

MANUAL OF
PATENT
EXAMINING
PROCEDURE

ORIGINAL EDITION



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MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

Instructions regarding Revision No. 26

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

Change Notice 17-2, relating to the Trial Multiple Dependent Claim Practice, should be retained until prosecution of all applications under the program is concluded. The termination of this program was announced in the Notice of June 9, 1969; 864 O.G. 323. All other Change Notices up to and including 26-1 have been incorporated into the Manual.

The notation "R-26" in the attached pages appears either at the title or at the end of a section that has been altered in any way.

Page 186.1 issued in Revision No. 25 was erroneously numbered 168.1.

Louis O. Maassel
Editor, Manual of Patent
Examining Procedure

Particular attention is called to the following sections:

The checklist of pages has been updated.

- 201.06 Incorporates Notice of June 5, 1970 (875 O.G. 702) on notation of divisional application papers.
- 506 Revised incomplete and informal applications procedure.
- 608.01(p) Incorporation by reference portion revised to indicate that if a soft copy is furnished, no affidavit is required. ✓
- 708.02 Entire petition to make special guidelines revised.
- 710.02(e) Indicates that Primary Examiners may grant first requests for extension of time up to the statutory limit.

(Over)

- 710.05 Sets forth new holidays, effective January 1, 1971.
- 713.01 States that Examiners are to avoid interruptions during interviews.
- 821.03 Indicates that an amendment canceling all claims to the elected species and presenting only claims drawn to the non-elected species is not entered.
- 903.03 Outlines new foreign patent classification procedure.
- 903.08(a) Revised application transfer procedure details & (d) included.
- 1208 Confidential memoranda to Board of Appeals practice ended. Incorporates Change Notice 26-1.
- 1706 Acknowledgment of Disclosure Document procedure included.
- Appendix Updated
I & II

List of replacement pages for Revision 26:

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*Added sheet

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.

Change Notice

Reference: MPEP 608.01(n)

SERIES NO. 17-2
(Follows Change 17-1)

June 4, 1968

TRIAL MULTIPLE DEPENDENT CLAIM PRACTICE

For the trial period running from July 1, 1968 through December 31, 1968, all applications and amendments to applications filed in the Patent Office will be permitted to include multiple dependent claims which refer back to any of the preceding claims in the alternative whether independent or dependent. In this manner a claim may have a single number but would effectively be considered and treated as a plurality of claims. Entry into this program will require (1) the filing of a written request in which the applicant agrees to abide by the conditions of the program, and (2) the filing of appropriate fees and a showing of the fee calculation. Although the trial period terminates December 31, 1968, the prosecution of all applications placed in this program will continue under the program guidelines.

A claim dependent upon any of a plurality of preceding claims will be considered in acceptable form and entered provided it is otherwise acceptable and does not (1) cross statutory classes with any of its parent claims, or (2) depend from any other multiple dependent claim, or (3) refer back to preceding claims in the conjunctive rather than the disjunctive form (e.g., "The tool as defined in any one of claims 1, 2, and 4 . . ." is acceptable, but "The tool as defined in claims 1 and 2 . . ." is not acceptable. Likewise, "The tool as defined in claims 1, 2, or 4 . . ." is acceptable, whereas "The tool as defined in claims 1, 2 and/or 4 . . ." is not acceptable). Should any dependent claim include a claim association that violates any of the above prohibitions the claim will be rejected as indefinite for failure to comply with 35 U.S.C. 112 and will not be further treated with regard to any other claim association. Also, multiple dependent claims will not be considered for entry after final rejection. Further, during this trial period, for the applications involved in this program the total numbered claims may not exceed ten. Non-compliance with this condition will result in applicant being given one month to reduce the total numbered claims to ten. In newly filed cases, the failure to comply within the one month period will result in loss of filing date. In all other cases the entire amendment will not be entered in the absence of compliance with this requirement.

