claim in the patent.☐ by reason of other errors.

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, such must be stated with an explanation as to the nature of the broadening:

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Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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(REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)		Docket Number (Optional)	
<p>All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant. As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith.</p> <p>Name(s) _____ Registration Number _____</p> <p>_____</p> <p>_____</p>			
<p>Correspondence Address: Direct all communications about the application to:</p> <p><input type="checkbox"/> Customer Number → Place Customer Number Bar Code Label here</p> <p style="text-align: center; margin-left: 150px;">Type Customer Number here</p>			
<input type="checkbox"/> Firm or Individual Name			
Address			
Address			
City	State	Zip	
Country			
Telephone		Fax	
<p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.</p>			
Full name of sole or first inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Mailing Address			
Full name of second joint inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Mailing Address			
Full name of third joint inventor (given name, family name)			
Inventor's signature		Date	
Residence		Citizenship	
Mailing Address			
<input type="checkbox"/> Additional joint inventors are named on separately numbered sheets attached hereto.			

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE		Docket Number (optional)
<p>I hereby declare that:</p> <p>My residence and mailing address and citizenship are stated below next to my name.</p> <p>I am authorized to act on behalf of the following assignee: _____</p> <p>and the title of my position with said assignee is: _____</p> <p>The entire title to the patent identified below is vested in said assignee.</p>		
Name of Patentee(s): _____		
Patent Number	Date of Patent Issued	
Title of Invention		
<p>I believe said patentee(s) to be the original, first and sole/joint inventor(s) of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention entitled _____</p> <p>the specification of which</p> <p><input type="checkbox"/> is attached hereto.</p> <p><input type="checkbox"/> was filed on _____ as reissue application number _____ / _____</p> <p style="padding-left: 100px;">and was amended on _____</p> <p style="text-align: center; padding-left: 100px;">(If applicable)</p> <p>I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.</p> <p>I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.</p> <p>I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)</p> <p><input type="checkbox"/> by reason of a defective specification or drawing.</p> <p><input type="checkbox"/> by reason of the patentee claiming more or less than he had the right to claim in the patent.</p> <p><input type="checkbox"/> by reason of other errors.</p> <p>At least one error upon which reissue is based is described as follows:</p> <p style="text-align: center;">[Attach additional sheets, if needed.]</p> <p>All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.</p>		

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Burden Hour Statement: This form is estimated to take 0.5 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/52 (02-01)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE		Docket Number (Optional)	
I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith. Name(s) _____ Registration Number _____			
Correspondence Address: Direct all communications about the application to: <div style="display: flex; align-items: center; justify-content: space-between;"> <div style="display: flex; align-items: center;"> <input type="checkbox"/> Customer Number <div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 10px;"></div> <div style="font-size: 24px;">→</div> <div style="border: 1px solid black; padding: 5px; text-align: center;"> Place Customer Number Bar Code Label Here </div> </div> <div style="text-align: center; margin-top: 5px;"> Type Customer Number Here </div> </div>			
OR			
<input type="checkbox"/> Firm or Individual Name			
Address			
Address			
City	State	Zip	
Country			
Telephone	Fax		
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.			
Full name of person signing (given name, family name)			
Signature		Date	
Address of Assignee			
Patentee		Citizenship	
Residence/Mailing Address			
Patentee		Citizenship	
Residence/Mailing Address			
<input type="checkbox"/> Additional Patentees are named on separately numbered sheets attached hereto.			

[Page 2 of 2]

1414.01 Supplemental Reissue Oath/ Declaration

If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any "error" under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant.

An example of acceptable language is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by the prior declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

WHEN AN ERROR MUST BE STATED IN THE SUPPLEMENTAL OATH/DECLARATION

In the supplemental reissue oath/declaration, there is **no need to state an error** which is relied upon to support the reissue application **if**:

(A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and

(B) that error is still being corrected in the reissue application.

If applicant chooses to state any further error at this point (even though such is not needed), the examiner should not review the statement of the further error.

The supplemental reissue oath/declaration must state an error which is relied upon to support the reissue application only where one of the following is true:

(A) the prior reissue oath/declaration failed to state an error;

(B) the prior reissue oath/declaration attempted to state an error but did not do so properly; or

(C) all errors under 35 U.S.C. 251 stated in the prior reissue oath(s)/declaration(s) are no longer being corrected in the reissue application.

WHEN A SUPPLEMENTAL OATH/DECLARATION MUST BE SUBMITTED

The supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1) must be submitted before allowance. See MPEP § 1444 for a discussion of the action to be taken by the examiner to obtain the supplemental oath/declaration in accordance with 37 CFR 1.175(b)(1), where such is needed.

Where applicant seeks to correct an error after allowance of the reissue application, a supplemental reissue oath/declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance will be directed to the error applicant seeks to correct after allowance. This supplemental oath/declaration need not cover any earlier errors, since all earlier errors should have been covered by a reissue oath/declaration submitted prior to allowance.

SUPPLEMENTAL OATH/DECLARATION IN BROADENING REISSUE

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath/declaration must be signed by all of the inventors. See MPEP § 1414. If a supplemental oath/declaration in a broadening reissue application is subsequently needed in the application in order to fulfill the requirements of 37 CFR 1.175, the supplemental reissue oath/declaration must be signed by all of the inventors. *In re Hayes*, 53 USPQ2d 1222, 1224 (Comm'r Pat. 1999) ("37 CFR 1.175(b)(1), taken in conjunction with Section 1.172, requires a supplemental declaration be signed by all of the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and declaration must bear the appropriate signatures of all the inventors.").

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed

provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

Form PTO/SB/51S, Supplemental Declaration For Reissue Patent Application To Correct "Errors" Statement (37 CFR 1.175), may be used to prepare a supplemental reissue declaration.

1415 Reissue Filing and Issue Fees

The reissue applicant is permitted to present every claim that was issued in the original patent for the basic filing fee. In addition to the basic filing fee, the

filing or later presentation of each independent claim which is in excess of the number of independent claims in the original patent requires a fee. In addition, the filing or later presentation of each claim (whether independent or dependent) in excess of 20, and also in excess of the number of claims in the original patent, requires a fee. Fees for claims in reissue continued prosecution applications are calculated in the same manner as outlined above. The Office has prepared Form PTO/SB/56, Reissue Application Fee Transmittal Form, which is designed to assist in the correct calculation of reissue filing fees.

Please type a plus sign (+) inside this box ☐

PTO/SB/51S (02-01)

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SUPPLEMENTAL DECLARATION FOR REISSUE PATENT APPLICATION TO CORRECT "ERRORS" STATEMENT (37 CFR 1.175)	Attorney Docket Number	
	First Named Inventor	
	COMPLETE	
	Application Number	
	Filing Date	
	Group Art Unit	
	Examiner Name	

I/We hereby declare that:

Every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oath(s) and/or declaration(s) submitted in this application, arose without any deceptive intention on the part of the applicant.

I/We hereby declare that all statements made herein of my/our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor
Given Name (first and middle (if any))		Family Name or Surname
Inventor's Signature		Date
Name of Second Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor
Given Name (first and middle (if any))		Family Name or Surname
Inventor's Signature		Date
Name of Third Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor
Given Name (first and middle (if any))		Family Name or Surname
Inventor's Signature		Date
Name of Fourth Inventor:		<input type="checkbox"/> A petition has been filed for this unsigned inventor
Given Name (first and middle (if any))		Family Name or Surname
Inventor's Signature		Date

☐ Additional inventors are being named on the _____ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto.

(Page 1 of 1)

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PTO/SB/56 (02-01)

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REISSUE APPLICATION FEE TRANSMITTAL FORM						Docket Number (Optional)		
Claims as Filed - Part 1								
Claims in Patent		Number Filed in Reissue Application	(3) Number Extra	Small Entity		Other than a Small Entity		
				Rate	Fee	Rate	Fee	
(A)	Total Claims (37 CFR 1.16(j))	(B)	****	=	x \$ _____	or	x \$ _____	
(C)	Independent claims (37 CFR 1.16(i))	(D)	*	=	x \$ _____		x \$ _____	
Basic Fee (37 CFR 1.16(h))				\$ _____	OR		\$ _____	
Total Filing Fee				\$				\$
Claims as Amended - Part 2								
	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))	***	MINUS	**	=	x \$ _____	or	x \$ _____	
Independent Claims (37 CFR 1.16(i))	***	MINUS	*****	=	x \$ _____		x \$ _____	
Total Additional Fee					\$	OR		\$
<p>* If the entry in (D) is less than the entry in (C), Write "0" in column 3.</p> <p>** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.</p> <p>*** After any cancellation of claims.</p> <p>**** If "A" is greater than 20, use (B - A); if "A" is 20 or less, use (B - 20).</p> <p>***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input type="checkbox"/> Please charge Deposit Account No. _____ in the amount of _____.</p> <p style="margin-left: 20px;">A duplicate copy of this sheet is enclosed.</p> <p><input type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. _____.</p> <p style="margin-left: 20px;">A duplicate copy of this sheet is enclosed.</p> <p><input type="checkbox"/> A check in the amount of \$ _____ to cover the filing / additional fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p style="text-align: center;">WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <div style="display: flex; justify-content: space-between; margin-top: 20px;"> <div style="width: 45%;"> <p>_____ Date</p> </div> <div style="width: 45%;"> <p>_____ Signature of Applicant, Attorney or Agent of Record</p> <p>_____ Typed or printed name</p> </div> </div>								

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

1415.01 Maintenance Fees on the Original Patent

The filing of a reissue application does not alter the schedule of payments of maintenance fees on the original patent. If maintenance fees have not been paid on the original patent as required by 35 U.S.C. 41(b) and 37 CFR 1.20, and the patent has expired, no reissue patent can be granted. 35 U.S.C. 251, first paragraph, only authorizes the granting of a reissue patent for the unexpired term of the original patent. Once a patent has expired, the Commissioner no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

The examiner should determine whether all required maintenance fees have been paid *prior to conducting an examination* of a reissue application. In addition, during the process of preparing the reissue application for issue, the examiner should again determine whether all required maintenance fees have been paid up to date.

