

# **Manual of PATENT EXAMINING PROCEDURE**

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**U.S. DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Rev. 2, July 1996

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## Foreword

This Manual is published to provide Patent and Trademark Office patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the Patent and Trademark Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The Manual does not have the force of law or the force of the Patent Rules of Practice in Title 37, Code of Federal Regulations.

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

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

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

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

Commissioner of Patents and Trademarks  
Editor, MPEP  
Washington, D.C. 20231

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# Introduction

## Constitutional Basis

The Constitution of the United States provides:

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

## Statutes

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

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

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into substantially its present form. The patent law is Title 35 of the United States Code which governs all cases in the Patent and Trademark Office. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31.

### *35 U.S.C. 1. Establishment.*

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

## Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents and Trademarks, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

### *37 CFR 1.351. Amendments to rules will be published.*

All amendments in this part will be published in the *Official Gazette* and in the *Federal Register*.

### *35 CFR 1.352. Publication of notice of proposed amendments.*

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

considered before adoption of the proposed amendments which may be modified in the light thereof.

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

These regulations or rules and amendments thereto are published in the *Federal Register* and in the *Official Gazette*. 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, called sections, are numbered with the Part number and a decimal point prefixed to the rule number. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules as well as trademark rules and copyright rules. Persons desiring a copy of the patent rules should order a complete copy of "Title 37, Code of Federal Regulations" from the Superintendent of Documents.

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

## Commissioner's Orders and Notices

From time to time, the Commissioner of Patents and Trademarks has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent and Trademark Office. Notices and circulars of 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 objections on formal matters may be reviewed by petition to the Commissioner of Patents and Trademarks (see MPEP § 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 Patent Appeals and Interferences (see § 1201). The distinction is set forth in 37 CFR 1.181 and 1.191. In citing decisions as

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authority for his or her actions, the examiner should cite the decision in the manner set forth in MPEP § 707.06.

### Publications Available from Superintendent of Documents

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

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

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

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

*Manual of Classification.* A looseleaf volume listing the numbers and descriptive titles of the more than 300 classes and 95,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time.

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

*Manual of Patent Examining Procedure.* A looseleaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent and Trademark Office's Examining Corps including statutes, rules, treaties, etc. Subscription service includes basic manual, revisions, and change notices.

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

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

*Title 37—Code of Federal Regulations.* Compilation of the rules of practice of the U. S. Patent and Trademark Office.

### Publications Available From the Patent and Trademark Office

Orders should be addressed to Patent and Trademark Office, Washington, D.C. 20231. Remittances should be made payable to Commissioner of Patents and Trademarks. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of Patent and Trademark Office fees.

*Q & A About Patents.* Brief nontechnical answers to questions most frequently asked about Patents.

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

*Patents.* Copies of the specification and drawings of all patents are available at one dollar and fifty cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

*Classification Definitions.* Contain the changes in classification of patents as well as definitions of new and revised classes and subclasses. Price is based upon size of publication.

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

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## 601 Content of Provisional and Nonprovisional Applications [R-2]

### 35 U.S.C. 111 Application

#### (a) IN GENERAL.—

(1) **WRITTEN APPLICATION.**—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner.

#### (2) **CONTENTS.**—Such application shall include—

- (A) a specification as prescribed by section 112 of this title;
- (B) a drawing as prescribed by section 113 of this title; and
- (C) an oath by the applicant as prescribed by section 115 of this title.

(3) **FEE AND OATH.**—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.

(4) **FAILURE TO SUBMIT.**—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

#### (b) **PROVISIONAL APPLICATION.**—

(1) **AUTHORIZATION.**—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include—

- (A) a specification as prescribed by the first paragraph of section 112 of this title; and
- (B) a drawing as prescribed by section 113 of this title.

(2) **CLAIM.**—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) **FEE.**—(A) The application must be accompanied by the fee required by law.

- (B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.
- (C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned,

unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee was unavoidable or unintentional.

