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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 [R-3]

Canceled matter in the application file of a U.S. patent >or U.S. application publication< 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 >or U.S. application publication< may be used as prior art as of the patent *>or publication date, respectively,< in that it then constitutes prior public knowledge under

FEDEX 1211
Fedex Corp. v. Valtrus Innovations Ltd.
IPR2026-00039

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 [R-3]

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) *>of an application that has become abandoned may be< available as prior art under 35 U.S.C. 102(e) as of the earliest effective U.S. filing date of the published application**. 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 >unpublished< abandoned application is **>identified or whose benefit is claimed in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2), the file contents of the unpublished abandoned application may be made available to the public. See 37 CFR 1.14(a)(1)(iv).< Subject matter from abandoned applications which is available to the public under 37 CFR 1.14** 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*>, paragraph I<.

Published abstracts, abbreviatures, defensive publications (MPEP § 901.06(d)), and statutory invention registrations (MPEP Chapter 1100) are references.

901.03 Pending Applications [R-3]

Except as provided in 37 CFR 1.11(b), 37 CFR 1.14*>(a)(1)(v)< and 37 CFR 1.14*>(a)(1)(vi)<, pending U.S. applications ** 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 **>, that is,< publication or disclosure >of the application< 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**>. See MPEP § 1122.<

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 >under 35 U.S.C. 122(b)< 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 **>and a WIPO publication of an international application under PCT Article 21(2) are considered to be prior art under 35 U.S.C. 102(e) as of the international filing date, or an earlier effective U.S. filing date, only if the international application was filed on or after November 29, 2000, designated the United States, and was published under PCT Article 21(2) in English.<

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901.04 U.S. Patents [R-3]

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 >§ 706.02(f)(1) and< § 2127, paragraph II. The 35 U.S.C. 102(e) date *>of a U.S. patent can be an earlier effective U.S. filing date. For example, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from< 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 >for subject matter that is disclosed in 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 [R-3]

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 Application	Pre-grant publication available March 2001
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 [R-3]

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 *>is< 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 **>the U.S. search files<. 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 **>the U.S. paper search files< and these copies were generally not removed when the higher priority patent was added to *>the U.S.< 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 **>that, in< 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 section, 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 nonpatent 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 **>. Sources< for this data which are not maintained by the Office do exist and can be utilized for locating corresponding patents. One source is >the Derwent World Patents Index (DWPI) and INPADOC. Additionally,< *Chemical Abstracts* * publishes abstracts of patents >in the chemical arts< 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 Abstracts* is available online via commercial databases or on CD-ROM in the Scientific and Technical Information Center (STIC). To get access to Chemical Abstracts, examiners should contact the STIC facility – Electronic Information Center or Library – in their Technology Center.<

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 **>STIC< 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 *>documents< 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
EP European Patent Office	European patent application European patent specification New European patent specification (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.
FR France	Demande de brevet d'invention (patent application) Brevet d'invention (patent)	Disposition du public de la demande (date of laying 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 usually 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
FR France	Demande de certificat d'utilite (utility certificate application 1st level publication) Certificat d'utilite (utility certificate, 2nd publication)	Disposition du public de la demande (date published) Disposition du public du certificat d'utilite (date 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
DE Germany	Offenlegungschrift (unexamined patent application) Patentschrift (examined patent)	Offenlegungstag (date application printed) Veræfentlichungstag der patenterteilung (date printed)	Patentschrift are printed (up to four different times) after examination and at various stages of opposition. DE dates are in day/ month/year order
DE Germany	Patentschrift (Ausschließungspatent) (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.
DE Germany	Patentschrift (Wirtschaftpatent) (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.
DE 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.

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
JP Japan	Kôkai Tokkyo kôhô (unexamined patent application) Kôhyo Tokkyo kôhô (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.
	Tokkyo kôhô (examined patent application)	Upper right corner beneath number (date laid open and printed; 1st publication when Kôkai Tokkyo kôhô or Kôhyo Tokkyo kôhô 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.
JP Japan	Tokkyo shinpan seikyû kôkoku (corrected patent specification)	Upper right corner beneath number (date laid open and printed)	
JP Japan	Kôkai jitsuyô shin-an kôhô (unexamined utility model application) or Kôhyo jitsuyô shin-an kôhô (unexamined utility model application based on international)	Upper right corner beneath number (date laid open and printed)	
	Jitsuyô shin-an kôhô (examined utility model application)	Upper right corner beneath number (date laid open and printed; 1st publication when Kôkai or Kôhyo not published)	
JP Japan	Tôroku jitsuyô shin-an shinpan seikyû kôkoku (corrected registered utility model)		

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
JP Japan	Isyô kôhô (registered design application)		
RU Russian Federation	Zayavka Na Izobretenie (unexamined application for invention) Patent Na Izobreteniye (Patent)	Date application printed (1st publication) Date printed (normally 2nd publication, but 1st publication when application not published)	
RU Russian Federation	Svidetelstvo Na Poleznuyu Model (utility model)		Supplied upon request only
RU Russian Federation	Patent Na Promishlenniy Obrazec (design patent)		Supplied upon request only
GB United Kingdom	Published patent application (searched, but unexamined) Patent Specification (granted examined patent)	(date of printing the application) (date of printing)	
GB United Kingdom	Amended or Corrected Patent Specification (amended granted patent)	(date of printing)	
WO World Intellectual Property Organization	International application (PCT patent application)	(date of printing the application)	

901.05(a) Citation Data [R-3]

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.

>

I. < 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
kvÈten	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

>

II. < 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 vorenede 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 Americke
Stany Zjednoczone Ameriki
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
Vorenede Stater i Amerika

901.05(b) Other Significant Data [R-3]

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I. < 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 >and other agreement not specifically provided for elsewhere<

°(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(l) or 40(l)

(86) Filing data 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.

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II. < 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 [R-3]

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 *>most< foreign patents ** 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 Patent and Scientific Literature 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 **>STIC facility in their Technology Center or from the Foreign Patent and Scientific Literature Branch of STIC<. If examiners so choose, they can make copies themselves. The most current patent documents are accessible through the USPTO's automated search systems, which *>allow< public and USPTO users to look up, view, and print foreign documents. Older documents can be found on microfilm **>or print copies in the Main Branch of the STIC<. 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 [R-5]

Examiners may consult the translators in the Translations 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. Effective January 1, 2004, the Translations Branch will use e-mail as the sole delivery method for written translations. Paper copies of the translation request form, the foreign document and the translation will no longer be returned to the examiner. Therefore, it is important that examiners submit to STIC <u>only copies</u> of the foreign documents to be translated, and retain the original documents.

Translation service requests can be submitted electronically, via phone, or by fax to STIC. More information is available at: http://ptoweb/patents/stic**.

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 Translations Branch. Before any translation request is processed, the staff of the Translations Branch checks for equivalents or previous translations. The staff of STIC's Foreign Patent and Scientific Literature Branch or the Translations Branch can assist examiners in locating equivalents or abstracts. See MPEP § 901.06(a), STIC Services - Foreign Patent Services.