PALM may be used to determine the history of maintenance fees by entering 2970 and then the patent number. This PALM screen shows when any maintenance fees have been paid and when the next maintenance fee is due to be paid.

If the window for the maintenance fee due has closed (maintenance fees are due by the day of the 4th, 8th and 12th year anniversary of the grant of the patent), but the maintenance fee has not been paid, then the reissue should be rejected under 35 U.S.C. 251 as having expired and may not be passed to issue. However, if time remains for applicant to pay the maintenance fee, then the application should not be rejected under 35 U.S.C. 251 and it may be passed to issue when it is in condition for allowance, because the patent has not expired.

See MPEP Chapter 2500 for additional information pertaining to maintenance fees.

1416 Offer to Surrender and Return Original Patent

37 CFR 1.178. *Original patent; continuing duty of applicant.*

(a) The application for a reissue should be accompanied by either an offer to surrender the original patent, or the original patent itself, or if the original is lost or inaccessible, by a state-

ment to that effect. The application may be accepted for examination in the absence of the original patent or the statement, but one or the other must be supplied before the application is allowed. If a reissue application is refused, the original patent, if surrendered, will be returned to applicant upon request.

An examination on the merits of the reissue application is made even though the offer to surrender the original patent, the actual surrender, or a statement to the effect that the original is lost or inaccessible, has not been received. Either the original patent, or a statement as to loss or inaccessibility of the original patent, must be received before the examiner can allow the reissue application.

Form paragraph 14.05.01 may be used to notify applicant that the original patent or an affidavit or declaration as to loss is required before allowance.

¶ 14.05.01 Original Patent Required Prior to Allowance

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Examiner Note:

1. This form paragraph may be used in an Office action to remind applicant of the requirement for submission of the original patent before allowance.
2. It may also be used in an *Ex parte Quayle* action to require such submission.
3. Do not use this form paragraph in an examiner's amendment. The original patent or a statement of loss must be filed prior to mailing of the "Notice of Allowability".

If the original patent has been surrendered in the reissue application, and applicant requests the return of the surrendered original patent upon abandonment of the reissue application, the original patent will be sent to the applicant by the Technology Center.

An applicant may request that a surrendered original patent be transferred from an abandoned reissue application to a continuation or divisional reissue application. The technical support staff making the transfer should note the transfer on the "Contents" of the abandoned application. The application number and filing date of the reissue application to which it is transferred must be included in the notation. Even where the original patent grant is submitted together with the reissue application as filed, patentee must include a copy of the printed original patent to serve as the specification of the reissue application. See 37 CFR 1.172(a) and MPEP § 1411.

Form PTO/SB/55, Reissue Patent Application Statement As To Loss Of Original Patent, may be

used by applicant for filing a statement to the effect that the original patent is lost or inaccessible.

PTO/SB/55 (02-01)

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REISSUE PATENT APPLICATION STATEMENT AS TO LOSS OF ORIGINAL PATENT		Docket Number (Optional)
I hereby state that: I am the applicant for a reissue patent based on the original patent identified below.		
Name of Inventor(s)/Assignee(s)		
Patent Number		
Title of Invention		
Reissue application number (if known)		
The ribboned original patent grant is lost or inaccessible.		
Signature		
Typed or printed name		Date
Title (e.g. inventor(s), officer of assignee)		

Burden Hour Statement: This form is estimated to take 0.05 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

1417 Claim for Benefit Under 35 U.S.C. 119(a)-(d)

PRIORITY UNDER 35 U.S.C. 119(a)-(d) WAS PERFECTED IN THE ORIGINAL PATENT

A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application on which the original patent was granted. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for "Continuing Applications" in MPEP § 201.14(b).

In addition, 37 CFR 1.63 requires that in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55, the oath or declaration must identify the foreign application for patent or inventors' certificate on which priority is claimed unless supplied on an application data sheet (37 CFR 1.76), and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying:

(A) the application number of the foreign application;

(B) the foreign country or intellectual property authority; and

(C) the day, month, and year of the filing of the foreign application.

The examiner should note that the heading on printed copies of the patent will not be carried forward to the reissue from the original patent. Therefore, it is important that the bibliographic data sheet reprint (for series 09/ and later applications) or the front face of the reissue file wrapper (for series 08/ and earlier applications) be endorsed by the examiner under "FOREIGN APPLICATIONS."

PRIORITY UNDER 35 U.S.C. 119(a)-(d) IS NEWLY PERFECTED IN THE REISSUE AP- PLICATION

A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted. In *Brenner*, the claim

for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant will have to file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

1418 Notification of Prior/Concurrent Proceedings and Decisions Thereon, and of Information Known to be Material to Patentability

37 CFR 1.178. *Original patent; continuing duty of applicant.*

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

37 CFR 1.178(b) requires reissue applicants to call to the attention of the Office any prior or concurrent proceeding in which the patent (for which reissue is requested) is or was involved and the results of such proceedings. These proceedings would include interferences, reissues, reexaminations, and litigations. Litigation would encompass any papers filed in the court or issued by the court, which may include, for example, motions, pleadings, and court decisions. This duty to submit information is continuing, and runs from the time the reissue application is filed until the reissue application is abandoned or issues as a reissue patent.

In addition, a reissue application is subject to the same duty of disclosure requirements as is any other nonprovisional application. The provisions of 37 CFR 1.63 require acknowledgment in the reissue oath or declaration of the "duty to disclose to the Office all information known to the [applicants] to be material

to patentability as defined in § 1.56." Form paragraph 14.11.01 may be used to remind applicant of the duty to disclose any litigation information which is material to patentability.

¶ 14.11.01 Reminder of Duties Imposed by 37 CFR 1.178(b) and 37 CFR 1.56

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. [1] is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Examiner Note:

This form paragraph is to be used in the first action in a reissue application.

Reissue applicants may utilize 37 CFR 1.97 and 1.98 to comply with the duty of disclosure required by 37 CFR 1.56. This does not, however, relieve applicant of the duties under 37 CFR 1.175 of, for example, stating "at least one error being relied upon."

While 37 CFR 1.97(b) provides for filing an information disclosure statement within 3 months of the filing of an application or before the mailing date of a first Office action, reissue applicants are encouraged to file information disclosure statements at the time of filing so that such statements will be available to the public during the 2-month period provided by in MPEP § 1441.

1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, Official Gazette

37 CFR 1.11. Files open to the public.

(b) All reissue applications, all applications in which the Office has accepted a request to open the complete application to inspection by the public, and related papers in the application file, are open to inspection by the public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications, other than continued prosecution applications under § 1.53(d) of reissue applications, will be announced in the *Official Gazette*. The announcement shall include at least the filing date, reissue application and original patent numbers, title, class and subclass,

name of the inventor, name of the owner of record, name of the attorney or agent of record, and examining group to which the reissue application is assigned.

Under 37 CFR 1.11(b) all reissue applications filed after March 1, 1977, are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The filing of reissue applications (except for continued prosecution applications (CPA's) filed under 37 CFR 1.53(d)) will be announced in the *Official Gazette*. The announcement gives interested members of the public an opportunity to submit to the examiner information pertinent to the patentability of the reissue application. The announcement includes the filing date, reissue application and original patent numbers, title, class and subclass, name of the inventor, name of the owner of record, name of the attorney or agent of record, and the Technology Center (TC) to which the reissue application is initially assigned. A TC Director or other appropriate Office official may, under appropriate circumstances, postpone access to or the making of copies of a reissue application, such as, for example, to avoid interruption of the examination or other review of the application by an examiner. Those reissue applications already on file prior to March 1, 1977 are not automatically open to inspection, but a liberal policy is followed by the Office of Patent Legal Administration and by the Board of Patent Appeals and Interferences (see MPEP § 1002.02(b), item 19) in granting petitions for access to such applications.

A notice of a reissue application in the *Official Gazette* should be published prior to any examination of the application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the application may be delayed until two months after the publication, allowing for any protests to be filed.

The filing of a continued prosecution application (CPA) under 37 CFR 1.53(d) of a reissue application will not be announced in the *Official Gazette*. Although the filing of a CPA of a reissue application constitutes the filing of a reissue application, the announcement of the filing of such CPA would be redundant in view of the announcement of the filing of the prior reissue application in the *Official Gazette*.

and the fact that the same application number and file will continue to be used for the CPA.