(4) **FILING DATE.**—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) **ABANDONMENT.**—The provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival thereafter.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Commissioner, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) **\* >APPLICABLE< PROVISIONS.**—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

### 37 CFR 1.51. General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

(1) A complete application filed under § 1.53(b)(1) comprises:

(i) A specification, including a claim or claims, see §§ 1.71 to 1.77;

(ii) An oath or declaration, see §§ 1.63 and 1.68;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

(iv) The prescribed filing fee, see § 1.16.

(2) A complete provisional application filed under § 1.53(b)(2) comprises:

(i) A cover sheet identifying:

(A) The application as a provisional application,

(B) The name or names of the inventor or inventors, (see § 1.41),

(C) The residence of each named inventor,

(D) The title of the invention,

(E) The name and registration number of the attorney or agent (if applicable),

(F) The docket number used by the person filing the application to identify the application (if applicable),

(G) The correspondence address, and

(I) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(ii) A specification as prescribed by 35 U.S.C. 112, first paragraph, see § 1.71;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

(iv) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §§ 1.97 and 1.98. No information disclosure statement may be filed in a provisional application.

(c) Applicants may desire and are permitted to file with, or in, the application or authorization to charge, at any time during the pendency

# Pages Omitted For Relevance

oath or declaration filed therewith. Once an oath or declaration is submitted in an application filed under 37 CFR 1.53 identifying the papers which the inventor(s) has "reviewed and understands" as required by 37 CFR 1.63, the original disclosure of the application is defined and cannot be altered merely by filing of a subsequent oath or declaration referring to different papers. If the application is filed without an executed oath or declaration pursuant to 37 CFR 1.53(b), the original oath or declaration submitted later than the filing date must refer to the preliminary amendment filed along with the application in order to comply with 37 CFR 1.63.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application under 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed under 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

#### 608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancelation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

#### 608.05 Deposit of Computer Program Listings

##### 37 CFR 1.96. Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program

listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

(a) *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as camera ready copy when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a microfiche appendix. The microfiche appendix will not be part of the printed patent. Reference in the application to the microfiche appendix should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such an application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National (ANSI) or National Micrographics Association (NMA) Standards (Note: As new editions of these standards are published, the latest shall apply):

ANSI PH 1.28-1976-Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41-1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANSI/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9-1975) Microfiche of Documents.

## MANUAL OF PATENT EXAMINING PROCEDURE

### 608.05

ANSI PH 2.19 (1959)—Diffuse Transmission Density.  
except as modified or clarified below:

(i) Either Computer—Output—Microfilm (COM) output or copies of photographed paper copy may be submitted. In the former case, NMA standards MS1 and MS2 apply; in the latter case, standard MS5 applies.

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Film submitted shall have a thickness of at least .005 inches (0.13 mm) and not more than .009 inches (0.23 mm) for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left—most 1/3 (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply serial number and filing date thereto in an eye—readable form. The middle portion of the header shall be used by applicant to apply an eye—readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right—hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Micro—copy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA—MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right—reading) of each microfiche. See NMA—MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative—appearing COM—generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

Special procedures for presentation of computer program listings in the form of microfiche in U.S. national patent applications are set forth in 37 CFR 1.96. Use of microfiche is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred pages in length. By filing and publishing such computer program listings on microfiche rather than on paper, substantial cost savings can result to the applicants, the public, and the Patent and Trademark Office.

### BACKGROUND

A computer program listing, as used in these rules, means the printout that lists, in proper sequence, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine—dependent (object or source) programming language which will cause a computer to perform a desired task, such as solving a problem, regulating the flow of work in computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while computer program listing may appear either directly or as a microfiche as appendix to the specification and be incorporated into the specification by reference.

### DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The provisions of 37 CFR 1.52 and 1.84 for submitting specifications and drawings on paper have been found suitable for most patent applications. However, when lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome.

The cost of printing long computer programs in patent documents is also very expensive to the Patent and Trademark Office.

In the past, all disclosures forming part of a patent application were presented on paper with the exception of microorganisms. Under 37 CFR 1.96, several different methods for submitting computer program listings, including the use of microfiche, are set forth.

Relatively short computer program listings (10 pages or less) must be submitted on paper and will be printed as part of the patent. If the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred.

Copies of publicly available computer program listings are available from the Patent and Trademark Office on paper and on microfiche at the cost set forth in 37 CFR 1.19(a)(5) and (6).

