

MPEP Search Strategy

Instructions	2
100 Secrecy, Access, National Security, and Foreign Filing	3
200 Types, Cross-Noting, and Status of Application	5
300 Ownership and Assignment	7
400 Representative of Inventor or Owner	9
500 Receipt and Handling of Mail and Papers	11
600 Parts, Form, and Content of Application	12
700 Examination of Applications	17
800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting	24
900 Prior Art, Classification, and Search	27
1000 Matters Decided by Various U.S. Patent and Trademark Office Officials	30
1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)	32
1200 Appeal	34
]1300 Allowance and Issue	35
1400 Correction of Patents	38
1500 Design Patents	41
1600 Plant Patents	43
1700 Miscellaneous	45
1800 Patent Cooperation Treaty	46
1900 Protest	51
2000 Duty of Disclosure	53
2100 Patentability	55
2200 Citation of Prior Art and Ex Parte Reexamination of Patents	60
2300 Interference Proceedings	63
2400 Biotechnology	65
2500 Maintenance Fees	68
2600 Optional Inter Partes Reexamination	70
2700 Patent Terms and Extensions	74

### Instructions

For each chapter memorize the subsections included here and know where they are located in our searchable electronic MPEP. This is the best way to ensure that you can quickly and efficiently search for the answers to questions that you are unsure of during the patent bar exam.

100 Secrecy, Access, National Security, and Foreign Filing

- 100 Secrecy, Access, National Security, and Foreign Filing
- 101 General
- 102 Information as to Status of an Application
- 103 Right of Public To Inspect Patent Files and Some Application Files
- 104 Power to Inspect Application
- 105 Suspended or Excluded Practitioner Cannot Inspect
- 106 Control of Inspection by Assignee
  - 106.01 Rights of Assignee of Part Interest
- 110 Confidential Nature of International Applications
- 115 Review of Applications for National Security and Property Rights Issues
- 120 Secrecy Orders
- 121 Handling of Applications and Other Papers Bearing Security Markings
- 130 Examination of Secrecy Order Cases
- 140 Foreign Filing Licenses
- 150 Statements to DOE and NASA
- 151 Content of the Statements

200 Types, Cross-Noting, and Status of Application

```
200 Types, Cross-Noting, and Status of Application
201 Types of Applications [R-3]
       201.01 Sole
       201.02 Joint
       201.03 Correction of Inventorship in an Application [R-3]
       201.04 Parent Application
       201.04(a) Original Application
        201.04(b) Provisional Application [R-3]
       201.05 Reissue Application [R-3]
       201.06 Divisional Application
       201.06(a) Former 37 CFR 1.60 Divisional-Continuation Procedure
       201.06(b) Former 37 CFR 1.62 File Wrapper Continuing Procedure
       201.06(c) 37 CFR 1.53(b) and 37 CFR 1.63(d) Divisional-Continuation Procedure [R-3]
        201.06(d) 37 CFR 1.53(d) Continued Prosecution Application (CPA) Practice [R-3]
       201.07 Continuation Application [R-3]
       201.08 Continuation-in-Part Application (CIP)[R-3]
       201.09 Substitute Application [R-3]
       201.10 Refile
       201.11 Claiming the Benefit of an Earlier Filing Date Under 35 U.S.C. 120 and 119(e) [R-
       201.11(a) Filing of Continuation or CIP Application During Pendency of International
       Application Designating the U.S. [R-3]
       201.12 Title to an Application Claiming Benefit of an Earlier Application [R-3]
       201.13 Right of Priority of Foreign Application [R-3]
       201.13(a) Right of Priority Based Upon an Application for an Inventor's Certificate
       201.13(b) Right of Priority Based Upon an International Application Filed Under the PCT
       201.14 Right of Priority, Formal Requirements
       201.14(a) Right of Priority, Time for Filing Papers [R-3]
       201.14(b) Right of Priority, Papers Required
       201.14(c) Right of Priority, Practice [R-3]
       201.14(d) Proper Identification of Priority Application
       201.15 Right of Priority, Overcoming a Reference
       201.16 Using Certificate of Correction to Perfect Claim for Priority Under 35 U.S.C.
        119(a)-(d) or (f)
        201.17 Incorporation by Reference Under 37 CFR 1.57(a) [R-3]
202 Cross-Noting
       202.02 Notation in File History Regarding Prior U.S. Applications, Including Provisional
       Applications [R-3]
        202.03 Notation on File Wrapper When Priority Is Claimed for Foreign Application [R-3]
       202.04 In Oath or Declaration
203 Status of Applications
       203.01 New
       203.02 Rejected
       203.03 Amended
       203.04 Allowed or in Issue
       203.05 Abandoned [R-3]
       203.06 Incomplete [R-3]
       203.08 Status Inquiries
```

203.08(a) Congressional and Other Official Inquiries [R-3]

**300 Ownership and Assignment** 

```
300 Ownership and Assignment
301 Ownership/Assignability of Patents and Applications [R-3]
       301.01 Accessibility of Assignment Records [R-3]
302 Recording of Assignment Documents [R-3]
       302.01 Assignment Document Must Be Copy for Recording [R-3]
       302.02 Translation of Assignment Document
       302.03 Identifying Patent or Application [R-3]
       302.04 Foreign Assignee May Designate Domestic Representative [R-3]
       302.05 Address of Assignee
       302.06 Fee for Recording [R-3]
       302.07 Assignment Document Must Be Accompanied by a Cover Sheet [R-3]
       302.08 Mailing Address for Submitting Assignment Documents [R-3]
       302.09 Facsimile Submission of Assignment Documents [R-3]
       302.10 Electronic Submission of Assignment Documents [R-3]
303 Assignment Documents Not Endorsed on Pending Applications
306 Assignment of Division, Continuation, Substitute, and Continuation-in-Part in Relation to
Parent Application [R-3]
       306.01 Assignment of an Application Claiming the Benefits of a Provisional Application
[R-3]
307 Issue to Assignee [R-3]
309 Restrictions Upon Employees of U.S. Patent and Trademark Office [R-3]
310 Government License Rights to Contractor-Owned Inventions Made Under Federally
Sponsored Research and Development [R-3]
311 Filing of Notice of Arbitration Awards [R-3]
313 Recording of Licenses, Security Interests, and Other Documents Other Than Assignments
[R-3]
314 Certificates of Change of Name or of Merger
315 Indexing Against a Recorded Certificate [R-3]
317 Handling of Documents in the Assignment Division [R-3]
       317.01 Recording Date
       317.02 Correction of Unrecorded Returned Documents and Cover Sheets [R-3]
       317.03 Effect of Recording
318 Documents Not to be Placed in Files
320 Title Reports [R-3]
323 Procedures for Correcting Errors in Recorded Assignment Document [R-3]
       323.01 Correction of Error in Recorded Cover Sheet [R-3]
       323.01(a) Typographical Errors in Cover Sheet [R-3]
       323.01(b) Typographical Errors in Recorded Assignment Document [R-3]
       323.01(c) Assignment or Change of Name Improperly Filed and Recorded by Another
       Person Against Owner's Application or Patent [R-3]
       323.01(d) Expungement of Assignment Records [R-3]
324 Establishing Right of Assignee To Take Action [R-3]
```

400 Representative of Inventor or Owner

```
400 Representative of Inventor or Owner
401 U.S. Patent and Trademark Office Cannot Aid in Selection of Attorney [R-3]
402 Power of Attorney; Acting in a Representative Capacity [R-3]
       402.01 Exceptions as to Registration [R-3]
       402.02 Appointment of Associate Attorney or Agent [R-3]
       402.05 Revocation [R-3]
       402.06 Attorney or Agent Withdraws [R-3]
       402.07 Assignee Can Revoke Power of Attorney of Applicant and Appoint New Power of
       Attorney [R-3]
       402.08 Application in Interference
       402.09 International Application [R-3]
       402.10 Appointment/Revocation by Less Than All Applicants or Owners [R-3]
403 Correspondence - With Whom Held [R-3]
       403.01 Correspondence Held With Associate Attorney [R-3]
       403.02 Two Attorneys for Same Application [R-3]
404 Conflicting Parties Having Same Attorney
405 Attorney Not of Record [R-3]
406 Death of Attorney
407 Suspended or Excluded Practitioner [R-3]
408 Telephoning Attorney [R-3]
409 Death, Legal Incapacity, or Unavailability of Inventor [R-3]
       409.01 Death of Inventor
       409.01(a) Prosecution by Administrator or Executor
       409.01(b) Proof of Authority of Administrator or Executor
       409.01(c) After Administrator or Executor Has Been Discharged
       409.01(d) Exception in Some Foreign Countries
       409.01(e) If Applicant of Assigned Application Dies
       409.01(f) Intervention of Executor Not Compulsory
       409.02 Insanity or Other Legal Incapacity [R-3]
       409.03 Unavailability of Inventor [R-3]
       409.03(a) At Least One Joint Inventor Available
       409.03(b) No Inventor Available
       409.03(c) Legal Representatives of Deceased Inventor Not Available
       409.03(d) Proof of Unavailability or Refusal [R-3]
       409.03(e) Statement of Last Known Address
       409.03(f) Proof of Proprietary Interest
       409.03(g) Proof of Irreparable Damage
       409.03(h) Processing and Acceptance of a 37 CFR 1.47 Application [R-3]
       409.03(i) Rights of the Nonsigning Inventor [R-3]
       409.03(j) Action Following Acceptance of a 37 CFR 1.47 Application [R-3]
410 Representations to the U.S. Patent and Trademark Office [R-3]
```

500 Receipt and Handling of Mail and Papers

```
500 Receipt and Handling of Mail and Papers
501 Filing Papers With the U.S. Patent and Trademark Office [R-3]
502 Depositing Correspondence [R-3]
502.01 Correspondence Transmitted by Facsimile [R-3]
502.02 Correspondence Signature Requirements [R-3]
502.03 Communications via the Internet
502.04 Duplicate Copies of Correspondence
503 Application Number and Filing Receipt [R-3]
504 Assignment of Application for Examination
505 "Office Date" Stamp of Receipt [R-3]
506 Completeness of Original Application [R-3]
506.02 Review of Refusal To Accord Filing Date [R-3]
507 Drawing Review in the Office of Initial Patent Examination [R-3]
508 Distribution
508.01 Papers Sent to Wrong Technology Center (TC)
508.02 Papers Received After Patenting or Abandonment
508.03 Unmatched Papers
508.04 Unlocatable Patent or Application Files [R-3]
509 Payment of Fees [R-3]
509.01 Deposit Accounts [R-3]
509.02 Small Entity Status - Definitions [R-3]
509.03 Claiming Small Entity Status [R-3]
510 U.S. Patent and Trademark Office Business Hours [R-3]
511 Postal Service Interruptions and Emergencies [R-3]
512 Certificate of Mailing or Transmission [R-3]
513 Deposit as Express Mail with U.S. Postal Service [R-3
]
```

