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201 Types of 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.

(Amended Aug. 27, 1982, Public Law 97-247, sec. 5, 96 Stat. 319; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(3), 108 Stat. 4986; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582, 588 (S. 1948 secs. 4732(a)(10)(A), 4801(a)).)

37 CFR 1.9. Definitions.

(a)(1)A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

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NATIONAL APPLICATIONS (35 U.S.C. 111) VS. NATIONAL STAGE APPLICATIONS (35 U.S.C. 371)

Nonprovisional and provisional applications are national applications. Treatment of a national application under 35 U.S.C. 111 and a national stage application (a national application which entered the national stage from an international application after compliance with 35 U.S.C. 371) are similar but not identical. Note the following examples:

(A) Restriction practice under MPEP § 806+ is applied to national applications under 35 U.S.C. 111(a) while unity of invention practice under MPEP Chapter 1800 is applied to national stage applications.

(B) National nonprovisional applications filed under 35 U.S.C. 111(a) without an executed oath or declaration *>, basic< filing fee>, search fee, or examination fee< are governed by the notification practice set forth in 37 CFR 1.53(f) while national stage applications filed without an oath or declaration or national stage fee are governed by the notification practice set forth in 37 CFR 1.495.

37 CFR 1.9(a)(1) defines a national application as a U.S. application which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. Domestic national patent applications fall under three broad types:

(A) applications for patent under 35 U.S.C. 101 relating to a “new and useful process, machine, manufacture, or composition of matter, etc.”;

(B) applications for plant patents under 35 U.S.C. 161; and

(C) applications for design patents under 35 U.S.C. 171.

The first type of patents are sometimes referred to as “utility” patents when being contrasted with plant or design patents. The specialized procedure which pertains to the examination of applications for design and plant patents are treated in detail in Chapters 1500 and 1600, respectively. Domestic national applications include original (nonprovisional), provisional, plant, design, reissue, divisional, and continuation applications (which may be filed under 37 CFR 1.53(b)), continued prosecution applications (CPA) (filed under 37 CFR 1.53(d), only applicable if the

application is for a design patent) and continuation-in-part applications (which may be filed under 37 CFR 1.53(b)).

201.01 Sole

An application wherein the invention is presented as that of a single person is termed a sole application.

201.02 Joint

A joint application is one in which the invention is presented as that of two or more persons. See MPEP § 605.07.

201.03 Correction of Inventorship in an Application [R-5]

Correction of inventorship in an application is permitted by amendment under 35 U.S.C. 116, which is implemented by 37 CFR 1.48. The utilization of a request under 37 CFR 1.48 will generally correct the inventorship in the application in which it is filed. 37 CFR 1.48(a) is directed at correcting the inventorship in an application where the inventorship was improperly set forth in the executed oath or declaration filed in the application. 37 CFR 1.48(b) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to prosecution of the application, e.g., claim cancellation or amendment, fewer than all of the currently named inventors are the actual inventors of the remaining claims. 37 CFR 1.48(c) is directed at correcting the inventorship where the executed oath or declaration had correctly set forth the inventorship but due to amendment of the claims to include previously unclaimed but disclosed subject matter, one or more inventors of the amended subject matter must be added to the current inventorship. 37 CFR 1.48(d) is directed at provisional applications where an inventor is to be added. 37 CFR 1.48(e) is directed at provisional applications where an inventor is to be deleted. 37 CFR 1.48(f) operates to automatically correct the inventorship upon filing of a first executed oath or declaration under 37 CFR 1.63 by any of the inventors in a nonprovisional application or upon filing of a cover sheet in a provisional application.

Correction of inventorship may also be obtained by the filing of a continuing application under 37 CFR 1.53 without the need for filing a request under 37 CFR 1.48, either in the application containing the inventorship err(using a copy of the executed oath or declaration from the parent application)or (to be abandoned) or in the continuing application. The continuing application must be filed with the correct inventorship named therein. The filing of a continuing application to correct the inventorship is appropriate if at least one of the correct inventors has been named in the prior application (35 U.S.C. 120 and 37 CFR 1.78(a)(1)). That is, at least one of the correct inventors must be named in the executed oath or declaration filed in the prior application, or where no executed oath or declaration has been submitted in the prior application, the name of at least one correct inventor must be set forth in the application papers pursuant to 37 CFR 1.41(a)(1). Where the name of at least one inventor is to be added, correction of inventorship can be accomplished by filing a continuing application under 37 CFR 1.53(b) with a newly executed oath or declaration under 37 CFR 1.63(a). Where the name of an inventor(s) is to be deleted, applicant can file a *>continuation or divisional< application >(using a copy of the executed oath or declaration from the parent application)< with a request for deletion of the name of the inventor(s). >See 37 CFR 1.63(d)(2). If a continuing application is filed with a new executed oath or declaration properly naming the correct inventors, a request for deletion of the name(s) of the person(s) who are not inventors in the continuing application is not necessary.< The continuing application may be filed under 37 CFR 1.53(b) or, if the application is for a design patent, under 37 CFR 1.53(d). Note the requirements of 37 CFR 1.78 (a)(1)(ii).