If applicant files a Request for Continued Examination (RCE) of the reissue application under 37 CFR 1.114 (which can be filed on or after May 29, 2000 for a reissue application filed on or after June 8, 1995), such filing will not be announced in the *Official Gazette*. An RCE continues prosecution of the existing reissue application and is not a filing of a new application.

For those reissue applications filed on or after March 1, 1977, the following procedure will be observed:

(A) The filing of all reissue applications, except for CPAs filed under 37 CFR 1.53(d), will be announced in the *Official Gazette* and will include certain identifying data as specified in 37 CFR 1.11(b). Any member of the general public may request access to a particular reissue application filed after March 1, 1977. Since no record of such request is intended to be kept, an oral request will suffice.

(B) The reissue application files will be maintained in the TCs and inspection thereof will be supervised by TC personnel. Although no general limit is placed on the amount of time spent reviewing the files, the Office may impose limitations, if necessary, e.g., where the application is actively being processed.

(C) Where the reissue application has left the TC for administrative processing, requests for access should be directed to the appropriate supervisory personnel where the application is currently located.

(D) Requests for copies of papers in the reissue application file must be in writing and addressed to the Commissioner of Patents and Trademarks, Box 10, Washington, D.C. 20231 and may be either mailed or delivered to the Office Customer Service Window (See MPEP § 502). The price for copies made by the Office is set forth in 37 CFR 1.19.

1431 Notice in Patent File

37 CFR 1.179. Notice of reissue application.

When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

Whenever a reissue application is filed, a Form PTO-445 notice is placed in the patented file identify-

ing the reissue application by application number and its filing date. The pertinent data is filled in by the Office of Initial Patent Examination. When divisional or continuation reissue applications are filed, a separate form for each reissue application is placed in the original patent file. When the reissue is issued, it is important that the File Information Unit (Record Room) be informed by the Examining Group technical support staff of that fact by written memo. File Information Unit (Record Room) personnel will update the Form PTO-445 in the patented file.

1440 Examination of Reissue Application

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176 provides that an original claim, if re-presented in a reissue application, will be fully examined in the same manner, and subject to the same rules as if being presented for the first time in an original non-reissue, nonprovisional application, except that division will not be required by the examiner. See MPEP § 1450 and § 1451. Reissue applications are normally examined by the same examiner who issued the patent for which reissue is requested. In addition, the application will be examined with respect to compliance with 37 CFR 1.171-1.179 relating specifically to reissue applications, for example, the reissue oath or declaration will be carefully reviewed for compliance with 37 CFR 1.175. See MPEP § 1444 for handling applications in which the oath or declaration lacks compliance with 37 CFR 1.175. Reissue applications with related litigation will be acted on by the examiner before any other special applications, and will be acted on immediately by the examiner, subject only to a 2-month delay after publication for examining reissue applications; see MPEP § 1441.

The original patent file wrapper should always be ordered and reviewed when examining a reissue application thereof.

1441 Two-Month Delay Period

37 CFR 1.176 provides that reissue applications will be acted on by the examiner in advance of other applications, i.e., "special." Generally, a reissue application will not be acted on sooner than 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. The 2-month delay is provided in order that members of the public may have time to review the reissue application and submit pertinent information to the Office before the examiner's action. The pertinent information is submitted in the form of a protest under 37 CFR 1.291(a). As set forth in MPEP § 1901.04, the public should be aware that such submissions should be made as early as possible, since under certain circumstances the 2-month delay period will not be employed. For example, the Office will act on continuation and divisional reissue applications prior to the expiration of the 2-month period after announcement. Additionally, the Office will entertain petitions under 37 CFR 1.182 which are accompanied by the required petition fee (37 CFR 1.17(h)) to act on a reissue application without delaying for 2 months. Accordingly, protestors to reissue applications (see MPEP § 1441.01) cannot automatically assume that a full 2-month delay period will always be available. Appropriate reasons for requesting that the 2-month delay period not be employed include that litigation has been stayed to permit the filing of the reissue application. Such petitions are decided by the Office of Patent Legal Administration.

1441.01 Protest in Reissue Applications

A protest with regard to a reissue application should be filed within the 2-month period following the announcement of the filing of the reissue application in the *Official Gazette*. If the protest of a reissue application cannot be filed within the 2-month delay period, the protest can be submitted at a later time. Where the protest is submitted after the 2-month period, no petition for entry of the protest under 37 CFR 1.182 is needed with respect to the protest being submitted after the 2 months unless a final rejection has been issued or prosecution on the merits has been closed for the reissue application.

Where the protest is submitted after the 2-month period, the protest may be received after the first Office action by the examiner, since reissue applications are taken up "special." Once the first Office action is mailed (after the 2-month period), a member of the public may still submit pertinent information in the form of a protest under 37 CFR 1.291(a), and the examiner will consider the information submitted in the next Office action, to the extent that such consideration is appropriate. See MPEP § 1901.04 and § 1901.06 for the timeliness and content criteria as to when a protest is considered.

The Technology Center (TC) to which the reissue application is assigned is listed in the *Official Gazette* notice of filing of the reissue application. Accordingly, the indicated TC should retain the reissue application file for 2 months after the date of the *Official Gazette* notice before transferring the reissue application under the procedure set forth in MPEP § 903.08(d).

The publication of a notice of a reissue application in the *Official Gazette* should be done prior to any examination of the reissue application. If an inadvertent failure to publish notice of the filing of the reissue application in the *Official Gazette* is recognized later in the examination, action should be taken to have the notice published as quickly as possible, and action on the reissue application may be delayed until 2 months after the publication, allowing for any protests to be filed.

See MPEP § 1901.06 for general procedures on examiner treatment of protests in reissue applications.

1442 Special Status

All reissue applications are taken up "special," and remain "special" even though applicant does not respond promptly.

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to immediately. Furthermore, reissue applications involved in litigation will be taken up for action in advance of other reissue applications.

1442.01 Litigation-Related Reissues

During initial review, the examiner should determine whether the patent for which the reissue has

been filed is involved in litigation, and if so, the status of that litigation. If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, will inquire regarding the specific details of the litigation.

Form paragraph 14.06 may be used for such an inquiry.

¶ 14.06 *Litigation-Related Reissue*

The patent sought to be reissued by this application [1] involved in litigation. Any documents and/or materials which would be material to patentability of this reissue application are required to be made of record in response to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Examiner Note:

In bracket 1, insert either —is— or —has been—.

If additional details of the litigation appear to be material to examination of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

If the existence of litigation has not already been noted, the examiner should place a prominent notation on the application file to indicate the litigation (1) at the bottom of the face of the file in the box just to the right of the box for the retention label, and (2) on the pink Reissue Notice Card form.

Applicants will normally be given 1 month to reply to Office actions in all reissue applications which are being examined during litigation, or after litigation had been stayed, dismissed, etc., to allow for consideration of the reissue by the Office. This 1-month period may be extended only upon a showing of *clear justification* pursuant to 37 CFR 1.136(b). The Office action will inform applicant that the provisions of 37 CFR 1.136(a) are not available. Of course, up to 3 months may be set for reply if the examiner determines such a period is clearly justified.

1442.02 Concurrent Litigation

In order to avoid duplication of effort, action in reissue applications in which there is an indication of concurrent litigation will be suspended automatically unless and until it is evident to the examiner, or the

applicant indicates, that any one of the following applies:

- (A) a stay of the litigation is in effect;
- (B) the litigation has been terminated;
- (C) there are no significant overlapping issues between the application and the litigation; or
- (D) it is applicant's desire that the application be examined at that time.

Where any of (A) - (D) above apply, form paragraphs 14.08-14.10 may be used to deny a suspension of action in the reissue, i.e., to deny a stay of the reissue proceeding.

¶ 14.08 *Action in Reissue Not Stayed — Related Litigation Terminated*

Since the litigation related to this reissue application is terminated and final, action in this reissue application will NOT be stayed. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

¶ 14.09 *Action in Reissue Not Stayed — Related Litigation Not Overlapping*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because there are no significant overlapping issues between the application and that litigation. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

¶ 14.10 *Action in Reissue Not Stayed — Applicant's Request*

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

Where none of (A) through (D) above apply, action in the reissue application in which there is an indication of concurrent litigation will be suspended by the examiner. The examiner should consult with the Group Special Program Examiner prior to suspending action in the reissue. Form paragraph 14.11 may be used to suspend action, i.e., stay action, in a reissue application with concurrent litigation.

¶ 14.11 *Action in Reissue Stayed - Related Litigation*

In view of concurrent litigation, and in order to avoid duplication of effort between the two proceedings, action in this reissue application is STAYED until such time as it is evident to the examiner that (1) a stay of the litigation is in effect, (2) the litigation

tion has been terminated, (3) there are no significant overlapping issues between the application and the litigation, or (4) applicant requests that the application be examined.

If the reissue application has been merged with a reexamination proceeding, the merged proceeding generally will **not** be stayed where there is litigation. In a merged reexamination/reissue proceeding, the reexamination will control because of the *statutory* (35 U.S.C. 305) requirement that reexamination proceedings be conducted with special dispatch. See MPEP § 2285 and § 2286.