600 Parts, Form, and Content of Application

```
600 Parts, Form, and Content of Application
601 Content of Provisional and Nonprovisional Applications [R-3]
       601.01 Complete Application [R-3]
       601.01(a) Nonprovisional Applications Filed Under 35 U.S.C. 111(a) [R-3]
       601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b) [R-3]
       601.01(c) Conversion to or From a Provisional Application [R-3]
       601.01(d) Application Filed Without All Pages of Specification [R-3]
       601.01(e) Nonprovisional Application Filed Without At Least One Claim [R-3]
       601.01(f) Applications Filed Without Drawings [R-3]
       601.01(g) Applications Filed Without All Figures of Drawings [R-3]
       601.01(h) Forms
       601.02 Power of Attorney [R-3]
       601.03 Change of Correspondence Address [R-3]
       601.04 National Stage Requirements of the United States as a Designated Office
       601.05 Bibliographic Information - Application Data Sheet (ADS) [R-3]
602 Original Oath or Declaration [R-3]
       602.01 Oath Cannot Be Amended
       602.02 New Oath or Substitute for Original
       602.03 Defective Oath or Declaration
       602.04 Foreign Executed Oath
       602.04(a) Foreign Executed Oath Is Ribboned to Other Application Papers
       602.05 Oath or Declaration - Date of Execution
       602.05(a) Oath or Declaration in Continuation and Divisional Applications [R-3]
       602.06 Non-English Oath or Declaration [R-3]
        602.07 Oath or Declaration Filed in United States as a Designated Office [R-3]
603 Supplemental Oath or Declaration
       603.01 Supplemental Oath or Declaration Filed After Allowance
604 Administration or Execution of Oath
       604.01 Seal [R-3]
       604.02 Venue
       604.03(a) Notarial Powers of Some Military Officers
       604.04 Consul
       604.04(a) Consul - Omission of Certificate
       604.06 By Attorney in Application
605 Applicant
       605.01 Applicant's Citizenship
       605.02 Applicant's Residence
       605.03 Applicant's Mailing or Post Office Address
       605.04(a) Applicant's Signature and Name
       605.04(b) One Full Given Name Required [R-3]
       605.04(c) Inventor Changes Name [R-3]
       605.04(d) Applicant Unable to Write
       605.04(e) May Use Title With Signature
       605.04(f) Signature on Joint Applications - Order of Names [R-3]
       605.04(g) Correction of Inventorship
       605.05 Administrator, Executor, or Other Legal Representative
       605.07 Joint Inventors
606 Title of Invention
        606.01 Examiner May Require Change in Title
607 Filing Fee [R-3]
       607.02 Returnability of Fees
608 Disclosure
       608.01 Specification [R-3]
               608.01(a) Arrangement of Application [R-3]
               608.01(b) Abstract of the Disclosure [R-3]
               608.01(c) Background of the Invention
```

```
608.01(d) Brief Summary of Invention
               608.01(e) Reservation Clauses Not Permitted
               608.01(f) Brief Description of Drawings [R-3]
               608.01(g) Detailed Description of Invention
               608.01(h) Mode of Operation of Invention
               608.01(i) Claims [R-3]
               608.01(j) Numbering of Claims
               608.01(k) Statutory Requirement of Claims
               608.01(I) Original Claims
               608.01(m) Form of Claims [R-3]
               608.01(n) Dependent Claims [R-3]
               608.01(o) Basis for Claim Terminology in Description [R-3]
               608.01(p) Completeness [R-3]
               608.01(g) Substitute or Rewritten Specification [R-3]
               608.01(r) Derogatory Remarks About Prior Art in Specification
               608.01(s) Restoration of Canceled Matter
               608.01(t) Use in Subsequent Application
               608.01(u) Use of Formerly Filed Incomplete Application [R-3]
               608.01(v) Trademarks and Names Used in Trade
       608.02 Drawing [R-3]
               608.02(a) New Drawing - When Replacement is Required Before Examination
               608.02(b) Informal Drawings [R-3]
               608.02(c) Drawing Print Kept in File Wrapper
               608.02(d) Complete Illustration in Drawings [R-3]
               608.02(e) Examiner Determines Completeness and Consistency of Drawings [R-
               31
               608.02(f) Modifications in Drawings [R-3]
               608.02(g) Illustration of Prior Art [R-3]
               608.02(h) Replacement Drawings [R-3]
               608.02(i) Transfer of Drawings From Prior Applications
               608.02(m) Drawing Prints [R-3]
               608.02(n) Duplicate Prints in Patentability Report Applications
               608.02(o) Notations Entered on Drawing
               608.02(p) Correction of Drawings [R-3]
               608.02(g) Conditions Precedent to Amendment of Drawing
               608.02(t) Cancelation of Figures
               608.02(v) Drawing Changes Which Require Annotated Sheets
               608.02(w) Drawing Changes Which May Be Made Without Applicant's Annotated
               Sheets
               608.02(x) Drawing Corrections or Changes Accepted Unless Notified Otherwise
               608.02(y) Return of Drawing
               608.02(z) Allowable Applications Needing Drawing Corrections or Corrected
               Drawings [R-3]
       608.03 Models, Exhibits, Specimens [R-3]
               608.03(a) Handling of Models, Exhibits, and Specimens [R-3]
       608.04 New Matter
               608.04(a) Matter Not in Original Specification, Claims, or Drawings
               608.04(b) New Matter by Preliminary Amendment [R-3]
               608.04(c) Review of Examiner's Holding of New Matter
       608.05 Sequence Listing Table, or Computer Program Listing Appendix Submitted on a
Compact Disc [R-3]
               608.05(a) Deposit of Computer Program Listings [R-3]
               608.05(b) Compact Disc Submissions of Large Tables [R-3]
               608.05(c) Compact Disc Submissions of Biosequences
609 Information Disclosure Statement [R-3]
       609.01 Examiner Checklist for Information Disclosure Statements [R-3]
```

609.02 Information Disclosure Statements in Continued Examinations or Continuing Applications [R-3]
609.03 Information Disclosure Statements in National Stage Applications [R-3]
609.04(a) Content Requirements for an Information Disclosure Statement [R-3]
609.04(b) Timing Requirements for an Information Disclosure Statement [R-3]
609.05 Examiner Handling of Information Disclosure Statements [R-3]
609.05(a) Noncomplying Information Disclosure Statements [R-3]

609.05(b) Complying Information Disclosure Statements [R-3] 609.05(c) Documents Submitted as Part of Applicant's Reply to Office Action [R-3]

609.06 Information Printed on Patent [R-3]
609.07 IDSs Electronically Submitted (e-IDS) Using EFS [R-3]

# 700 Examination of Applications

```
700 Examination of Applications
701 Statutory Authority for Examination
702 Requisites of the Application [R-3]
       702.01 Obviously Informal Cases
703 "General Information Concerning Patents"
704 Search and Requirements for Information
       704.01 Search
       704.10 Requirements for Information [R-3]
       704.11 What Information May Be Required [R-3]
               704.11(a) Examples of Information Reasonably Required [R-3]
               704.11(b) When May a Requirement for Information Be Made
       704.12 Replies to a Requirement for Information
               704.12(a) Relationship of Requirement for Information to Duty of Disclosure
               704.12(b) What Constitutes a Complete Reply [R-3]
               704.12(c) Treatment of an Incomplete Reply
       704.13 Time Periods for Reply
       704.14 Making a Requirement for Information
               704.14(a) Format of the Requirement [R-3]
               704.14(b) Examiner's Obligation Following Applicant's Reply
               704.14(c) Petitions to Requirements Under 37 CFR 1.105
               704.14(d) Relationship to Information Disclosure Statements [R-3]
705 Patentability Reports [R-3]
       705.01 Instructions re Patentability Reports
               705.01(a) Nature of P.R., Its Use and Disposal [R-3]
               705.01(b) Sequence of Examination
               705.01(c) Counting and Recording P.R.s
               705.01(d) Duplicate Prints of Drawings
               705.01(e) Limitation as to Use
               705.01(f) Interviews With Applicants
706 Rejection of Claims [R-3]
       706.01 Contrasted With Objections
       706.02 Rejection on Prior Art [R-3]
               706.02(a) Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or
               Patent [R-3]
               706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication
               or Patent [R-3]
               706.02(c) Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or
               Public Use or Sale
               706.02(d) Rejections Under 35 U.S.C. 102(c)
               706.02(e) Rejections Under 35 U.S.C. 102(d)
               706.02(f) Rejection Under 35 U.S.C. 102(e) [R-3]
               706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C.
               102(e) [R-3]
               706.02(f)(2) Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a
               Copending U.S. Patent Application [R-3]
               706.02(g) Rejections Under 35 U.S.C. 102(f)
               706.02(h) Rejections Under 35 U.S.C. 102(a)
               706.02(i) Form Paragraphs for Use in Rejections Under 35 U.S.C. 102 [R-3]
               706.02(j) Contents of a 35 U.S.C. 103 Rejection
               706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103 [R-3]
               706.02(I) Rejections Under 35 U.S.C. 103(a) Using Prior Art Under Only 35
               U.S.C. 102 (e), (f), or (g)
                       706.02(I)(1) Rejections Under 35 U.S.C. 103(a) Using Prior Art Under 35
                       U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under 35 U.S.C.
```

706.02(I)(2) Establishing Common Ownership or Joint Research

103(c) [R-3]

Agreement [R-3] 706.02(I)(3) Examination Procedure With Respect to 35 U.S.C. 103(c) 706.02(m) Form Paragraphs for Use in Rejections Under 35 U.S.C. 103 [R-3] 706.02(n) Biotechnology Process Applications; 35 U.S.C. 103(b) 706.03 Rejections Not Based on Prior Art 706.03(a) Rejections Under 35 U.S.C. 101 [R-3] 706.03(b) Barred by Atomic Energy Act 706.03(c) Rejections Under 35 U.S.C. 112, First Paragraph 706.03(d) Rejections Under 35 U.S.C. 112, Second Paragraph [R-3] 706.03(k) Duplicate Claims 706.03(m) Nonelected Inventions 706.03(o) New Matter [R-3] 706.03(s) Foreign Filing Without License 706.03(u) Disclaimer [R-3] 706.03(v) After Interference or Public Use Proceeding 706.03(w) Res Judicata 706.03(x) Reissue [R-3] 706.04 Rejection of Previously Allowed Claims 706.05 Rejection After Allowance of Application 706.06 Rejection of Claims Copied From Patent [R-3] 706.07 Final Rejection [R-3] 706.07(a) Final Rejection, When Proper on Second Action [R-3] 706.07(b) Final Rejection, When Proper on First Action 706.07(c) Final Rejection, Premature 706.07(d) Final Rejection, Withdrawal of, Premature 706.07(e) Withdrawal of Final Rejection, General 706.07(f) Time for Reply to Final Rejection [R-3] 706.07(g) Transitional After-Final Practice [R-3] 706.07(h) Request for Continued Examination (RCE) Practice [R-3] 707 Examiner's Letter or Action [R-3] 707.01 Primary Examiner Indicates Action for New Assistant 707.02 Applications Up for Third Action and 5-Year Applications 707.05 Citation of References [R-3] 707.05(a) Copies of Cited References [R-3] 707.05(b) Citation of Related Art and Information by Applicants 707.05(c) Order of Listing 707.05(d) Reference Cited in Subsequent Actions 707.05(e) Data Used in Citing References 707.05(f) Effective Dates of Declassified Printed Matter 707.05(g) Incorrect Citation of References [R-3] 707.06 Citation of Decisions, Orders Memorandums, and Notices 707.07 Completeness and Clarity of Examiner's Action 707.07(a) Complete Action on Formal Matters [R-3] 707.07(b) Requiring New Oath 707.07(c) Draftsperson's Requirement 707.07(d) Language To Be Used in Rejecting Claims 707.07(e) Note All Outstanding Requirements 707.07(f) Answer All Material Traversed [R-3] 707.07(g) Piecemeal Examination 707.07(h) Notify of Inaccuracies in Amendment 707.07(i) Each Claim To Be Mentioned in Each Office Action [R-3] 707.07(j) State When Claims Are Allowable 707.07(k) Numbering Paragraphs 707.07(I) Comment on Examples