In certain instances where the statement of the lack of deceptive intent of the inventor to be added or deleted cannot be obtained, a petition under 37 CFR 1.183 requesting waiver of that requirement may be possible.

For provisional applications, it may not be necessary to correct the inventorship under 37 CFR 1.48 (d) and (e) unless there would be no overlap of inventors upon the filing of the nonprovisional application with the correct inventorship. See subsections V. and VI. below.

The need to correct the inventorship in any U.S. nonprovisional or provisional application may in part

be dependent upon whether a foreign filing under the Paris Convention will occur subsequent to the U.S. filing. See MPEP § 201.13.

37 CFR 1.48 does not apply to reissue applications as is noted in its title, whether correcting an inventorship error in the patent to be reissued or in the reissue application itself. Where an error in inventorship in a patent is to be corrected via a reissue application, see MPEP § 1412.04. Where such an error is to be corrected via a certificate of correction under 37 CFR 1.324, see MPEP § 1481.

Where a request under 37 CFR 1.48 is denied in a final agency action, the examiner must determine whether a rejection under 35 U.S.C. 102(f) or (g) is appropriate. Where the request under 37 CFR 1.48 has been entered (for a decision thereon) and is dismissed (due to a defect that can be corrected) consideration under 35 U.S.C. 102(f) or (g) would be premature.

Although 37 CFR 1.48 does not contain a diligence requirement for filing the request, once an inventorship error is discovered, timeliness requirements under 37 CFR 1.116 and 37 CFR 1.312 apply. For allowed applications where the issue fee has been paid prior to the entry of a request under 37 CFR 1.48, if the request under 37 CFR 1.48 is dismissed or denied in an Office action, the application must be withdrawn from issue so that applicant would be given time to correct the defect(s). If the request under 37 CFR 1.48 is granted, then it would not be necessary to withdraw the application from issue.

Requests under 37 CFR 1.48 are generally decided by the primary examiner except:

(A) When the application is involved in an interference (decided by the Board of Patent Appeals and Interferences);

(B) When the application is a national stage application filed under 35 U.S.C. 371 which, as of the date of filing of the request, has not been accepted as satisfying the requirements for entry into the national stage (decided in the PCT Legal Office); and

(C) When accompanied by a petition under 37 CFR 1.183 requesting waiver of a requirement under 37 CFR 1.48(a) or (c), e.g., waiver of the statement of lack of deceptive intent by an inventor to be added or deleted, or waiver of the reexecution of the declaration by all of the inventors (decided in the Office of Petitions).

When any request for correction of inventorship under 37 CFR 1.48(a)-(c) is granted, the examiner will acknowledge any addition or deletion of the names of inventors by using either form paragraph 2.14 or form paragraph 2.14.01 in the next Office communication to applicant or his/her attorney. It will be necessary to revise the PALM records, issue a corrected filing receipt, and change the bib-data sheet. The correction should be noted on the original oath or declaration by writing in ink in the left column "See Paper No. __ for inventorship corrections." See MPEP § 605.04(g). For Image File Wrapper (IFW) processing, see the IFW Manual.

¶ *2.14 Correction of Inventorship Under 37 CFR 1.48(a) or (c), Sufficient*

In view of the papers filed **[1]**, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48 (**[2]**). The inventorship of this application has been changed by **[3]**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Examiner Note:

1. In bracket 2, insert --a-- or --c--, as appropriate.
2. In bracket 3, insert explanation of correction made, including addition or deletion of appropriate names.

¶ *2.14.01 Correction of Inventorship Under 37 CFR 1.48(b), Sufficient*

In view of the papers filed **[1]**, the inventorship of this nonprovisional application has been changed by the deletion of **[2]**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Examiner Note:

1. This form paragraph is to be used only for 37 CFR 1.48(b) corrections.
2. In bracket 2, insert the names of the deleted inventor(s).

The grant or denial of a request under 37 CFR 1.48(a) may result in the lack of inventorship overlap between a parent application and a continuing application and the consequent inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.

For correction of inventorship in a patent, see 37 CFR 1.324 and MPEP § 1481.

