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## 601 Content of Provisional and Non-provisional Applications [R-3]

### 35 U.S.C. 111. Application

#### (a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

#### (2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

#### (b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

#### (3) FEE.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) ABANDONMENT.—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed

under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) **APPLICABLE PROVISIONS.**—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

*37 CFR 1.51. General requisites of an application.*

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

- (1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;
- (2) An oath or declaration, see §§ 1.63 and 1.68;
- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) **\*\*>**The prescribed filing fee, search fee, examination fee, and application size fee, see § 1.16.<

(c) A complete provisional application filed under § 1.53(c) comprises:

- (1) A cover sheet identifying:
  - (i) The application as a provisional application,
  - (ii) The name or names of the inventor or inventors, (see § 1.41(a)(2)),
  - (iii) The residence of each named inventor,
  - (iv) The title of the invention,
  - (v) The name and registration number of the attorney or agent (if applicable),
  - (vi) The docket number used by the person filing the application to identify the application (if applicable),
  - (vii) The correspondence address, and
  - (viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);
- (2) A specification as prescribed by the first paragraph of 35 U.S.C. 112, see § 1.71;
- (3) Drawings, when necessary, see §§ 1.81 to 1.85; and
- (4) **\*\*>**The prescribed filing fee and application size fee, see § 1.16.<

(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See § 1.97 and § 1.98. No information disclosure statement may be filed in a provisional application.

## **I. GUIDELINES FOR DRAFTING A NON-PROVISIONAL PATENT APPLICATION UNDER 35 U.S.C. 111(a)**

The following guidelines illustrate the preferred layout and content of patent applications filed under 35 U.S.C. 111(a). These guidelines are suggested for the applicant's use. See also 37 CFR 1.77 and MPEP § 608.01(a). If an application data sheet (37 CFR 1.76) is used, data supplied in the application data sheet need not be provided elsewhere in the application except that the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 even if this information is provided in the application data sheet (see 37 CFR 1.76(b)). If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors. See MPEP § 601.05.

A complete application filed under 35 U.S.C. 111(a) comprises a specification, including claims, as prescribed by 35 U.S.C. 112, drawings as prescribed by 35 U.S.C. 113, an oath or declaration as prescribed by 35 U.S.C. 115, and the prescribed filing fee<, search fee, examination fee and application size fee<.

### ***Arrangement and Contents of the Specification***

The following order of arrangement is preferable in framing the specification. See also MPEP § 608.01(a). Each of the lettered items should appear in upper case, without underlining or bold type, as section headings.

- (A) Title of the invention. (See MPEP § 606).
- (B) Cross-reference to related applications. (See MPEP § 201.11).
- (C) Statement regarding federally sponsored research or development. (See MPEP § 310).
- (D) >The names of the parties to a joint research agreement (see 37 CFR 1.71(g)).
- (E) < Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation-by-reference of the material on the compact disc. For computer listings filed on or prior to March 1, 2001, reference to a "Microfiche appendix" (see former 37 CFR 1.96(c) for Microfiche appendix).

\*>

(F) < Background of the invention. (See MPEP § 608.01(c)).

(1) Field of the invention.

(2) Description of related art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98.

\*>

(G) < Brief summary of the invention. (See MPEP § 608.01(d)).

\*>

(H) < Brief description of the several views of the drawing. (See MPEP § 608.01(f)).

\*>

(I) < Detailed description of the invention. (See MPEP § 608.01(g)).

\*>

(J) < Claim(s) (commencing on a separate sheet). (See MPEP § 608.01(i)-(p)).

\*>

(K) < Abstract of the Disclosure (commencing on a separate sheet). (See MPEP § 608.01(b)).

\*>

(L) < Sequence Listing, if on paper (see 37 CFR 1.821 through 1.825).

## II. GUIDELINES FOR DRAFTING A PROVISIONAL APPLICATION UNDER 35 U.S.C. 111(b)

A provisional application should preferably conform to the arrangement guidelines for nonprovisional applications. The specification must, however, comply with the first paragraph of 35 U.S.C. 112 and refer to drawings, where necessary for an understanding of the invention. Unlike an application filed under 35 U.S.C. 111(a), a provisional application does not need claims. Furthermore, no oath or declaration is required. See MPEP § 201.04(b).