1442.03 Litigation Stayed

All reissue applications, except those under suspension because of litigation, will be taken up for action ahead of other "special" applications; this means that all issues not deferred will be treated and responded to *immediately*. Furthermore, reissue applications involved in "stayed litigation" will be taken up for action in advance of other reissue applications. Great emphasis is placed on the expedited processing of such reissue applications. The courts are especially interested in expedited processing in the Office where litigation is stayed.

In reissue applications with "stayed litigation," the Office will entertain petitions under 37 CFR 1.182, which are accompanied by the fee under 37 CFR 1.17(h), to not apply the 2-month delay period stated in MPEP § 1441. Such petitions are decided by the Office of Patent Legal Administration.

Time-monitoring systems have been put into effect which will closely monitor the time used by applicants, protestors, and examiners in processing reissue applications of patents involved in litigation in which the court has stayed further action. Monthly reports on the status of reissue applications with related litigation are required from each Technology Center (TC). Delays in reissue processing are to be followed up. The TC Special Program Examiner is responsible for oversight of reissue applications with related litigation.

The purpose of these procedures and those deferring consideration of certain issues, until all other issues are resolved or the application is otherwise ready for consideration by the Board of Patent Appeals and Interferences (note MPEP § 1448), is to reduce the time between filing of the reissue applica-

tion and final action thereon, while still giving all parties sufficient time to be heard.

Requests for stays or suspension of action in reissues where litigation has been stayed may be answered with form paragraph 14.07.

¶ 14.07 Action in Reissue Not Stayed or Suspended — Related Litigation Stayed

While there is a stay of the concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed or suspended because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

1442.04 Litigation Involving Patent

37 CFR 1.178. *Original patent; continuing duty of applicant.*

(b) In any reissue application before the Office, the applicant must call to the attention of the Office any prior or concurrent proceedings in which the patent (for which reissue is requested) is or was involved, such as interferences, reissues, reexaminations, or litigations and the results of such proceedings (see also § 1.173(a)(1)).

Where the patent for which reissue is being sought is, or has been, involved in litigation, the applicant should bring the existence of such litigation to the attention of the Office. 37 CFR 1.178(b). This should be done at the time of, or shortly after, the applicant files the application, either in the reissue oath or declaration, or in a separate paper, preferably accompanying the application as filed. Litigation begun after filing of the reissue application also should be promptly brought to the attention of the Office.

Litigation encompasses any papers filed in the court or issued by the court. This may include, for example, motions, pleadings, and court decisions, as well as the results of such proceedings. When applicant notifies the Office of the existence of the litigation, enough information should be submitted so that the Office can reasonably evaluate the need for asking for further materials in the litigation. Note that the existence of supporting materials which may substantiate allegations of invalidity should, at least, be fully described, and preferably submitted. The Office is not interested in receiving voluminous litigation materials which are not relevant to the Office's consideration of the reissue application. The status of the litigation

should be updated in the reissue application as soon as significant events happen in the litigation.

When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision(s) of the court, and also other papers in the suit, may provide information essential to the examination of the reissue. Examiners should inform the applicant of the duty to supply information as to litigation involving the patent. Form paragraph 14.11.01 may be used for this purpose. See MPEP § 1418.

Additionally, the patented file will contain notices of the filing and termination of infringement suits on the patent. Such notices are required by law to be filed by the clerks of the Federal District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. *Shepard's Federal Citations* and the cumulative digests of the *United States Patents Quarterly*, both of which are in the Lutrelle F. Parker, Sr., Memorial Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent.

A litigation computer search by the Scientific and Technical Information Center (STIC) should be requested by the examiner to determine whether the patent has been, or is, involved in litigation. The "Search Notes" box on the application file wrapper can then be completed to indicate that the review was conducted. A copy of the STIC search should be hole-punched and placed in the reissue file.

Additional information or guidance as to making a litigation search may be obtained from the library of the Office of the Solicitor. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was filed in view of the holding of a court.

If the examiner becomes aware of litigation involving the patent sought to be reissued during examination of the reissue application, and applicant has not made the details regarding that litigation of record in the reissue application, the examiner, in the next Office action, should inquire regarding the same.

Form paragraph 14.06 may be used for such an inquiry. See MPEP § 1442.01.

If the additional details of the litigation appear to be material to patentability of the reissue application, the examiner may make such additional inquiries as necessary and appropriate.

1442.05 Cases in Which Stays Were Considered

Federal District Courts stay litigation in significant numbers of cases to permit consideration of a reissue application by the Office. Several exemplary cases are listed here for the convenience of the Office, the courts and the public.

In most instances, the reissue-examination procedure is instituted by a patent owner who voluntarily files a reissue application as a consequence of related patent litigation. However, some District Courts have required a patentee-litigant to file a reissue application, for example:

Alpine Engineering Inc. v. Automated Building Components Inc., BNA/PTCJ 367: A-12 (S.D. Fla. 1978);

Lee-Boy Mfg. Co. v. Puckett, 202 USPQ 573 (D. Ga. 1978);

Choat v. Rome Industries Inc. 203 USPQ 549 (N.D. Ga. 1979).

Other courts have declined to so order, for example:

Bielomatik Leuze & Co., v. Southwest Tablet Mfg. Co., 204 USPQ 226 (N.D. Texas 1979);

RCA Corp. v. Applied Digital Data Systems Inc., 201 USPQ 451 (D. Del. 1979);

Antonious v. Kamata-Ri & Co. Ltd., 204 USPQ 294 (D. Md. 1979).

Only a patentee or his or her assignee may file a reissue patent application. An order for a different party to file a reissue will not be binding on the Office.

1442.05(a) Stays Granted

"Stays" of court or administrative proceedings in litigation were ordered in the following sampling of reported decisions.

PIC Inc. v. Prescon Corp., 195 USPQ 525 (D. Del. 1977).

Fisher Controls Co. Inc. v. Control Components, Inc., 196 USPQ 817 (S.D. Iowa 1977) (Note also 203 USPQ 1059 denying discovery during the stay.).

Alpine Engineering Inc. v. Automated Building Components Inc., BNA/PTCJ 367: A-12 (S.D. Fla. 1978) (dismissed a Declaratory Judgment suit with order for patentee to seek reissue in the Office).

AMI Industries, Inc. v. E. A. Industries, Inc., 204 USPQ 568 (W.D. N.C. 1978) (with dicta that if suit had not been dismissed, proceedings would have been stayed for Office consideration).

Reynolds Metal Co. v. Aluminum Co. of America, 198 USPQ 529 (N.D. Ind. 1978).

Sauder Industries, Inc. v. Carborundum Co., 201 USPQ 240 (N.D. Ohio 1978).

Rohm and Haas Co. v. Mobil Oil Corp., 201 USPQ 80 (D. Del. 1978) (with provision for limited discovery on allegations of fraud for Office's benefit).

Lee-Boy Mfg. Co. v. Puckett, 202 USPQ 573 (D. Ga. 1978) (reissue ordered after discovery and during wait for trial).

Fas-Line Sales & Rentals, Inc. v. E-Z Lay Pipe Corp., 203 USPQ 497 (W.D. Okla. 1979).

Choat v. Rome Industries Inc., 203 USPQ 549 (N.D. Ga. 1979) (directed patentee to file reissue application).

In re Certain High-Voltage Circuit Interrupters and Components Thereof, 204 USPQ 50 (Int'l Trade Comm'n 1979).

1442.05(b) Stays Denied

"Stays" of court or administrative proceedings in litigation were denied in the following sampling of reported decisions.

General Tire and Rubber Co. v. Watson-Bowman Associates, Inc., 193 USPQ 479 (D. Del. 1977).

Perkin-Elmer Corp. v. Westinghouse Electric Corp., BNA/PTCJ 376: A-11 (E.D. N.Y. 1978).

In re Certain Ceramic Tile Setters, No. 337-TA-41, BNA/PTCJ 385: A-21 (Int'l Trade Comm'n 1978).

E.C.H. Will v. Freundlich-Gomez Machinery Corp., 201 USPQ 476 (S.D. N.Y. 1978).

RCA Corp. v. Applied Digital Data Systems Inc., 201 USPQ 451 (D. Del. 1979) (denied stay where a patentee had not filed a reissue).

Bielomatik Leuze & Co., v. Southwest Tablet Mfg. Co., 204 USPQ 226 (N.D. Texas 1979) (refused to order reissue).

Antonious v. Kamata-Ri & Co. Ltd., 204 USPQ 294 (D. Md. 1979) (refused to order reissue).

1443 Initial Examiner Review

As part of an examiner's preparation for the examination of a reissue application, the Examiner Reissue Guide and Checklist should be consulted for basic guidance and suggestions for handling the prosecution. The Technology Center (TC) Special Program Examiners (SPREs) should make the Guide and Checklist available at the time a reissue application is docketed to an examiner.

On initial receipt of a reissue application, the examiner should inspect the submission under 37 CFR 1.172 as to documentary evidence of a chain of title from the original owner to the assignee to determine whether the consent requirement of 37 CFR 1.172 has been met. The examiner will compare the consent and documentary evidence of ownership; the assignee indicated by the documentary evidence must be the same assignee which signed the consent. Also, the person who signs the consent for the assignee and the person who signs the submission of evidence of ownership for the assignee must both be persons having authority to do so. See also MPEP § 324.