It is suggested that the claims be arranged in order of narrowing scope whereby the first claim presented is the broadest. Claims dependent upon the broad claim should come next, followed by claims which are dependent upon any of the plurality of preceding claims.

Practice and Rejections

When acting on a multiple dependent claim, the examiner will consider the patentability of the various claim associations encompassed by said claim and apply any pertinent prior art in the usual manner. Each of these associations should be compared with the prior art, exactly as if it were presented as an independent claim. If a claim having multiple dependency should include both patentable and unpatentable claim associations, the Examiner will identify each of the patentable claim associations and identify and specifically reject each of the unpatentable claim associations. However, mere failure to reject a claim association does not give rise to a presumption of allowability.

For fee purposes every claim which refers to any of the preceding claims will be considered effectively as a dependent claim for each association of claims that it represents, thereby effectively increasing the number of claims in the case. Therefore, in these cases the additional fees required for claims in excess of ten will be two dollars (\$2.00) times the total effective number of claims in excess of ten. This fee is based on the fact that such a claim is, in substance and so far as the work of examination is concerned, equivalent to a number of dependent claims each based on a single preceding claim.

(over)

In applications not under this program but having multiple dependent claims, it will be assumed that applicant intends these claims as effectively only a single claim. Accordingly, such claims will be considered alternative and therefore indefinite under 35 U. S. C. 112.

Rule 75(c) is hereby suspended for the duration of the trial period in those cases presenting multiple dependent claims under this program insofar as conflict exists between the requisites of the rule and the proposed practice.

Richard A. Wahl
Assistant Commissioner

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The Patent Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

Correspondence relating to any of the above items should be sent to the Superintendent of Documents at the following address:

**Superintendent of Documents
Mail List Section
P.O. Box 1533
Washington, D.C. 20013**

Orders for individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

**Commissioner of Patents
Washington, D.C. 20231
Attn.: Document Services Branch**

The cost per page will be 30¢ (see rules 13(a), 21(b), and 21(t) Rules of Practice).

Charges may be made to deposit accounts if the requestor is an account holder in good standing at the time the request is received. Checks or money orders should be payable to the Commissioner of Patents. Requests must identify the specific pages required and the number of copies of each page.

Employees of the Patent Office should direct their order for the Manual, replacement pages, notices, and revisions to the Scientific Library.

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Revision 20, April 1969

Revision 21, July 1969

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Revision 23, January 1970

Revision 24, April 1970

Revision 25, July 1970

Revision 26, October 1970

Foreword

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

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

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

EDWARD J. BRENNER,
Commissioner.

Acknowledgments

Preparation of the text of the Third Edition was directed by Ernest A. Faller, Editor, under the supervision of Manuel C. Rosa, Director, Patent Examining Operation.

The Supervisory Examiners, Isaac G. Stone, Norman H. Evans, Burnham Yung Kwai, Sam Spintman, John S. Hull, Thomas F. Murphy, Harvey E. Kauffman and George A. Gorecki took an active part in this work, especially in rewriting Chapter 700.

Others who assisted were Pasquale J. Federico, Hyman B. Freehof, Examiners-in-Chief; Joseph Schimmel, Deputy Solicitor; Samuel Levin, LaVerne L. Williams, Interference Examiners; and Florence A. Hoffman, Division Clerk.

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

Commissioner of Patents,
Washington, D.C. 20231

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Introduction

Constitutional Basis

The Constitution of the United States provides:

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

Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent 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.

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

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner 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 rules are set forth in a Patent Office booklet entitled "Rules of Practice of the United States Patent Office in Patent Cases" (available from the Superintendent of Documents for 55 cents). These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. 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. 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 other Office Officials under authority of the Commissioner. Orders and Notices have served various purposes including directions to the Examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

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

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objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the Examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board

of Appeals (see § 1201). The distinction is set forth in Rules 181 and 191. In citing decisions as authority for his actions, the Examiner should cite the decision in the manner set forth in § 707.06.