A cover sheet providing identifying information is required for a complete provisional application. In accordance with 37 CFR 1.51(c)(1) the cover sheet must state that it is for a provisional application, it must identify and give the residence of the inventor or inventors, and it must give a title of the invention. The cover sheet must also give the name and registration number of the attorney or agent (if applicable), the docket number used by the person filing the application (if applicable) and the correspondence address. If

there is a governmental interest, the cover sheet must include a statement as to rights to inventions made under Federally sponsored research and development (See MPEP § 310). 37 CFR 1.51(c)(1)(viii) requires the name of the Government agency and the contract number, if the invention was developed by or while under contract with an agency of the U.S. Government.

Unlike applications filed under 35 U.S.C. 111(a), provisional applications should not include an information disclosure statement. See 37 CFR 1.51(d). Since no substantive examination is made, such statements are unnecessary. The Office will not accept an information disclosure statement in a provisional application. Any such statement received, will be returned or disposed of at the convenience of the Office.

This cover sheet information enables the Office to prepare a proper filing receipt and provides the Office of Initial Patent Examination (OIPE) with most of the information needed to process the provisional application. See MPEP § 201.04(b) for a sample cover sheet.

## III. THE APPLICATION

The parts of the application may be included in a single document.

The paper standard requirements for papers submitted as part of the record of a patent application is covered in MPEP § 608.01 under the heading “Paper Requirement.”

Determination of completeness of an application is covered in MPEP § 506 and § 601.01 - § 601.01(g).

The elements of the application are secured together in a file wrapper, bearing appropriate identifying data including the application number and filing date (MPEP § 719).

### Note

Provisional applications, MPEP § 201.04(b).

Divisional applications, MPEP § 201.06.

Continuation applications, MPEP § 201.07.

Continued prosecution applications, MPEP § 201.06(d).

Reissue applications, MPEP § 1401.

Design applications, MPEP Chapter 1500.

Plant applications, MPEP Chapter 1600.

*Ex Parte* Reexamination, MPEP Chapter 2200.

*Inter Partes* Reexamination, MPEP Chapter 2600.

A model, exhibit, or specimen is normally not admitted as part of the application, although it may be required in the prosecution of the application (37 CFR 1.91 and 1.93, MPEP § 608.03).

Copies of an application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e), (f) and (g)).

All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, or in the application data sheet after the title of the invention (see 37 CFR 1.76(b)(3)), for example “Proposed Class 2, subclass 129.”

### 601.01 Complete Application [R-3]

*37 CFR 1.53. Application number, filing date, and completion of application.*

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(b) *Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute

and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

- (i) Abandonment of the application filed under paragraph (b) of this section;
- (ii) Payment of the issue fee on the application filed under paragraph (b) of this section;
- (iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or
- (iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(3) *\*\*>*A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C. 112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A

request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.<

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a)(4) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application that is complete as defined by § 1.51(b); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) *\*\*>*The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in § 1.16(b), the search fee as set

forth in § 1.16 (l), and the examination fee as set forth in § 1.16(p).<

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

(9) *\*\*>*See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.<

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under § 1.114.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§ 1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in 1.21(n), will be refunded.

(f) *\*\*>Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has provided a correspondence address (§1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, search fee, and examination fee, file an oath or declaration in an application under paragraph (b) of this section, and pay the surcharge if required by § 1.16(f) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, the search fee, the examination fee, or an oath or declaration by the applicant pursuant to §§ 1.63, 1.162 or § 1.175, and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, search fee, and examination fee, file an oath or declaration, and pay the surcharge required by § 1.16(f) to avoid abandonment.

(3) If the excess claims fees required by §§ 1.16(h) and (i) and multiple dependent claim fee required by § 1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by §§ 1.16(h), (i) and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by § 1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under § 1.16(s), the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and

to continuation-in-part applications under paragraph (b) of this section. See § 1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

(5) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.<

(g) *\*\*>Completion of application subsequent to filing—Provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(d)), and applicant has provided a correspondence address (§ 1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(g) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by § 1.51(c)(1) or the basic filing fee (§ 1.16(d)), and applicant has not provided a correspondence address (§ 1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§ 1.51(c)(1)), and pay the surcharge required by § 1.16(g) to avoid abandonment.