901.06 Nonpatent Publications [R-3]

All printed publications may be used as references, the date to be cited being the publication date. See MPEP § 2128 - § 2128.02.

**>The Scientific and Technical Information Center (STIC) maintains an Electronic Information Center (EIC) or Library in each Technology Center. Copies of non-patent literature can be requested from these facilities.< See MPEP § 707.05(e) for information on how to cite such publications.

901.06(a) Scientific and Technical Information Center (STIC) [R-5]

The Scientific and Technical Information Center (STIC) is located at Room 1C35, Madison West >Building, 600 Dulany Street, Alexandria, VA 22314<. STIC maintains satellite information centers in each Technology Center (TC).

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. Collections of books and trade catalogs are also purchased by STIC for permanent location in specific TCs. For instance, the Design Patent Art Units have a great many manufacturers' catalogs. Books may be ordered by examiners for location in the TCs by contacting the STIC EIC or Library in each TC. The request for purchase form is available on the STIC Intranet site. The locations of all acquired publications are recorded in the STIC Online Catalog 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 Information Access and Management Branch.

Reference works including encyclopedias, dictionaries, handbooks, and abstracting and indexing services are also available in print and at the desktop from 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

Over >17,000 scientific, technical, business and general< periodical titles >that< are in print and electronic format are available to examiners through STIC. 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).

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.

>Most periodicals are available electronically on the examiner's desktop.< Current issues of periodicals in print are arranged alphabetically and located on shelves near the reference collection. Bound periodicals are interfiled with the book collection. Periodi-

cals on microfilm and CD-ROM are housed in cabinets.

C. Foreign Patent Documents

The USPTO receives foreign patent documents through exchange agreements with almost all countries that print or otherwise publish their patent documents. This makes STIC's collection of foreign patent documents the most comprehensive in the United States.

The collection is located in the Main Branch of the STIC. 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 earliest patent documents, as far back 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.

D. Special Collections

Although STIC still houses substantial print collections, the majority of the collections are now in the form of electronic books, journals, and foreign patents. The electronic books and journals are accessible at the examiner's desktop. To locate the NPL Services for Examiners on the Intranet site, go to the Patent Examiner's Toolkit and click on Non-Patent Literature. Collections are arranged by TC and are also accessible by title via the STIC Online Catalog.

Biotechnology/Chemical

The Biotechnology/Chemical Library is located on the first floor of the Remsen Building. This facility offers a specialized collection of print, electronic, and microfilm resources in the biological and chemical fields. The Library is open to the public as well as to patent examiners.

The Lutrelle F. Parker, Sr., Memorial Law Library contains a legal collection focusing on intellectual property. The Law Library is located in the Main STIC.

Each Electronic Information Center has a small print collection tailored to the art areas covered by the TC.

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 availability. Examiners can access the online catalog from their desktops via the Patent Examiner's Toolkit.

Materials acquired by the STIC are classified according to the Library of Congress classification system. Books and bound periodicals are intershelved 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 *>Service< Desk. (Noncirculating material includes reference publications, print journals, foreign patent documents, and microfilm.) 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

STIC staff assist examiners in the use of the STIC and its resources. Upon request, they provide guidance on finding information in the electronic and print collections. If any problems are encountered in locating materials 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 database searching is provided by the STIC facility located in each TC. All STIC branches have access to a number of vendors' commercial database 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, Scientific and Technical Network (STN), Questel-Orbit, and others. 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 >electronically via the NPL Intranet website or on paper< to the appropriate branch. Searches are usually completed in two working days or less. Completed searches are delivered to the examiners.

Examiners can conduct searches of online commercial databases independently of STIC staff. **>Once approval from the supervisory patent examiner (SPE) has been obtained, training is provided through STIC's Digital Resources Division. Individual assistance in searching these databases< is available from the STIC and ITRP staffs, 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 system developed for this purpose. 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 Patent and Scientific Literature Branch of the STIC is available to assist with any problem or informational need regarding foreign patent searching or foreign patent documents. These services are also available to examiners in the Electronic Information Centers.

Online patent family search services are performed for patent examiners by the Foreign Patent and Scientific Literature 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 foreign patent searches after receiving appropriate training through the Office of Patent Training can consult foreign patent experts for difficult searches.

The staff of the Foreign Patent and Scientific Literature 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 from the Foreign Patent and Scientific Literature Branch of the Information Center.

D. Translations

Examiners may consult the translators in the Translations Branch of STIC 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. See also MPEP § 901.05(d).

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 can be submitted to the STIC facility in an examiner's TC >or via the electronic form on the STIC Intranet website<. Those that can be filled by libraries in the metropolitan area are handled by the staff of the Reference Delivery Branch of the STIC 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.

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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 STIC facility in the examiner's TC. 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 and its branches can be arranged for examiners or for outside groups by contacting the STIC facility in the examiner's TC.

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.

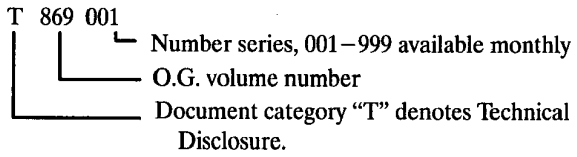
The manner of citing one of these publications is as follows: A.P.C. Application of ....., Ser. No. ....., Published .....

The Patent Search Room contains a complete set of A.P.C. published applications arranged numerically in bound volumes.

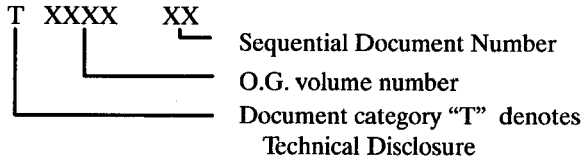
901.06(d) Abstracts, Abbreviatures, and Defensive Publications

Abstracts and Abbreviatures 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.



For Defensive Publications published on and after November 4, 1980, a different numbering system is used.



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 [R-5]

In the Technology Centers (TCs) **>, the only documents that are maintained in the paper form are patents from the plant class, foreign patent documents, and non-patent literature. The patent documents< 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 **>the classifications of the International Patent Classification system< .

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 * kept in shoes **>in designated locations<.

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 [R-5]

The search files in each *>Technology Center (TC)< that maintains paper search files 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.

902 Search Tools and Classification Information

902.01 Manual of Classification [R-5]

The Manual of Classification is the key to the U.S. Patent Classification System >(USPC)<. The complete Manual of Classification is available to USPTO personnel from the Classification Home Page >(http://ptoweb:8081/)<, which is accessible from the desktop via the Patent Examiner's Toolkit. The Manual of Classification is also available via the Internet at http://www.uspto.gov/web/patents/classification. The information in the Manual is updated every 2 months. In addition, the Manual of Classification is archived every June and December in **>portable document format (PDF)< on CD-ROM.

There are over 400 classes in the **>USPC. Each class has a title descriptive of its subject matter, is identified by a class number, and is subdivided into a number of subclasses. Each subclass also has a descriptive title, is identified by a subclass number, and the subclass number is an integral number that 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 *>all< class and subclass titles, **>the ordered arrangements are referred to as class schedules. The class and subclass titles are brief and are as suggestive as possible of the subject matter included. Therefore, it is best not to depend exclusively upon titles to explain the subject matter encompassed by a class and subclass but to refer also to the respective definitions and notes.< 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) Overview of the Classification System.