A request under 37 CFR 1.48 will not be required:

(A) Where an application is to issue with the correct inventorship based on the allowed claims even though the application may have been filed with an incorrect inventorship based on the claims as originally submitted;

(B) Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required. See MPEP § 605.04(g). Reference to the notification will be made on the previously filed oath or declaration;

(C) Where an inventor's name has been changed after the application has been filed, see MPEP § 605.04(c);

(D) Where a court has issued an order under 35 U.S.C. 256 for correction of the inventorship of a patent, it should be submitted directly to the Certificate of Correction Division along with **> form PTO/SB/44 (see MPEP § 1485).< A new oath or declaration under 37 CFR 1.63 is not required;

(E) Where there is no change of individual but an incorrect name was given, a petition under 37 CFR 1.182 should be filed requesting correction of applicant's name;

(F) In a nonprovisional application filed under 35 U.S.C. 111(a), where the first-filed executed oath or declaration was filed on or after December 1, 1997 and names the correct inventors, but the inventive entity on the executed oath or declaration differs from that which was set forth on filing of the application, e.g., the application transmittal letter or an unexecuted oath or declaration. See 37 CFR 1.48(f)(1);

(G) In a provisional application filed under 35 U.S.C. 111(b), where the cover sheet was filed on or after December 1, 1997 which names the correct inventors, but the inventive entity on the cover sheet differs from that which was set forth on filing of the provisional application without a cover sheet. See 37 CFR 1.48(f)(2).

I. APPLICATIONS FILED UNDER 37 CFR 1.53(f) - NO OATH/DECLARATION

The Office will issue a filing receipt listing the inventors identified at the time of filing of the application even if the application was filed under 37 CFR 1.53(f) without an executed oath or declaration. Where the first-filed executed oath or declaration was filed on or after December 1, 1997 and sets forth an inventive entity which is different from the inventive entity initially set forth at the time of filing of the application, the actual inventorship of the application will be taken from the executed oath or declaration. See 37 CFR 1.41(a)(1). A request under 37 CFR 1.48(a), (b), or (c) will not be necessary. See 37 CFR 1.48(f).

Where the first-filed executed oath or declaration was submitted prior to December 1, 1997 in an application filed without an executed oath or declaration, if the inventive entity identified on the executed oath or declaration differs from the inventive entity identified at the time of filing of the application, a request under 37 CFR 1.48(a) or (c) must also be submitted.

The original named inventors should not execute or submit an oath or declaration under 37 CFR 1.63 merely to timely complete the filing requirements in reply to a "Notice to File Missing Parts of Application" where the possibility of an error in inventorship has been discovered, nor should the oath or declaration be signed by someone who cannot properly make the averments therein. Additional time to reply to the Notice is available under 37 CFR 1.136(a) and possibly under 37 CFR 1.136(b). See MPEP § 710.02(d).

Example

A nonprovisional application is filed (either prior to, on or after December 1, 1997) naming A as the sole inventor without an executed oath or declaration under 37 CFR 1.63. Only claim 1 is presented. A "Notice to File Missing Parts of Application" is mailed to the applicant requiring an oath or declaration under 37 CFR 1.63. In timely reply thereto after December 1, 1997, a preliminary amendment adding claim 2, and a declaration under 37 CFR 1.63 executed by inventors A and B are submitted with B being added in view of claim 2. A request under 37 CFR 1.48(c) is not required, in that 37 CFR 1.48(f)(1) will act to set forth an inventorship of A and B.

Similarly, where a preliminary amendment canceling or amending claims concomitantly requires the deletion of an inventor, such deletion may be accomplished by the submission of a first-filed executed oath or declaration on or after December 1, 1997 naming the actual inventive entity. A request under 37 CFR 1.48(b) would not be necessary.

II. 37 CFR 1.48(a)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

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Under 37 CFR 1.48(a), if the correct inventor or inventors are not named in an executed oath or declaration under 37 CFR 1.63 in a nonprovisional application for patent, the application can be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the person named as an inventor in error or the person who through error was not named as an inventor.

37 CFR 1.48(a) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

Correction may be requested in cases where the person originally named as inventor was in fact not an inventor or the sole inventor of the subject matter being claimed. If such error occurred without any deceptive intention on the part of the inventor named and/or not named in error, the Office has the authority to substitute the true inventive entity for the erroneously named inventive entity. Instances where corrections can be made include changes from: a mistaken sole inventor to a different but actual sole inventor; a mistakenly identified sole inventor to different, but actual, joint inventors; a sole inventor to joint inventors to include the original sole inventor; erroneously identified joint inventors to different but actual joint inventors; erroneously identified joint inventors to a different, but actual, sole inventor. (Note that 35 U.S.C. 120 and 37 CFR 1.78 require an overlap of inventorship, hence, refiling, rather than requesting under 37 CFR 1.48, to change inventorship where the change would not result in an inventorship overlap may result in the loss of a benefit claim.)