(3) If the application size fee required by § 1.16(s) (if any) is not paid on filing, the fee required by § 1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.<

(h) *Subsequent treatment of application - Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application - Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

37 CFR 1.53 relates to application numbers, filing dates, and completion of applications. 37 CFR 1.53(a) indicates that an application number is assigned for identification purposes to any paper which purports to

be an application for a patent, even if the application is incomplete or informal. The remaining sections of 37 CFR 1.53 treat nonprovisional applications filed under 35 U.S.C. 111(a) separately from provisional applications filed under 35 U.S.C. 111(b).

37 CFR 1.53(d) sets forth the filing date requirements for a continued prosecution application (CPA). A CPA is a nonprovisional application which must be filed on or after December 1, 1997. Only a continuation or divisional application (but not a continuation-in-part) may be filed as a CPA. See MPEP § 201.06(d). Effective July 14, 2003, CPA practice under 37 CFR 1.53(d) does not apply to utility and plant applications. CPAs can only be filed in design applications.

### **601.01(a) Nonprovisional Applications - Filed Under 35 U.S.C. 111(a) [R-3]**

The procedure for filing a nonprovisional application under 35 U.S.C. 111(a) is set forth in 37 CFR 1.53(b) and 37 CFR 1.53(d). 37 CFR 1.53(b) may be used to file any original, reissue, or substitute nonprovisional application and any continuing application, i.e., continuation, divisional, or continuation-in-part. Under 37 CFR 1.53(b), a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the U.S. Patent and Trademark Office (USPTO). Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.

37 CFR 1.53(d) may be used to file either a continuation or a divisional application (but not a continuation-in-part) of a design application. The prior nonprovisional application must be a design application that is complete as defined by 37 CFR 1.51(b). Any application filed under 37 CFR 1.53(d) must disclose and claim only subject matter disclosed in the prior nonprovisional application and must name as inventors the same or less than all of the inventors named in the prior nonprovisional application. Under 37 CFR 1.53(d), the filing date assigned is the date on which a request, on a separate paper, for an applica-

tion under 37 CFR 1.53(d) is filed. An application filed under 37 CFR 1.53(d) must be filed before the earliest of:

- (A) payment of the issue fee on the prior application, unless a petition under 37 CFR 1.313(c) is granted in the prior application;
- (B) abandonment of the prior application; or
- (C) termination of proceedings on the prior application.

The filing fee, search fee and examination fee for an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d) and the oath or declaration for an application filed under 37 CFR 1.53(b) can be submitted after the filing date. However, no amendment may introduce new matter into the disclosure of an application after its filing date.

37 CFR 1.53(e) provides for notifying applicant of any application which is incomplete under 37 CFR 1.53(b) or 37 CFR 1.53(d) and giving the applicant a time period to correct any omission. If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee set forth in 37 CFR 1.21(n) will be retained from any refund of a filing fee.

37 CFR 1.53(f) provides that, where a filing date has been assigned to an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d), the applicant will be notified if a correspondence address has been provided and be given a period of time in which to file the missing fees, oath or declaration, and to pay any surcharge (37 CFR 1.16(f)) due in order to prevent abandonment of the application. The time period usually set is 2 months from the mailing date of notification by the USPTO. This time period may be extended under 37 CFR 1.136(a).

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For applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if the search and/or examination fees are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is not required. For applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the

application, the surcharge under 37 CFR 1.16(f) is required.<

If the required basic filing fee is not timely paid, or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid during the pendency of the application, the application will be disposed of. >Effective July 1, 2005, the processing and retention fee (formerly 37 CFR 1.21(l)) practice has been eliminated. The basic filing fee (rather than just the processing and retention fee set forth in former 37 CFR 1.21(l)) must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under 35 U.S.C. 120, 121, or 365(c) in a subsequent nonprovisional or international application.< The notification under 37 CFR 1.53(f) may be made simultaneously with any notification pursuant to 37 CFR 1.53(e). If no correspondence address is included in the application, applicant has 2 months from the filing date to file the \*>fee(s)<, oath or declaration and to pay the >required< surcharge as set forth in 37 CFR 1.16\*>(f)< in order to prevent abandonment of the application.