707.08 Reviewing and Initialing by Assistant Examiner [R-3]

```
707.09 Signing by Primary or Other Authorized Examiner
       707.10 Entry
       707.11 Date
       707.12 Mailing
       707.13 Returned Office Action [R-3]
708 Order of Examination
       708.01 List of Special Cases
       708.02 Petition To Make Special [R-3]
       708.03 Examiner Tenders Resignation
709 Suspension of Action [R-3]
       709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee [R-3]
710 Period for Reply
       710.01 Statutory Period [R-3]
       710.01(a) Statutory Period, How Computed
       710.02 Shortened Statutory Period and Time Limit Actions Computed [R-3]
               710.02(b) Shortened Statutory Period: Situations in Which Used [R-3]
               710.02(c) Specified Time Limits: Situations in Which Used [R-3]
               710.02(d) Difference Between Shortened Statutory Periods for Reply and
               Specified Time Limits [R-3]
               710.02(e) Extension of Time [R-3]
       710.04 Two Periods Running [R-3]
               710.04(a) Copying Patent Claims [R-3]
       710.05 Period Ending on Saturday, Sunday, or a Federal Holiday
       710.06 Situations When Reply Period Is Reset or Restarted [R-3]
711 Abandonment of Patent Application [R-3]
       711.01 Express or Formal Abandonment [R-3]
       711.02 Failure To Take Required Action During Statutory Period [R-3]
               711.02(a) Insufficiency of Reply
               711.02(b) Special Situations Involving Abandonment [R-3]
               711.02(c) Termination of Proceedings
       711.03 Reconsideration of Holding of Abandonment; Revival
               711.03(a) Holding Based on Insufficiency of Reply
               711.03(b) Holding Based on Failure To Reply Within Period
               711.03(c) Petitions Relating to Abandonment [R-3]
               711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding
       711.04 Public Access to Abandoned Applications
               711.04(a) Pulling and Forwarding Abandoned Applications
               711.04(b) Ordering of Patented and Abandoned Files
               711.04(c) Notifying Applicants of Abandonment
       711.05 Letter of Abandonment Received After Application Is Allowed
       711.06 Abstracts, Abbreviatures, and Defensive Publications
               711.06(a) Citation and Use of Abstracts, Abbreviatures, and Defensive
       Publications as References
713 Interviews
       713.01 General Policy, How Conducted [R-3]
       713.02 Interviews Prior to First Official Action
       713.03 Interview for "Sounding Out" Examiner Not Permitted
       713.04 Substance of Interview Must Be Made of Record [R-3]
       713.05 Interviews Prohibited or Granted, Special Situations
       713.06 No Inter Partes Questions Discussed Ex Parte
       713.07 Exposure of Other Cases
       713.08 Demonstration, Exhibits, Models [R-3]
       713.09 Finally Rejected Application
       713.10 Interview Preceding Filing Amendment Under 37 CFR 1.312
714 Amendments, Applicant's Action [R-3]
       714.01 Signatures to Amendments
```

714.01(a) Unsigned or Improperly Signed Amendment [R-3]

714.01(c) Signed by Attorney or Agent Not of Record

714.01(d) Amendment Signed by Applicant but Not by Attorney or Agent of Record

714.01(e) Amendments Before First Office Action [R-3]

714.02 Must Be Fully Responsive [R-3]

714.03 Amendments Not Fully Responsive, Action To Be Taken [R-3]

714.03(a) Supplemental Amendment [R-3]

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty

714.05 Examiner Should Immediately Inspect [R-3]

714.06 Amendments Sent to Wrong Technology Center

714.07 Amendments Not in Permanent Ink [R-3]

714.10 Claims Added in Excess of Claims Previously Paid For [R-3]

714.11 Amendment Filed During Interference Proceedings [R-3]

714.12 Amendments and Other Replies After Final Rejection or Action [R-3]

714.13 Amendments and Other Replies After Final Rejection or Action, Procedure Followed [R-3]

714.14 Amendments After Allowance of All Claims [R-3]

714.15 Amendment Received in Technology Center After Mailing of Notice of Allowance [R-3]

714.16 Amendment After Notice of Allowance, 37 CFR 1.312 [R-3]

714.16(a) Amendments Under 37 CFR 1.312, Copied Patent Claims [R-3]

714.16(b) Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR 41.208 [R-3]

714.16(c) Amendments Under 37 CFR 1.312, Additional Claims

714.16(d) Amendments Under 37 CFR 1.312, Handling [R-3]

714.16(e) Amendments Under 37 CFR 1.312, Entry in Part [R-3]

714.17 Amendment Filed After the Period for Reply Has Expired [R-3]

714.18 Entry of Amendments [R-3]

714.19 List of Amendments, Entry Denied [R-3]

714.20 List of Amendments Entered in Part

714.21 Amendments Inadvertently Entered, No Legal Effect

714.25 Discourtesy of Applicant or Attorney

715 Swearing Back of Reference - Affidavit or Declaration Under 37 CFR 1.131 [R-3]

715.01 37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits

715.01(a) Reference Is a Joint Patent or Published Application to Applicant and Another

715.01(b) Reference and Application Have Common Assignee

715.01(c) Reference Is Publication of Applicant's Own Invention

715.01(d) Activities Applied Against the Claims

715.02 How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims

715.03 Genus-Species, Practice Relative to Cases Where Predictability Is in Question 715.04 Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations

715.05 U.S. Patent or Application Publication Claiming Same Invention [R-3]

715.07 Facts and Documentary Evidence [R-3]

715.07(a) Diligence

715.07(b) Interference Testimony Sometimes Used

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country or a

NAFTA or WTO Member Country

715.07(d) Disposition of Exhibits

715.08 Passed Upon by Primary Examiner

715.09 Seasonable Presentation [R-3]

715.10 Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or

Failure to Disclose Best Mode

716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132

716.01 Generally Applicable Criteria [R-3]

716.01(a) Objective Evidence of Nonobviousness

716.01(b) Nexus Requirement and Evidence of Nonobviousness

716.01(c) Probative Value of Objective Evidence

716.01(d) Weighing Objective Evidence

716.02 Allegations of Unexpected Results

716.02(a) Evidence Must Show Unexpected Results

716.02(b) Burden on Applicant

716.02(c) Weighing Evidence of Expected and Unexpected Results

716.02(d) Unexpected Results Commensurate in Scope With Claimed Invention

716.02(e) Comparison With Closest Prior Art

716.02(f) Advantages Disclosed or Inherent

716.02(g) Declaration or Affidavit Form

716.03 Commercial Success

716.03(a) Commercial Success Commensurate in Scope With Claimed Invention

716.03(b) Commercial Success Derived From Claimed Invention

716.04 Long-Felt Need and Failure of Others

716.05 Skepticism of Experts

716.06 Copying

716.07 Inoperability of References

716.08 Utility and Operability of Applicant's Disclosure

716.09 Sufficiency of Disclosure

716.10 Attribution

718 Affidavit or Declaration to Disqualify Commonly Owned Patent as Prior Art, 37 CFR 1.130 [R-3]

719 File Wrapper

719.01 Papers in File Wrapper

719.01(a) Arrangement of Papers in File Wrapper

719.01(b) Prints

719.02 Data Entered on File Wrapper

719.02(b) Name or Residence of Inventor or Title Changed

719.03 Classification During Examination [R-3]

719.04 Index of Claims [R-3]

719.05 Field of Search [R-3]

719.06 Foreign Filing Dates

719.07 Related Applications [R-3]

720 Public Use Proceedings [R-3]

720.01 Preliminary Handling [R-3]

720.02 Examiner Determination of Prima Facie Showing

720.03 Preliminary Hearing

720.04 Public Use Proceeding Testimony [R-3]

720.05 Final Decision

724 Trade Secret, Proprietary, and Protective Order Materials

724.01 Completeness of the Patent File Wrapper

724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials [R-3]

724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under 724.02

724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02

724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122

724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)

724.04(c) Materials Submitted in Reexamination File Open to the Public Under 37 CFR 1.11(d)

724.05 Petition To Expunge Information or Copy of Papers in Application File [R-3] 724.06 Handling of Petitions To Expunge Information or Copy of Papers in Application File [R-3]

## 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

```
800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting
801 Introduction
802 Basis for Practice in Statute and Rules
        802.01 Meaning of "Independent" and "Distinct" [R-3]
        802.02 Definition of Restriction [R-3]
803 Restriction - When Proper [R-3]
        803.01 Review by Examiner with at Least Partial Signatory Authority [R-3]
       803.02 Markush Claims [R-3]
       803.03 Transitional Applications [R-3]
       803.03(a) Transitional Application - Linking Claim Allowable [R-3]
       803.03(b) Transitional Application - Generic Claim Allowable [R-3]
803.04 Nucleotide Sequences [R-3]
804 Definition of Double Patenting [R-3]
        804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121 [R-3]
       804.02 Avoiding a Double Patenting Rejection [R-3]
       804.03 Commonly Owned Inventions of Different Inventive Entities; Non-Commonly
        Owned Inventions Subject to a Joint Research Agreement [R-3]
       804.04 Submission to Technology Center Director
805 Effect of Improper Joinder in Patent [R-3]
806 Determination of Distinctness or Independence of Claimed Inventions [R-3]
        806.01 Compare Claimed Subject Matter [R-3]
        806.03 Single Embodiment, Claims Defining Same Essential Features [R-3]
        806.04 Genus and/or Species Inventions [R-3]
               806.04(b) Species May Be Independent or Related Inventions [R-3]
               806.04(d) Definition of a Generic Claim [R-3]
               806.04(e) Claims Limited to Species [R-3]
               806.04(f) Restriction Between Mutually Exclusive Species [R-3]
               806.04(h) Species Must Be Patentably Distinct From Each Other [R-3]
               806.04(i) Generic Claims Presented After Issue of Species [R-3]
        806.05 Related Inventions [R-3]
               806.05(a) Combination and Subcombination [R-3]
               806.05(c) Criteria of Distinctness Between Combination and Subcombination [R-
               806.05(d) Subcombinations Usable Together [R-3]
               806.05(e) Process and Apparatus for Its Practice [R-3]
               806.05(f) Process of Making and Product Made [R-3]
               806.05(g) Apparatus and Product Made [R-3]
               806.05(h) Product and Process of Using [R-3]
               806.05(i) Product, Process of Making, and Process of Using [R-3]
               806.05(j) Related Products; Related Processes [R-3]
       806.06 Independent Inventions [R-3]
807 Patentability Report Practice Has No Effect on Restriction Practice
808 Reasons for Insisting Upon Restriction [R-3]
        808.01 Reasons for Holding of Independence or Distinctness [R-3]
        808.01(a) Species [R-3]
        808.02 Establishing Burden [R-3]
809 Linking Claims [R-3]
        809.02(a) Election of Species Required [R-3]
        809.03 Restriction Between Linked Inventions [R-3]
810 Action on the Merits [R-3]
811 Time for Making Requirement [R-3]
        811.02 New Requirement After Compliance With Preceding Requirement [R-3]
        811.03 Repeating After Withdrawal Proper [R-3]
       811.04 Proper Even Though Grouped Together in Parent Application
812 Who Should Make the Requirement [R-3]
       812.01 Telephone Restriction Practice [R-3]
```

```
814 Indicate Exactly How Application Is To Be Restricted [R-3]
815 Make Requirement Complete [R-3]
817 Outline of Letter for Restriction Requirement [R-3]
818 Election and Reply [R-3]
       818.01 Election Fixed by Action on Claims
       818.02 Election Other Than Express
               818.02(a) By Originally Presented Claims
               818.02(b) Generic Claims Only - No Election of Species [R-3]
               818.02(c) By Optional Cancellation of Claims
        818.03 Express Election and Traverse [R-3]
               818.03(a) Reply Must Be Complete
               818.03(b) Must Elect, Even When Re-quirement Is Traversed [R-3]
               818.03(c) Must Traverse To Preserve Right of Petition [R-3]
               818.03(d) Traverse of Restriction Requirement With Linking Claims [R-3]
819 Office Generally Does Not Permit Shift [R-3]
821 Treatment of Claims Held To Be Drawn to Nonelected Inventions [R-3]
        821.01 After Election With Traverse [R-3]
       821.02 After Election Without Traverse [R-3]
       821.03 Claims for Different Invention Added After an Office Action [R-3]
       821.04 Rejoinder [R-3]
               821.04(a) Rejoinder Between Product Inventions; Rejoinder Between Process
               Inventions [R-3]
               821.04(b) Rejoinder of Process Requiring an Allowable Product [R-3]
822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Inventive Entity [R-
3]
        822.01 Copending Before the Examiner [R-3]
823 Unity of Invention Under the Patent Cooperation Treaty [R-3]
```