A. Statement of Lack of Deceptive Intention

Where a similar inventorship error has occurred in more than one application for which correction is requested wherein petitioner seeks to rely on identical statements, only one original set need be supplied if copies are submitted in all other applications with a reference to the application containing the originals (original oaths or declarations under 37 CFR 1.63 and written consent of assignees along with separate processing fees must be filed in each application).

The statement required from each inventor being added or deleted may simply state that the inventorship error occurred without deceptive intention. The statement need not be a verified statement (see MPEP § 410).

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a *>petition< and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. *In re Cooper*, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the inventors' or alleged inventors' actual

contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

In those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor.

An available remedy to obtain correction of inventorship where waiver of a required statement is not available to correct the inventorship in a particular application is to refile the application naming the correct inventive entity. A request under 37 CFR 1.48(a) would not then be required in the newly filed application as no correction would be needed. Furthermore, a request under 37 CFR 1.48(a) would also not be required in the prior application that was refiled, since the prior application will be abandoned. Benefit of the parent application's filing date would be available under 35 U.S.C. 120 provided there is at least one inventor overlap between the two applications. (Note: a sole-to-sole correction would not obtain benefit under 35 U.S.C. 120).

B. Oath or Declaration

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Conflicting oaths or declarations filed: If the first executed oaths or declarations that are submitted name different inventive entities (e.g., one declaration names A, B, and C as inventors and a second declaration names D as the inventor) and are filed on the same day, the application will be considered to name the inventors named in both declarations (A, B, C, and D) and a new oath or declaration in compliance with 37 CFR 1.63 including the entire inventive entity will be required. Where an application is filed with an executed declaration under 37 CFR 1.63 naming an inventive entity that is in conflict with another paper filed in the application, such as the transmittal letter, the executed declaration will govern. However, where an executed declaration is never submitted and the application papers are in conflict as to the inventorship, each party identified as an inventor on filing will be considered to have been named as part of the inventive entity. See 37 CFR 1.41(a)(1).

37 CFR 1.47 is available to meet the requirement for an oath or declaration under 37 CFR 1.63 as for example where A, B, and C were originally named as inventors and D who refuses to cooperate is to be later added as an inventor. The oath or declaration under 37 CFR 1.63 of inventor D may be supplied pursuant to 37 CFR 1.47(a), but note that the required 37 CFR 1.48(a)(2) statement must still be supplied by inventor D (an unlikely event in view of the inability to obtain the executed oath or declaration under 37 CFR 1.63), or waiver thereof petitioned under 37 CFR 1.183. Alternatively, where D is to be added as an inventor (where inventors A, B, and C have previously executed the application under 37 CFR 1.63) and it is original inventor A who refuses to cooperate, the statement under 37 CFR 1.48(a)(2) is only required to be signed by inventor D. Originally named inventor A is merely required to reexecute an oath or declaration in compliance with 37 CFR 1.63. Petitions under 37 CFR 1.47 are only applicable to an original oath or

declaration and are not applicable to the reexecution of another oath or declaration by A. In such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement of 37 CFR 1.64 that each of the actual inventors, i.e., inventor A, execute the oath or declaration, particularly where assignee consent is given to the requested correction. Absent assignee consent, the petition under 37 CFR 1.183 requesting waiver of the reexecution of the oath or declaration will be evaluated as to whether the nonsigning inventor was actually given the opportunity to reexecute the oath or declaration, or whether the nonsigning inventor could not be reached.

Applications filed with a petition under 37 CFR 1.47 and a request under 1.48(a) will be forwarded to the Office of Petitions, after mailing the filing receipt by the Office of Initial Patent Examination, for consideration of the petition and the request. In those instances wherein a request under 37 CFR 1.48(a) and a petition under 37 CFR 1.47 have both been filed in an application, the Office of Petitions may first issue a decision on the request under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47.

The oath or declaration submitted subsequent to the filing date (37 CFR 1.53(f)) of an application filed under 37 CFR 1.53(b) must clearly identify the previously filed specification it is intended to execute. See MPEP § 601.01(a) and § 602.