Copies of an application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the application has been disposed of (see 37 CFR 1.53(e) and (f)). \*>Prior to July 1, 2005, the< basic filing fee or the processing and retention fee must be paid in a nonprovisional application, if any claim for benefits under 35 U.S.C. 120, 121, or 365(c) based on that application is made in a subsequently filed copending nonprovisional application. \*\*>Effective July 1, 2005, the basic filing fee must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under 35 U.S.C. 120, 121 or 365(c) in a subsequent nonprovisional or international application. See 37 CFR 1.78(a)(1).<

37 CFR 1.53(h) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received. 37 CFR 1.53(j) indicates that international applications filed under the Patent Cooperation Treaty which designate the United States of America are considered to have a United States filing date under PCT Article 11(3), except as provided in 35 U.S.C. 102(e), on the date the requirements of PCT Article 11(1)(i) to (iii) are met.

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53(b), a filing date is granted to a nonprovisional application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the U.S. Patent and Trademark Office. If an application which has been accorded a filing date does not include the appropriate filing fee>, search fee, examination fee,< or oath or declaration, applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16\*>(f)< in order to prevent abandonment of the application.

Applicants should submit a copy of the notice(s) to file missing parts and the notice(s) of incomplete applications with the reply submitted to the U.S. Patent and Trademark Office. Applicants should also include the application number on all correspondence to the Office. These measures will aid the Office in matching papers to applications, thereby expediting the processing of applications.

In order for the Office to so notify the applicant, a correspondence address must also be provided in the application. The correspondence address may be different from the mailing (post office) address of the applicant. For example, the address of applicant's registered attorney or agent may be used as the correspondence address. If applicant fails to provide the Office with a correspondence address, the Office will be unable to provide applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16\*>(f)<. In such a case, applicant will be considered to have constructive notice as of the filing date that the application must be completed within 2 months from the filing date before abandonment occurs per 37 CFR 1.53(f). This time period may be extended pursuant to 37 CFR 1.136.

The oath or declaration filed in reply to such a notice under 37 CFR 1.53(f) must be executed by the inventors and must identify the specification and any amendment filed with the specification \*\*>which includes subject matter not otherwise included in the specification (including claims) or drawings of the application as filed.< See MPEP § 602. If an amendment is filed with the oath or declaration filed after

the filing date of the application, it may be identified in the oath or declaration but may not include new matter. No new matter may be included after the filing date of the application. See MPEP § 608.04(b). If the oath or declaration improperly refers to an amendment filed after the filing date of the application which contains new matter, a supplemental oath or declaration will be required pursuant to 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under 37 CFR 1.53(b) is filed a part of the original application papers and the question of new matter is not considered. Similarly, if the application papers are altered prior to execution of the oath or declaration and the filing of the application, new matter is not a consideration since the alteration is considered as part of the original disclosure.

### **601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b) [R-3]**

A provisional application will be given a filing date in accordance with 37 CFR 1.53(c) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in 37 CFR 1.53(c) parallel the requirements for a nonprovisional application set forth in 37 CFR 1.53(b), except that no claim is required. Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

When the specification or drawing are omitted, 37 CFR 1.53(e) requires that the applicant be notified and given a time period in which to submit the missing element to complete the filing. See MPEP § 601.01(f) and § 601.01(g) for treatment of applications filed without drawings, or filed without all figures of drawings, respectively.

37 CFR 1.53(c)(1) requires all provisional applications be filed with a cover sheet, which may be an application data sheet (37 CFR 1.76) or a cover letter identifying the application as a provisional application. The Office will treat an application as having been filed under paragraph (b), unless the application is clearly identified as a provisional application. A provisional application, which is identified as such,

but which does not have a complete cover sheet as required by 37 CFR 1.51(c)(1) will be treated as a provisional application. However, the complete cover sheet and a surcharge will be required to be submitted at a later date in conformance with 37 CFR 1.53(g).

