

MANUAL OF  
PATENT  
EXAMINING  
PROCEDURE



PROPERTY OF THE UNITED STATES GOVERNMENT

**U. S. DEPARTMENT OF COMMERCE**  
**Patent Office**  
**Washington**

**MANUAL OF PATENT EXAMINING PROCEDURE**  
**Second Edition**

**Revision Notice No. 3**

Transmitted herewith is one set of revised pages for the Manual of Patent Examining Procedure incorporating changes prescribed in examining procedure through June 1957. Substitute these pages for those now in your Manual having corresponding page numbers.

The following list of these replacement pages may be used as a check list for determining whether your set is complete. The parallel listing, which is provided to facilitate identification of new matter on these pages, includes only those sections in which significant subject matter changes have been made.

<u>Page No.</u>	<u>Section(s) Revised</u>	<u>Page No.</u>	<u>Section(s) Revised</u>
Title Page		46	
3	-	46-1	608.01(v)
4	-	47	608.02
5	-	48	608.02(a), 608.02(c)
6	-	49	-
9	-	50	-
10	201.11	51	608.02(u)
11	201.11	52	-
12	201.13	53	-
13	-	54	-
14	-	59	705.01(e)
15	-	60	-
16	-	61	-
17	-	62	-
18	202.02	63	-
18-1	203.08	64	-
21	-	65	706.03(s), 706.03(w)
22	402.03, 402.04, 402.04(a)	66	-
23	-	67	-
24	403.02, 406	68	-
25	-	69	-
26	-	70	-
27	410	71	-
29	-	72	707.05(a)
30	506	73	707.05(e)
35	604.01, 604.02, 604.03	74	-
36	-	81	710.05
37	605.04, 605.04(b)	82	-
38	605.04(b), 605.04(f)	83	-
39	605.04(f)	84	711.04(b)
40	-	85	712
45	608.01(p), 608.01(r)	86	-

<u>Page No.</u>	<u>Section(s) Revised</u>	<u>Page No.</u>	<u>Section(s) Revised</u>
87	-	186	1208, 1208.01
88	714.01(b)	187	1208.01
89	-	188	1214.01
90	714.07, 714.10	189	1214.01
91	-	190	1214.08
92	714.16	191	-
93	714.16(d), 714.16(e)	192	-
94	-	192-1	-
94-1	-	193	-
97	715.03	194	1302.04
98	-	195	-
103	-	196	1302.09
104	802.01	197	1302.12
105	802.01, 802.02	198	1303
106	-	199	1309.01
107	806.04(b)	200	-
108	806.04(c)	207	1503, 1503.01
108-1	806.04(h)	208	-
108-2	-	211	1603, 1604
111	809.02(c)	212	1605
112	-	221	-
112-1	-	222	-
119	821.01	223	-
120	-	224	-
120-1	-	225	-
123	901.05(b)	235	-
124	901.06(b)	236	-
124-1	-	237	-
127	-	238	-
128	903.03	241	-
129	-	242	-
130	903.07	251	-
135	905.03	252	-
148	1101.01(j)	253	-
153	1101.02(f)	254	-
154	-	255	-
154-1	-	256	-
174	1112.01, 1112.02	257	-
185	1208	258	-

**DEPARTMENT OF COMMERCE  
UNITED STATES PATENT OFFICE  
WASHINGTON**

**MANUAL OF PATENT EXAMINING PROCEDURE  
(Second Edition)**

**NOTES CONCERNING REVISION NO. 3**

Sections 714.13 and 1207 reflect the following new procedure:

Where the Examiner has determined that a finally rejected or appealed application is allowable in view of an amendment, but the immediate issuance of the formal Notice of Allowance may be delayed for some time on the desk of the Docket Clerk or Typist, and the time for filing an appeal or brief is two weeks or less, the Examiner should write a letter to applicant indicating the allowability of the application. Suggested language is given in 1207.

Other new procedures are found in:

- 201.11 Stating relationship of copending applications
- 201.11 Copending applications not entitled to prior filing date
- 402.03 Substitute powers of attorney
- 402.04(a) Change of firm name
- 608.01(p) Copending application to complete disclosure
- 608.01(v) Trademarks in specifications
- 608.02 Applications filed without drawings
- 712 Delayed acceptance of final fee
- 715.03 Rule 131 affidavit-chemical case
- 802.01 "Independent", "Distinct" inventions
- 809.02(c) Species claims not in conformity with Rule 141
- 901.05(b) German printed (allowed) applications
- 1208 Examiner's Answer on appeal
- 1208.01 Examiner's Answer - new ground of rejection
- 1214.01 Shortened period for response in Board's decision
- 1214.06 Rule 196(b) rejections
- 1604 Newly found plant

MANUAL OF  
**PATENT  
EXAMINING  
PROCEDURE**

Second Edition, November 1953



PATENT OFFICE • U. S. DEPARTMENT OF COMMERCE

First Edition, November 1949  
Revision 1, November 1950  
Revision 2, December 1951  
Revision 3, May 1952  
Second Edition, November 1953  
Revision 1, April 1955  
Revision 2, June 1956  
Revision 3, June 1957

---

For sale by the Superintendent of Documents, U. S. Government Printing Office, Washington 25, D. C.  
Price \$6.25 domestic, \$7.50 foreign, including supplements

# Foreword

This Manual is published to provide examiners in the Patent Office with a reference work on the practice and procedure within the Office as it relates to their duties and operations. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and generally outlines the current procedure which the examiners are required or authorized to follow in appropriate cases in the normal examination of applications.