900 Prior Art, Classification, and Search

```
900 Prior Art, Classification, and Search
901 Prior Art
        901.01 Canceled Matter in U.S. Patent Files [R-3]
       901.02 Abandoned Applications [R-3]
        901.03 Pending Applications [R-3]
        901.04 U.S. Patents [R-3]
                901.04(a) Kind Codes [R-3]
        901.05 Foreign Patent Documents [R-3]
                901.05(a) Citation Data [R-3]
                901.05(b) Other Significant Data [R-3]
                901.05(c) Obtaining Copies [R-3]
                901.05(d) Translation [R-3]
        901.06 Nonpatent Publications [R-3]
                901.06(a) Scientific and Technical Infor-mation Center (STIC) [R-3]
                901.06(b) Borrowed Publications
                901.06(c) Alien Property Custodian Publications
                901.06(d) Abstracts, Abbreviatures, and Defensive Publications
        901.07 Arrangement of Art in Technology Centers [R-3]
        901.08 Borrowing References [R-3]
902 Search Tools and Classification Information
        902.01 Manual of Classification [R-3]
                902.01(a) Index to the U.S. Patent Classification System [R-3]
        902.02 Class and Subclass Definitions [R-3]
                902.02(a) Definition Notes
                902.02(b) Search Cards [R-3]
        902.03 Classification Information
                902.03(a) Patent Classification Home Page on the Internet [R-3]
                902.03(b) Patent Classification Home Page on the USPTO Intranet [R-3]
                902.03(c) Classification Insight on USPTO Local Area Network (LAN)
                902.03(d) Patent Information and Search Tools: the Cassis CD-ROM Series [R-
                902.03(e) Automated Search Tools: EAST and WEST [R-3]
        902.04 Classification Orders [R-3]
                902.04(a) Reclassification Alert Report [R-3]
903 Classification
        903.01 Statutory Authority
        903.02 Basis and Principles of Classification [R-3]
                903.02(a) New and Revised Classes [R-3]
                903.02(b) Scope of a Class
                903.02(c) Establishing Subclasses and Cross-Reference Art Col-lections [R-3]
        903.03 Availability of Foreign Patents [R-3]
        903.04 Classifying Applications for Publication as a Patent App-lication Publication [R-3]
        903.05 Addition, Deletion, or Transfer of U.S. Patents and U.S. Patent Application
        Publications [R-3]
        903.07 Classifying and Cross-Referencing at Allowance [R-3]
                903.07(a) Cross-Referencing - Keep Systematic Notes During Prosecution
                903.07(b) Issuing in Another Technology Center Without Transfer [R-3]
        903.08 Applications: Assignment and Transfer
                903.08(a) New Applications [R-3]
                903.08(b) Classification and Assignment to Examiner [R-3]
                903.08(c) Immediate Inspection of Amendments
                903.08(d) Transfer Procedure [R-3]
                903.08(e) General Guidelines Governing the Assignment of Non-provisional
                Applications for Examination [R-3]
        903.09 International Classification of Patents for Inventions [R-3]
                903.09(a) Locarno Classification Desig-nations [R-3]
```

```
904 How to Search [R-3]
```

904.01 Analysis of Claims

904.01(a) Variant Embodiments Within Scope of Claim

904.01(b) Equivalents

904.01(c) Analogous Arts

904.02 General Search Guidelines [R-3]

904.02(a) Classified Search

904.02(b) Search Tool Selection [R-3]

904.02(c) Internet Searching [R-3]

904.03 Conducting the Search

#### 905 Miscellaneous

905.03 Ordering of Patented and Abandoned Provisional and Nonprovisional Application

Files [R-3]

905.06 Patent Family Information [R-3]

1000 Matters Decided by Various U.S. Patent and Trademark Office Officials

```
1000 Matters Decided by Various U.S. Patent and Trademark Office Officials
```

1001 Statutory Authority of Director of the USPTO

1001.01 Modes of Exercising Authority

1002 Petitions to the Director of the USPTO

1002.01 Procedure

1002.02 Delegation of Authority To Decide Petitions

1002.02(b) Petitions and Requests Decided by the Office of the Deputy Commissioner for Patent Examination Policy

1002.02(c) Petitions and Requests Decided by the Technology Center Directors 1002.02(c)(1) Petitions Decided by the Director of Technology Center

1002.02(c)(2) Petitions Decided by the Director of Technology Center 1600

1002.02(c)(3) Petitions Decided by the Director of Technology Center 2900

1002.02(d) Petitions and Matters Decided by Supervisory Patent Examiners

1002.02(e) Requests Decided by Primary Examiners

1002.02(f) Petitions and Matters Decided by the Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences

1002.02(g) Petitions Decided by the Administrative Patent Judges

1002.02(i) Petitions Decided by the Commissioner for Trademarks

1002.02(j) Petitions Decided by the Board of Patent Appeals and Interferences

1002.02(k)(1) Petitions and Matters Decided by the General Counsel

1002.02(k)(2) Requests Decided by the Office of General Law

1002.02(k)(3) Petitions Decided by the Solicitor

1002.02(I) Requests Decided by the Certificates of Correction Branch

1002.02(m) Petitions Decided by the Director of Enrollment and Discipline

1002.02(o) Petitions and Other Matters Decided by the Deputy Director of the USPTO

1002.02(p) Petitions and Matters Decided by the PCT Legal Administrator

1002.02(q) Petitions and Requests Decided by the Director of Office of Initial Patent Examination

1002.02(r) Petitions Decided by the Director of Office of Patent Publication

1002.02(s) Petitions and Matters Decided by the Special Program Examiners in the Technology Centers

1003 Matters Submitted to Technology Center Directors

1004 Actions Which Require the Attention of a Primary Examiner

1005 Exceptions to Partial Signatory Authority

1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)

- 1100 Statutory Invention Registration (SIR) and Pre-Grant Publication (PG Pub)
- 1101 Request for Statutory Invention Registration (SIR)
- 1103 Examination of a SIR
- 1105 Review of Final Refusal to Publish SIR
- 1107 Preparing a SIR for Publication
- 1109 Withdrawal of SIR Request
- 1111 SIR Publication and Effect
- 1120 Eighteen-Month Publication of Patent Applications
- 1121 Content of a Patent Application Publication
- 1122 Requests for Nonpublication
- 1123 Rescission of a Nonpublication Request
- 1124 Notice of Foreign Filing
- 1125 Express Abandonment to Avoid Publication
- 1126 Publication Fees
- 1127 Notice of Publication
- 1128 Availability of Published Applications
- 1129 Request for Early Publication
- 1130 Republication and Correction of Patent Application Publications
- 1132 Requests for Redacted Publication
- 1133 Voluntary Publication
- 1134 Third Party Inquiries and Correspondence in a Published Application 1134.01 Third Party Submissions Under 37 CFR 1.99
- 1135 PGPub Forms

## 1200 Appeal

```
1200 Appeal
1201 Introduction [R-3]
1202 Composition of Board [R-3]
1203 Administrative Handling [R-3]
1204 Notice of Appeal [R-3]
       1204.01 Reinstatement of Appeal [R-3]
1205 Appeal Brief [R-3]
       1205.01 Time for Filing Appeal Brief [R-3]
       1205.02 Appeal Brief Content [R-3]
       1205.03 Non-Compliant Appeal Brief and Amended Brief [R-3]
1206 Amendments and Affidavits or Other Evidence Filed With or After Appeal [R-3]
1207 Examiner's Answer [R-3]
       1207.01 Appeal Conference [R-3]
       1207.02 Contents of Examiner's Answer [R-3]
       1207.03 New Ground of Rejection in Examiner's Answer [R-3]
       1207.04 Reopening of Prosecution After Appeal [R-3]
       1207.05 Supplemental Examiner's Answer [R-3]
1208 Reply Briefs and Examiner's Responses to Reply Brief [R-3]
1209 Oral Hearing [R-3]
1210 Actions Subsequent to Examiner's Answer but Before Board's Decision [R-3]
1211 Remand by Board [R-3]
       1211.01 Remand by Board for Further Consideration of Rejection [R-3]
       1211.02 Remand by Board To Consider Amendment [R-3]
       1211.03 Remand by Board To Consider Affidavits or Declarations [R-3]
       1211.04 Remand by Board for Further Search [R-3]
1212 Board Requires Appellant to Address Matter [R-3]
1213 Decision by Board [R-3]
       1213.01 Statement by Board of How an Appealed Claim May Be Amended To Overcome
       a Specific Rejection [R-3]
       1213.02 New Grounds of Rejection by Board [R-3]
       1213.03 Publication of and Public Access to Board Decision [R-3]
1214 Procedure Following Decision by Board [R-3]
       1214.01 Procedure Following New Ground of Rejection by Board [R-3]
       1214.03 Rehearing [R-3]
       1214.04 Examiner Reversed [R-3]
       1214.05 Cancellation of Withdrawn Claims [R-3]
       1214.06 Examiner Sustained in Whole or in Part [R-3]
       1214.07 Reopening of Prosecution [R-3]
1215 Withdrawal or Dismissal of Appeal
       1215.01 Withdrawal of Appeal [R-3]
       1215.02 Claims Standing Allowed
       1215.03 Partial Withdrawal [R-3]
       1215.04 Dismissal of Appeal [R-3]
1216 Judicial Review [R-3]
       1216.01 Appeals to the Federal Circuit [R-3]
       1216.02 Civil Suits Under 35 U.S.C. 145 [R-3
1
```

## 1300 Allowance and Issue

```
1300 Allowance and Issue
1301 Substantially Allowable Application, Special
1302 Final Review and Preparation for Issue
        1302.01 General Review of Disclosure [R-3]
        1302.02 Requirement for a Rewritten Specification
        1302.03 Notice of Allowability [R-3]
        1302.04 Examiner's Amendments and Changes [R-3]
                1302.04(a) Title of Invention
               1302.04(b) Cancellation of Nonstatutory Claim
               1302.04(c) Cancellation of Claims to Nonelected Invention
               1302.04(d) Cancellation of Claim Lost in Interference [R-3]
               1302.04(e) Cancellation of Rejected Claims Following Appeal
               1302.04(g) Identification of Claims
                1302.04(h) Rejoinder of Claims [R-3]
        1302.05 Correction of Drawing [R-3]
                1302.05(a) Original Drawings Cannot Be Located [R-3]
        1302.06 Prior Foreign Application
        1302.07 Use of Retention Labels to Preserve Abandoned Companion Applications
        1302.08 Interference Search [R-3]
        1302.09 Classification, Print Figure, and Other Notations [R-3]
        1302.10 Issue Classification Notations [R-3]
        1302.11 Reference to Assignment Division
        1302.12 Listing of References [R-3]
        1302.13 Signing [R-3]
        1302.14 Reasons for Allowance
1303 Notice of Allowance [R-3]
        1303.01 Amendment Received After Allowance [R-3]
        1303.02 Undelivered
        1303.03 Not Withheld Due to Death of Inventor
1304 Amendments After D-10 Notice
        1304.01 Withholding From Issue of "Secrecy Order" Applications
1305 Jurisdiction
1306 Issue Fee
        1306.01 Deferring Issuance of a Patent
        1306.02 Simultaneous Issuance of Patents
        1306.03 Practice After Payment of Issue Fee: Receipt of Issue Notification [R-3]
1307 Change in Classification of Cases Which Are in Issue
1308 Withdrawal From Issue [R-3]
        1308.01 Rejection After Allowance
        1308.02 For Interference Purposes [R-3]
        1308.03 Quality Review Program for Examined Patent Applications
```