When the provisional application does not have a complete cover sheet or the appropriate fee, the applicant will be notified pursuant to 37 CFR 1.53(g) and given a time period in which to provide the necessary fee or cover sheet and to pay the surcharge as set forth in 37 CFR 1.16\*(g) in order to avoid abandonment of the application. The time period will usually be set at 2 months from the date of notification. This time period may be extended under 37 CFR 1.136(a). If the filing fee is not timely paid, the Office may dispose of the provisional application. If no correspondence address has been provided, applicant has 2 months from the filing date to file the basic filing fee, cover sheet, and to pay the surcharge as set forth in 37 CFR 1.16\*(g) in order to avoid abandonment of the provisional application. Copies of a provisional application will be provided by the USPTO upon request and payment of the fee set forth in 37 CFR 1.19(b) unless the provisional application has been disposed of (see 37 CFR 1.53(e) and (g)).

The basic filing fee must be paid in a provisional application on filing or within the time period set forth in 37 CFR 1.53(g), and the provisional application must be entitled to a filing date under 37 CFR 1.53(c), if any claim for benefits under 35 U.S.C. 119(e) based on that application is made in a subsequently filed nonprovisional application. 37 CFR 1.78(a)(4).

37 CFR 1.53(e)(2) requires that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in 37 CFR 1.17\*(f) (see MPEP § 506.02).

### **601.01(c) Conversion to or From a Provisional Application [R-3]**

#### **I. CONVERSION FROM A NONPROVISIONAL APPLICATION TO A PROVISIONAL APPLICATION**

*37 CFR 1.53. Application number, filing date, and completion of application.*

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(c)(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

- (i) Abandonment of the application filed under paragraph (b) of this section;
- (ii) Payment of the issue fee on the application filed under paragraph (b) of this section;
- (iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or
- (iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

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An application filed under 37 CFR 1.53(b) may be converted to a provisional application in accordance with the procedure described in 37 CFR 1.53(c)(2). The procedure requires the filing of a request for conversion and the processing fee set forth in 37 CFR 1.17(q). Filing of the request in the nonprovisional application is required prior to the abandonment of the 37 CFR 1.53(b) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 37 CFR 1.53(b) application, or the filing of a request for a statutory invention registration under 37 CFR 1.293, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under 37 CFR 1.53(b).

Converting a nonprovisional application to a provisional application will not avoid the publication of the nonprovisional application unless the request to convert is recognized in sufficient time to permit the appropriate officials to remove the nonprovisional application from the publication process. The Office cannot ensure that it can remove an application from publication or avoid publication of application information any time after the publication process for the application has been initiated. For information on procedures for removing an application from publication, see MPEP § 1120.

A provisional application is not entitled to claim priority to or benefit of a prior-filed application under 35 U.S.C. 119, 120, 121, or 365. See MPEP § 201.04(b). After the nonprovisional application has

been converted to a provisional application, any priority or benefit claims submitted in the nonprovisional application will be disregarded.

Applicants who wish to file a request for conversion under 37 CFR 1.53(c)(2) by mail should designate “Mail Stop Conversion” as part of the U. S. Patent and Trademark Office address.

## II. CONVERSION FROM A PROVISIONAL APPLICATION TO A NONPROVISIONAL APPLICATION

*37 CFR 1.53. Application number, filing date, and completion of application.*

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(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C.112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

- (i) Abandonment of the provisional application filed under paragraph (c) of this section; or
- (ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.<

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An application filed under 37 CFR 1.53(c) may be converted to a nonprovisional application in accordance with the procedure described in 37 CFR 1.53(c)(3). Applicants should carefully consider the patent term consequences of requesting conversion rather than simply filing a nonprovisional application claiming the benefit of the filing date of the provisional application under 35 U.S.C. 119(e). Claiming the benefit of the provisional application under 35 U.S.C. 119(e) is less expensive and will result in a longer patent term. The procedure requires the filing of a request for the conversion of the provisional application to a nonprovisional application and the fee set forth in 37 CFR 1.17(i) as well as the basic filing fee, search fee, and examination fee for the nonprovisional application. In addition, if the provisional application was not filed with an executed oath or declaration and the appropriate fees for a nonprovisional application, the surcharge set forth in 37 CFR 1.16(f) is required. See MPEP § 601.01(a). Filing of the request for conversion in the provisional application is required prior to the abandonment of the provisional application or the expiration of 12 months after the filing date of the 37 CFR 1.53(c) application, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under 37 CFR 1.53(c).