#### OTHER INFORMATION

The micrographic standards referred to in 37 CFR 1.96(b)(2) may be obtained from either the National Micrographic Association, 8719 Colesville Road, Silver Spring, Maryland, 20910 or the American National Standards Institute, 1430 Broadway, New York, New York 10018.

The effect of 37 CFR 1.96 is that if a computer program listing (printout) is 11 or more pages long, the applicant may submit such listing in the form of microfiche. Relatively short computer program listings (10 pages or fewer) must be submitted on paper and will be printed as part of the patent, as in the past. When the computer program listing is 11 or more pages in length, it may be submitted on either paper or microfiche, although microfiche is preferred. A microfiche filed with a patent application will be referred to as a "Microfiche Appendix," and will be identified as such on the front page of the patent but will not be part of the printed patent. "Microfiche Appendix," denotes the total microfiche, whether only one or two or more. One microfiche is equivalent to a maximum of either 63 (9x7) or 98 (14x7) frames (pages), or less.

The face of the file jacket will bear a label to denote that a Microfiche Appendix is included in the application. A statement must be included in the specification to the effect that a microfiche appendix is included in the application. The specification entry must appear at the beginning of the specification immediately following any

cross-reference to related applications, 37 CFR 1.77(c)(2). The patent front page and the *Official Gazette* entry will both contain information as to the number of microfiche and frames of computer program listings appearing in the microfiche appendix.

When an application containing microfiche is received in the Correspondence and Mail Division, a special pocket will be affixed to the center section of the inside of the file wrapper underneath all papers, and the microfiche inserted therein. The application file will then proceed on its normal course, and when it reaches the Application Branch, a label which sticks up above the file wrapper will be placed at the center section of the face of the wrapper. When the application file reaches the Micrographics Division, the Microfiche Appendix label will be placed on the face of the file wrapper. When the Allowed Files and Assembly Branch of the Office of Publications receives the application file, the person placing the patent number on the face of the file, upon seeing the Microfiche Appendix label, will give the file to the Supervisor who will call Micrographics Division and give the serial number and patent number, and request copies of the microfiche. Micrographics Division personnel will then put the patent number on the microfiche(s), making certain each microfiche is the most recent, and numbering each correctly; e.g., 1 of 1, 1 of 2, etc. Upon completion, two copies will be produced and provided to Allowed and Assembly Branch Files — one for the grant head and one for the file wrapper.

At the time of assembly, the Microfiche Appendix will be placed inside the grant head behind the patent grant for eyeletting, ribboning, and mailing to the patentee/attorney. During the signing of the grant heads by the Attesting Officer, the patent will be checked to assure proper assembly prior to mailing.

#### 609 Information Disclosure Statement [R-2]

##### 37 CFR 1.97. Filing of information disclosure statement.

(a) In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

(1) A final action under § 1.113 or

(2) A notice of allowance under § 1.311, whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (e) of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either:

(1) A final action under § 1.113 or

(2) A notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

(i) A certification as specified in paragraph (e) of this section,

(ii) A petition requesting consideration of the information disclosure statement, and

(iii) The petition fee set forth in § 1.17(i)(1).

(e) A certification under this section must state either:

(1) That each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual designated in § 1.56(c) more than three months prior to the filing of the statement.

(f) No extensions of time for filing an information disclosure statement are permitted under § 1.136. If a bona fide attempt is made to comply with § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(h).

(i) Information disclosure statements, filed before the grant of a patent, which do not comply with this section and § 1.98 will be placed in the file, but will not be considered by the Office.

### 37 CFR 1.98. Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) A list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. and foreign patent;

(ii) Each publication or that portion which caused it to be listed; and

(iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise

explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. Each foreign patent or published foreign patent application shall be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication shall be identified by author (if any), title, relevant pages of the publication, date and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. If a written English-language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in § 1.56(c), a copy of the translation shall accompany the statement.

(d) A copy of any patent, publication or other information listed in an information disclosure statement is not required to be provided if it was previously cited by or submitted to the Office in a prior application, provided that the prior application is properly identified in the statement and relied upon for an earlier filing date under 35 U.S.C. 120.