Where the application is assigned, and there is no submission under 37 CFR 1.172 as to documentary evidence in the application, the examiner should require the submission using form paragraph 14.16. Once the submission under 37 CFR 1.172 as to documentary evidence is received, it must be compared with the consent to determine whether the assignee indicated by the documentary evidence is the same assignee which signed the consent. See MPEP § 1410.01 for further discussion as to the required consent and documentary evidence.

Where there is a statement of record that the application is **not** assigned, there should be no submission under 37 CFR 1.172 as to documentary evidence of ownership in the application, and none should be required by the examiner.

The filing of all reissue applications, except for continued prosecution applications (CPAs) filed under 37 CFR 1.53(d), must be announced in the *Official Gazette*. Accordingly, for any reissue application other than a CPA, the examiner should determine if the filing of the reissue application has been announced in the *Official Gazette* as provided in 37 CFR 1.11(b), especially where the reissue is a file wrapper continuation under former 37 CFR 1.62. The date of the *Official Gazette* notice can usually be found on the pink "REISSUE" tag which protrudes from the top of the application file of 08/ or earlier series. Where the date is missing from the tag, or where the tag itself is missing, the PALM screen (2952) should be checked for the presence of an "NRE" entry in the contents. For 09/ and later series reissue applications, the *Official Gazette* publication date appears on the face of the file wrapper. If the filing of the reissue application has not been announced in the *Official Gazette*, the reissue application should be returned to the Office of Initial Patent Examination (Special Processing) to handle the announcement. The examiner should not further act on the reissue until 2 months after announcement of the filing of the reissue has appeared in the *Official Gazette*. See MPEP § 1440.

The examiner should determine if there is concurrent litigation, and if so, the status thereof (MPEP § 1442.01), and whether the reissue file has been appropriately marked. Note MPEP § 1404.

The examiner should determine if a protest has been filed, and if so, it should be handled as set forth in MPEP § 1901.06.

The examiner should determine whether the patent is involved in an interference, and if so, should refer to MPEP § 1449.01 before taking any action on the reissue application.

The examiner should check that an offer to surrender the original patent, or a statement to the effect that the original is lost or inaccessible, has been received. An examination on the merits is made even though the above has not been received. See MPEP § 1416.

The examiner should verify that all Certificate of Correction changes have been properly incorporated into the reissue application. See MPEP § 1411.01.

The examiner should verify that the patent on which the reissue application is based has not expired, either because its term has run or because required

maintenance fees have not been paid. Once a patent has expired, the Commissioner no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1992). See also MPEP § 1415.01.

1444 Review of Reissue Oath/Declaration

In accordance with 37 CFR 1.175, the following is required in the reissue oath/declaration:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid-

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, i.e., which provides a basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

MPEP § 1414 contains a discussion of each of the above elements (i.e., requirements of a reissue oath/declaration). The examiner should carefully review the reissue oath/declaration in conjunction with that discussion, in order to ensure that each element is provided in the oath/declaration. If the examiner's review of the oath/declaration reveals a lack of compliance with any of the requirements of 37 CFR 1.175, a rejection of all the claims under 35 U.S.C. 251 should be made on the basis that the reissue oath/declaration is insufficient.

In preparing an Office action, the examiner should use form paragraphs 14.01 through 14.01.04 to state the objection(s) to the oath/declaration, i.e., the defects in the oath/declaration. These form paragraphs are reproduced in MPEP § 1414. The examiner should then use form paragraph 14.14 to reject the claims under 35 U.S.C. 251, based upon the improper oath/declaration.

¶ 14.14 Rejection, Defective Reissue Oath or Declaration

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the [3] is set forth in the discussion above in this Office action.

Examiner Note:

1. In bracket 1, list all claims in the reissue application. See MPEP § 706.03(x).
2. This paragraph should be preceded by at least one of the paragraphs 14.01 to 14.01.04.
3. In brackets 2 and 3, insert either --oath-- or --declaration--.

A lack of signature on a reissue oath/declaration (except as otherwise provided in 37 CFR 1.42, 1.43, and 1.47 and in 37 CFR 1.172) would be considered a lack of compliance with 37 CFR 1.175(a) and result in a rejection, including final rejection, of all the claims on the basis that the reissue oath/declaration is insufficient. If the unsigned reissue oath/declaration is submitted as part of a reply which is otherwise properly signed and responsive to the outstanding Office action, the reply should be accepted by the examiner as proper and responsive, and the oath/declaration considered fully in the next Office action. The reply should not be treated as an unsigned or improperly signed amendment (see MPEP § 714.01(a)), nor do the holdings of *Ex parte Quayle* apply in this situation. The lack of signature, along with any other oath/declaration deficiencies, should be noted in the next Office action *rejecting* the claims as being based upon an insufficient reissue oath/declaration.

HANDLING OF THE REISSUE OATH/DECLARATION DURING THE REISSUE PROCEEDING

An initial reissue oath/declaration is submitted with the reissue application (or within the time period set for filing the oath/declaration in a Notice To File Missing Parts under 37 CFR 1.53(f)). Where the reissue oath/declaration fails to comply with 37 CFR 1.175(a), the examiner will so notify the applicant in an Office action, rejecting the claims under 35 U.S.C. 251 as discussed above. In reply to the Office action, a supplemental reissue oath/declaration should be submitted dealing with the noted defects in the reissue oath/declaration.

Where the initial reissue oath/declaration (1) failed to provide *any* error statement, or (2) attempted to provide an error statement, but failed to identify any error under 35 U.S.C. 251 upon which reissue can be based (see MPEP § 1402), the examiner should reject all the claims as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. To support the

rejection, the examiner should specifically point out the failure of the initial oath/declaration to comply with 37 CFR 1.175 because an "error" under 35 U.S.C. 251 upon which reissue can be based was not identified therein. In reply to the rejection under 35 U.S.C. 251, a supplemental reissue oath/declaration must be submitted stating an error under 35 U.S.C. 251 which can be relied upon to support the reissue application. Submission of this supplemental reissue oath/declaration to obviate the rejection cannot be deferred by applicant until the application is otherwise in condition for allowance. In this instance, a proper statement of error *was never provided in the initial reissue oath/declaration*, thus a supplemental oath/declaration is required *in reply to the Office action* in order to properly establish grounds for reissue.

A different situation may arise where the initial reissue oath/declaration does properly identify one or more errors under 35 U.S.C. 251 as being the basis for reissue, however, because of changes or amendments made during prosecution, none of the identified errors are relied upon any more. A supplemental oath/declaration will be needed to identify at least one error *now* being relied upon as the basis for reissue, even though the prior oath/declaration was earlier found proper by the examiner. The supplemental oath/declaration need *not* also indicate that the error(s) identified in the prior oath(s)/declaration(s) is/are no longer being corrected. In this instance, applicant's submission of the supplemental reissue oath/declaration to obviate the rejection under 35 U.S.C. 251 can, at applicant's option, be deferred until the application is otherwise in condition for allowance. The submission can be deferred because a proper statement of error was provided in the initial reissue oath/declaration. Applicant need only request that submission of the supplemental reissue oath/declaration be deferred until allowance, and such a request will be considered a complete reply to the rejection.

SUPPLEMENTAL REISSUE OATH/DECLARATION UNDER 37 CFR 1.175(b)(1):

Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a

reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

See MPEP § 1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

A supplemental oath/declaration under 37 CFR 1.175(b)(1) must be submitted before allowance. It may be submitted with any reply prior to allowance. It may be submitted to overcome a rejection under 35 U.S.C. 251 made by the examiner, where it is indicated that the submission of the supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required where:

(A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;

(B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and

(C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251.

When a supplemental oath/declaration under 37 CFR 1.175(b)(1) directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02 where the action issued is a second or subsequent action on the merits.

¶ 14.05.02 Supplemental Oath or Declaration Required Prior to Allowance

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim [1] rejected as being based upon a defective reissue [2] under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert either --oath-- or --declaration--.
3. This form paragraph is used in an Office action to: (a) remind applicant of the requirement for submission of the supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) before allowance and (b) at the same time, reject all the claims since the reissue application is defective until the supplemental oath/declaration is submitted.
4. Do not use this form paragraph if no amendments (or other corrections of the patent) have been made subsequent to the last oath/declaration filed in the case; instead allow the case.
5. This form paragraph cannot be used in an *Ex parte Quayle* action to require the supplemental oath/declaration, because the rejection under 35 U.S.C. 251 is more than a matter of form.
6. Do not use this form paragraph in an examiner's amendment. The supplemental oath/declaration must be filed prior to mailing of the Notice of Allowability.

As noted above, the examiner will issue a final Office action where the application is otherwise in condition for allowance, and amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application. The examiner will be introducing (via form paragraph 14.05.02) a rejection into the case for the first time in the prosecution, when the claims have been determined to be otherwise allowable. This introduction of a new ground of rejection under 35 U.S.C. 251 will not prevent the action from being made final on a second or subsequent action because of the following factors:

(A) The finding of the case in condition for allowance is the first opportunity that the examiner has to make the rejection;

(B) The rejection is being made in reply to, i.e., was caused by, an amendment of the application (to correct errors in the patent);

(C) All applicants are on notice that this rejection will be made upon finding of the case otherwise in condition for allowance where errors have been corrected subsequent to the last oath/declaration filed in the case, so that the rejection should have been expected by applicant; and

(D) The rejection will not prevent applicant from exercising any rights to cure the rejection, since applicant need only submit a supplemental oath/declaration with the above-described language, and it will be entered to cure the rejection.

