## **Chapter 700 Examination of Applications**

701	<b>Statutory Authority for Examination</b>	706.02(a)(1)	Determining Whether To
702	Requisites of the Application		Apply 35 U.S.C. 102(a)(1) of
702.01	Obviously Informal Cases		102(a)(2)
703	[Reserved]	706.02(a)(2)	Determining Whether To
704	Search and Requirements for		Apply Pre-AIA 35 U.S.C.
	Information		102(a), (b), or (e)
704.01	Search	<b>706.02(b)</b>	Overcoming a 35 U.S.C. 102
704.02	[Reserved]		Rejection Based on a Printed
-704.09			Publication or Patent
704.10	Requirements for Information	706.02(b)(1)	Overcoming a 35 U.S.C.
704.11	What Information May Be Required		102(a)(1) or 102(a)(2)
704.11(a)	•		Rejection Based on a Printe
<b>-</b> 04447	Reasonably Required	<b>T</b> 0 < 00 (1 ) (0)	Publication or Patent
704.11(b)		706.02(b)(2)	Overcoming a Pre-AIA 35
<b>-</b> 0446	Information Be Made		U.S.C. 102(a), (b), or (e)
704.12	Replies to a Requirement for		Rejection Based on a Printe
<b>=</b> 0.4.4 <b>0</b> ( )	Information	<b>T</b> 0 < 02 ( )	Publication or Patent
704.12(a)		706.02(c)	Rejections Under 35 U.S.C.
504 10(L)	Information to Duty of Disclosure		102(a)(1) or Pre-AIA 35 U.S.C.
704.12(b)	-		102(a) or (b); Knowledge by
704 12(a)	Reply	704.03(a)(1)	Others or Public Use or Sale
704.12(c)	<u>-</u>	706.02(c)(1)	Rejections under 35 U.S.C. 102(a)(1); Public Use or
704.13	Reply Time Periods for Reply		Public Sale
704.13 704.14	Making a Requirement for	706.02(c)(2)	Rejections under Pre-AIA 3:
/04.14	Information	700.02(C)(2)	U.S.C. 102(a) and (b); Publi
704.14(a)			Use or On Sale
704.14(b)	-	706.02(d)	Rejections Under Pre-AIA 35
704.14(0)	Applicant's Reply	700.02(u)	U.S.C. 102(c)
704.14(c)		706.02(e)	Rejections Under Pre-AIA 35
	37 CFR 1.105	70002(0)	U.S.C. 102(d)
704.14(d)		706.02(f)	Rejection Under Pre-AIA 35
()	Disclosure Statements	(-)	U.S.C. 102(e)
705	Patentability Reports	706.02(f)(1)	Examination Guidelines for
705.01	Instructions re Patentability Reports		Applying References Under
705.01(a)	• •		Pre-AIA 35 U.S.C. 102(e)
, ,	Disposal	706.02(f)(2)	Provisional Rejections Unde
705.01(b)	-		35 U.S.C. 102(a)(2) or
705.01(c)			Pre-AIA 35 U.S.C. 102(e);
705.01(d)			Reference Is a Copending
705.01(e)	Limitation as to Use		U.S. Patent Application
705.01(f)	Interviews With Applicants	706.02(g)	Rejections Under Pre-AIA 35
706	Rejection of Claims		U.S.C. 102(f)
706.01	Contrasted With Objections	706.02(h)	Rejections Under Pre-AIA 35
706.02	Rejection on Prior Art		U.S.C. 102(g)
706.02(a)	5	706.02(i)	Form Paragraphs for Use in
	102(a)(1) and (a)(2) and Pre-AIA		Rejections Under 35 U.S.C. 102
	35 U.S.C. 102(a), (b), or (e);	706.02(j)	Contents of a 35 U.S.C. 103
	Printed Publication or Patent		Rejection
		706.02(k)	Provisional Rejection
			(Obviousness) Under 35 U.S.C.



