

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

MANUAL OF PATENT EXAMINING PROCEDURE
Eighth Edition

Instructions Regarding Revision No. 8

Appendix R has been updated to incorporate the following final rules and final rule corrections:

- (1) Changes to Representation of Others Before the United States Patent and Trademark Office, which became effective on September 15, 2008;
- (2) Revision of Patent Fees for Fiscal Year 2009, which became effective on October 2, 2008;
- (3) Changes to Representation of Others Before the United States Patent and Trademark Office (final rule corrections), which became effective on October 9, 2008;
- (4) Changes to Representation of Others Before the United States Patent and Trademark Office, which became effective on December 17, 2008;
- (5) Fiscal Year 2009 Changes to Patent Cooperation Treaty Transmittal and Search Fees, which became effective on January 12, 2009;
- (6) Miscellaneous Changes to Trademark Rules of Practice, which became effective on January 16, 2009;
- (7) July 2009 Revision of Patent Cooperation Treaty Procedures, which became effective on July 1, 2009;
- (8) Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, which became effective on October 14, 2009 (to remove changes made by the final rules in 72 FR 46716);
- (9) Cancellation of Rule of Practice 41.200(b) Before the Board of Patent Appeals and Interferences in Interference Proceedings, which became effective on April 15, 2010; and
- (10) Correspondence With the United States Patent and Trademark Office, which became effective on June 25, 2010.

This revision consists of replacement pages for the **Title Page** in the front of the Manual, **entire Chapters 300, 500, 1200 and 1700, Appendix R – Patent Rules, and entire Index.**

Pages which have been printed in this revision are labeled as “**Rev. 8**” on the bottom. Sections of the Manual that have been changed by this revision are indicated by “[**R-8**]” after the section title. Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule that was not reproduced.

Magdalen Y. C. Greenlief, Editor
Manual of Patent Examining Procedure

Remove Pages

Title Page

300-1 through 300-28

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Particular attention is called to the changes in the following sections:

CHAPTER 300:

- 301.01 Revised to change web to “Web.”
- 302.07 Revised to update 37 CFR 3.31(a)(8) and (f). Updated form PTO-1595.
- 302.09 Revised to change web to “Web.”
- 302.10 Revised to update 37 CFR 1.4(d)(2), (d)(3) and (d)(4). Revised to change web to “Web” and to add a reference to the USPTO Web site for information concerning EPAS. Revised to indicate that electronic submission of assignment documents must be done via EPAS since it is no longer permitted to submit assignment documents via EFS.
- 307 Revised to change website to “Web site.”
- 310 Revised to be consistent with the language in 35 U.S.C. 202(c)(6) and 37 CFR 401.14(f)(4).
- 323 Revised to delete the requirement that the person signing the new recordation form cover sheet must state that information provided on the new cover sheet is true and correct to be consistent with 37 CFR 3.31 and 37 CFR 11.18.
- 324 Revised to clarify that the Office will resolve procedural issues but not ownership questions. Form PTO/SB/96 has been updated.

CHAPTER 500:

- 501 Revised to update 37 CFR 1.1(a)(3)(ii), (a)(3)(iii), 1.4(d)(2), (d)(3) and (d)(4). Revised to change the Office of Patent Publication to “Office of Data Management.” Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Addresses for the Madrid Processing Unit, Office of the General Counsel, Office of the Solicitor, maintenance fee payment, and replenishing deposit accounts have been updated.
- 502 Revised to update 37 CFR 1.6(a)(4) and (g). Revised to add a cross-reference to MPEP § 502.05 regarding information concerning EFS-Web. Revised to change the Office of Patent Publication to “Office of Data Management.” Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Addresses for the File Information Unit (FIU), Office of Public Records, and the Office of Data Management have been updated.
- 502.01 Revised to indicate that correspondence such as a draft proposed amendment should be made of record as part of the interview summary record. Revised to change the Office of Patent Publication to “Office of Data Management.” The

fax number for the Office of Pre-Grant Publication has been deleted. The out-dated Web address for assignment information has been deleted.