Applicants who wish to file a request for conversion under 37 CFR 1.53(c)(3) by mail should designate “Mail Stop Conversion” as part of the U. S. Patent and Trademark Office address.

### **601.01(d) Application Filed Without All Pages of Specification [R-3]**

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the pages of specification are present in the application. If the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a “Notice of Omitted Items” indicating that the application papers so

deposited have been accorded a filing date, but are lacking some page(s) of the specification.

The mailing of a “Notice of Omitted Items” will permit the applicant to either: (A) promptly establish prior receipt in the USPTO of the page(s) at issue (generally by way of a date-stamped itemized postcard receipt (MPEP § 503)); or (B) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the page(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the “Notice of Omitted Item(s)”, file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(f), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing. An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within 2 months from the date of the “Notice of Omitted Item(s),” file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(f), requesting the later filing date (37 CFR 1.181(f)).

If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the specification pursuant to 37 CFR 1.57(a). Such amendment should be by way of a preliminary amendment and the preliminary amendment must be submitted within the time period set forth in the “Notice of Omitted Item(s)”. The amendment should be identified as an amendment pursuant to 37 CFR 1.57(a) and must comply with the requirements of 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

An applicant willing to accept the application as deposited in the USPTO need not respond to the “Notice of Omitted Items,” and the failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the “Notice of Omitted Item(s)” (37 CFR 1.181(f)) will be treated as constructive acceptance by applicant of the application as deposited in the USPTO. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted page(s). Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

If the application does not contain anything that can be construed as a written description, OIPE will mail a Notice of Incomplete Application (PTO-1123) indicating that the application lacks the specification required by 35 U.S.C. 112. Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(f), asserting that: (A) the missing specification was submitted; or (B) the application papers as deposited contain an adequate written description under 35 U.S.C. 112. The petition under 37 CFR 1.53(e) must be accompanied by sufficient evidence (37 CFR 1.181(b)) to establish applicant’s entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in the USPTO of the missing specification). Alternatively, applicant may submit the omitted specification, including at least one claim in a nonprovisional application, accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the specification being submitted and accept the date of such submission as the application filing date.

As an alternative to a petition under 37 CFR 1.53(e), if the specification was inadvertently omitted from an application filed on or after September 21, 2004, and the application contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted specification is completely contained in the prior-filed

application, the applicant may submit the omitted specification by way of an amendment in compliance with 37 CFR 1.57(a). The amendment must be by way of a petition under 37 CFR 1.57(a)(3) accompanied by the petition fee set forth in 37 CFR 1.17(f). See MPEP § 201.17.<

Original claims form part of the original disclosure >. See *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973).< As such, an application that contains at least one claim, but does not contain anything which can be construed as a written description of such claim(s), would be unusual.

In instances in which a “Notice of Incomplete Application” has been mailed, further action by applicant is necessary for the application to be accorded a filing date. As such, the application will be retained in OIPE to await such action. Unless applicant \* completes the application, or files a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR >1.17(f), or files a petition under 37 CFR 1.57(a)(3) with the petition fee set forth in 37 CFR 1.17(f),< within the period set in the “Notice of Incomplete Application,” the application will be processed as an incomplete application under 37 CFR 1.53(e).

In instances in which a “Notice of Omitted Items” has been mailed, the application will be retained in OIPE for a period of 2 months from the mailing date of “Notice of Omitted Items” to permit applicant to \*: >(A)< establish prior receipt in the USPTO of the page(s) or drawing(s) at issue; >(B)< promptly submit the omitted page(s) or drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date>; or (C) submit an amendment under 37 CFR 1.57(a) if the application was filed on or after September 21, 2004<. As an applicant may, but is not required to, reply to such a “Notice of Omitted Items,” extensions of time under 37 CFR 1.136 will not be applicable to this 2-month time period.