#### MANUAL OF PATENT EXAMINING PROCEDURE

	103 Using Provisional Prior Art	706.03(x)	Reissue
	Under Pre-AIA 35 U.S.C. 102(e)	706.04	Rejection of Previously Allowed
706.02(l)	Rejections Under Pre-AIA 35		Claims
	U.S.C. 103(a) Using Prior Art	706.05	Rejection After Allowance of
	Under Only Pre-AIA 35 U.S.C.		Application
	102 (e), (f), or (g)	706.06	Rejection of Claims Copied From
706.02(l)(1)	Rejections Under Pre-AIA 35		Patent
	U.S.C. 103(a) Using Prior Art	706.07	Final Rejection
	Under Pre-AIA 35 U.S.C.	706.07(a)	Final Rejection, When Proper on
	102(e), (f), or (g); Prior Art		Second Action
	Disqualification Under	<b>706.07(b)</b>	Final Rejection, When Proper on
	Pre-AIA 35 U.S.C. 103(c)		First Action
706.02(I)(2)	Establishing Common	706.07(c)	Final Rejection, Premature
	Ownership or Joint Research	<b>706.07(d)</b>	Final Rejection, Withdrawal of,
	Agreement Under Pre-AIA	-0 < 0-( )	Premature
<b>=</b> 0.4.04.00(a)	35 U.S.C. 103(c)	706.07(e)	Withdrawal of Final Rejection,
706.02(I)(3)	Examination Procedure With	<b>-</b> 0.4.0 <b>-</b> 4.0	General
	Respect to Pre-AIA 35	706.07(f)	Time for Reply to Final Rejection
<b>50</b> (02()	U.S.C. 103(c)	706.07(g)	Transitional After-Final Practice
706.02(m)	Form Paragraphs for Use in	706.07(h)	Request for Continued
706 02(n)	Rejections Under 35 U.S.C. 103 Biotechnology Process	707 E	Examination (RCE) Practice Examiner's Letter or Action
706.02(n)	Applications; Pre-AIA 35 U.S.C.	707 E	Primary Examiner Indicates Action
	103(b)	707.01	for New Assistant
706.03	Rejections Not Based on Prior Art	707.02	Applications Up for Third Action and
706.03(a)	Rejections Under 35 U.S.C. 101	707.02	5-Year Applications
706.03(b)	Barred by Atomic Energy Act	707.03-707.04	[Reserved]
706.03(c)	Rejections Under 35 U.S.C.	707.05	Citation of References
	112(a) or Pre-AIA 35 U.S.C. 112,	707.05(a)	Copies of Cited References
	First Paragraph	707.05(b)	Citation of Related Art and
706.03(d)	Rejections Under 35 U.S.C.		Information by Applicants
, ,	112(b) or Pre-AIA 35 U.S.C. 112,	707.05(c)	Order of Listing
	Second Paragraph	707.05(d)	Reference Cited in Subsequent
706.03(e)	Form Paragraphs for Use Relating		Actions
	to 35 U.S.C. 112(f) or Pre-AIA	707.05(e)	Data Used in Citing References
	35 U.S.C. 112, Sixth Paragraph	707.05(f)	[Reserved]
706.03(f)	[Reserved]	707.05(g)	Incorrect Citation of References
-706.03(j)		707.06	Citation of Decisions, Orders
706.03(k)	Duplicate Claims		Memorandums, and Notices
<b>706.03(1)</b>	[Reserved]	707.07	Completeness and Clarity of
706.03(m)	Nonelected Inventions		Examiner's Action
706.03(n)	[Reserved]	707.07(a)	Complete Action on Formal
706.03(o)	New Matter	<b>=0=0=</b> 0	Matters
706.03(p)	[Reserved]	707.07(b)	[Reserved]
-706.03(r)	E ' E'l' W'd (I'	-707.07(c)	
706.03(s)	Foreign Filing Without License	<b>707.07(d)</b>	Language To Be Used in
706.03(t)	[Reserved] Disclaimer	707 07(a)	Rejecting Claims
706.03(u) 706.03(v)	After Interference or Former	707.07(e)	Note All Outstanding Requirements
/00.03(V)	Public Use Proceeding	707.07(f)	Answer All Material Traversed
706.03(w)	Res Judicata	707.07(1) 707.07(g)	Piecemeal Examination
/00.03(W)	Nes juuicata	101.07(g)	riccenicai examination