(B) >*Classes Within the U.S. Classification System Arranged by Related Subject Matter:*< A hierarchical arrangement of class titles organized into four main groups by related subject matter. **>Only as a last resort should this hierarchical arrangement of class titles<, be used to determine document placement**, 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.

(C) >*Classes Arranged by Art Unit (CAAU):*< A list, in numerical order, by art unit indicating the classification(s) assigned to each.

(D) >*Classes Arranged Numerically With Art Unit and Search Room Locations (CAN):*< 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.

(E) >*Classes Arranged in Alphabetical Order (CAA):*< A list of classes in alphabetical order by class title with associated class numbers.

(F) >*Class Schedules:*< Class schedules for utility patent, design, and plant classes.

902.01(a) Index to the U.S. Patent Classification System [R-5]

The Index to the U.S. Patent Classification System >(USPC)< is an alphabetic listing of technical and common terms referring to specific classes and subclasses of the **>USPC. The index is used< as an initial entry into the system and should not be considered exhaustive. All appropriate class schedules should be scanned for specifically related subclasses>,< and the definitions and associated notes of the pertinent classifications *>should< also be reviewed, even when the citation found in the Index appears to be restricted to a specific subject matter area.

The Index is **>regularly updated<. Suggestions or changes to the Index are encouraged and should be directed to the **>Technology Center (TC) classification contact in the TCs<.

The Index is available online to USPTO personnel from the Classification Home Page – USPC Index. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit.

902.02 Class and Subclass Definitions [R-5]

All of the utility classes (i.e., classes devoted to technology), and the plant class have definitions. All design classes will * eventually have definitions.

Definitions state the subject matter of the classes and subclasses **>in much more detail than it is possible to state in the brief< 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 >(USPC)<.

All classes and subclasses (class definitions) in the **>USPC< are available online to USPTO personnel from the Classification Home Page under the heading Search Classification Data. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit. The >class< definitions are archived >in portable document formats (PDFs)< to CD-ROM every June and 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 >these< changes. Classification Orders are available online to USPTO personnel from the Classification Home Page under the heading Classification Reports. The Classification Home Page is accessible from the desktop via the Patent Examiner's Toolkit.

902.02(a) Definition Notes [R-5]

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.

*>The< 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. **>Each "See or Search" note helps< a user reach a decision either to include or exclude an area containing relevant subject matter.

Search notes are not exhaustive and **>do not limit the search but suggest< additional fields of search **. Additionally, since a search note *>that< applies to a particular subclass is rarely repeated for subclasses indented thereunder, it is advisable to review the search notes of all parent subclasses.

**

902.03 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 [R-5]

The >Office of< Patent Classification Home Page address on the Internet is http://www.uspto.gov/web/offices/opc/. 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 **>includes the following in HTML and PDF: (A) the Index to the U.S. Patent Classification system (USPC) (linked from "Classification Index, Patents"); (B) class definitions (linked from "Classification Definitions, Patents"); and (C) class schedules (linked from "Classification Manual, Patents").< The site integrates with the USPTO Patent Full-Text and Image Database site by allowing a search of a subclass by clicking on a patent icon in the classification schedules and definitions which generates a search result in the USPTO Patent Full-Text and Image Database. The USPTO Patent Full-Text and Image Database 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 the USPTO Patent Full-Text and Image Database.

902.03(b) Patent Classification Home Page on the USPTO Intranet [R-5]

The address for the Patent Classification Home Page on the USPTO Intranet is http://ptoweb:8081/. The Classification Home Page is also accessible from the desktop via the Patent Examiner's Toolkit. 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). Examiners and the public are provided with access to identical information for the Index, schedules, and definitions.

The * Intranet **>Classification Home Page site also includes links to international information such as IPC8 Concordance, IPC8 Schedules, IPC8 Catchword Index, WIPO Handbook on Industrial Property Information and Documentation, and to national (U.S.) information such as Overview of the Classification System, Classification Guides and Bulletins, and the Patent Classification Search Page.

The Patent Classification Retrieval System (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) [R-5]

The Classification Insight product on the USPTO LAN site is a custom browser **>that is accessible from the desktop via the Patent Examiner's Toolkit. The Classification Insight product contains classification schedules and definitions in Adobe Acrobat portable document format (PDF) and various classification documents in a full-text searchable hyperlinked format, as follows:

(A) Patent Classification Data;
(B) U.S. Schedules by Class Number;
(C) U.S. Class Definitions by Class Number;
(D) US-to-IPC Concordance by Class Number;
(E) Schedules by Tech Center;
(F) Definitions by Tech Center;
(G) Schedules (MoC);
(H) Definitions;
(I) US-to-IPC Concordance;
(J) US-to-Locarno Concordance; and
(K) PDFs.<

902.03(d) Patent Information and Search Tools: the Cassis *>DVD<-ROM Series [R-5]

Access to a great deal of patent information as well as various search tools is available in the Cassis DVD-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 **>originals (ORs) and cross-references (XRs)<.

(B) Patents BIB: Bibliographic information for utility patents issued since 1969 (other patents, since 1977), and patent application publications since March 15, 2001, including inventor, issue or publication 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 since 1988.

(C) Patents and Trademarks ASSIGN: Shows assignment of patent and trademarks rights recorded at the USPTO from August 1980 to present.

(D) Patents ASSIST: This disc provides a variety of files: Manual of Classification; Classification Definitions; 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; 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 DVD-ROMs are text-searchable. Search results can be viewed on-screen, printed, or downloaded to diskette. Patents CLASS, Patents BIB, and Patents and Trademarks ASSIGN are updated with

new information every two months; Patents ASSIST is updated every three months.

In addition to the text-searchable discs, USAPat offers full facsimile images on DVD-ROM of U.S. patents issued weekly. The backfile includes patents issued since 1790. 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. USAApp offers full facsimile images on DVD-ROM of U.S. patent application publications beginning with March 15, 2001, and is issued weekly.

902.03(e) Automated Search Tools: EAST and WEST [R-5]

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>: (A)< full text of U.S. published applications since 2001 *>; (B) full text of U.S.< patents granted since 1970 **>; and (C)< optically scanned full text of U.S. patents granted 1920-1970. Additionally, EAST and WEST each provide current classification information and images for all U.S. published applications and patents. Images are available for foreign patent documents, 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 and on the EAST, WEST, and BRS Search Strategy web pages on the Intranet, available 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 [R-5]

Classification orders **>are issued monthly; each order details the changes resulting from a classification project effective< 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 *>U.S. Patent Classification System<, Classification Definitions) are updated.