Where the application is in condition for allowance and no amendments or other corrections of error in the patent have been made subsequent to the last oath/declaration filed in the application, a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) should not be required by the examiner. Instead, the examiner should issue a Notice of Allowability indicating allowance of the claims.

AFTER ALLOWANCE

Where applicant seeks to correct an error after allowance of the application, any amendment of the patent correcting the error must be submitted in accordance with 37 CFR 1.312. As set forth in 37 CFR 1.312, no amendment may be made as a matter of right in an application after the mailing of the notice of allowance. An amendment filed under 37 CFR 1.312 must be filed before or with the payment of the issue fee and may be entered on the recommendation of the primary examiner, and approved by the supervisory patent examiner, without withdrawing the case from issue.

Because the amendment seeks to correct an error in the patent, the amendment will affect the disclosure, the scope of a claim, or add a claim. Thus, in accordance with MPEP § 714.16, the remarks accompanying the amendment must fully and clearly state:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.

A supplemental reissue oath/declaration must accompany the amendment. The supplemental reissue oath/declaration must state that the error(s) to be corrected arose without any deceptive intention on the part of the applicant. The supplemental reissue oath/declaration submitted after allowance must be directed to the error(s) applicant seeks to correct after allowance. This oath/declaration need not cover any earlier errors, since all earlier errors should have been

covered by a reissue oath/declaration submitted prior to allowance.

Occasionally correcting an error after allowance does not include an amendment of the specification or claims of the patent. For example, the correction of the error could be the filing of a certified copy of the original foreign application (prior to the payment of the issue fee - see 37 CFR 1.55(a)(2)) to obtain the right of foreign priority under 35 U.S.C. 119 (see *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968)) where the claim for foreign priority had been timely made in the application for the original patent. In such a case, the requirements of 37 CFR 1.312 must still be met. This is so, because the correction of the patent is an amendment of the patent, even though no amendment is physically entered into the case. Thus, for a reissue oath/declaration submitted after allowance to correct an additional error (or errors), the reissue applicant must comply with 37 CFR 1.312 in the manner discussed above.

1445 Reissue Application Examined in Same Manner as Original Application

As stated in 37 CFR 1.176, a reissue application, including all the claims therein, is subject to "be examined in the same manner as a non-reissue, non-provisional application." Accordingly, the claims in a reissue application are subject to any and all rejections which the examiner deems appropriate. It does not matter whether the claims are identical to those of the patent or changed from those in the patent. It also does not matter that a rejection was not made in the prosecution of the patent, or could have been made, or was in fact made and dropped during prosecution of the patent; the prior action in the prosecution of the patent does not prevent that rejection from being made in the reissue application. Claims in a reissue application enjoy no "presumption of validity." *In re Doyle*, 482 F.2d 1385, 1392, 179 USPQ 227, 232-233 (CCPA 1973); *In re Sneed*, 710 F.2d 1544, 1550 n.4, 218 USPQ 385, 389 n.4 (Fed. Cir. 1983). Likewise, the fact that during prosecution of the patent the examiner considered, may have considered, or should have considered information such as, for example, a specific prior art document, does not have any bearing on, or prevent, its use as prior art during prosecution of the reissue application.

1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues

The Office no longer investigates and rejects reissue applications under 37 CFR 1.56. The Office will not comment upon duty of disclosure issues which are brought to the attention of the Office in reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications. Examination as to the lack of deceptive intent requirement in reissue applications will continue but without any investigation of fraud, inequitable conduct, or duty of disclosure issues. Applicant's statement in the reissue oath or declaration of lack of deceptive intent will be accepted as dispositive except in special circumstances such as an admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure.

ADMISSION OR JUDICIAL DETERMINATION

An admission or judicial determination of fraud, inequitable conduct, or violation of the duty of disclosure is a special circumstance, because no investigation need be made. Accordingly, after consulting with the Technology Center (TC) Special Program Examiner (SPRE), a rejection should be made using the appropriate one of form paragraphs 14.21.09 or 14.22 as reproduced below.

Any admission of fraud, inequitable conduct or violation of the duty of disclosure must be explicit, unequivocal, and not subject to other interpretation. Where a rejection is made based upon such an admission (see form paragraph 14.22 below) and applicant responds with any reasonable interpretation of the facts that would not lead to a conclusion of fraud, inequitable conduct or violation of the duty of disclosure, the rejection should be withdrawn. Alternatively, if applicant argues that the admission noted by the examiner was not in fact an admission, the rejection should also be withdrawn.

Form paragraph 14.21.09 should be used where the examiner becomes aware of a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant independently of the record of the case, i.e., the examiner has external knowledge of the judicial determination.

Form paragraph 14.22 should be used where, in the application record, there is (a) an explicit, unequivocal admission by applicant of fraud, inequitable conduct or violation of the duty of disclosure which is not subject to other interpretation, or (b) information as to a judicial determination of fraud, inequitable conduct or violation of the duty of disclosure on the part of the applicant. External information which the examiner believes to be an *admission* by applicant should never be used by the examiner, and such external information should never be made of record in the reissue application.

¶ 14.21.09 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention - External Knowledge

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of the judicial determination in [2] of [3] on the part of applicant, a conclusion that any error was "without deceptive intention" cannot be supported. [4]

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, list the Court or administrative body which made the determination of fraud or inequitable conduct on the part of applicant.
3. In bracket 3, insert --fraud--, --inequitable conduct-- and/or --violation of duty of disclosure--.
4. In bracket 4, point out where in the opinion (or holding) of the Court or administrative body the determination of fraud, inequitable conduct or violation of duty of disclosure is set forth. Page number, column number, and paragraph information should be given as to the opinion (or holding) of the Court or administrative body. The examiner may add explanatory comments.

¶ 14.22 Rejection, 35 U.S.C. 251, No Error Without Deceptive Intention-Evidence in the Application

Claims [1] rejected under 35 U.S.C. 251 since error "without any deceptive intention" has not been established. In view of Paper No. [2], filed [3], a conclusion that any error was "without deceptive intention" cannot be supported.

[4]

Examiner Note:

1. In bracket 1, list all claims in the reissue application.
2. In bracket 2, insert the paper number providing an admission of fraud, inequitable conduct or violation of duty of disclosure, or that there was a judicial determination of same.
3. In bracket 3, insert the filing date of the paper.
4. In bracket 4, insert a statement that there has been an admission or a judicial determination of fraud, inequitable conduct or violation of duty of disclosure which provide circumstances why applicant's statement in the oath or declaration of lack of deceptive intent should not be taken as dispositive. Any admission of fraud, inequitable conduct or violation of duty of disclosure must be explicit, unequivocal, and not subject to other interpretation.

See MPEP § 2012 for additional discussion as to fraud, inequitable conduct or violation of duty of disclosure in a reissue application.

1449 Protest Filed in Reissue Where Patent Is in Interference

If a protest (see MPEP Chapter 1900) is filed in a reissue application related to a patent involved in a pending interference proceeding, the reissue application should be referred to the Office of Patent Legal Administration (OPLA) before considering the protest and acting on the reissue application.

The OPLA will check to see that:

(A) all parties to the interference are aware of the filing of the reissue; and

(B) the Office does not allow claims in the reissue which are unpatentable over the pending interference count(s), or found unpatentable in the interference proceeding.

1449.01 Concurrent Office Proceedings

37 CFR 1.565(d) provides that if "a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to 37 CFR 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings." A similar policy is in effect for *inter partes* reexamination proceedings pending concurrently on a patent with a reissue application. If an examiner becomes aware that a reissue application and a reexamination proceeding are both pending for the same patent, he or she should inform the Technology Center (TC) Special Program Examiner (SPRE) immediately.

Where a reissue application and a reexamination proceeding are pending concurrently on a patent, and an order granting reexamination has been issued for the reexamination proceeding, the files for the reissue application and the reexamination will be forwarded to the Office of Patent Legal Administration (OPLA) for a decision whether to merge the reissue and the reexamination, or stay one of the two. See *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985). See also MPEP § 2285.

If the original patent is involved in an interference, the examiner must consult the administrative patent

judge in charge of the interference before taking any action on the reissue application. It is particularly important that the reissue application not be granted without the administrative patent judge's approval. See MPEP § 2360.

