

Patent Office Rules and Practice

MANUAL OF PATENT EXAMINING PROCEDURE
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VOLUME 1

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MANUAL OF PATENT EXAMINING PROCEDURE
Eighth Edition
Instructions Regarding Revision No. 9

Introduction

Appendix L has been updated to incorporate the Leahy-Smith America Invents Act, Public Law 112-29, 125Stat. 284.

Appendix R has been updated to incorporate rule changes and corrections subsequent to July 2010.

This revision consists of replacements for the **Title Page** in the front of the Manual, **entire Chapters 500, 600, 700, 1200, 1400, and 2100, Appendix L—Patent Laws, Appendix R—Patent Rules, Appendix ii—List of Decisions Cited, and entire Index.**

Sections of the Manual that have been changed by this revision are indicated by "[R-9]" after the section title. Additions to the text of the Manual are indicated by arrows (>) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws and rules indicates a portion of the law or rule that was not reproduced.

Robert A. Clarke, Editor

Manual of Patent Examining Procedure

Particular attention is called to the changes in the following sections:	
CHAPTER 500:	
502.03	Revised to delete reference to a paper copy of an e-mail communication being placed in an application file.
502.05	Revised to list web-based e-petitions as documents permitted to be filed via EFS-Web.
503	Revised to include series codes 13 for nonprovisional applications.
508.01	Deleted section directed to papers sent to the wrong technology center.
508.02	Revised to delete unnecessary references to the technology center and the IFW Manual.
508.03	Deleted section directed to unmatched papers.
509.01	Revised to include a reference to MPEP § 607.02 for refunds to a deposit account.
512	Section revised to delete reference to placement of Certificates of Mailing or Transmission in paper file wrappers.
CHAPTER 600:	
601	Revised to include a reference to MPEP Chapter 1800 for international applications filed under the Patent Cooperation Treaty (PCT).
601.01(c)	Revised to indicate conversion from a nonprovisional application to a provisional application requires, in addition to the processing fee set forth in 37 CFR 1.17(q), the provisional application filing fee (37 CFR 1.16(d)) and the surcharge set forth in 37 CFR 1.16(g).
601.01(d)	Revised in view of "Change in Procedure for Handling Nonprovisional Applications Having Omitted Items," 1315 O.G. 103 (February 20, 2007).
601.01(g)	Revised in view of "Change in Procedure for Handling Nonprovisional Applications Having Omitted Items," 1315 O.G. 103 (February 20, 2007).
601.02	Form PTO/SB/81 has been updated.
601.05	Updated to reference fillable form PTO/SB/14 for Application Data Sheet (ADS) submissions and to indicate form PTO/SB/14 cannot be used for the filing of a supplemental application data sheet.
602	Deleted from applicant's options "an amendment that cancels the subject matter not supported by the originally filed specification and drawings" when responding to examiner's requirement for a 602 supplemental oath or declaration referring to a preliminary amendment present on the filing date of the application. Forms PTO/SB/01 and PTO/SB/01A have been updated.
602.03	Form paragraph 6.05.05 has been revised.
605.04(b)	Revised because oath or declaration is not required for a provisional application.

607	Revised to include discussion of the 15 percent fee surcharge effective September 26, 2011 and the non-electronic filing fee effective November 15, 2011.
608.01(b)	Revised to remove reference to “the computer tape by the printer” from the GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS. Form paragraph 6.16 has been revised.
608.01(g)	Removed subsection entitled “USE OF SYMBOL “Phi” IN PATENT APPLICATION.”
608.01(n)	Revised subsections II and III for consistency with “Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications,” 76 Fed. Reg. 7162 (2011) (Supplemental Section 112 Examination Guidelines). Form paragraph 7.36 has been revised to provide a statement of statutory basis for rejections under 35 U.S.C. 112, fourth paragraph. New form paragraph 7.36.01 has been added for rejecting a dependent claim that fails to further limit the subject matter of the claim upon which it depends, or which fails to include all the limitations of the claim upon which it depends.
608.01(p)	Revised to change “Specific operative embodiments or examples” to “At least one specific operative embodiment or example.”
608.02	Revised to indicate that while color drawings are not permitted to be transmitted by facsimile, black and white drawings may be transmitted by facsimile in appropriate circumstances. Deleted reference to examiner pencil notations in drawings.
608.02(b)	Deleted references to form PTO-948 as the Office no longer routes drawings to a draftsman for review.
608.02(h)	Deleted reference to routing replacement drawings through a draftsman.
608.02(o)	Revised to delete reference to draftsman’s stamp.
608.02(p)	Deleted references to form PTO-948 from form paragraphs.
608.04(b)	Deleted from applicant’s options “an amendment that cancels the subject matter not supported by the originally filed specification and drawings” when responding to examiner’s requirement for a supplemental oath or declaration referring to a preliminary amendment present on the filing date of the application.
608.05(b)	Form paragraph 6.63.02 has been revised.
609	Form PTO/SB/08A and form PTO/SB/08B replaced with updated forms including “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH” stamps.