- 502.02 Revised to update 37 CFR 1.4(d)(2), (d)(3) and (d)(4). Revised to delete reference and discussion regarding EFS character coded signature to be consistent with 37 CFR 1.4(d)(3). References to 37 CFR 10.18 have been changed to “37 CFR 11.18” to be consistent with the rule.
- 502.03 The title has been revised to refer to electronic mail (e-mail).
- 502.05 New section added to incorporate the EFS-Web legal framework published in the Federal Register on October 27, 2009 at 74 FR 55200.
- 503 Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Revised to update the series codes assigned to applications. Revised to indicate that the PALM data base allows a maximum of 25 characters for attorney docket numbers. Revised to add a cross-reference to MPEP § 502.05 regarding electronic acknowledgement receipt for EFS-Web filings.
- 504 Revised to change the Office of Initial Patent Examination to “Office of Patent Application Processing.”
- 505 Revised to add a cross-reference to MPEP § 502.05 regarding EFS-Web filing.
- 506 Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).”
- 506.02 Revised to change the Office of the Deputy Commissioner for Patent Examination Policy to “Office of the Associate Commissioner for Patent Examination Policy.” Revised to delete the statement that petitions relating to the filing date accorded to design applications are decided by Technology Center 2900.
- 507 Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).”
- 508.03 Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Revised to change the Office of Patent Publication to “Office of Data Management.”
- 508.04 Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Revised to delete the reference to PACR. Reference to 37 CFR 10.18 has been changed to “37 CFR 11.18” to be consistent with the rule.
- 509 Form PTO-2038 has been updated.
- 509.01 Revised to update 37 CFR 1.25(c)(3). The address for replenishing deposit accounts has been updated.

- 509.03 Revised to update 37 CFR 1.4(d)(4) and 37 CFR 11.18(b). Reference to 37 CFR 10.18 has been changed to “37 CFR 11.18” to be consistent with the rule.
- 510 Revised to add reference to 37 CFR Part 11. Revised to change the Deputy Commissioner for Patent Operations to “Deputy Commissioner for Patents.”
- 511 Revised to change web to “Web.”
- 512 Revised to update 37 CFR 1.8. Revised to add a “Certificate of EFS-Web Transmission.” Form paragraph has been revised. Revised to change the Office of Initial Patent Examination (OIPE) to “Office of Patent Application Processing (OPAP).” Revised to change the Office of Patent Publication to “Office of Data Management.” Revised to add discussion regarding a receipt date for EFS-Web transmission under 37 CFR 1.6(a)(4).
- 513 Revised to update 37 CFR 1.6(a)(4).

Chapter 1200:

- 1203 Revised to add discussion regarding the Patent Appeal Center. Revised to delete discussion regarding what formalities the Board will review when receiving an application from the patent examining corps.
- 1204 Form PTO/SB/31 has been updated.
- 1205.01 Revised to add form paragraphs.
- 1205.02 Revised to add a reference to the USPTO Web page where the checklist for notices of appeal and appeal briefs is posted. Under the subheading “Claims appendix,” revised to add a reference to reexamination proceeding to be consistent with 37 CFR 1.530(d) and (f).
- 1205.03 Revised to incorporate the notice, “Streamlined Procedure for Appeal Brief Review,” published in the Federal Register on March 30, 2010 at 75 FR 15689 and the memo entitled “Revised Procedure for Appeal Brief Review” dated March 29, 2010 and posted at http://www.uspto.gov/patents/law/exam/bpai_revised_procedure_20100329.pdf. Forms PTOL-462 and PTOL-462R and some form paragraphs have been deleted to be consistent with the memo.
- 1206 Reference to 37 CFR 41.33(a)(2) has been corrected to “37 CFR 41.33(b)(2).”
- 1207.02 Revised to be consistent with the memo entitled “Revised Procedure for Appeal Brief Review” dated March 29, 2010 and the memo entitled “Machine Translation of a Non-English Document Being Relied Upon by the Examiner in Support of a Rejection in an Examiner’s Answer” dated November 17, 2009. Form paragraphs have been revised.

- 1207.04 Form paragraph has been updated.
- 1213.03 Revised to change web to “Web.”
- 1214.01 Reference to 37 CFR 1.96(f) has been corrected to “37 CFR 41.50(f).”
- 1214.06 The procedures as to what the examiners should do if no timely reply is received under subsection I., item (B)(2) have been corrected. Form paragraph has been updated.
- 1215.04 Revised to clarify what appropriate actions the examiner should take if only formal matters remained. Form paragraph has been updated.
- 1216 Revised subsection II. to be consistent with Public Law 106-113 and 107-273 and MPEP § 2279. Revised to update the address for the Office of the Solicitor.

Chapter 1700:

- 1703 Revised to change web to “Web.”
- 1704 Revised to update references to docket reports and examiners’ Web time and attendance.
- 1705 Revised to update the examiner’s case action worksheet and the examiner’s activities recordation.
- 1706 Section deleted in view of the elimination of the disclosure document program on February 1, 2007.
- 1721 Revised to update the titles of the Deputy Commissioner for Patents and the Associate Commissioner for Patent Examination Policy.
- 1730 Details of the EFS-Web filings have been deleted and a cross-reference to MPEP § 502.05 has been added. Revised to add the address for the File Information Unit and to add a reference to the Application Assistance Unit. Revised to change web to “Web.”