*>A classification< order includes the following:

(A) **>New< class schedules *>and/or< changes to existing class schedules necessitated by the project; **>

(B) < Source and Disposition lists showing how the old art has been distributed into the newly established subclasses; *

*>

(C) < A revised concordance showing the relationship between the newly established subclasses and their International Patent Classification (IPC) counterparts>; and

(D) Necessary changes to the definitions that corroborate the changes in the schedules<

Copies of classification orders are available online to USPTO personnel from the Classification Home Page under the heading Classification Reports. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit.

902.04(a) Reclassification Alert Report [R-5]

The Reclassification Alert Report is updated quarterly and is available online to USPTO personnel from the Classification Home Page under the heading Classification Reports. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit. The report numerically lists the classes and subclasses affected by classification orders which issued during the quarter, indicating if the classifications were established, >were< abolished, or had definition changes.

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 [R-3]

*>Many of the principles that form the< basis of classification used in the U.S. Patent and Trademark Office** are set forth in the ** "Examiner Handbook to the U.S. Patent Classification System" which can be accessed from either the **>Intranet on the Classification Home Page (http://ptoweb:8081/) or the Internet on the Office of Patent Classification home page (http://www.uspto.gov/web/offices/opc/). Any questions not covered in this handbook can be directed to the Office of Patent Classification.<

903.02(a) New and Revised Classes [R-5]

The establishment of new classes or subclasses and the revision of old classes are done under the guidance of **>the Technology Center classification contact, as follows:

(A) The staff performing the reclassification develops an arrangement of documents which is satisfactory for searching;

(B) The definition of the new class or revised class is written or modified;

(C) The lines between the class and other classes are drawn up;

(D) The subclass definitions are established and definitions of all revised classes and subclasses are included in the classification orders; and

(E) The Index of the U.S. Classification System and the Classification Data System files are updated.<

Notification of the new class or subclass is published in a classification order. Copies of classification orders are available online to USPTO personnel from the Classification Home Page under the heading Classification Reports. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit.

**

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 [R-5]

**>Any examiner having the Technology Center Director's approval to create new subclasses should contact the supervisory patent classifier (SPC) for his or her technology< before work is begun. The SPC will assist the examiner in establishing any new

subclass ** by >(A)< providing appropriate instructions on how to transfer patents from an existing subclass to a new subclass, **>(B)< determining the title >and definition< of the newly established subclass **, and >(C)< assigning the numeric designation to be placed on the new subclass **.

All newly created subclasses will be made official so as to be a part of the defined classification system. **>New classification data will be added to the Subclass Data File (SDF) and Master Classification File (MCF) as appropriate. 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 [R-5]

Many 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 >(USPC)< or, in relatively few instances, **>the International Patent Classification (IPC) system<. Foreign patents received by the Office after October 1, 1995 are available on the USPTO's automated search systems, the Foreign Patent Access System (FPAS), Internet sites, and the Scientific and Technical Information Center (STIC) collections.

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 (or bibliographic information) to his or her supervisory patent classifier with a request for the desired transaction attached.

The 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)).

903.04 Classifying Applications for Publication as a Patent Application Publication [R-5]

Patent applications filed on or after November 29, 2000>,< are published as a patent application publication pursuant to 35 U.S.C. 122(b), unless certain exceptions apply. See MPEP § 1120.

Patent application publications are given a primary classification (equivalent to an original classification), and may also be given a secondary classification (equivalent to a cross reference). While there may be only one primary classification for a single patent application publication, there may be **>any number of< secondary classifications. The >selection of a< primary classification of a patent application publication is * based on the application's main inventive concept using the claims as a guide. A primary classification could be any U.S. class/subclass (except cross reference art collections, digests and foreign art collection subclasses). A secondary classification is based on other inventive concepts (mandatory) or valuable disclosure (discretionary), and may be any U.S. class/subclass (including cross reference collections and digests, but excluding foreign art collection subclasses). The classification of a patent application publication is printed on the front page of the publication.

**>At least 9 weeks prior to< the projected publication date, applications ** are classified using programs designed to enable entry of certain data required for publication of patent applications. Applications are classified by giving each application at least a primary classification >and an international classification<. The >suggested< international classification>(s)< corresponding to *>each assigned< U.S. classification is **>provided<. In addition, if a figure is to be published, the figure is selected at the time of classification.

903.05 ** >Addition, Deletion, or Transfer of U.S. Patents and U.S. Patent Application Publications< [R-3]

*>Requests for addition, deletion, or< transfer of official copies of U.S. patents**>and U.S. patent application publications may be carried out by using

the Patent Post Publication Classification Manager and the PGPub Post Publication Classification Manager, which are available online from the Classification Home Page under the heading Patents, their Classifications and Locations. The Classification Home Page is accessible from the desktop via the Patent Examiner's Toolkit.

Using these tools, examiners can request the following transactions:

(A) Add any classification(s) from the U.S. Patent Classification system as a cross-reference (XR) classification to a patent or a secondary classification to a patent application publication.

(B) Delete XR classification(s) or secondary classification assigned to the Technology Center (TC) of the person requesting the deletion.

(C) Change original classifications (ORs) or primary patent application publication classification to a classification in the TC of the person requesting the change.

(D) Add or delete any International Patent Classification system (IPC) classification to a patent.<

>

903.06 Harmonized Subclasses [R-5]

The U.S. Patent Classification System (USPC) includes subclasses that have been harmonized with subclasses from the European Patent Office (EPO) and the Japan Patent Office (JPO). These subclasses are regularly populated with documents from the EPO and JPO databases. Subclasses that have been harmonized have a designation of "EPO," "JPO," or "EPO/JPO" in parentheses following the subclass title to indicate if the subclass has been harmonized with the EPO or JPO or with both systems.<

903.07 Classifying and Cross-Referencing at Allowance [R-5]

When an application is passed to issue, 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 Image File Wrapper (IFW) issue classification form in **>the Office Action Correspondence Subsystem (OACS)<. This form provides 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 IFW issue classification form ONLY in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" space on the form, as appropriate, to make it clear that the absence of information in the box was not an oversight.

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 original classification is the mandatory classification that, looking at the schedule from the top down, is the most indented subclass array in which any classifications are assigned, 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, the original classification, looking at the schedule from the top down, is the mandatory classification that is the most indented subclass of the first subclass array in which any classifications are assigned.

For a more complete discussion of this subject, see the "Examiner Handbook to Classification" which is available online to USPTO personnel from the Classification Home Page under the heading Classification Guides and Bulletins. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit.

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.

The examiner must **>complete< the IFW issue classification form 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. 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 IFW issue classification form 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 IFW issue classification form>,< 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, >the Office of Patent< Classification **>oversees< any necessary changes. Patents issuing from applications which already have been sent to the printer will be reclassified **.

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 [R-3]

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 **>IFW issue classification form< 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 **>supervisory patent examiner (SPE)< having jurisdiction over the art area to which the application is presently assigned. The **>SPE will work with the SPE of the other impacted area for resolution. In the case where an impasse develops, the application will be forwarded to the classification dispute TC representative panel for a final determination (see MPEP § 903.08(d)). At all stages of the process, the application is to be given< a high priority.