1309 Issue of Patent

1309.02 "Query/Printer Waiting" Cases

## **1400 Correction of Patents**

```
1400 Correction of Patents
1400 [No Text]
        1400.01 Introduction
1401 Reissue [R-3]
1402 Grounds for Filing [R-3]
1403 Diligence in Filing [R-3]
1404 Submission of Papers Where Reissue Patent Is in Litigation
1405 Reissue and Patent Term
1406 Citation and Consideration of References Cited in Original Patent [R-3]
1410 Content of Reissue Application [R-3]
1410.01 Reissue Applicant, Oath or Declaration, and Consent of all Assignees [R-3]
1411 Form of Specification [R-3]
        1411.01 Certificate of Correction or Disclaimer in Original Patent
        1411.02 New Matter
1412 Content of Claims
        1412.01 Reissue Claims Must Be for Same General Invention
        1412.02 Recapture of Canceled Subject Matter [R-3]
        1412.03 Broadening Reissue Claims [R-3]
        1412.04 Correction of Inventorship [R-3]
1413 Drawings
1414 Content of Reissue Oath/Declaration [R-3]
        1414.01 Supplemental Reissue Oath/ Declaration [R-3]
1415 Reissue Application and Issue Fees [R-3]
        1415.01 Maintenance Fees on the Original Patent [R-3]
1416 No Physical Surrender of Original Patent [R-3]
1417 Claim for Benefit Under 35 U.S.C. 119(a)-(d) [R-3]
1418 Notification of Prior/Concurrent Proceedings and Decisions There-on, and of Information
Known to be Material to Patentability [R-3]
1430 Reissue Files Open to the Public and, Notice of Filing Reissue Announced in, Official
Gazette [R-3]
1440 Examination of Reissue Application [R-3]
1441 Two-Month Delay Period [R-3]
        1441.01 Protest in Reissue Applications [R-3]
1442 Special Status
        1442.01 Litigation-Related Reissues
        1442.02 Concurrent Litigation [R-3]
        1442.03 Litigation Staved [R-3]
        1442.04 Litigation Involving Patent [R-3]
        1442.05 Court Ordered Filing of Reissue Application [R-3]
1443 Initial Examiner Review [R-3]
1444 Review of Reissue Oath/Declaration [R-3]
1445 Reissue Application Examined in Same Manner as Original Application
1448 Fraud, Inequitable Conduct, or Duty of Disclosure Issues
1449 Protest Filed in Reissue Where Patent Is in Interference [R-3]
        1449.01 Concurrent Office Proceedings [R-3]
        1449.02 Interference in Reissue [R-3]
1450 Restriction and Election of Species Made in Reissue Application
1451 Divisional Reissue Applications; Continuation Reissue Applications Where the Parent is
Pending [R-3]
1452 Request for Continued Examination of Reissue Application
1453 Amendments to Reissue Applications [R-3]
1454 Appeal Brief [R-3]
1455 Allowance and Issue [R-3]
1456 Reissue Review [R-3]
1457 Design Reissue Applications and Patents [R-3]
1460 Effect of Reissue
```

1470 Public Access of Reissue Applications [R-3]

1480 Certificates of Correction - Office Mistake [R-3]

1480.01 Expedited Issuance of Certificates of Correction - Error Attributable to Office

1481 Certificates of Correction - Applicant's Mistake [R-3]

1481.01 Correction of Assignees' Names [R-3]

1481.02 Correction of Inventors' Names [R-3]

1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits [R-3]

1485 Handling of Request for Certificates of Correction [R-3]

1490 Disclaimers [R-3]

## 1500 Design Patents

```
1500 Design Patents
1501 Statutes and Rules Applicable
1502 Definition of a Design
1502.01 Distinction Between Design and Utility Patents
1503 Elements of a Design Patent Application
1503.01 Specification
1503.02 Drawing
1504 Examination
       1504.01 Statutory Subject Matter for Designs
               1504.01(a) Computer-Generated Icons
               1504.01(b) Design Comprising Multiple Articles or Multiple Parts Embodied in a
               Single Article
               1504.01(c) Lack of Ornamentality
               1504.01(d) Simulation
               1504.01(e) Offensive Subject Matter
       1504.02 Novelty
       1504.03 Nonobviousness
       1504.04 Considerations Under 35 U.S.C. 112
       1504.05 Restriction
       1504.06 Double Patenting
       1504.10 Priority Under 35 U.S.C. 119(a)-(d)
       1504.20 Benefit Under 35 U.S.C. 120
       1504.30 Expedited Examination
1505 Allowance and Term of Design Patent
1509 Reissue of a Design Patent
1510 Reexamination
1511 Protest
1512 Relationship Between Design Patent, Copyright, and Trademark
1513 Miscellaneous
```

## **1600 Plant Patents**

- 1600 Plant Patents
- 1601 Introduction: The Act, Scope, Type of Plants Covered
- 1602 Rules Applicable
- 1603 Elements of a Plant Application
- 1604 Applicant, Oath or Declaration
- 1605 Specification and Claim
- 1606 Drawings
- 1607 Specimens
- 1608 Examination
- 1609 Report of Agricultural Research Service
- 1610 The Action
- 1611 Issue
- 1612 UPOV Convention
- 1613 Right of Priority Based upon Application for Plant Breeder's Rights

## 1700 Miscellaneous

**1800 Patent Cooperation Treaty** 

```
1800 Patent Cooperation Treaty
1801 Basic Patent Cooperation Treaty (PCT) Principles [R-3]
1802 PCT Definitions
1803 Reservations Under the PCT Taken by the United States of America
1805 Where To File an International Application [R-3]
1807 Agent or Common Representative and General Power of Attorney [R-3]
1808 Change in or Revocation of the Appointment of an Agent or a Common Representative [R-
1810 Filing Date Requirements
1812 Elements of the International Application
1817 PCT Member States [R-3]
        1817.01 Designation of States in International Applications Having an International Filing
Date On or After January 1, 2004
                1817.01(a) Designation of States and Precautionary Designations in International
        Applications Having an International Filing Date Before January 1, 2004
        1817.02 Continuation or Continuation-in-Part Indication in the Reguest [R-3]
1819 Earlier International or International-Type Search [R-3]
1820 Signature of Applicant
1821 The Request
1823 The Description
1823.01 Reference to Deposited Biological Material
1823.02 Nucleotide and/or Amino Acid Sequence Listings, and Tables Related to Sequence
Listings [R-3]
1824 The Claims
1825 The Drawings
1826 The Abstract
1827 Fees
1828 Priority Claim and Document
1830 International Application Transmittal Letter
1832 License Request for Foreign Filing Under the PCT
1834 Correspondence [R-3]
1834.01 Use of Telegraph, Teleprinter, Facsimile Machine
1834.02 Irregularities in the Mail Service
1836 Rectification of Obvious Errors
1840 The International Searching Authority [R-3]
1840.01 The European Patent Office as an International Searching Authority
1842 Basic Flow Under the PCT
1843 The International Search [R-3]
        1843.01 Prior Art for Chapter I Processing
        1843.02 Certain Subject Matter Need Not Be Searched
        1843.03 No Search Required if Claims Are Unclear
        1843.04 Procedure for Claims Not Required To Be Searched and for Claims That Are
       Unclear
        1843.05 Time Limit for Establishing the International Search Report and the Written
       Opinion of the International Searching Authority
1844 The International Search Report
        1844.01 Preparing the International Search Report (Form PCT/ISA/210) [R-3]
1845 Written Opinion of the International Searching Authority
        1845.01 Preparing the Written Opinion of the International Searching Authority (Form
        PCT/ISA/237) [R-3]
        1845.02 Notification of Transmittal of the International Search Report and the Written
       Opinion of the International Searching Authority, or the Declaration (Form PCT/ISA/220)
        [R-3]
1846 Sections of the Articles, Regulations, and Administrative Instructions Under the PCT
```

Relevant to the International Searching Authority

1847 Refund of International Search Fee

```
1848 Sequence Listings and Tables Related to Sequence Listings [R-3]
```

1850 Unity of Invention Before the International Searching Authority [R-3]

1851 Identification of Patent Documents

1852 International-Type Search

1853 Amendment Under PCT Article 19

1857 International Publication

1857.01 Prior Art Effect of the International Publication

1859 Withdrawal of International Application, Designations, or Priority Claims

1860 International Preliminary Examination Procedure for Applications Having an International Filing Date On or After January 1, 2004

1860.01 International Preliminary Examination Procedure for Applications Having an International Filing Date Before January 1, 2004

1862 Agreement With the International Bureau To Serve as an International Preliminary Examining Authority

1864 The Demand and Preparation for Filing of Demand

1864.01 Amendments Filed Under PCT Article 34

1864.02 Applicant's Right To File a Demand

1864.03 States Which May Be Elected

1864.04 Agent's Right To Act

1865 Filing of Demand [R-3]

1865.01 The European Patent Office as an International Preliminary Examining Authority

1866 Filling in of Headings on Chapter II Forms

1867 Preliminary Examination Fees

1868 Correction of Defects in the Demand

1869 Notification to International Bureau of Demand

1870 Priority Document and Translation Thereof

1871 Processing Amendments Filed Under Article 19 and Article 34 Prior to or at the Start of International Preliminary Examination in International Applications Having an International Filing Date On or After January 1, 2004 [R-3]

1871.01 Processing Amendments Filed Under Article 19 and Article 34 Prior to or at the Start of International Preliminary Examination in International Applications Having an International Filing Date Before January 1, 2004

1872 Transmittal of Demand to the Examining Corps

1874 Determination if International Preliminary Examination Is Required and Possible

1875 Unity of Invention Before the International Preliminary Examining Authority

1875.01 Preparation of Invitation Concerning Unity [R-3]

1875.02 Reply to Invitation Concerning Lack of Unity of Invention [R-3]

1876 Notation of Errors and Informalities by the Examiner

1876.01 Request for Rectification and Notification of Action Thereon [R-3]

1877 Nucleotide and/or Amino Acid Sequence Listings During the International Preliminary Examination [R-3]

1878 Preparation of the Written Opinion of the International Preliminary Examining Authority in International Applications Having an International Filing Date On or After January 1, 2004 [R-3]

1878.01 Preparation of the Written Opinion in International Applications Having an International Filing Date Before January 1, 2004 [R-3]

1878.01(a) Prior Art for Purposes of the Written Opinion and the International Preliminary Examination Report

1878.01(a)(1) Novelty for Purposes of the Written Opinion and the International Preliminary Examination Report

1878.01(a)(2) Inventive Step for Purposes of the Written Opinion and the International Preliminary Examination Report

1878.01(a)(3) Industrial Applicability for Purposes of the Written Opinion and the International Preliminary Examina- tion Report