Examiners will continue to be governed as in the past by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner, the Executive Examiner or the Supervisory Examiners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated and identified as such. Some Orders and Notices have been revised to coordinate them with changes in the patent laws and in the Rules of Practice, and are included in their revised form. Orders and Notices, or portions thereof, relating to the examiners' duties and functions included in this Manual which have been omitted or not incorporated in the text may be considered obsolete.

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

ROBERT C. WATSON,  
*Commissioner.*

NOVEMBER 30, 1953.

## Acknowledgments

Preparation of the text of the Second Edition of the Manual was directed by E. A. Faller, Secretary, Committee on Practice and Procedure, under the supervision of the Executive Examiner.

The following members of the Committee on Practice and Procedure took an active part in this work:

E. A. Faller, P. J. Federico, M. H. Friedman, H. Magil, E. L. Reynolds, M. C. Rosa, A. Shapiro, I. G. Stone, B. Yung Kwai.

They were assisted by the following members of the Examining Corps:

D. D. Andrews, M. F. Bailey, H. B. Freehof, C. F. Gareau, A. J. Goldberg, R. Leibowitz, R. A. O'Leary.

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

Commissioner of Patents,  
Washington 25, D. C.,

and marked for the attention of the Committee on Practice and Procedure.

# Numbering System

The system of numbering used in this Manual was selected to indicate to the reader topical indentations in the tables of contents. It may be understood by considering specific examples. Thus, the symbol "1100" refers to Chapter 1100 as a whole; the symbol "1101" refers to a subdivision indented under 1100; the symbol "1101.01" refers to a further subdivision indented under 1101; and "1101.01 (a)" refers to a still further indentation under 1101.01. Thus Chapter 1100 is numbered as follows:

## Chapter 1100 Interference

- 1101 Preliminaries to an Interference
  - 1101.01 Between Applications
    - 1101.01 (a) In Different Divisions
    - 1101.01 (b) Common Ownership
    - 1101.01 (c) The Interference Search
    - 1101.01 (d) Correspondence Under Rule 202
    - 1101.01 (e) How Conducted

Indentations beyond the third indentation are ignored in the assignment of a symbol. Fourth and further indentations are given the same type of symbol as a third indentation. Thus in the above example the section entitled "How Conducted" has the same type of symbol as the section entitled "Correspondence Under Rule 202." Because a fourth indent in the table of contents does not show up in the numbering system, those sections which are a fourth indent in the table of contents are given a title in the text which includes the title of the section under which they are indented. Thus, in the text, the heading for Sec. 1101.01 (e) reads: "Correspondence Under Rule 202, How Conducted."

# Contents

	Page
Introduction . . . . .	1
Chapter 100 Secrecy and Access . . . . .	3
200 Types, Cross-noting, and Status of Applications . . . . .	7
300 Ownership and Assignment . . . . .	19
400 Representative of Inventor or Owner. . . . .	21
500 Receipt and Handling of Mail and Papers . . . . .	29
600 Parts, Form and Content of Application . . . . .	31
700 Examination of Applications . . . . .	55
800 Restriction; Double Patenting . . . . .	103
900 Prior Art, Classification, Search . . . . .	121
1000 Petitions; Cases Submitted to Commissioner and Super- visory Examiners . . . . .	137
1100 Interference. . . . .	141
1200 Appeal . . . . .	183
1300 Allowance and Issue . . . . .	193
1400 Correction of Patent . . . . .	201
1500 Design Patents . . . . .	207
1600 Plant Patents . . . . .	211
1700 Miscellaneous . . . . .	215
Appendix I Table of Orders and Notices . . . . .	217
Appendix II List of Decisions Cited . . . . .	223
Index . . . . .	227

# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

Pursuant to the foregoing provision of the Constitution, Congress has passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office. Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts. These statutes, as well as old Title 35 of the United States Code, were compiled and reprinted several times prior to January 1, 1953, in a pamphlet entitled "Patent Laws".

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 95 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the new patent code the citation is given, for example, as, 35 U. S. C. 31. The current edition of the pamphlet "Patent Laws" reprints the patent code and some additional statutes; following each section of the patent code, the citation of the old statute corresponding to that section is given in parentheses, and the pamphlet also contains tables of the old section numbers with the corresponding new sections.

## Rules of Practice

One of the sections of the patent statute, namely, 35 U. S. C. 6, authorizes the Commis-

sioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. These regulations are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases". The Rules of Practice have a long history, going back to pamphlets of general information to the public, first issued in 1836. The content has been determined by history, tradition and other factors. Primarily the function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. But the Patent Office Rules of Practice have always additionally included, as numbered rules, informational material, copies of sections of the patent statutes, purely internal procedure, and the like. It goes without saying that the Rules of Practice govern the Examiners, as well as applicants and their attorneys.

## Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by the Supervisory Examiners under authority of the Commissioner. Orders and Notices have served various purposes including directions to the examiners giving them instructions, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

## Decisions

In addition to the statutory regulations, the actions taken by the Examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Those dissatisfied with an Examiner's action may have it reviewed. In general, it may be stated that from that portion of the Examiner's action pertaining to objections on formal matters, a petition for review may be taken to the

MANUAL OF PATENT EXAMINING PROCEDURE

Commissioner of Patents (1002) and from that portion of the Examiner's action pertaining to the rejection of claims on the merits, an appeal may be taken to the Board of Appeals (1201). The distinction is set forth in Rules 181 and 191. The decision of the Commissioner on for-

mal matters is final but the decision of the Board of Appeals on questions passed on by it may be carried to the courts. See 1216. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in 707.06.