Only when both examiners concur in the proposed classification of the patent, or where there has been a ruling by **>the SPE, or a final determination by the classification dispute TC representative panel<, may patent applications sent to issue from one TC be assigned to classes in another TC. **

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 [R-3]

New nonprovisional applications are assigned to the various Technology Centers (TCs) in the first instance by the Office of Initial Patent Examination (OIPE). **

The supervisory patent examiner or his/her designee reviews *>each< 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).
**

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 [R-3]

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 >classifies the application and< assigns the application**>to an examiner<. 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 >(i.e., Claim 1)< 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.
**

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 [R-5]

I. TRANSFER BETWEEN ART UNITS WITHIN THE SAME TECHNOLOGY CENTER

Each Technology Center (TC) has developed internal procedures for transferring application between art units and resolving application assignment disputes.

II. TRANSFERS BETWEEN DIFFERENT TECHNOLOGY CENTERS

Where a supervisory patent examiner (SPE) believes an application (including PCT applications), either new or amended, does not belong in his or her art unit, he or she may 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).

Where the application is a PCT application or an application that has been docketed to an examiner, the decision as to the classification resolution and assignment of the application is made by agreement between the SPEs involved in the transfer.

Where the application is an application (other than a PCT application) that has <u>not</u> been docketed to an examiner, the decision as to the classification resolution and assignment of the application is made by agreement between the SPEs involved in the transfer. If no agreement can be reached between the SPEs, the application may be forwarded to the classification dispute **>TC< representative panel of the TC where the application was originally assigned for a final decision. The classification dispute TC representative panel consists of designated representatives from each TC.

Before an application is sent to a receiving art unit of a different TC, the application must be fully reviewed to ensure that all appropriate areas in the originating TC have been considered with respect to the classification of the application. In all cases when a transfer is initiated, the application must be sent on transfer inquiry to a receiving art unit. Even if the application is confusing or contains unfamiliar subject matter, the SPE of the originating art unit 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), an SPE or 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 SPE or primary 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).

III. PROCESS FOR TRANSFER

When the SPE or primary examiner of the originating art unit determines that a transfer is appropriate, he or she must complete the Application Transfer Request form in PALM EXPO and provide a full explanation of the reasons for classification in the receiving art unit. >An eDAN message should also be sent notifying the receiving art unit of the transfer.< At least one of the following should be included in the form in the space provided:

(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.

>If the SPE or examiner of the originating art unit believes an application has been improperly assigned to their art unit, but is unable to determine an appropriate place to send the application, a "gatekeeper" or search assistant should be consulted. A listing of examiners who function in this role may be found at http://ptoweb/patents/tsa/. It is noted that "gatekeepers" or search assistants exist in all of the TCs except the TC that examines design applications (TC 2900).<

If the receiving SPE or primary examiner agrees to accept the application, he or she classifies and assigns the application. The transfer is effected by accepting the application in PALM EXPO.

If the receiving SPE or primary examiner refuses to accept the application, the reasons for refusal must be entered in PALM EXPO. For an image file wrapper (IFW) application, an eDAN message stating that the application is being returned should be sent to the originally assigned art unit. The refusal must be recorded in the PALM EXPO transfer inquiry page. Where the application is an application (other than a PCT application) that has not been docketed to an examiner, the originating art unit may then either accept the application for examination or send the disputed transfer application to the classification dispute TC representative panel for final resolution. The panel considers the statements and evidence of both the originating and receiving art units and assigns the application to the art unit that has jurisdiction over the art in which the controlling claims of the application are properly classified.

Under certain circumstances, the classification dispute TC representative panel, contrary to controlling classification rules, may assign an application to a class or art unit which the panel *>deems< is better equipped to examine the application. See MPEP § 903.08(e).

Every application, no matter how peculiar or confusing, must be assigned somewhere for examination. Thus, in contesting the assignment of an application, the SPE or primary examiner should **>indicate< another class that is ** a better *>class in which< to classify the application, rather than simply arguing that the application does not fit the examiner's class.

If an application contains both classification issues and issues unrelated to classification, e.g., a dispute both as to the classification of claims and the propriety of restriction, the issues unrelated to classification should be resolved first. If>,< thereafter>,< classification issues still need to be addressed, application transfer may be appropriate. For the procedure in the classification groups for applications which contain examining corps issues, see MPEP § 903.08(e).

The question of need for a restriction requirement does not influence the determination of transfer.

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.

>If an application has been assigned a class/subclass by the Office of Initial Patent Examination (OIPE) and the application is routed to an art unit that does not examine applications assigned to that class/

subclass, an eDAN message to "OIPEClass/GAUMismatch" IFW mailbox should be sent.<

903.08(e) General Guidelines Governing the Assignment of Nonprovisional Applications for Examination [R-5]

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. 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 patent examiners 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 are appropriately assigned. 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 generally assigned on the basis of where the application would have an original classification, if the claims it contains were in a patent.

(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 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. Supervisory patent examiners (SPEs) 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, looking down from the top of the schedule, the OR subclass is chosen from among the classifications of the claimed disclosure according to whichever one is the most indented subclass of the first subclass array.

(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.

(G) The classification dispute TC representative panel is authorized in all cases, where they evaluate the facts as warranting it, to assign applications for examination to the 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 classification dispute TC representative panel 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 **>SPE< in one discipline *>determines< 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 request a transfer of 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 electri-

cal 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 person requesting the transfer is ordinarily required 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 classification dispute TC representative panel 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 classification TC representative panel, 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 ensure the record includes the result of the search.

(M) When an application is received by the classification dispute TC representative panel 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 TCs, 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 returned to the originating TC for resolution on the issues unrelated to the classification.

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 issues unrelated to the classification, there is still a dispute as to which TC should examine the application, the originating application may be returned to the classification dispute TC representative panel for assignment.