### **EXAMINATION OF APPLICATIONS**

707.07(h)	Notify of Inaccuracies in	711.02	Failure To Take Required Action
707.07(II)	Amendment	/11.02	During Statutory Period
707.07(i)	Each Claim To Be Mentioned in	711.02(a)	Insufficiency of Reply
101101(2)	Each Office Action	711.02(b)	Special Situations Involving
707.07(j)	State When Claims Are		Abandonment
<b>(</b> )	Allowable	711.02(c)	Termination of Proceedings
707.07(k)	Numbering Paragraphs	711.03	Reconsideration of Holding of
707.07(l)	Comment on Examples		Abandonment; Revival
707.08	Reviewing and Initialing by Assistant	711.03(a)	Holding Based on Insufficiency
	Examiner		of Reply
707.09	Signing by Primary or Other	711.03(b)	Holding Based on Failure To
	Authorized Examiner		Reply Within Period
707.10	Entry	711.03(c)	Petitions Relating to
707.11	Date		Abandonment
707.12	Mailing	<b>711.03(d)</b>	Examiner's Statement on Petition
707.13	Returned Office Action		To Set Aside Examiner's Holding
	ler of Examination	711.04	Public Access to Abandoned
	List of Special Cases		Applications
	Petition To Make Special	711.04(a)	Date of Abandonment
708.02(a)	Accelerated Examination	<b>711.04(b)</b>	Ordering of Patented and
708.02(b)	Prioritized Examination	711 04(-)	Abandoned Files
708.02(c)	Patent Prosecution Highway	711.04(c)	Notifying Applicants of
708.03	Program Examiner Tenders Resignation	711.05	Abandonment Letter of Abandonment Received
	pension of Action	/11.03	After Application Is Allowed
709.01	Overlapping Applications by Same	711.06	Abstracts, Abbreviatures, and
702.01	Applicant or Owned by Same	711.00	Defensive Publications
	Assignee	711.06(a)	Citation and Use of Abstracts,
710 Per	iod for Reply	/1100(u)	Abbreviatures, and Defensive
710.01	Statutory Period		Publications as References
710.01(a)	Statutory Period, How Computed	712	Reserved]
710.02	Shortened Statutory Period and Time	<b>-</b>	nterviews
	Limit Actions Computed	713.01	General Policy, How Conducted
710.02(a)	[Reserved]	713.02	Interviews Prior to First Official
710.02(b)	Shortened Statutory Period:		Action
	Situations in Which Used	713.03	Interview for "Sounding Out"
710.02(c)	Specified Time Limits: Situations		Examiner Not Permitted
	in Which Used	713.04	Substance of Interview Must Be Made
710.02(d)	Difference Between Shortened		of Record
	Statutory Periods for Reply and	713.05	Interviews Prohibited or Granted,
	Specified Time Limits		Special Situations
710.02(e)	Extension of Time	713.06	No Inter Partes Questions Discussed
710.03	[Reserved]	712.07	Ex Parte
710.04	Two Periods Running	713.07	Exposure of Other Cases
710.04(a) 710.05	Copying Patent Claims  Poriod Ending on Saturday Sunday	713.08	Demonstration, Exhibits, Models
/10.05	Period Ending on Saturday, Sunday,	713.09 713.10	Finally Rejected Application
710.06	or a Federal Holiday Situations When Reply Period Is	/13.10	Interview Preceding Filing Amendment Under 37 CFR 1.312
/ 10.00	Reset or Restarted	714 A	mendments, Applicant's Action
711 Aba	andonment of Patent Application	714 A 714.01	Signatures to Amendments
711.01	Express or Formal Abandonment	/ 17.01	orginatures to runchaments
111.01	Lapress of Formal Abandonment		