Unless applicant timely files a petition under 37 CFR 1.53(e) or 37 CFR 1.182 with the required petition fee>, or a preliminary amendment under 37 CFR 1.57(a) if the application was filed on or after September 21, 2004<, the application will maintain the filing date as of the date of deposit of the application papers in the USPTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the

USPTO on the date of deposit. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate Technology Center for examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the “Notice of Omitted Item(s)” may be dismissed as untimely. 37 CFR 1.181(f). Under the adopted procedure, the USPTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted page(s) or drawing(s) in a nonprovisional application and request the date of such submission as the application filing date as: \*(A) according to the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and \*(B) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

The submission of omitted page(s) or drawing(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17\*(f)) with any omitted page(s) or drawing(s), which is a cost effective alternative in instances in which a nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the USPTO’s desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) or drawing(s) and accord an application filing date as of

the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

### APPLICATION LOCATED IN A TECHNOLOGY CENTER

If it is discovered that an application, located in a Technology Center (TC), was filed without all of the page(s) of the specification, and a Notice of Omitted Items has not been mailed by OIPE, the examiner should review the application to determine whether the application is entitled to a filing date. An application is entitled to a filing date if the application contains something that can be construed as a written description, at least one drawing figure (if necessary under 35 U.S.C. 113, first sentence), and at least one claim.

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#### A. < Application Entitled to a Filing Date

If the application is entitled to a filing date, the examiner should notify applicant of the omission in the next Office action and require applicant to do one of the following:

(A) accept the application, as filed, without all of the page(s) of the specification;

(B) file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the omitted page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17\*(f), requesting the date of submission of the omitted page(s) as the application filing date; or

(C) file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17\*(f) alleging that the page(s) indicated as omitted was in fact deposited with the USPTO with the application papers, including any and all evidence supporting the allegation. See MPEP § 503. The petition fee will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing.

If applicant is willing to accept the application, as filed, without all of the page(s) of the application (item A above), an amendment of the specification is required to renumber the pages of the application consecutively and to cancel any incomplete sentences caused by the absence of the omitted page(s). The

amendment should be submitted in response to the Office action.

>If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the specification pursuant to 37 CFR 1.57(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.<

Any petition filed in accordance with item B or C above should be filed with the TC. The TC will match the petition with the application file and forward the application file with the petition to the Office of Petitions, along with a brief explanation as to the page(s) of the specification that has been omitted on filing, for consideration of the petition in due course. For Image File Wrapper (IFW) processing, see IFW Manual section 5.3.

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#### **B. < Application NOT Entitled to a Filing Date**

If upon review of the application, the examiner determines that the application is NOT entitled to a filing date, the examiner should forward the application to OIPE for mailing of a “Notice of Incomplete Application.”

### **601.01(e) Nonprovisional Application Filed Without At Least One Claim [R-3]**

35 U.S.C. 111(a)(2) requires that an application for patent include, *inter alia*, “a specification as prescribed by section 112 of this title,” and 35 U.S.C. 111(a)(4) provides that the “filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 112, first paragraph, provides, in part, that “[t]he specification shall contain a written description of the invention,” and 35

U.S.C. 112, second paragraph, provides that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Also, the Court of Appeals for the Federal Circuit stated in *Litton Systems, Inc. v. Whirlpool Corp.*:

Both statute, 35 U.S.C. 111 [(a)], and federal regulations, 37 CFR 1.51 [(b)], make clear the requirement that an application for a patent *must* include. . . a specification and claims. . . . The omission of any *one* of these component parts makes a patent application incomplete and thus not entitled to a filing date.

728 F.2d 1423, 1437, 221 USPQ 97, 105 (Fed. Cir. 1984)(citing *Gearon v. United States*, 121 F. Supp 652, 654, 101 USPQ 460, 461 (Ct. Cl. 1954), *cert. denied*, 348 U.S. 942, 104 USPQ 409 (1955))(emphasis in the original).

Therefore, in an application filed under 35 U.S.C. 111(a), a claim is a statutory requirement for according a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that “[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

If a nonprovisional application does not contain at least one claim, a “Notice of Incomplete Application” will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. See *In re Mattson*, 208 USPQ 168 (Comm’r Pat. 1980). An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

If a nonprovisional application is accompanied by a preliminary amendment which cancels all claims without presenting any new >or substitute< claims, the Office will **\*\*>disapprove<** such an amendment. See >37 CFR 1.115(b)(1) and< *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368

(Fed. Cir. 2001). Thus, the application will not be denied a filing date merely because such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim.