1878.02 Reply to the Written Opinion of the ISA or IPEA [R-3]

1879 Preparation of the International Preliminary Examination Report [R-3]

1879.01 Time Limit for Preparing Report in International Applications Having an

```
International Filing Date On or After January 1, 2004 [R-3]
                1879.01(a) Time Limit for Preparing Report in International Application Having an
        International Filing Date Before January 1, 2004
        1879.02 Transmittal of the International Preliminary Examination Report
        1879.03 Translations
        1879.04 Confidential Nature of the Report [R-3]
1880 Withdrawal of Demand or Election
1881 Receipt of Notice of Election and Preliminary Examination Report by the United States
Patent and Trademark Office
1893 National Stage (U.S. National Application Filed Under 35 U.S.C. 371)
        1893.01 Commencement and Entry [R-3]
                1893.01(a) Entry via the U.S. Designated or Elected Office [R-3]
                        1893.01(a)(1) Submissions Required by 30 Months from the Priority Date
                        1893.01(a)(2) Article 19 Amendment (Filed With the International
                        Bureau) [R-3]
                        1893.01(a)(3) Article 34 Amendments (Filed with the International
                        Preliminary Examining Authority) [R-3]
                1893.01(c) Fees [R-3]
                1893.01(d) Translation [R-3]
                1893.01(e) Oath/Declaration [R-3]
        1893.02 Abandonment
        1893.03 Prosecution of U.S. National Stage Applications Before the Examiner [R-3]
                1893.03(a) How To Identify That an Application Is a U.S. National Stage
                1893.03(b) The Filing Date of a U.S. National Stage Application [R-3]
                1893.03(c) The Priority Date, Priority Claim, and Priority Papers for a U.S.
                National Stage Application [R-3]
                1893.03(d) Unity of Invention [R-3]
                1893.03(e) Papers Received from the International Bureau and Placed in a U.S.
                National Stage Application File [R-3]
                1893.03(f) Drawings and PCT Rule 11
                1893.03(g) Information Disclosure Statement in a National Stage Application [R-
1895 A Continuation, Divisional, or Continuation- in- Part Application of a PCT Application
Designating the United States
        1895.01 Handling of and Considerations in the Handling of Continuations, Divisions, and
Continuations-In-Part of PCT Applications [R-3]
1896 The Differences Between a National Application Filed Under 35 U.S.C. 111(a) and a
National Stage Application Submitted Under 35 U.S.C. 371
```

## 1900 Protest

1907 Unauthorized Participation by Protestor [R-3] 1920 Citation of Prior Art Under 37 CFR 1.501(a)

# 2000 Duty of Disclosure

2000 Duty of Disclosure

2000 [No Text]

2000.01 Introduction

2001 Duty of Disclosure, Candor, and Good Faith

2001.01 Who Has Duty To Disclose

2001.03 To Whom Duty of Disclosure Is Owed

2001.04 Information Under 37 CFR 1.56(a)

2001.05 Materiality Under 37 CFR 1.56(b)

2001.06 Sources of Information

2001.06(a) Prior Art Cited in Related Foreign Applications

2001.06(b) Information Relating to or From Copending United States Patent Applications

2001.06(c) Information From Related Litigation

2001.06(d) Information Relating to Claims Copied From a Patent

2002 Disclosure - By Whom and How Made

2002.01 By Whom Made

2002.02 Must be in Writing

2003 Disclosure \_\_ When Made

2003.01 Disclosure After Patent Is Granted

2004 Aids to Compliance With Duty of Disclosure

2005 Comparison to Requirement for Information

2010 Office Handling of Duty of Disclosure/Inequitable Conduct Issues

2012 Reissue Applications Involving Issues of Fraud, Inequitable Conduct, and/or Violation of Duty of Disclosure

2012.01 Collateral Estoppel

2013 Protests Involving Issues of Fraud, Inequitable Conduct, and/or Violation of Duty of Disclosure

2014 Duty of Disclosure in Reexamination Proceedings

2016 Fraud, Inequitable Conduct, or Violation of Duty of Disclosure Affects All Claims

2022.05 Determination of "Error Without Any Deceptive Intention"

# 2100 Patentability

```
2100 Patentability
2105 Patentable Subject Matter - Living Subject Matter
2106 Patentable Subject Matter - Computer-Related Inventions [R-3]
        2106.01 Computer Programming and 35 U.S.C. 112, First Paragraph [R-3]
        2106.02 Disclosure in Computer Programming Cases
2107 Guidelines for Examination of Applications for Compliance with the Utility Requirement
        2107.01 General Principles Governing Utility Rejections [R-3]
        2107.02 Procedural Considerations Related to Rejections for Lack of Utility
       2107.03 Special Considerations for Asserted Therapeutic or Pharmacological Utilities
2111 Claim Interpretation; Broadest Reasonable Interpretation
        2111.01 Plain Meaning [R-3]
       2111.02 Effect of Preamble [R-3]
       2111.03 Transitional Phrases [R-3]
        2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3]
2112 Requirements of Rejection Based on Inherency; Burden of Proof [R-3]
        2112.01 Composition, Product, and Apparatus Claims [R-3]
       2112.02 Process Claims
2113 Product-by-Process Claims
2114 Apparatus and Article Claims - Functional Language
2115 Material or Article Worked Upon by Apparatus
2116 Material Manipulated in Process
        2116.01 Novel, Unobvious Starting Material or End Product
2121 Prior Art; General Level of Operability Required to Make a Prima Facie Case
        2121.01 Use of Prior Art in Rejections Where Operability Is in Question [R-3]
        2121.02 Compounds and Compositions - What Constitutes Enabling Prior Art [R-3]
       2121.03 Plant Genetics - What Con-stitutes Enabling Prior Art [R-3]
        2121.04 Apparatus and Articles - What Constitutes Enabling Prior Art
2122 Discussion of Utility in the Prior Art
2123 Rejection Over Prior Art's Broad Disclosure Instead of Preferred Embodiments [R-3]
2124 Exception to the Rule That the Critical Reference Date Must Precede the Filing Date
2125 Drawings as Prior Art
2126 Availability of a Document as a "Patent" for Purposes of Rejection Under 35 U.S.C. 102 (a),
(b), and (d)
        2126.01 Date of Availability of a Patent as a Reference [R-3]
       2126.02 Scope of Reference's Disclosure Which Can Be Used to Reject Claims When
       the Reference Is a "Patent" but Not a "Publication"
2127 Domestic and Foreign Patent Applications as Prior Art
2128 "Printed Publications" as Prior Art
        2128.01 Level of Public Accessibility Required [R-3]
       2128.02 Date Publication Is Available as a Reference
2129 Admissions as Prior Art [R-3]
2131 Anticipation - Application of 35 U.S.C. 102 (a), (b), and (e)
       2131.01 Multiple Reference 35 U.S.C. 102 Rejections
       2131.02 Genus-Species Situations
       2131.03 Anticipation of Ranges
       2131.04 Secondary Considerations
        2131.05 Nonanalogous Art
2132 35 U.S.C. 102(a)
        2132.01 Publications as 35 U.S.C. 102 (a) Prior Art
2133 35 U.S.C. 102(b)
        2133.01 Rejections of Continuation-In-Part (CIP) Applications
       2133.02 Rejections Based on Publications and Patents
       2133.03 Rejections Based on "Public Use" or "On Sale"
               2133.03(a) "Public Use" [R-3]
               2133.03(b) "On Sale" [R-3]
               2133.03(c) The "Invention" [R-3]
```

```
2133.03(d) "In This Country"
               2133.03(e) Permitted Activity; Experimental Use [R-3]
                       2133.03(e)(1) Commercial Exploitation
                       2133.03(e)(2) Intent
                       2133.03(e)(3) "Completeness" of the Invention [R-3]
                       2133.03(e)(4) Factors Indicative of an Experimental Purpose
                       2133.03(e)(5) Experimentation and Degree of Supervision and Control
                       2133.03(e)(6) Permitted Experimental Activity and Testing [R-3]
                       2133.03(e)(7) Activity of an Independent Third Party Inventor
2134 35 U.S.C. 102(c)
2135 35 U.S.C. 102(d)
        2135.01 The Four Requirements of 35 U.S.C. 102(d)
2136 35 U.S.C. 102(e) [R-3]
        2136.01 Status of U.S. Application as a Reference [R-3]
       2136.02 Content of the Prior Art Available Against the Claims [R-3]
       2136.03 Critical Reference Date
        2136.04 Different Inventive Entity; Meaning of "By Another"
       2136.05 Overcoming a Rejection Under 35 U.S.C. 102(e)
2137 35 U.S.C. 102(f)
        2137.01 Inventorship [R-3]
        2137.02 Applicability of 35 U.S.C. 103(c) [R-3]
2138 35 U.S.C. 102(g) [R-3]
        2138.01 Interference Practice [R-3]
       2138.02 "The Invention Was Made in This Country"
       2138.03 "By Another Who Has Not Abandoned, Suppressed, or Concealed It"
       2138.04 "Conception"
       2138.05 "Reduction to Practice" [R-3]
       2138.06 "Reasonable Diligence"
2141 35 U.S.C. 103; the Graham Factual Inquiries [R-3]
       2141.01 Scope and Content of the Prior Art [R-3]
               2141.01(a) Analogous and Nonanalogous Art [R-3]
        2141.02 Differences Between Prior Art and Claimed Invention [R-3]
       2141.03 Level of Ordinary Skill in the Art
2142 Legal Concept of Prima Facie Obviousness
2143 Basic Requirements of a Prima Facie Case of Obviousness
        2143.01 Suggestion or Motivation To Modify the References [R-3]
        2143.02 Reasonable Expectation of Success Is Required
       2143.03 All Claim Limitations Must Be Taught or Suggested
2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103
        2144.01 Implicit Disclosure
        2144.02 Reliance on Scientific Theory
        2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art
       2144.04 Legal Precedent as Source of Supporting Rationale
       2144.05 Obviousness of Ranges [R-3]
       2144.06 Art Recognized Equivalence for the Same Purpose
       2144.07 Art Recognized Suitability for an Intended Purpose
       2144.08 Obviousness of Species When Prior Art Teaches Genus
       2144.09 Close Structural Similarity Between Chemical Compounds (Homologs,
        Analogues, Isomers)
2145 Consideration of Applicant's Rebuttal Arguments [R-3]
2146 35 U.S.C. 103(c) [R-3]
2161 Three Separate Requirements for Specification Under 35 U.S.C. 112, First Paragraph
2162 Policy Underlying 35 U.S.C. 112, First Paragraph
2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1,
"Written Description" Requirement
        2163.01 Support for the Claimed Subject Matter in Disclosure
```

```
2163.02 Standard for Determining Compliance With the Written Description Requirement
       2163.03 Typical Circumstances Where Adequate Written Description Issue Arises
       2163.04 Burden on the Examiner with Regard to the Written Description Requirement
       2163.05 Changes to the Scope of Claims
       2163.06 Relationship of Written Description Requirement to New Matter
       2163.07 Amendments to Application Which Are Supported in the Original Description [R-
       3]
               2163.07(a) Inherent Function, Theory, or Advantage
               2163.07(b) Incorporation by Reference [R-3]
2164 The Enablement Requirement
       2164.01 Test of Enablement
               2164.01(a) Undue Experimentation Factors
               2164.01(b) How to Make the Claimed Invention
               2164.01(c) How to Use the Claimed Invention
       2164.02 Working Example
       2164.03 Relationship of Predictability of the Art and the Enablement Requirement
       2164.04 Burden on the Examiner Under the Enablement Requirement
       2164.05 Determination of Enablement Based on Evidence as a Whole
               2164.05(a) Specification Must Be Enabling as of the Filing Date
               2164.05(b) Specification Must Be Enabling to Persons Skilled in the Art
       2164.06 Quantity of Experimentation
               2164.06(a) Examples of Enablement Issues-Missing Information
               2164.06(b) Examples of Enablement Issues - Chemical Cases
       2164.07 Relationship of Enablement Requirement to Utility Requirement of 35 U.S.C.
       2164.08 Enablement Commensurate in Scope With the Claims
               2164.08(a) Single Means Claim
               2164.08(b) Inoperative Subject Matter
               2164.08(c) Critical Feature Not Claimed
2165 The Best Mode Requirement
       2165.01 Considerations Relevant to Best Mode
       2165.02 Best Mode Requirement Compared to Enablement Requirement
       2165.03 Requirements for Rejection for Lack of Best Mode
       2165.04 Examples of Evidence of Concealment [R-3]
2171 Two Separate Requirements for Claims Under 35 U.S.C. 112, Second Paragraph
2172 Subject Matter Which Applicants Regard as Their Invention
       2172.01 Unclaimed Essential Matter
2173 Claims Must Particularly Point Out and Distinctly Claim the Invention
       2173.01 Claim Terminology
       2173.02 Clarity and Precision [R-3]
       2173.03 Inconsistency Between Claim and Specification Disclosure or Prior Art
       2173.04 Breadth Is Not Indefiniteness
       2173.05 Specific Topics Related to Issues Under 35 U.S.C. 112, Second Paragraph
               2173.05(a) New Terminology [R-3]
               2173.05(b) Relative Terminology
               2173.05(c) Numerical Ranges and Amounts Limitations
               2173.05(d) Exemplary Claim Language ("for example," "such as")
               2173.05(e) Lack of Antecedent Basis
               2173.05(f) Reference to Limitations in Another Claim
               2173.05(g) Functional Limitations [R-3]
               2173.05(h) Alternative Limitations
               2173.05(i) Negative Limitations
               2173.05(j) Old Combination
               2173.05(k) Aggregation
               2173.05(m) Prolix
               2173.05(n) Multiplicity
```