1449.02 Interference in Reissue

In appropriate circumstances, a reissue application may be placed into interference with a patent or pending application. A patentee may provoke an interference with a patent or pending application by filing a reissue application, if the reissue application includes an appropriate reissue error as required by 35 U.S.C. 251. Reissue error must be based upon applicant error; a reissue cannot be based solely on the error of the Office for failing to declare an interference or to suggest copying claims for the purpose of establishing an interference. See *In re Keil*, 808 F.2d 830, 1 USPQ2d 1427 (Fed. Cir. 1987); *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982); *In re Bostwick*, 102 F.2d 886, 888, 41 USPQ 279, 281 (CCPA 1939); and *In re Guastavino*, 83 F.2d 913, 916, 29 USPQ 532, 535 (CCPA 1936). See also *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 48 USPQ2d 1055 (Fed. Cir. 1998) (Two patents issued claiming the same patentable subject matter, and the patentee with the earlier filing date requested reexamination of the patent with the later filing date (Slip Track's patent). A stay of litigation in a priority of invention suit under 35 U.S.C. 291, pending the outcome of the reexamination, was reversed. The suit under 35 U.S.C. 291 was the only option available to Slip Track to determine priority of invention. Slip Track could not file a reissue application solely to provoke an interference proceeding before the Office because it did not assert that there was any error as required by 35 U.S.C. 251 in the patent.). A reissue application can be employed to provoke an interference if the reissue application:

(A) adds copied claims which are not present in the original patent;

(B) amends claims to correspond to those of the patent or application with which an interference is sought; or

(C) contains at least one error (not directed to provoking an interference) appropriate for the reissue.

In the first two situations, the reissue oath/declaration must assert that applicant erred in failing to include claims of the proper scope to provoke an interference in the original patent application. Note that in *In re Metz*, 1998 U.S. App. LEXIS 23733 (Fed. Cir. 1998)(unpublished), the Federal Circuit permitted a patentee to file a reissue application to copy claims from a patent in order to provoke an interference with that patent. Furthermore, the subject matter of the copied or amended claims in the reissue application must be supported by the disclosure of the original patent under 35 U.S.C. 112, first paragraph. See *In re Molins*, 368 F.2d 258, 261, 151 USPQ 570, 572 (CCPA 1966) and *In re Spencer*, 273 F.2d 181, 124 USPQ 175 (CCPA 1959).

A reissue applicant cannot present added or amended claims to provoke an interference, if the claims were deliberately omitted from the patent. If there is evidence that the claims were not inadvertently omitted from the original patent, e.g., the subject matter was described in the original patent as being undesirable, the reissue application may lack proper basis for the reissue. See *In re Bostwick*, 102 F.2d at 889, 41 USPQ at 282 (CCPA 1939)(reissue lacked a proper basis because the original patent pointed out the disadvantages of the embodiment that provided support for the copied claims).

The issue date of the patent, or the publication date of the application publication (whichever is applicable under 35 U.S.C. 135(b)), with which an interference is sought must be less than 1 year prior to the presentation of the copied or amended claims in the reissue application. See 35 U.S.C. 135(b) and MPEP § 715.05 and § 2307. If the reissue application includes broadened claims, the reissue application must be filed within two years from the issue date of the original patent. See 35 U.S.C. 251 and MPEP § 1412.03.

REISSUE APPLICATION FILED WHILE PATENT IS IN INTERFERENCE

If a reissue application is filed while the original patent is in an interference proceeding, the reissue applicant is required to notify the Board of Patent Appeals and Interferences of the filing of the reissue application within 10 days from the filing date. See 37 CFR 1.660(b) and MPEP § 2360.

1450 Restriction and Election of Species

37 CFR 1.176. Examination of reissue.

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

(b) Restriction between subject matter of the original patent claims and previously unclaimed subject matter may be required (restriction involving only subject matter of the original patent claims will not be required). If restriction is required, the subject matter of the original patent claims will be held to be constructively elected unless a disclaimer of all the patent claims is filed in the reissue application, which disclaimer cannot be withdrawn by applicant.

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between claims newly added in a reissue application and the original patent claims, where the added claims are directed to an invention which is separate and distinct from the invention(s) defined by the original patent claims. The criteria for making a restriction requirement in a reissue application between the newly added claims and the original claims are the same as that applied in a non-reissue application. See MPEP §§ 806 through 806.05(i). The authority to make a "restriction" requirement under 37 CFR 1.176(b) extends to and includes the authority to make an election of species.

Where a restriction requirement is made by the examiner, the original patent claims will be held to be constructively elected (except for the limited situation where a disclaimer is filed as discussed in the next paragraph). Thus, the examiner will issue an Office action (1) providing notification of the restriction requirement, (2) holding the added claims to be constructively non-elected and withdrawn from consideration, and (3) treating the original patent claims on the merits.

If a disclaimer of all the original patent claims is filed in the reissue application containing newly added claims that are separate and distinct from the original patent claims, only the newly added claims will be present for examination. In this situation, the examiner's Office action will treat the newly added claims in the reissue application on the merits. The disclaimer of all the original patent claims must be filed in the reissue application prior to the issuance of the examiner's Office action containing the restriction requirement, in order for the newly added claims to be

treated on the merits. Once the examiner has issued the Office action providing notification of the restriction requirement and treating the patent claims on the merits, it is too late to obtain an examination on the added claims in the reissue application by filing a disclaimer of all the original patent claims. If reissue applicant wishes to have the newly added claims be treated on the merits, a divisional reissue application must be filed to obtain examination of the added claims. Reissue applicants should carefully note that once a disclaimer of the patent claims is filed, it cannot be withdrawn. It does not matter whether the reissue application is still pending, or whether the reissue application has been abandoned or issued as a reissue patent. For all these situations, 37 CFR 1.176(b) states that the disclaimer cannot be withdrawn; the disclaimer will be given effect.

Claims elected pursuant to a restriction requirement will receive a complete examination on the merits, while the non-elected claims (to any added invention(s)) will be held in abeyance in a withdrawn status, and will only be examined if filed in a divisional reissue application. If the reissue application containing only original unamended claims becomes allowable first (and no "error" under 35 U.S.C. 251 exists), further action in that reissue application will be suspended to await examination in the divisional reissue application(s) containing the added claims. The Office will not allow claims in a reissue application which does not correct any error in the original patent. Once a divisional reissue application containing the added claims is examined and becomes allowable, the examiner will rejoin the two sets of examined and allowable claims into a single reissue application for issuance. Unless applicant requests to the contrary prior to the examiner's rejoinder of the claims, the claims will be rejoined in the first reissue application (containing the pending original patent claims), and the divisional reissue application will be held abandoned. See MPEP § 1451 for additional discussion for presenting multiple reissue applications.

As stated in 37 CFR 1.176(b), the examiner is not permitted to require restriction among original claims of the patent (i.e., among claims that were in the patent prior to filing the reissue application). Even

where the original patent contains claims to different inventions which the examiner considers independent or distinct, and the reissue application claims the same inventions, a restriction requirement would be improper. If such a restriction requirement is made, it must be withdrawn.

Restriction between multiple inventions recited in the newly added claims will be permitted provided the added claims are drawn to several separate and distinct inventions. In such a situation, the original patent claims would be examined in the first reissue application, and applicant is permitted to file a divisional reissue application for each of the several separate and distinct inventions identified in the examiner's restriction requirement.

A situation will sometimes arise where the examiner makes an election of species requirement between the species claimed in the original patent claims and a species of claims added in the reissue application. In such a situation, if (1) the non-elected claims to the added species depend from (or otherwise include all limitations of) a generic claim which embraces all species claims, and (2) the generic claim is found allowable, then the non-elected claims of the added species must be rejoined with the elected claims of the original patent. See MPEP § 809.02(c).

A reissue applicant's failure to timely file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). See also *In re Mead*, 581 F.2d 251, 198 USPQ 412 (CCPA 1978). Likewise, if the original patent specification or the prosecution history of the original patent shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. In these situations, the reissue claims should be rejected under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. See also MPEP § 1412.01.

1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is Pending

35 U.S.C. 251. *Reissue of defective patents.*

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

37 CFR 1.177. *Issuance of multiple reissue patents.*

(a) The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under § 1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice.

(b) If applicant files more than one application for the reissue of a single patent, each claim of the patent being reissued must be presented in each of the reissue applications as an amended, unamended, or canceled (shown in brackets) claim, with each such claim bearing the same number as in the patent being reissued. The same claim of the patent being reissued may not be presented in its original unamended form for examination in more than one of such multiple reissue applications. The numbering of any added claims in any of the multiple reissue applications must follow the number of the highest numbered original patent claim.

(c) If any one of the several reissue applications by itself fails to correct an error in the original patent as required by 35 U.S.C. 251 but is otherwise in condition for allowance, the Office may suspend action in the allowable application until all issues are resolved as to at least one of the remaining reissue applications. The Office may also merge two or more of the multiple reissue applications into a single reissue application. No reissue application containing only unamended patent claims and not correcting an error in the original patent will be passed to issue by itself.

The court in *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that "[t]he statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met." Following the decision in *Graff*, the Office has adopted a policy of treating continuations and divi-

sionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.

Questions relating to the propriety of divisional reissue applications and continuation reissue applications should be referred via the Technology Center (TC) Special Program Examiner to the Office of Patent Legal Administration.

DIVISIONAL REISSUE APPLICATIONS

37 CFR 1.176(b) permits the examiner to require restriction in a reissue application between the original claims of the patent and any newly added claims which are directed to a separate and distinct invention(s). See also MPEP § 1450. As a result of such a restriction requirement, divisional applications may be filed for each of the inventions identified in the restriction requirement.