Information Disclosure Statements are not permitted in provisional applications filed under 35 U.S.C. 111(b). Since no substantive examination is given in provisional applications, a disclosure of information is unnecessary. Any such statement filed in a provisional application will be returned or destroyed at the option of the Office. In applications filed under 35 U.S.C. 111(a), applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in 37 CFR 1.56. These individuals also may want the Office to consider information for a variety of other reasons; e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantively involved with the preparation or prosecution of a patent application.

An information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 1.98 provides the procedure available to an applicant to submit information to the Office so that the information will be considered by the examiner assigned to the application.

## Appendix R – Patent Rules

### Title 37 – Code of Federal Regulations Patents, Trademarks, and Copyrights

#### CHAPTER 1—PATENT AND TRADEMARK OFFICE, DEPARTMENT OF COMMERCE

##### SUBCHAPTER A – GENERAL

##### *PATENTS*

###### *Part*

- 1 Rules of practice in patent cases
- 3 Assignment, Recording, and Rights of Assignee
- 5 Secrecy of certain inventions and licenses to export and file applications in foreign countries
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- 10 Representation of others before the Patent and Trademark Office
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##### SUBCHAPTER C – PROTECTION OF FOREIGN MASK WORKS

- 150 Requests for Presidential proclamations pursuant to 17 U.S.C. 902(a)(2)

##### SUBCHAPTER A – GENERAL

##### **PART 1 – RULES OF PRACTICE IN PATENT CASES**

##### **Subpart A – General Provisions**

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###### *Sec*

- 1.1 All communications to be addressed to the Commissioner of Patents and Trademarks.
- 1.2 Business to be transacted in writing.
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- 1.4 Nature of correspondence and signature requirements.
- 1.5 Identification of application, patent, or registration.
- 1.6 Receipt of correspondence.
- 1.7 Times for taking action; expiration on Saturday, Sunday, or Federal holiday.
- 1.8 Certificate of mailing or transmission.
- 1.9 Definitions.
- 1.10 Filing of papers and fees by "Express Mail" with certificate.
- 1.11 Files open to the public.
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- 1.15 Requests for identifiable records.
- 1.16 National application filing fees.
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- 1.19 Document supply fees.
- 1.20 Post-issuance fees.
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- 1.22 Fees payable in advance.
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- 1.24 Coupons.
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- 1.27 Statement of status as small entity.
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##### **Subpart B – National Processing Provisions**

##### **PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT**

- 1.31 Applicants may be represented by a registered attorney or agent.
- 1.32 [Reserved]
- 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.
- 1.34 Recognition for representation.
- 1.36 Revocation of power of attorney or authorization; withdrawal of attorney or agent.

##### **WHO MAY APPLY FOR A PATENT**

- 1.41 Applicant for patent.
- 1.42 When the inventor is dead.
- 1.43 When the inventor is insane or legally incapacitated.
- 1.44 Proof of authority.
- 1.45 Joint inventors.
- 1.46 Assigned inventions and patents.
- 1.47 Filing when an inventor refuses to sign or cannot be reached.
- 1.48 Correction of inventorship.

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- 1.52 Language, paper, writing, margins.
- 1.53 Application number, filing date, and completion of application.
- 1.54 Parts of application to be filed together; filing receipt.
- 1.55 Claim for foreign priority.
- 1.56 Duty to disclose information material to patentability.
- 1.57 [Reserved]
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- 1.60 Continuation or divisional application for invention disclosed in a prior nonprovisional application.
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- 1.64 Person making oath or declaration.
- 1.66 Officers authorized to administer oaths.
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- 1.73 Summary of the invention.
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- 1.75 Claim(s).
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- 1.84 Standards for drawings.
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- 1.106 Rejection of claims.
- 1.107 Citation of references.
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- 1.112 Reconsideration.
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- 1.116 Amendments after final action.
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- 1.118 Amendment of disclosure.
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- 1.121 Manner of making amendments.
- 1.122 Entry and consideration of amendments.
- 1.123 Amendments to the drawing.
- 1.124 Amendment of amendments.
- 1.125 Substitute specification.
- 1.126 Numbering of claims.
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- 1.129 Transitional procedures for limited examination after final rejection and restriction practice.

