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## 901 Prior Art

*Extract from Rule 104.* (a) On taking up an application for examination, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the invention sought to be patented.

### 901.01 Canceled Matter in U. S. Patent File

Canceled matter in the application file of a U. S. patent is not a proper reference, since it is neither a patent nor a printed publication. See *Fessenden v. Wilson et al.*, 1931 C. D. 419; 410 O. G. 815.

### 901.02 Abandoned and Forfeited Applications

*Rule 108 Abandoned and forfeited applications not cited.* Abandoned and forfeited applications as such will not be cited as references.

[Old Rule 177]

Where a forfeited or abandoned application is referred to in an issued U. S. patent and such patent relies upon the disclosure of the abandoned or forfeited application, such disclosure is incorporated by reference into the disclosure of the patent and is available to the public. See 101, Rule 14.

In *re Heritage*, 1950 C. D. 419; 639 O. G. 638 holds that where a patent refers to and relies

derstood that any such variant encountered during the search will be recognized and selected.

In each type of subject matter capable of such treatment (e. g., a machine or other apparatus), the subject matter as defined by the claim may be sketched in order to clearly delineate the limitations of the claim. Two or more sketches, each of which is as divergent from the particular disclosure as is permitted by claim recitation, will assist the Examiner in determining the claim's actual breadth or scope.

#### 904.01 (b) Equivalents

Also, all subject matter that is the patentable equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered.

#### 904.01 (c) Analogous Arts

Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified.

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not what it is called.

For example, a tea mixer and a concrete mixer are for the same art, namely the mixing art, this being the necessary function of each. Similarly a brick cutting machine and a biscuit cutting machine have the same necessary function.

#### 904.01 (d) Outlining Field of Search

In outlining a field of search the Examiner should note every class and subclass that may have material pertinent to the subject matter as claimed, or that may in the future properly be claimed in that case. Every subclass pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part needed to anticipate any disclosure properly claimable in that case.

The following should be kept in mind: (a) that a combination reference is necessary to anticipate a claim drawn to an old or exhausted combination, (b) that a combination reference is valuable as a basic reference where elements thereof may be substituted by elements of a secondary reference, (c) that a convincing aid to a rejection on the ground of old combination is the citation of references showing the subcombinations to have been already recognized as having practical and more general utility, (d)

that combination claims at times can be anticipated by combining separately classified subcombinational elements where reasons can be given for holding non-invention in forming the combination, and (e) that in the rejection of a claim on the ground of aggregation, the citation of references showing the individual utility of the elements may better prove that the aggregative structure is no more than the sum of the features shown by the several elemental patents.

In each action by an Examiner upon an application, he makes an initialed endorsement in ink in the space provided on the left-hand page of the open file wrapper, stating the classes and subclasses of domestic and foreign patents, and the publications in which search for references was made and also the date of the search.

In subsequent actions, if further search is made, notation of the additional field covered is also endorsed and initialed on the file wrapper.

#### 904.02 Selecting Pertinent References

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and exhaustive search be made in the first action. It is not enough that the claims alone be searched, especially if they be broad in their scope; but the search should, in so far as possible, *cover the entire claimable subject matter in the case.*

It thus results that the Examiner finds references that, while not needed for treating the claims before him, *would be useful in forestalling the possible presentation of claims to other subject matter disclosed by applicant* but shown to be old by these references. To that end, an Examiner may cite at the beginning of his letter two groups of references, one under the heading, "References applied," 707.05 (b) and the other under the heading, "References further showing the state of the art 707.05 (c)."

In selecting the references to be cited the Examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The Examiner is not called upon to cite *all* the references that may be available, but only the "best." (Rule 106.) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution, and should therefore be avoided. However, if doubt exists as to the inclusion of a reference, it is better to err in citing too much art rather than too little.

While the best reference should always be the one used, yet if this is of a date less than one year prior to the filing date of the application, a second reference, though inferior but not thus open to being overcome under Rule 131, if such

reference is found, should be cited and the claims additionally rejected thereon.

In all references, including non-patent, foreign patents and domestic patents, the Examiner should study the specification or description as it relates to every feature in the drawing which he does not thoroughly understand.

## **905 Miscellaneous**

### **905.01 Orders for Photostats To Be Signed by Primary Examiner**

All orders for photostats or for photoprints (Form 247) sent to the Manuscript and Lithographic Branch from the examining divisions must be signed by the Primary Examiner or in his absence by the Assistant Chief. (Extract from Notice of Apr. 19, 1930.)

### **905.02 Orders for Soft Copies**

Soft copies may be ordered on FO-14 by the Examiner for his use. These orders are filled by employees of Patent Copy Sales Branch. No employees other than those assigned to this Branch have access to the files of printed copies of patents. In emergency cases, orders may be taken to the Chief of the Branch whose approval thereof, if given, will insure immediate filling of said orders. (Notice of Feb. 25, 1927, Revised.)

Copies of patents retail at twenty-five cents each (design patents at ten cents each) and economy should be exercised in their use. It is advisable to place in the application file soft copies of those patents cited from other classes. This will avoid a duplicate order when the application as amended is re-examined, or appealed.

#### **905.02 (a) Return of Soft Copies**

All soft copies which are in perfect condition and unmarked and which are not deemed useful for cross-reference or other purposes should be returned to the Patent Copy Sales Branch from time to time for replacement on the shelves. (Notice of Feb. 2, 1924, Revised.)

### **905.03 Orders for Patented and Abandoned Files**

In the examination of an application it is sometimes necessary to inspect the application papers of some previously abandoned application or granted patent. This is always true in the case of a reissue application.

Patented and abandoned files may be obtained in the Record Room and Abandoned File Room, respectively, by filling out a slip (PO-125), found there, and leaving this slip with the clerk in charge. The patented files are drawn from the shelves and distributed, the slip being retained by the clerk as a charge. The patent file should be promptly returned when the Examiner has finished with it, and it should not be kept longer than thirty days without renewing the charge. Where the file is needed for the purpose of reissue or interference, this information should be given to the Record Room upon obtaining the file, and as soon as these matters have been disposed of, the file should be returned to the Record Room.

When an interference is declared between a patent and an application and the interference is forwarded to the Examiner of Interference, the clerk in charge of the Record Room should be informed in order that the charge may be changed and the location of the file known at all times. (Notice of Mar. 19, 1947, Revised.)

Patent Copy Sales Branch has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the "Abandoned Files and Drawings."

### **905.04 Marking Examiner's Copies of Patents**

When the Examiners' copies of patents are sent to their respective divisions to be filed, the assistant Examiners who examined the application should mark in ink on the face of the drawings, or the specifications where there are no drawings, such features as may be deemed advantageous in aiding understanding of the patents in future searches. (Order 2380, Revised.)