As 37 CFR 1.53(c)(2) permits the conversion of an application filed under 35 U.S.C. 111(a) to an application under 35 U.S.C. 111(b), an applicant in an application, other than for a design patent, filed under 35 U.S.C. 111(a) on or after June 8, 1995, without at least one claim has the alternative of filing a petition under 37 CFR 1.53(c)(2) to convert such application into an application under 35 U.S.C. 111(b), which does not require a claim to be entitled to its date of deposit as a filing date. Such a petition, however, must be filed prior to the expiration of 12 months after the date of deposit of the application under 35 U.S.C. 111(a), and comply with the other requirements of 37 CFR 1.53(c)(2). See MPEP § 601.01(c).

The treatment of an application subsequent to the mailing of a “Notice of Incomplete Application” is discussed in MPEP § 601.01(d).

### **601.01(f) Applications Filed Without Drawings [R-3]**

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113 of this title” and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the “filing date. . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” 35 U.S.C. 113 (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.”

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition applications. Other situations in which drawings are usually not considered necessary

for the understanding of the invention under 35 U.S.C. 113 (first sentence) are:

(A) *Coated articles or products*: where the invention resides solely in coating or impregnating a conventional sheet (e.g., paper or cloth, or an article of known and conventional character with a particular composition), unless significant details of structure or arrangement are involved in the article claims;

(B) *Articles made from a particular material or composition*: where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims;

(C) *Laminated structures*: where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims; or

(D) *Articles, apparatus, or systems where sole distinguishing feature is presence of a particular material*: where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims, for example:

(1) A hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

(2) Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular material.

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed \*\*, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the

specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO. The application will be returned to the Office of Initial Patent Examination (OIPE) for mailing of a “Notice of Incomplete Application.”

If a nonprovisional application does not have at least one claim directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, or a provisional application does not have at least some disclosure directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, and is filed without drawings, OIPE will mail a “Notice of Incomplete Application” indicating that the application lacks drawings and that 35 U.S.C. 113 (first sentence) requires a drawing where necessary for the understanding of the subject matter sought to be patented.

Applicant may file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17\*(f)<, asserting that \*(A)< the drawing(s) at issue was submitted, or \*(B)< the drawing(s) is not necessary under 35 U.S.C. 113 (first sentence) for a filing date. The petition must be accompanied by sufficient evidence to establish applicant’s entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § 503) to establish prior receipt in the USPTO of the drawing(s) at issue). Alternatively, applicant may submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to the drawing(s) being submitted and accept the date of such submission as the application filing date.

>As an alternative to a petition under 37 CFR 1.53(e), if the drawing(s) was inadvertently omitted from an application filed on or after September 21, 2004, and the application contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted drawing(s) is completely contained in the prior-filed

application, the applicant may submit the omitted drawing(s) by way of an amendment in compliance with 37 CFR 1.57(a). The amendment must be by way of a petition under 37 CFR 1.57(a)(3) accompanied by the petition fee set forth in 37 CFR 1.17(f). See MPEP § 201.17.<

In design applications, OIPE will mail a “Notice of Incomplete Application” indicating that the application lacks the drawings required under 35 U.S.C. 113 (first sentence). The applicant may: \*(A)< promptly file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17\*(f)<, asserting that the missing drawing(s) was submitted; or \*(B)< promptly submit drawing(s) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 and accept the date of such submission as the application filing date. >Applicant may also be able to file an amendment by way of a petition under 37 CFR 1.57(a)(3) as discussed above.< 37 CFR 1.153(a) provides that the claim in a design application “shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” As such, petitions under 37 CFR 1.53(e) asserting that drawings are unnecessary under 35 U.S.C. 113 (first sentence) for a filing date in a design application will not be found persuasive.

The treatment of an application subsequent to the mailing of a “Notice of Incomplete Application” is discussed in MPEP § 601.01(d).

### **601.01(g) Applications Filed Without All Figures of Drawings [R-3]**

The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a “Notice of Omitted Item(s)” indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification.

The mailing of a “Notice of Omitted Item(s)” will permit the applicant to either: \*(A)< promptly estab-

































































































































































































































































