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- 1.133 Interviews.

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- 1.137 Revival of abandoned application.
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- 1.141 Different inventions in one national application.
- 1.142 Requirement for restriction.
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- 1.311 Notice of Allowance.
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- 1.321 Statutory disclaimers, including terminal disclaimers.

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- 1.322 Certificate of correction of Office mistake.
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- 1.332 [Reserved]
- 1.333 [Reserved]
- 1.334 [Reserved]
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- 1.611 Declaration of interference.
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- 1.674 Persons before whom depositions may be taken.
- 1.675 Examination of witness, reading and signing transcript of deposition.
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- 1.710 Patents subject to extension of the patent term.
- 1.720 Conditions for extension of patent term.
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- 1.775 Calculation of patent term extension for a human drug, antibiotic drug or human biological product.
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- 1.780 Certificate of extension of patent term.
- 1.785 Multiple applications for extension of term of the same patent or of different patents for the same regulatory review period for a product.

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- 1.803 Acceptable depository.
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- 1.821 Nucleotide and/or amino acid sequence disclosures in patent applications.
- 1.822 Symbols and format to be used for nucleotide and/or amino acid sequence data.
- 1.823 Requirements for nucleotide and/or amino acid sequences as part of the application papers.
- 1.824 Form and format for nucleotide and/or amino acid sequence submissions in computer readable form.
- 1.825 Amendments to or replacement of sequence listing and computer readable copy thereof.

Appendix A – Sample Sequence Listing.

Appendix B – Headings for Information Items in § 1.823.

### Subpart A – General Provisions

#### GENERAL INFORMATION AND CORRESPONDENCE

#### § 1.1 All communications to be addressed to the Commissioner of Patents and Trademarks.

(a) All letters and other communications intended for the Patent and Trademark Office must be addressed to “Commissioner of Patents and Trademarks,” Washington, D.C. 20231. When appropriate, a letter should also be marked for the attention of a particular officer or individual.

(b) Letters and other communications relating to international applications during the international stage and prior to the assignment of a national serial number should be additionally marked “Box PCT.”

(c) Requests for reexamination should be additionally marked “Box Reexam.”

(d) Payments of maintenance fees in patents and other communications relating thereto should be additionally marked “Box M. Fee.”

(e) Communications relating to interferences and applications or patents involved in an interference should be additionally marked “BOX INTERFERENCE.”

(f) All applications for extension of patent term and any communications relating thereto intended for the Patent and Trademark Office should be additionally marked “Box Patent Ext.” When appropriate, the communication should also be marked to the attention of a particular individual, as where a decision has been rendered.

(g) All communications relating to pending litigation which are required by the Federal Rules of Civil or Appellate Procedure or by a rule or order of a court to be served on the Solicitor shall be hand-delivered to the Office of the Solicitor or shall be mailed to: Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215 or such other address as may be designated in writing in the litigation. All other communications to the Office of the Solicitor should be addressed to: Box 8, Commissioner of Patents and Trademarks, Washington, D.C. 20231. Any communication which does not involve pending litigation which is received at P.O. Box 15667 will not be filed in the Office but will be returned. See §§ 1.302(c) and 2.145(b)(3) for filing notice of appeal to the U.S. Court of Appeals for the Federal Circuit.

(h) In applications under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), all statements of use filed under section 1(d) of the Act, and requests for extensions of time therefor, should be additionally marked “Box ITU.”

(i) The filing of all provisional applications and any communications relating thereto should be additionally marked “Box Provisional Patent Application.”

NOTE. — Sections 1.1 to 1.26 are applicable to trademark cases as well as to national and international patent cases except for provisions specifically directed to patent cases. See § 1.9 for definitions of “national application” and “international application.”