In addition, applicant may initiate a division of the claims by filing more than one reissue application in accordance with 37 CFR 1.177. The multiple reissue applications which are filed may contain different groups of claims from among the original patent claims, or some of the reissue applications may contain newly added groups (not present in the original patent). There is no requirement that the claims of the multiple reissue applications be independent and distinct from one another; if they are not independent and distinct from one another, the examiner must apply the appropriate double patenting rejections.

There is no requirement that a family of divisional reissue applications issue at the same time; however, it is required that they contain a cross reference to each other in the specification. 37 CFR 1.177(a) requires that all multiple reissue applications resulting from a single patent must include as the first sentence of their respective specifications a cross reference to the other reissue application(s). Accordingly, the first sentence of each reissue specification must provide notice stating that more than one reissue application has been filed, and it must identify each of the reissue applications and their relationship within the family of reissue applications, and to the original patent. An example of the suggested language to be inserted is as follows:

Notice: More than one reissue application has been filed for the reissue of Patent No. 9,999,999. The

reissue applications are application numbers 09/999,994 (the present application), 09/999,995, and 09/999,998, all of which are divisional reissues of Patent No. 9,999,999.

The examiner should object to the specification and require an appropriate amendment if applicant fails to include such a cross reference to the other reissue applications in the first sentence of the specification of each of the reissue applications.

Where one of the divisional applications of the family has issued without the required cross reference to the other reissue application(s), the examiner will refer the matter to his/her Supervisory Patent Examiner (SPE). The SPE will initiate a certificate of correction under 37 CFR 1.322 to include the appropriate cross reference in the already issued first reissue patent before passing the pending reissue application to issue. Form paragraph 10.19 may be used for such purpose. After the SPE prepares the memorandum as per form paragraph 10.19, the patent file with the memorandum should be forwarded to the Certificates of Correction Branch for issuance of a certificate.

¶ 10.19 Memorandum - Certificate of Correction (Cross-Reference to Other Reissues in Family)

DATE: [1]

TO: Certificates of Correction Branch

FROM: [2], SPE, Art Unit [3]

SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

[5], SPE

Art Unit [6]

**UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE**

Patent No. [7]

Patented: [8]

The present reissue patent issued from an application that is one of a family of divisional reissue applications resulting from Patent No. [9]. The present reissue patent has issued without the cross reference to the other reissue application(s) of the family which is required pursuant to 37 CFR 1.177(a). Accordingly, insert in the first sentence of the specification as follows:

Notice: More than one reissue application has been filed for the reissue of patent [9]. The reissue applications are [10].

[11], Supervisory Patent Examiner

Art Unit [12]

Examiner Note:

1 In bracket 9, insert the patent number of the patent for which multiple reissue divisional applications have been filed.

2 This is an internal memo and must not be mailed to the applicant. This memo should accompany the patented file to the Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.

3 In brackets 5 and 11, insert the name of SPE and provide the signature of the SPE above each line.

4 In brackets 6 and 12, insert the Art Unit number.

5 Two separate pages of USPTO letterhead will be printed when using this form paragraph.

6 In bracket 10, identify each of the reissue applications (including the present application) and their relationship within the family of reissue applications, and to the original patent.

In addition to the amendment to the first sentence of the specification, the reissue application cross references will also be reflected in the file by way of the bibliographic data sheet reprint (for 09/ and later series), or the front face of the reissue file wrapper (for 08/ and earlier series), for all the multiple reissue applications, so that adequate notice is provided that more than one reissue application has been filed for a single original patent.

Pursuant to 37 CFR 1.177(b) all of the claims of the patent to be reissued must be presented in each reissue application in some form, i.e., as amended, as unamended or as canceled. Further, the same patent claim cannot be presented in more than one of the reissue applications, as a pending claim, in its original unamended version for examination. Finally, any added claims must be numbered beginning with the next highest number following the last patent claim.

If the same or similar claims are presented in more than one of the multiple reissue applications, the possibility of statutory double patenting (35 U.S.C. 101) or non-statutory (judicially created doctrine) double patenting should be considered by the examiner during examination, and the appropriate rejections made. A terminal disclaimer may be filed to overcome an obviousness type double patenting rejection. The terminal disclaimer is necessary in order to ensure common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

Situations yielding divisional reissues occur infrequently and usually involve only two such files. It should be noted, however, that in rare instances in the past, there have been more than two (and as many as five) divisional reissues of a patent.

CONTINUATION REISSUE APPLICATIONS

A continuation of a reissue is not ordinarily filed “for distinct and separate parts of the thing patented” as called for in the second paragraph of 35 U.S.C. 251. The decision of *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets 35 U.S.C. 251 to permit multiple reissue patents to issue even where the multiple reissue patents are not for “distinct and separate parts of the thing patented.” The court stated:

Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff’s continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor limits the statement in § 251[3] that the provisions of Title 5 apply to reissues.

111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, prosecution of a continuation of a reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. An appropriate amendment to the continuing data entries must be made to the first sentence of the specification, (see the discussion above under the heading “Divisional Reissue Applications”), and to the bibliographic data sheet reprint (for 09/ and later series) or to the front face of the reissue file wrapper (for 08/ and earlier series), for *both the parent and the continuation* reissue applications, so that the parent-continuation relationship of the reissue applications is specifically identified and notice is provided of both reissue applications.

Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent. Where the parent and the continuation reissue applications are

examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 - § 804.04 as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction. See the discussion above under the heading “Divisional Reissue Applications” as to how the Certificate of Correction is to be provided.

1452 Request for Continued Examination of Reissue Application

A request for continued examination (RCE) under 37 CFR 1.114 is available for a reissue application. Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was filed on or after June 8, 1995. This applies even where the application, which resulted in the original patent, was filed prior to June 8, 1995.

An RCE continues the prosecution of the existing reissue application and is not a filing of a new reissue application. Thus, the filing of an RCE will not be announced in the *Official Gazette*. Additionally, if a reissue application is merged with a reexamination proceeding (see MPEP § 1449.01), the filing of an RCE will not dissolve the merger, since the reissue application does not become abandoned.

1453 Amendments to Reissue Applications

37 CFR 1.121. *Manner of making amendments in application.*

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

37 CFR 1.173. Reissue specification, drawings, and amendments.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

The provisions of 37 CFR 1.173(b)-(g) and those of 37 CFR 1.121(h) apply to amendments in reissue applications. Any amendments submitted in a reissue application on or after March 1, 2001, must comply with 37 CFR 1.173(b) (see 37 CFR 1.121(h)).

Amendments filed prior to March 1, 2001, in compliance with former 37 CFR 1.121(b) (prior to the revision of the rule in the Patent Business Goals final rule) will be accepted. On or after March 1, 2001, amendments submitted in a reissue application must comply with 37 CFR 1.173(b). Accordingly, amendments submitted before March 1, 2001, under the prior practice need not, and should not, be re-submitted under the current practice. However, if such an amendment is *in fact re-submitted*, it will be entered, unless non-entry is directed or approved by the Supervisory Patent Examiner (SPE) or the Technology Center Special Program Examiner (SPRE).

Amendments submitted in a reissue application, including preliminary amendments (i.e., amendments filed as a separate paper to accompany the filing of a reissue application), must comply with the practice outlined below in this section; however, for examiner's amendments to the specification and claims, 37 CFR 1.121(g) provides certain exceptions to that practice in the interest of expediting prosecution. The exceptions set forth in 37 CFR 1.121(g) also apply in reissue applications.

Pursuant to 37 CFR 1.173(a), no amendment in a reissue application may enlarge the scope of the claims, unless "applied for within two years from the grant of the original patent." Further, the amendment may not introduce new matter. See MPEP § 1412.03

for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "markings:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "<U>" and end with "<U>" to properly identify the material being added.

THE SPECIFICATION

37 CFR 1.173(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

All amendments which include any deletions or additions must be made by submission of the entire text of each added or rewritten paragraph with markings (as defined above), except that an entire paragraph of specification text may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent, not in comparison to any prior amendment in the reissue application. Thus, all paragraphs which are newly *added* to the specification of the original patent must be submitted as completely underlined each time they are re-submitted in the reissue application.

THE CLAIMS

37 CFR 1.173(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings. 37 CFR 1.173(b)(2) requires that:

(A) For each claim that is being amended by the amendment being submitted (the current amendment),

the entire text of the claim must be presented with markings as defined above;

(B) For each new claim added to the reissue by the amendment being submitted (the current amendment), the entire text of the added claim must be presented completely underlined;

(C) A patent claim should be canceled by a direction to cancel that claim, there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

Original patent claims are never to be renumbered; see 37 CFR 1.173(e). A patent claim retains its number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

Also pursuant to 37 CFR 1.173(c), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for all changes made in the claim(s), whether insertions or deletions). The failure to submit an explanation will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

THE DRAWINGS

37 CFR 1.173(b)(3) relates to the manner of making amendments to the drawings.

37 CFR 1.173(a)(2), states that amendments to the original patent drawings are not permitted, and that any change to the drawings must be by way of 37 CFR 1.173(b)(3). 37 CFR 1.173(b)(3) requires that any change to the patent drawings be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new sheets of drawings in compliance with 37 CFR 1.84 including the approved