### MANUAL OF PATENT EXAMINING PROCEDURE

714.01(a)	Unsigned or Improperly Signed	714.17	Amendment Filed After the Period
714.01(a)	Amendment	/14.1/	for Reply Has Expired
714.01(b)	[Reserved]	714.18	Entry of Amendments
714.01(c)	Signed by Attorney or Agent Not	714.19	List of Amendments, Entry Denied
. ,	of Record	714.20	List of Amendments Entered in Part
714.01(d)	Amendment Signed by Applicant	714.21	Amendments Inadvertently Entered,
	but Not by Attorney or Agent of		No Legal Effect
	Record	714.22	[Reserved]
714.01(e)	Amendments Before First Office	-714.24	
	Action	714.25	Discourtesy of Applicant or Attorney
714.02	Must Be Fully Responsive		wearing Behind a Reference —
714.03	Amendments Not Fully Responsive,		ffidavit or Declaration Under 37 CFR
714.02(a)	Action To Be Taken	715.01	131(a) 27 CER 1 121(a) Affidavita Variana
714.03(a) 714.04	Supplemental Amendment Claims Presented in Amendment With	/15.01	37 CFR 1.131(a) Affidavits Versus 37 CFR 1.132 Affidavits
/14.04	No Attempt To Point Out Patentable	715.01(a)	Reference Is a Joint Patent or
	Novelty	713.01(a)	Published Application to
714.05	Examiner Should Immediately		Applicant and Another
	Review	715.01(b)	Reference and Application Have
714.06	[Reserved]		Common Assignee
714.07	Amendments Not in Permanent Ink	715.01(c)	Reference Is Publication of
714.08	[Reserved]		Applicant's Own Invention
-714.09		715.01(d)	Activities Applied Against the
714.10	Claims Added in Excess of Claims	<b>515.00</b>	Claims
71411	Previously Paid For	715.02	How Much of the Claimed Invention
714.11	Amendment Filed During Interference Proceedings		Must Be Shown, Including the General Rule as to Generic Claims
714.12	Amendments and Other Replies After	715.03	Genus-Species, Practice Relative to
/11112	Final Rejection or Action	710.00	Cases Where Predictability Is in
714.13	Amendments and Other Replies After		Question
	Final Rejection or Action, Procedure	715.04	Who May Make Affidavit or
	Followed		Declaration Under 37 CFR 1.131(a);
714.14	Amendments After Allowance of All		Formal Requirements of Affidavits
	Claims		and Declarations
714.15	Amendment Received in Technology	715.05	U.S. Patent or Application Publication
	Center After Mailing of Notice of	<b>=</b> 4 <b>=</b> 0¢	Claiming Same Invention
71416	Allowance	715.06	[Reserved]
714.16	Amendment After Notice of Allowance, 37 CFR 1.312	715.07 715.07(a)	Facts and Documentary Evidence Diligence
714.16(a)	Amendments Under 37 CFR	715.07(a) 715.07(b)	Interference Testimony
/1 1110(u)	1.312, Copied Patent Claims	/10.07(b)	Sometimes Used
<b>714.16(b)</b>	Amendments Under 37 CFR	715.07(c)	Acts Relied Upon Must Have
` ,	1.312 Filed With a Motion Under	. ,	Been Carried Out in This Country
	37 CFR 41.208		or a NAFTA or WTO Member
714.16(c)	Amendments Under 37 CFR		Country
	1.312, Additional Claims	715.07(d)	Disposition of Exhibits
<b>714.16(d)</b>	Amendments Under 37 CFR	715.08	Decided by Primary Examiner
=4444	1.312, Handling	715.09	Timely Presentation
<b>714.16</b> (e)	Amendments Under 37 CFR	715.10	Review of Affidavit or Declaration
	1.312, Entry in Part		for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode
			Said of Famule to Disclose Best Mode