I. UNDOCKETED APPLICATIONS RECEIVED FROM THE OFFICE OF INITIAL PATENT EXAMINATION (OIPE)

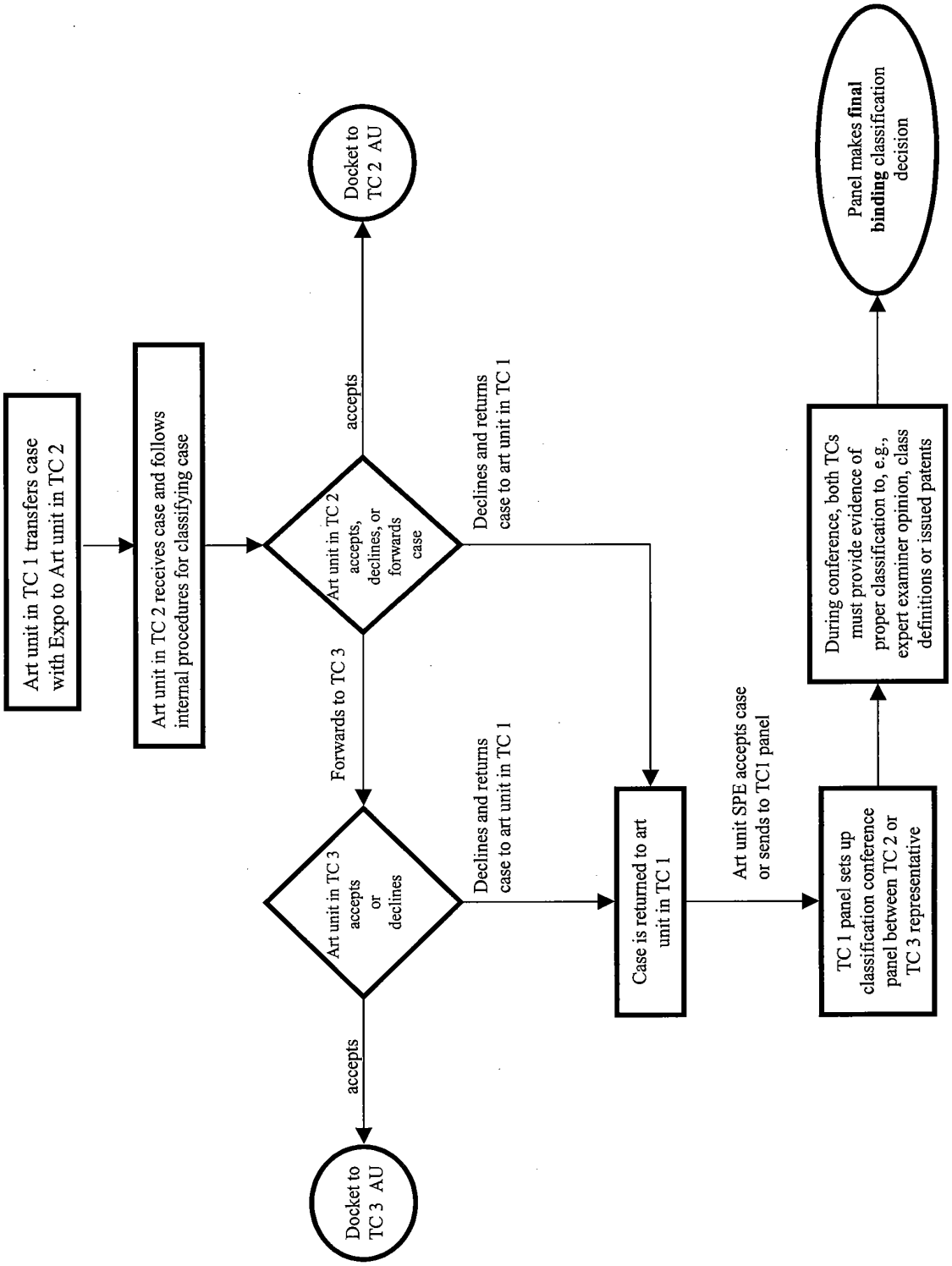
The *>flowchart< below shows the routing of undocketed applications between TCs after receipt from OIPE. (For routing of undocketed applications between art units within the <u>same</u> TC, see MPEP § 903.08(d).) The application should be considered by the receiving art unit in the TC (TC1), which will accept the application and assign it to an examiner, or forward it to an art unit in another TC (TC2) for consideration. An art unit in TC2 will classify and assign the application to an examiner, return the application to the SPE of the originating art unit, or forward it to an art unit in another TC (TC3). If the art unit in TC2 is not aware of any other likely classification, the application may be returned directly to the SPE of the originating art unit in TC1. In any of these scenarios,

the decisions concerning the transfer must be recorded in PALM EXPO and in the case of an image file wrapper (IFW) application, eDAN messaging should also be used.

Where the application is forwarded to an art unit in TC3 and the art unit in TC3 declines to accept the application, the application should be returned to the SPE of the originating art unit in TC1.

If an art unit in TC2 or TC3 declines to accept the application and the application is returned to the SPE of the originating art unit in TC1, the SPE of the art unit in TC1 may forward the application to a classification dispute TC representative panel for resolution. The SPE of the art unit in TC1 may contact a TC classification panel representative within his or her TC. The application will be given to the TC classification panel representative and the representative will contact either the TC2 or TC3 representative (forming a classification dispute TC representative panel) to set up a conference. The classification dispute TC representative panel will evaluate any evidence presented by the disputing TCs, and make a decision on the proper classification and assignment of the application. The decision of the classification dispute TC representative panel will be final and binding.

Inter-TC Classification Dispute Resolution Procedures



II. PALM EXPO

SPEs and examiners must use the EXPO Transfer Inquiry function, which creates a record of the transfer inquiry history of each application and facilitates tracking of applications.

PALM EXPO will provide a routing sheet to be included in the application file when a transfer inquiry is created.

903.09 International Classification of Patents for Inventions [R-5]

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 *>2006< (*>Eighth< Edition), hereinafter referred to as "Int. Cl.*."

The complete Int. Cl.* symbols must be placed in the indicated space on the Image File Wrapper (IFW) issue classification form when an application is issued.

I. INT. Cl.*LAYOUT

The layout of the Int.Cl.* is explained below with reference to the sample page.

A. 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

B. 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

C. 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.

D. 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.

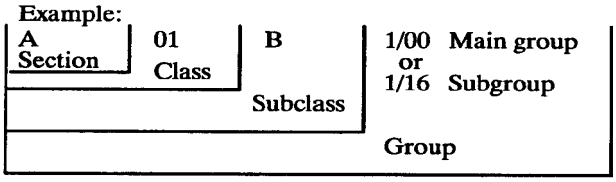
(E) *Subgroup Title* — The subgroup title defines a field of subject matter within the scope of its main group considered to be useful in searching for inventions. The title is preceded by one or more dots indicating the hierarchical position of the subgroup, i.e., indicating that each subgroup forms 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.)

E. Complete Classification Symbol

A complete classification symbol comprises the combined symbols representing the section, class, subclass, and main group or subgroup.



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.)

II. CLASSIFYING IN THE INT. Cl.* 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 relation 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