[46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (e), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985, para. (f) added, 52 FR 9394, Mar. 24, 1987; para. (g) added, 53 FR 16413, May 9, 1988;

# Pages Omitted for Relevance

## PATENT RULES

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(See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

[24 FR 10332, Dec. 22, 1959; 31 FR 12923, Oct. 4, 1966; 36 FR 9775, May 28, 1971; 43 FR 20464, May 11, 1978; 45 FR 73657, Nov. 6, 1980; paras. (a), (b), (i), (j), and (l) amended, paras. (n), (o), and (p) added, 53 FR 47809, Nov. 28, 1988, effective Jan. 1, 1989; revised, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

#### § 1.85 Corrections to drawings.

(a) The requirements of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for reproduction, may be admitted for examination but in such case a new drawing must be furnished.

(b) The Patent and Trademark Office will not release drawings in applications having a filing date after January 1, 1989, or any drawings from any applications after January 1, 1991, for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) When corrected drawings are required to be submitted at the time of allowance, the applicant is required to submit acceptable drawings within three months from the mailing of the "Notice of Allowability." Within that three-month period, two weeks should be allowed for review of the drawings by the Drafting Branch. If the Office finds that correction is necessary, the applicant must submit a new corrected drawing to the Office within the original three-month period to avoid the necessity of obtaining an extension of time and paying the extension fee. Therefore, the applicant should file corrected drawings as soon as possible following the receipt of the Notice of Allowability. The provisions with respect to obtaining an extension of time relates only to the late filing of corrected drawings. The time limit for payment of the issue fee is a fixed three-month period which cannot be extended as set forth in 35 U.S.C. 151.

[47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989]

#### § 1.88 [Removed and Reserved]

[Deleted, 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

### MODELS, EXHIBITS, SPECIMENS

#### § 1.91 Models not generally required as part of application or patent.

Models were once required in all cases admitting a model, as a part of the application, and these models became

a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

#### § 1.92 Model or exhibit may be required.

A model, working model, or other physical exhibit may be required if deemed necessary for any purpose on examination of the application.

#### § 1.93 Specimens.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

#### § 1.94 Return of models, exhibits or specimens.

Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it is deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

#### § 1.95 Copies of exhibits.

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

#### § 1.96 Submission of computer program listings.

Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of these rules is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications in the following forms:

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(a) *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) The listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as "camera ready copy" when a patent is subsequently printed. Such computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover. When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about 1/2 in size with two printout sheets being printed as one patent specification page. Any amendments must be made by way of submission of a substitute sheet if the copy is to be used for camera ready copy.

(b) *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants may submit such listing in the form of microfiche, referred to in the specification (see § 1.77(c)(2)). Such microfiche filed with a patent application is to be referred to as a "microfiche appendix." The "microfiche appendix" will not be part of the printed patent. Reference in the application to the "microfiche appendix" should be made at the beginning of the specification at the location indicated in § 1.77(c)(2). Any amendments thereto must be made by way of revised microfiche. All computer program listings submitted on paper will be printed as part of the patent.

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* Computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards set forth in the following American National Standards Institute (ANSI) or National Micrographics Association (NMA) standards (Note: As new editions of these standards are published, the latest shall apply):

ANSI PH 1.28-1976-Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41-1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANSI/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9-1975) Microfiche of Documents.

ANSI PH 2.19 (1959)-Diffuse Transmission Density, except as modified or clarified below:

(i) Either Computer-Output-Microfilm (COM) output or copies of photographed paper copy may be submitted. In the former case, NMA standards MS1 and MS2 apply; in the latter case, standard MS5 applies.

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Film submitted shall have a thickness of at least .005 inches (0.13 mm) and not more than .009 inches (0.23 mm) for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left-most 1/3 (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and

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Trademark Office can apply serial number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence information for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Microcopy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA-MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. the density shall be visual diffuse than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche. See NMA-MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative-appearing COM-generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

[46 FR 2612, Jan. 12, 1981, para. (b)(1), 54 FR 47519, Nov. 15, 1989, effective Jan. 16, 1990]

## INFORMATION DISCLOSURE STATEMENT

### § 1.97 Filing of information disclosure statement.

(a) In order to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, but before the mailing date of either:

(1) A final action under § 1.113 or

(2) A notice of allowance under § 1.311,

whichever occurs first, provided the statement is accompanied by either a certification as specified in paragraph (e) of this section or the fee set forth in § 1.17(p).