### **EXAMINATION OF APPLICATIONS**

716	Affidavits or Declarations Traversing	717.01(b)(1	
716.01	Rejections, 37 CFR 1.132 Generally Applicable Criteria		Affidavits under 37 CFR 1.130(b)
716.01 716.01(a)	7 22	717.01(b)(2	` '
/10.01(a)	Nonobviousness	/1/301(0)(2	Matter of the Intervening
716.01(b)			Disclosure is the Same as the
/10.01(D)	of Nonobviousness		Subject Matter of the
716.01(c)			Inventor–Originated Prior
/10.01(C)	Evidence		Public Disclosure
716.01(d)		717.01(c)	
716.01(d)	Allegations of Unexpected Results	/1/.U1(C)	Declaration; Formal
716.02(a)	-		Requirements of Affidavits and
710.02(a)	Results		Declarations
716.02(b)		717.01(d)	
716.02(c)		/1/.UI(u,	Publication Claiming Same
710.02(C)	and Unexpected Results		Invention
716.02(d)	<u>*</u>	717.01(e)	
710.02(u	Commensurate in Scope With	/1/.U1(C)	Primary Examiner
	Claimed Invention	717.01(f)	<u> </u>
716.02(e)		717.01(1)	Presentation
710.02(0)	Art	717.02	Prior Art Exception for Commonly
716.02(f)		717.02	Owned or Joint Research Agreement
716.02(g)	<u>c</u>		Subject Matter under AIA 35 U.S.C.
716.03	Commercial Success		102(b)(2)(C)
716.03(a)		717.02(a)	
7 20100 (4)	Commensurate in Scope With	71710 <b>2</b> (a)	under 35 U.S.C. 102(b)(2)(C)
	Claimed Invention	717.02(b)	
716.03(b)			Exception under AIA 35 U.S.C.
	From Claimed Invention		102(b)(2)(C) is Properly Invoked
716.04	Long-Felt Need and Failure of Others	717.02(c)	* * * * * * * * * * * * * * * * * * *
716.05	Skepticism of Experts	(-)	Respect to the Prior Art
716.06	Copying		Exception under AIA 35 U.S.C.
716.07	Inoperability of References		102(b)(2)(C)
716.08	Utility and Operability of Applicant's	717.02(d)	
	Disclosure		to the Prior Art Exception under
716.09	Sufficiency of Disclosure		AIA 35 U.S.C. 102(b)(2)(C)
716.10	Attribution Affidavit or Declaration	718	Affidavit or Declaration to Disqualify
	to Overcome Rejection Under		Commonly Owned Patent as Prior Art,
	Pre-AIA 35 U.S.C. 102 or 103		37 CFR 1.131(c)
717	Prior Art Exceptions under AIA 35	719	File Wrapper
	U.S.C. 102(b)(1) and (2)	719.01	Papers in Image File Wrapper
717.01	Affidavit or Declaration Under 37	719.02	Residence of Inventor Changed
	CFR 1.130	719.03	Classification During Examination
717.01(a)		719.04	Index of Claims
	37 CFR 1.130(a) – Attribution	719.05	Field of Search
717.01(a)(1		720	Public Use Proceedings
	Affidavits under 37 CFR	721-723	[Reserved]
	1.130(a)	724	Trade Secret, Proprietary, and
717.01(b)		<b>=</b> 0.4.6.1	Protective Order Materials
	37 CFR 1.130(b) – Prior Public	724.01	Completeness of the Patent File
	Disclosure		Wrapper



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