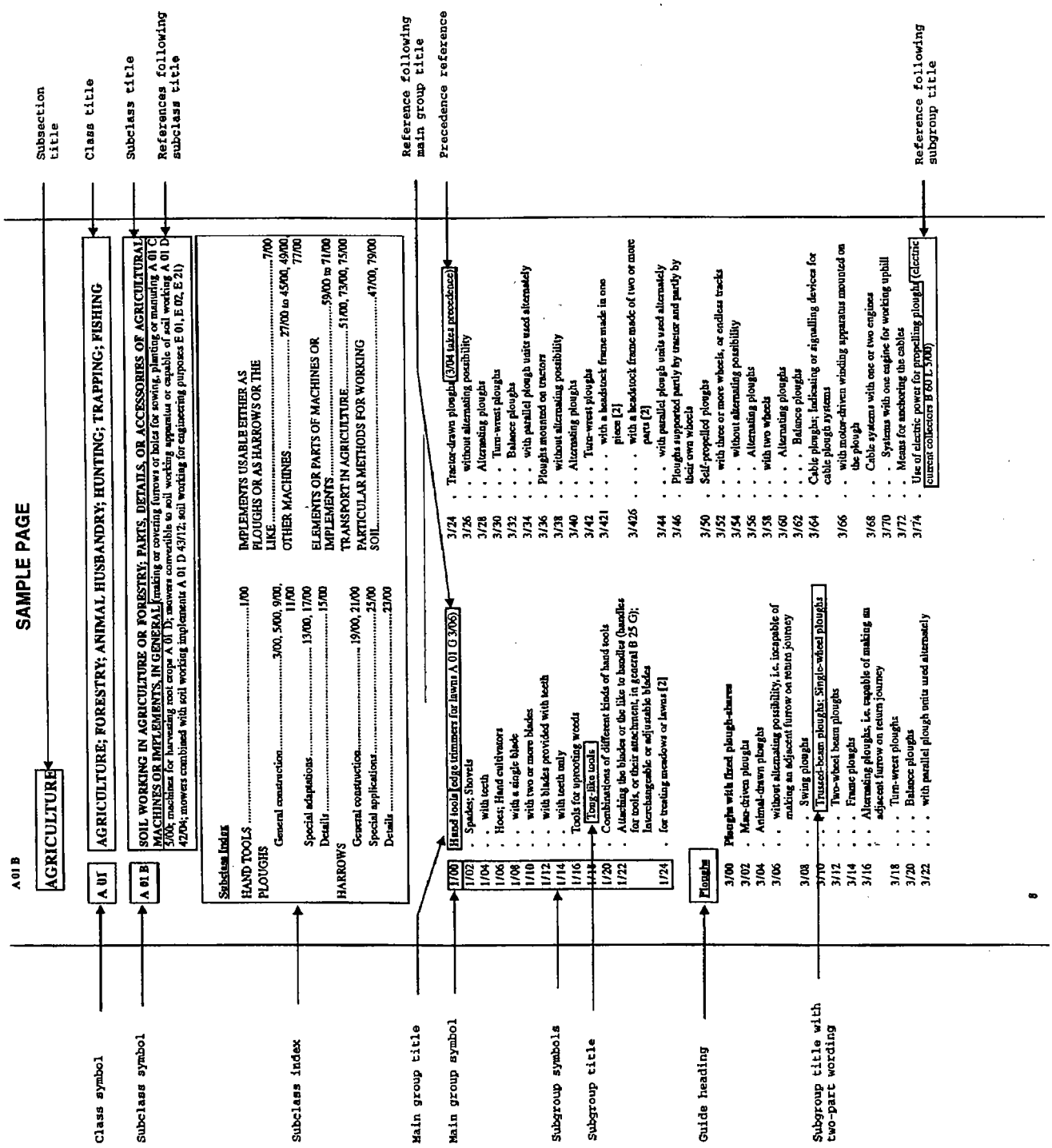
The scope of a main group is to be interpreted only within the effective scope of its subclass (as indicated above). Subject to this, the effective scope of a main group is determined by its title as modified by any relevant references or notes associated with the main group or with any guide heading 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.*.

**>


SAMPLE PAGE
A01B
AGRICULTURE
A 01
AGRICULTURE; FORESTRY; ANIMAL HUSBANDRY; HUNTING; TRAPPING; FISHING
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 5/00; machines for harvesting root crops A 01 D; mowers 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 Index
HAND TOOLS 1/00
PLOUGHS
General construction 3/00, 5/00, 9/00, 11/00
Special adaptations 13/00, 17/00
Details 15/00
HARROWS
General construction 19/00, 21/00
Special applications 25/00
Details 23/00
IMPLEMENTS USABLE EITHER AS PLOUGHS OR AS HARROWS OR THE LIKE 7/00
OTHER MACHINES ..... 27/00 to 45/00, 49/00, 77/00
ELEMENTS OR PARTS OF MACHINES OR IMPLEMENTS ..... 59/00 to 71/00
TRANSPORT IN AGRICULTURE 51/00, 73/00, 75/00
PARTICULAR METHODS FOR WORKING SOIL 47/00, 79/00
1/00 Hand tools (edge trimmers for lawns A 01 G 3/06)
1/02 . Spades; Shovels
1/04 . . with teeth
1/06 . Hoes; Hand cultivators
1/08 . . with a single blade
1/10 . . with two or more blades
1/12 . . with blades provided with teeth
1/14 . . with teeth only
1/16 . Tools for uprooting weeds
1/18 . Tong-like tools
1/20 . Combinations of different kinds of hand tools
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
1/24 . for treating meadows or lawns [2]
3/00 Ploughs
3/02 . Man-driven ploughs
3/04 . Animal-drawn ploughs
3/06 . . without alternating possibility, i.e. incapable of making an adjacent furrow on return journey
3/08 . . . Swing ploughs
3/10 . . . Trussed-beam ploughs; Single-wheel ploughs
3/12 . . . Two-wheel beam ploughs
3/14 . . . Frame ploughs
3/16 . . . Alternating ploughs, i.e. capable of making an adjacent furrow on return journey
3/18 . . . Turn-wrest ploughs
3/20 . . . Balance ploughs
3/22 . . . with parallel plough units used alternately
3/24 . Tractor-drawn ploughs (3/04 takes precedence)
3/26 . . without alternating possibility
3/28 . . Alternating ploughs
3/30 . . . Turn-wrest ploughs
3/32 . . . Balance ploughs
3/34 . . . with parallel plough units used alternately
3/36 . Ploughs mounted on tractors
3/38 . . without alternating possibility
3/40 . . Alternating ploughs
3/42 . . . Turn-wrest ploughs
3/421 . . . . with a headstock frame made in one piece [2]
3/426 . . . . with a headstock frame made of two or more parts [2]
3/44 . . . with parallel plough units used alternately
3/46 . Ploughs supported partly by tractor and partly by their own wheels
3/50 . Self-propelled ploughs
3/52 . . with three or more wheels, or endless tracks
3/54 . . without alternating possibility
3/56 . . Alternating ploughs
3/58 . . with two wheels
3/60 . . . Alternating ploughs
3/62 . . . Balance ploughs
3/64 . Cable ploughs; Indicating or signalling devices for cable plough systems
3/66 . . with motor-driven winding apparatus mounted on the plough
3/68 . . Cable systems with one or two engines
3/70 . . . Systems with one engine for working uphill
3/72 . . Means for anchoring the cables
3/74 . Use of electric power for propelling ploughs (electric current collectors B 60 L 5/00)
Class symbol
Subclass symbol
Subclass index
Main group title
Main group symbol
Subgroup symbols
Subgroup title
Guide heading
Subgroup title with two-part wording
Subsection title
Class title
Subclass title
References following subclass title
Reference following main group title
Precedence reference
Reference following subgroup title

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III. U.S. INT. Cl.* CONCORDANCE *

The Office of * Patent Classification has prepared a revised Concordance between the U.S. classes and subclasses and the Int. Cl.*. 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.*, and *not* as a translation list.

** The * Concordance is updated monthly, and is available to USPTO personnel online from the Classification Home Page under the heading Search Classification Data. The Classification Home Page >(http://ptoweb:8081/)< is accessible from the desktop via the Patent Examiner's Toolkit.

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 **>Technology Center classification contact via their supervisory patent examiner<.