2173.05(o) Double Inclusion

2173.05(p) Claim Directed to Product-By- Process or Product and Process

2173.05(q) "Use" Claims

2173.05(r) Omnibus Claim

2173.05(s) Reference to Figures or Tables

2173.05(t) Chemical Formula

2173.05(u) Trademarks or Trade Names in a Claim

2173.05(v) Mere Function of Machine

2173.06 Prior Art Rejection of Claim Rejected as Indefinite

2174 Relationship Between the Requirements of the First and Second Paragraphs of 35 U.S.C.

2181 Identifying a 35 U.S.C. 112, Sixth Paragraph Limitation [R-3]

2182 Scope of the Search and Identification of the Prior Art

2183 Making a Prima Facie Case of Equivalence

2184 Determining Whether an Applicant Has Met the Burden of Proving Nonequivalence After a Prima Facie Case Is Made

2185 Related Issues Under 35 U.S.C. 112, First or Second Paragraphs

2186 Relationship to the Doctrine of Equivalents

2190 Prosecution Laches

2200 Citation of Prior Art and Ex Parte Reexamination of Patents

```
2200 Citation of Prior Art and Ex Parte Reexamination of Patents
2201 Introduction [R-3]
2202 Citation of Prior Art
2203 Persons Who May Cite Prior Art
2204 Time for Filing Prior Art Citation [R-3]
2205 Content of Prior Art Citation
2206 Handling of Prior Art Citation [R-3]
2207 Entry of Court Decision in Patent File
2208 Service of Citation on Patent Owner
2209 Ex Parte Reexamination [R-3]
2210 Request for Ex Parte Reexamination [R-3]
2211 Time for Requesting Ex Parte Reexamination
2212 Persons Who May File a Request for Ex ParteReexamination
2213 Representative of Requester
2214 Content of Request for Ex Parte Reexamination [R-3]
2215 Fee for Requesting Ex Parte Reexamination [R-3]
2216 Substantial New Question of Patentability
2217 Statement in the Request Applying Prior Art [R-3]
2218 Copies of Prior Art
2219 Copy of Printed Patent [R-3]
2220 Certificate of Service
2221 Amendments Included in Request by Patent Owner [R-3]
2222 Address of Patent Owner [R-3]
2223 Withdrawal of Attorney or Agent [R-3]
2224 Correspondence [R-3]
2225 Untimely Paper Filed Prior to Order
2226 Initial Processing of Request for Ex Parte Reexamination
2227 Incomplete Request for Ex Parte Reexamination
2228 Informal Request for Ex Parte Reexamination
2229 Notice of Request for Ex Parte Reexamination in Official Gazette [R-3]
2230 Constructive Notice to Patent Owner
2231 Processing of Request Corrections [R-3]
2232 Public Access [R-3]
        2232.01 Determining if a Reexamination Was Filed for a Patent [R-3]
2233 Processing in Technology Center [R-3]
2234 Entry of Amendments [R-3]
2235 Record Systems [R-3]
2236 Assignment of Reexamination [R-3]
2237 Transfer Procedure [R-3]
2238 Time Reporting
2239 Reexamination Ordered at the Director's Initiative [R-3]
2240 Decision on Request [R-3]
2241 Time for Deciding Request
2242 Criteria for Deciding Request [R-3]
2243 Claims Considered in Deciding Request
2244 Prior Art on Which the Determination Is Based
2245 Processing of Decision [R-3]
2246 Decision Ordering Reexamination [R-3]
2247 Decision on Request for Reexam-ination, Request Denied [R-3]
        2247.01 Examples of Decisions on Request for Reexamination [R-3]
2248 Petition From Denial of Request [R-3]
2249 Patent Owner's Statement
2250 Amendment by Patent Owner [R-3]
       2250.01 Correction of Patent Drawings [R-3]
       2250.02 Correction of Inventorship[R-3]
```

2250.03 Fees for Adding Claims [R-3]

```
2251 Reply by Third Party Requester
2252 Consideration of Statement and Reply
2253 Consideration by Examiner
2254 Conduct of Ex ParteReexamination Proceedings [R-3]
2255 Who Reexamines
2256 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination
2257 Listing of Prior Art
2258 Scope of Ex Parte Reexamination [R-3]
        2258.01 Use of Previously Cited/Considered Art in Rejections [R-3]
2259 Res Judicata and Collateral Estoppel in Reexamination Proceedings
2260 Office Actions [R-3]
        2260.01 Dependent Claims
2261 Special Status for Action
2262 Form and Content of Office Action [R-3]
2263 Time for Response
2264 Mailing of Office Action [R-3]
2265 Extension of Time [R-3]
2266 Responses [R-3]
        2266.01 Submission Not Fully Responsive to Non-Final Office Action [R-3]
       2266.02 Examiner Issues Notice of Defective Paper in Ex Parte Reexam-ination [R-3]
       2266.03 Service of Papers [R-3]
2267 Handling of Inappropriate or Untimely Filed Papers [R-3]
2268 Petition for Entry of Late Papers for Revival of Reexamination Proceeding[R-3]
2269 Reconsideration
2270 Clerical Handling [R-3]
2271 Final Action [R-3]
        2271.01 Patentability Review Conferences
2272 After Final Practice [R-3]
2273 Appeal in Ex Parte Reexamination [R-3]
2274 Appeal Brief [R-3]
2275 Examiner's Answer [R-3]
2276 Oral Hearing [R-3]
2277 Board of Patent Appeals and Interferences Decision
2278 Action Following Decision
2279 Appeal to Courts [R-3]
2280 Information Material to Patentability in Reexamination Proceeding
2281 Interviews in Ex Parte Reexamination Proceedings [R-3]
2282 Notification of Existence of Prior or Concurrent Proceedings and Decisions Thereon [R-3]
2283 Multiple Copending Ex Parte Reexamination Proceedings [R-3]
2284 Copending Ex Parte Reexamination and Interference Proceedings [R-3]
2285 Copending Ex Parte Reexamination and Reissue Proceedings [R-3]
2286 Ex Parte Reeexamination and Litigation Proceedings [R-3]
2287 Conclusion of Ex Parte Reexamination Proceeding [R-3]
2288 Issuance of Ex Parte Reexamination Certificate [R-3]
2289 Reexamination Review
2290 Format of Ex Parte Reexamination Certificate [R-3]
2291 Notice of Ex Parte Reexamination Certificate Issuance in Official Gazette [R-3]
2292 Distribution of Certificate [R-3]
2293 Intervening Rights
2294 Concluded Reexamination Proceedings [R-3]
2295 Reexamination of a Reexamination
```

2296 USPTO Forms To Be Used In Ex Parte Reexamination [R-3]

## 2300 Interference Proceedings

```
2300 Interference Proceedings
2301 Introduction [R-4]
        2301.01 Statutory Basis [R-4]
       2301.02 Definitions [R-4]
        2301.03 Interfering Subject Matter [R-4]
2302 Consult an Interference Practice Specialist [R-4]
2303 Completion of Examination [R-4]
        2303.01 Issuance and Suspension [R-4]
        2303.02 Other Outstanding Issues with Patents [R-4]
2304 Suggesting an Interference [R-4]
        2304.01 Preliminaries to Referring an Interference to the Board [R-4]
               2304.01(a) Interference Search [R-4]
               2304.01(b) Obtaining Control Over Involved Files [R-4]
               2304.01(c) Translation of Foreign Benefit Application [R-4]
               2304.01(d) Sorting Claims [R-4]
        2304.02 Applicant Suggestion [R-4]
               2304.02(a) Identifying the Other Application or Patent [R-4]
               2304.02(b) Counts and Corresponding Claims [R-4]
               2304.02(c) Explaining Priority [R-4]
               2304.02(d) Adequate Written Description [R-4]
        2304.03 Patentee Suggestion [R-4]
       2304.04 Examiner Suggestion [R-4]
               2304.04(a) Interfering Claim Already in Application [R-4]
               2304.04(b) Requiring a Claim [R-4]
        2304.05 Common Ownership [R-4]
2305 Requiring a Priority Showing [R-4]
2306 Secrecy Order Cases [R-4]
2307 Action During an Interference [R-4]
        2307.01 Ex Parte Communications[R-4]
       2307.02 Access to Related Files [R-4]
       2307.03 Suspension of Related Examinations [R-4]
       2307.04 Additional Parties to Interference [R-4]
       2307.05 Board Action on Related Files [R-4]
       2307.06 Action at the Board [R-4]
2308 Action After an Interference [R-4]
        2308.01 Final Disposal of Claims [R-4]
        2308.02 Added or Amended Claims [R-4]
       2308.03 Estoppel Within the Office [R-4]
               2308.03(a) Losing Party [R-4]
               2308.03(b) No Interference-in-Fact [R-4]
               2308.03(c) No Second Interference [R-4]
2309 National Aeronautics and Space Administration or Department of Energy [R-4]
```

# 2400 Biotechnology

2400 Biotechnology

2401 Introduction

2402 The Deposit Rules

2403 Deposit of Biological Material

2403.01 Material Capable of Self- Replication

2403.02 Plant Material

2404 Need or Opportunity to Make a Deposit

2404.01 Biological Material That Is Known and Readily Available to the Public

2404.02 Biological Material That Can Be Made or Isolated Without Undue

Experimentation

2404.03 Reference to a Deposit in the Specification

2405 Acceptable Depository

2406 Time of Making an Original Deposit

2406.01 Description in Application Specification

2406.02 Deposit After Filing Date - Corroboration

2406.03 Possible Loss of U.S. Filing Date in Other Countries

2407 Replacement or Supplement of Deposit

2407.01 In a Pending Application

2407.02 After a Patent Has Issued

2407.03 Failure to Replace

2407.04 Treatment of Replacement

2407.05 Exemption From Replacement

2407.06 Replacement May Not Be Recognized

2408 Term of Deposit

2409 Viability of Deposit

2410 Furnishing of Samples

2410.01 Conditions of Deposit

2410.02 Certification of Statement of Availability of Deposit

2411 Examination Procedures

2411.01 Rejections Based on Deposit Issue

2411.02 Replies to Rejections Based on Deposit Issue

2411.03 Application in Condition for Allowance Except for Deposit

2411.04 After a Patent Has Been Granted

2411.05 Content of Application with Respect to Deposited Material

2420 The Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures - the Sequence Rules

2421 Overview of the Sequence Rules

2421.01 Applications Affected

2421.02 Summary of the Requirements of the Sequence Rules

2421.03 Notification of a Failure to Comply

2421.04 Future Changes to the Sequence Rules

2422 Nucleotide and/or Amino Acid Sequence Disclosures in Patent Applications

2422.01 Definitions of Nucleotide and/or Amino Acids for Purpose of Sequence Rules

2422.02 The Requirement for Exclusive Conformance; Sequences Presented in Drawing Figures

2422.03 The Requirements for a Sequence Listing and Sequence Identifiers; Sequences

Embed- ded in Application Text; Vari- ants of a Presented Sequence

2422.04 The Requirement for a Computer Readable Copy of the Official Copy of the Sequence Listing

2422.05 Reference to Previously Filed Identical Computer Readable Form; Continuing or Derivative Applications; Request for Transfer of Computer Readable Form

2422.06 Requirement for Statement Regarding Content of Official and Computer Readable Copies of Sequence Listing

2422.07 Requirements for Compliance, Statements Regarding New Matter, and Sanctions for Failure to Comply

2422.08 Presumptions Regarding Compliance

2422.09 Box Sequence; Hand Delivery of Sequence Listings and Computer Readable Forms

2423 Symbols and Format To Be Used for Nucleotide and/or Amino Acid Sequence Data

2423.01 Format and Symbols To Be Used in Sequence Listings

2423.02 Depiction of Coding Regions

2423.03 Presentation and Enumeration of Sequences

2424 Requirements for Nucleotide and/or Amino Acid Sequences as Part of the Application Papers

2424.01 Informational Requirements for the Sequence Listing

2424.02 Sequence Listing Numeric Identifiers

2424.03 Additional Miscellaneous Requirements

2425 Form and Format for Nucleotide and/or Amino Acid Sequence Submissions in Computer Readable Form

2426 Amendments to or Replacement of Sequence Listing and Computer Readable Copy Thereof

2427 Form Paragraphs and Notice to Comply

2427.01 Form Paragraphs

2427.02 Notice To Comply

2428 Sample Statements

2429 Helpful Hints for Compliance

2430 PatentIn Information; Utilities Programs; Training

2431 Sample Sequence Listing

2434 Examination of Patent Applications Claiming Large Numbers of Nucleotide Sequences

2435 Publishing of Patents and Patent Application Publications with Lengthy Sequence Listings

## 2500 Maintenance Fees

- 2500 Maintenance Fees
- 2501 Introduction
- 2504 Patents Subject to Maintenance Fees
- 2506 Times for Submitting Maintenance Fee Payments
- 2510 Submission of Maintenance Fee Payments and Documents
- 2515 Information Required for Submission of Maintenance Fee Payment
- 2520 Maintenance Fee Amounts
- 2522 Methods of Payment
- 2530 Special Acceptance of Maintenance Fee Payments Containing Informalities
- 2531 Payment Late or Insufficient
- 2532 Duplicate Payments
- 2540 Fee Address for Maintenance Fee Purposes
- 2542 Change of Correspondence Address
- 2550 Small Entity Status
- 2560 Revocation of Power of Attorney and Withdrawal of Attorney
- 2570 Maintenance Fee Payment Status Requests
- 2575 Notices
- 2580 Review of Decision Refusing to Accept and Record Payment of a Maintenance Fee Filed Prior to Expiration of Patent
- 2590 Acceptance of Delayed Payment of Maintenance Fee in Expired Patent to Reinstate Patent
- 2591 Intervening Rights in Reinstated Patents
- 2595 Forms

**2600 Optional Inter Partes Reexamination** 

```
2600 Optional Inter Partes Reexamination
2601 Introduction [Added R-2]
2601.01 Flowcharts [R-3]
2602 Citation of Prior Art [R-3]
2609 Inter Partes Reexamination [R-3]
2610 Request for Inter Partes Reexamination [Added R-2]
2611 Time for Requesting Inter Partes Reexamination [Added R-2]
2612 Persons Who May File a Request [R-3]
2613 Representative of Requester [Added R-2]
2614 Content of Request for Inter Partes Reexamination [R-3]
2615 Fee for Requesting Inter Partes Reexamination [Added R-2]
2616 Substantial New Question of Patentability [Added R-2]
2617 Statement in the Request Applying Prior Art [Added R-2]
2618 Copies of Prior Art (Patents and Printed Publications) [Added R-2]
2619 Copy of Printed Patent [Added R-2]
2620 Certificate of Service [Added R-2]
2622 Address of Patent Owner [R-3]
2623 Withdrawal of Attorney or Agent [R-3]
2624 Correspondence [R-3]
2625 Untimely Paper Filed Prior to First Office Action [R-3]
2626 Initial Processing of Request for Inter Partes Reexamination [Added R-2]
2627 Incomplete Request for Inter Partes Reexamination [Added R-2]
2628 Informal Request for Inter Partes Reexamination [Added R-2]
2629 Notice of Request for Inter Partes Reexamination in Official Gazette [Added R-2]
2630 Constructive Notice to Patent Owner [Added R-2]
2631 Processing of Request Corrections [Added R-2]
2632 Public Access [R-3]
2632.01 Determining If a Reexamination Was Filed for a Patent [R-3]
2633 Processing in Technology Center [R-3]
2634 Fee Processing and Procedure [R-3]
2635 Record Systems [R-3]
2636 Assignment of Reexamination [R-3]
2637 Transfer Procedure [R-3]
2638 Time Reporting [Added R-2]
2640 Decision on Request [R-3]
2641 Time for Deciding Request [R-3]
2642 Criteria for Deciding Request [R-3]
2643 Claims Considered in Deciding Request [Added R-2]
2644 Prior Art on Which the Determination Is Based [Added R-2]
2646 Decision Ordering Reexamination [R-3]
2647 Decision Denying Reexamination [R-3]
2647.01 Examples of Decisions on Requests [R-3]
2647.02 Processing of Decision [R-3]
2648 Petition From Denial of Request [R-3]
2654 Conduct of Inter Partes Reexamination Proceedings [Added R-2]
2655 Who Reexamines [Added R-2]
2656 Prior Art Patents and Printed Publications Reviewed by Examiner in Reexamination [Added
R-2]
2657 Listing of Prior Art [Added R-2]
2658 Scope of Inter Partes Reexamination [Added R-2]
2659 Res Judicata and Collateral Estoppel in Reexamination Proceedings [Added R-2]
2660 First Office Action [R-3]
2660.02 The Title [R-3]
2660.03 Dependent Claims [Added R-2]
2661 Special Status for Action [Added R-2]
```

2662 Time for Response and Comments [R-3]

```
2664 Mailing of Office Action [R-3]
2665 Extension of Time for Patent Owner Response [R-3]
2666 Patent Owner Response to Office Action [R-3]
       2666.01 Amendment by Patent Owner [R-3]
       2666.02 Correction of Patent Drawings [Added R-2]
       2666.03 Correction of Inventorship [Added R-2]
       2666.04 Fees for Adding Claims [R-3]
       2666.05 Third Party Comments After Patent Owner Response [R-3]
       2666.06 Service of Papers [R-3]
       2666.10 Patent Owner Does Not Respond to Office Action [R-3]
       2666.20 Third Party Does Not Comment After Patent Owner Response [R-3]
       2666.30 Submission Not Fully Responsive to Non-final Office Action [R-3]
       2666.40 Patent Owner Completion of Response and Third Party Comments Thereon [R-
       2666.50 Examiner Issues Notice of Defective Paper in Inter Partes Reexamination [R-3]
       2666.60 Response by Patent Owner/Third Party to Notice of Defective Paper [R-3]
2667 Handling of Inappropriate or Untimely Filed Papers [R-3]
2668 Petition for Entry of Late Papers for Revival of Reexamination Proceeding [R-3]
2670 Clerical Handling [Added R-2]
2671 Examiner Action Following Response/Comments or Expiration of Time for Same [Added R-
2]
       2671.01 Examiner Issues Action on Merits That Does Not Close Prosecution [R-3]
       2671.02 Examiner Issues Action Closing Prosecution (ACP) [R-3]
       2671.03 Patentability Review Conferences [Added R-2]
2672 Patent Owner Comments/Amendment After ACP and Third Party Requester Responsive
Comments [Added R-2]
2673 Examiner Consideration of Submissions After ACP and Further Action [Added R-2]
       2673.01 Reopening Prosecution After ACP [Added R-2]
       2673.02 Examiner Issues Right of Appeal Notice (RAN) [R-3]
2674 Appeal in Reexamination [R-3]
       2674.01 Cross Appeal After Original Appeal [R-3]
2675 Appellant Brief [R-3]
       2675.01 Respondent Brief [R-3]
       2675.02 Informalities in One or More of the Briefs [R-3]
2676 Appeal Conference [Added R-2]
2677 Examiner's Answer [R-3]
2678 Rebuttal Briefs [R-3]
2679 Office Treatment of Rebuttal Brief [R-3]
2680 Oral Hearing [R-3]
2681 Board of Patent Appeals and Interferences Decision [R-3]
2682 Action Following Decision [R-3]
2683 Appeal to Courts [R-3]
2684 Information Material to Patentability in Reexamination Proceeding [Added R-2]
2685 No Interviews on Merits in Inter Partes Reexamination Proceedings [Added R-2]
2686 Notification of Existence of Prior or Concurrent Proceedings and Decisions Thereon [R-3]
       2686.01 Multiple Copending Reexamination Proceedings [R-3]
       2686.02 Copending Reexamination and Interference Proceedings [R-3]
       2686.03 Copending Reexamination and Reissue Proceedings [R-3]
       2686.04 Reexamination and Litigation Proceedings [R-3]
2687 Notice of Intent to Issue Inter Partes Reexamination Certificate (NIRC) and Conclusion of
Reexamination Proceeding [R-3]
       2687.01 Examiner Consideration of Submissions After NIRC [Added R-2]
2688 Issuance of Inter Partes Reexamination Certificate [R-3]
2689 Reexamination Review [R-3]
2690 Format of Inter Partes Reexamination Certificate [R-3]
2691 Notice of Inter Partes Reexamination Certificate Issuance in Official Gazette [R-3]
```

2692 Distribution of Certificate [R-3]
2693 Intervening Rights [Added R-2]
2694 Concluded Reexamination Proceedings [R-3]
2695 Reexamination of a Reexamination [Added R-2]
2696 USPTO Forms To Be Used in Inter Partes Reexamination [R-3]

## **2700 Patent Terms and Extensions**

- 2700 Patent Terms and Extensions
- 2701 Patent Term
- 2710 Term Extensions or Adjustments for Delays Within the USPTO Under 35 U.S.C. 154
- 2720 Applications Filed Between June 8, 1995, and May 28, 2000
- 2730 Applications Filed on or After May 29, 2000; Grounds for Adjustment
- 2731 Period of Adjustment
- 2732 Reduction of Period of Adjustment of Patent Term
- 2733 Patent Term Adjustment Determination
- 2734 Application for Patent Term Adjustment; Due Care Showing
- 2735 Request for Reconsideration of Patent Term Adjustment Determination
- 2736 Third Party Papers
- 2750 Patent Term Extension for Delays at other Agencies under 35 U.S.C. 156
- 2751 Eligibility Requirements
- 2752 Patent Term Extension Applicant
- 2753 Application Contents
- 2754 Filing Date
  - 2754.01 Deadline for Filing an Application Under 35 U.S.C. 156(d)(1)
  - 2754.02 Filing Window for an Application Under 35 U.S.C. 156(d)(5)
  - 2754.03 Filing of a Request for an Extension Under 35 U.S.C. 156(e)(2)
- 2755 Eligibility Determination
  - 2755.01 Interim Extension of Patent Term During the Processing of the Application
  - 2755.02 Interim Extension of Patent Term Before Product Approval
- 2756 Correspondence Between the USPTO and the Regulatory Agency
- 2757 Regulatory Agency Determination of the Length of the Regulatory Review Period 2757.01 Due Diligence Determination
- 2758 Notice of Final Determination Calculation of Patent Term Extension
- 2759 Certificate of Extension of Patent Term
- 2760 Trade Secret, Confidential, and Protective Order Material
- 2761 Multiple Applications for Extension of Term of the Same Patent or of Different Patents for the Same Regulatory Review Period for a Product
- 2762 Duty of Disclosure in Patent Term Extension Proceedings
- 2763 Limitation of Third Party Participation
- 2764 Express Withdrawal of Application for Extension of Patent Term