903.09(a) Locarno Classification Designations [R-5]

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 Image File Wrapper (IFW) issue classification form 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 * Patent Classification has prepared a Concordance between the U.S. Design Classification classes and subclasses and 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 subclass. 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.

904 How to Search [R-5]

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. An inventor name search should be made to identify other applications and/or patents which may be applicable as references for double patenting rejections. See MPEP § 804.

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. For national stage applications filed under 35 U.S.C. 371, the examiner will consider the documents cited in an international search report when the Form PCT/DO/EO/903 indicates that both the international search report and the copies of the documents are present in the national stage application file. See MPEP § 609.03.

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 must complete the Image File Wrapper (IFW) search notes form in *>the Office Action Correspondence Subsystem (OACS)< to include 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 indicate on the IFW search notes form 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 relevant or pertinent 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 *no*t 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 [R-5]

Not only must the art be searched within which the invention claimed is classifiable, but also all analogous arts **>must be searched regardless of where the claimed invention is 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 context 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 [R-3]

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 >additional< 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 **.

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 browsing 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**>,< supervisory patent examiners, >and/or trained professional on-line search personnel,< 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 **>Office of Patent Training< 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).

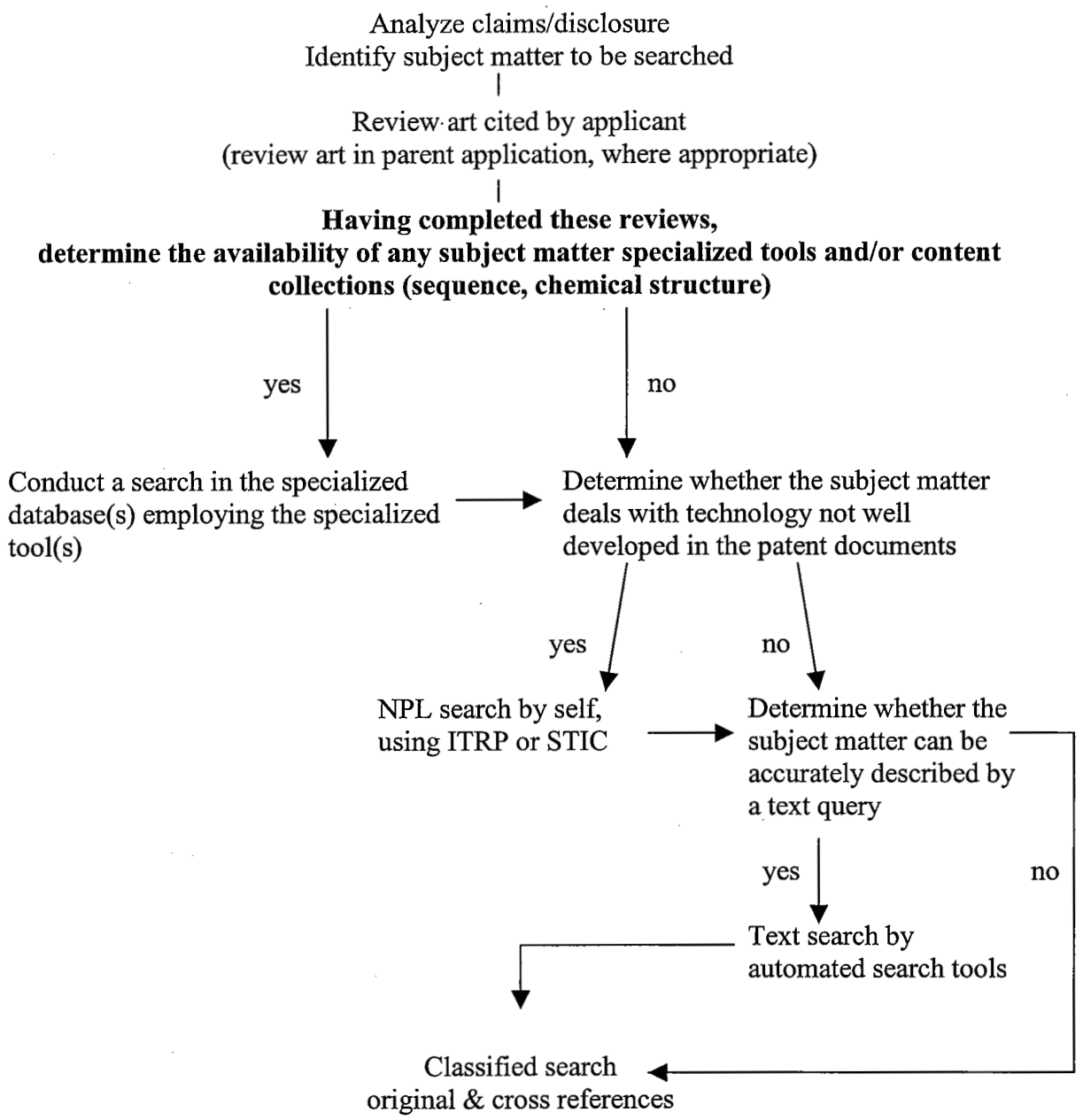
In outlining a field of search, the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross-reference art collection pertinent 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 [R-3]

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 Center (TC). However, a general methodology following a “decision tree” process, set forth below, for making broad decisions in search tool selection is suggested.

**>


Analyze claims/disclosure
Identify subject matter to be searched
Review art cited by applicant
(review art in parent application, where appropriate)
Having completed these reviews,
determine the availability of any subject matter specialized tools and/or content collections (sequence, chemical structure)
yes
no
Conduct a search in the specialized database(s) employing the specialized tool(s)
Determine whether the subject matter deals with technology not well developed in the patent documents
yes
no
NPL search by self, using ITRP or STIC
Determine whether the subject matter can be accurately described by a text query
yes
no
Text search by automated search tools
Classified search
original & cross references

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904.02(c) Internet Searching [R-3]

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. >Note that a reissue application, a reexamination proceeding, and an application that has been published pursuant to 35 U.S.C. 122(b) need not be kept in confidence; therefore, the restriction on the search queries used when performing an Internet search referenced in Article 9 below would not apply to these applications and proceedings. USPTO personnel may use the Internet to search, browse, or retrieve information relating to the claimed invention(s) of a published application, a reissue application, or a reexamination proceeding.< 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 sufficiently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

905 Miscellaneous

905.03 Ordering of Patented and Abandoned Provisional and Nonprovisional Application Files [R-5]

In the examination of an application>,< it is sometimes necessary to inspect the application papers of some previously abandoned application (provisional or nonprovisional) 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. Older files are housed in remote warehouses located in Maryland and Virginia. If the patented or abandoned file is an Image File Wrapper (IFW) file, examiners can view the application papers from their desktop via the Patent Examiner's Toolkit.

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 **>the examiner< of the status of the request for each file. The examiner is informed that the request

(A) is accepted;

(B) is accepted, but ** 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.

905.06 Patent Family Information [R-3]

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).

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I. < 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.

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II. < 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. **>For STIC services, see MPEP § 901.06(a), paragraph IV.<

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