C. Fee

Where waiver under 37 CFR 1.183 is requested in relation to a requirement under 37 CFR 1.48(a), a processing fee under 37 CFR 1.48(a) and a petition fee under 37 CFR 1.183 are required. Similarly, where in addition to a request under 37 CFR 1.48, two petitions under 37 CFR 1.183 are presented, e.g., one requesting waiver of a requirement under 37 CFR 1.48 and the other requesting waiver of the reexecution of an oath or declaration under 37 CFR 1.64, three fees are required (one for the request filed under 37 CFR 1.48 and two for the petitions filed under 37 CFR 1.183).

Where a similar error has occurred in more than one application a separate processing fee must be submitted in each application in which correction is requested.

If the processing fee has not been submitted or authorized the request will be dismissed.

D. Written Consent of Assignee

The written consent of every existing assignee of the original named inventors must be submitted. 37 CFR 1.48(a)(5). 37 CFR 1.48(a) does not limit assignees to those who are recorded in the U.S. Patent and Trademark Office records. The Office employee deciding the request should check the file record for any indication of the existence of an assignee (e.g., a small entity assertion from an assignee).

Where no assignee exists requester should affirmatively state that fact. If the file record including the request is silent as to the existence of an assignee it will be presumed that no assignee exists. Such presumption should be set forth in the decision to alert requesters to the requirement.

The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable. Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324.

E. Continuing Applications

35 U.S.C. 120 permits a continuing application to claim the benefit of the filing date of a copending, previously filed, parent application provided there is inventorship overlap between the continuing application and the parent application. If the inventive entity of a continuing application includes an inventor named in the parent application, the inventorship overlap required by 35 U.S.C. 120 is met.

Example

The parent application names inventors A and B and claims inventions 1 and 2. Inventor A contributes only to invention 1 and inventor B contributes only to invention 2. A restriction requirement is made and invention 1 was elected. Upon allowance of claims directed to invention 1 and cancellation of claims directed to invention 2, a request under 37 CFR 1.48(b) was filed requesting deletion of inventor B. The request under 37 CFR 1.48(b) was granted by the primary examiner. Prior to the issuance of the parent application, a divisional application claiming benefit under 35 U.S.C. 120 to the parent application, is filed claiming only invention 2 and naming only inventor B. The inventorship overlap required by 35 U.S.C. 120 is met in this instance even though at the time of filing of the divisional application, the inventorship overlap was lost as a result of the deletion of an inventor in the parent application. The overlap of inventorship need not be present on the date the continuing application is filed nor present when the parent application issues or becomes abandoned.

On filing a continuing application under 37 CFR 1.53(b) it should not be assumed that an error in inventorship made in a parent application was in fact corrected therein in response to a request under 37 CFR 1.48(a) unless a decision from the U.S. Patent and Trademark Office to that effect was received by the requester. A continuing application naming the additional inventor can be filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) with a newly executed oath or declaration by the new inventive entity along with a request for benefit under 35 U.S.C. 120 without the need for a decision on the request under 37 CFR 1.48 filed in the parent application.

Should an error in inventorship in a parent application be discovered, whether it is the need to add and/or to delete inventors, when preparing to file a continuing application, the continuing application may be filed under 37 CFR 1.53(b) with the correct inventive entity without the need for a request under 37 CFR 1.48(a) in the parent or continuing application provided the parent application is to be abandoned on filing of the continuing application. In filing **>a continuation or divisional< application under 37 CFR 1.53(b), a copy of an oath or declaration from the prior application can only be used where inventors are to be deleted (37 CFR 1.53(b)(1) and 37 CFR 1.63(d)(1)(ii)), but not where inventors are to be added. Where inventors are to be added, a newly executed oath or declaration must be submitted. See 37 CFR 1.63(d)(5).

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a request under 37 CFR 1.48(a) or (c) to add an inventor to a parent application that was not acted on (e.g., filed after final rejection) will be automatically considered in the CPA. Until the request is granted, the inventorship remains the same as the prior application. Note, however, that effective July 14, 2003, CPA practice has been eliminated as to utility and plant applications. If the application is a design application, after discovery of an inventorship error, the application can also be refiled under 37 CFR 1.53(d)(4) as a CPA where inventors are only to be deleted.

In filing a continuing application to correct the inventorship, it is important to recognize that 37 CFR 1.78 requires for purposes of claiming the benefit of the prior application that the prior application must either have had the filing fee, or the retention fee as set forth in 37 CFR 1.21(l), paid within the period set forth in 37 CFR 1.53(f) so as to establish copendency. See 37 CFR 1.78(a)(1). Effective July 1, 2005, the processing and retention fee (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. See 37 CFR 1.78(a)(1)(ii).

Should a *>continuation or divisional< application be filed under 37 CFR 1.53(b)(1) where a copy of the oath or declaration from the prior application is utilized (or under 37 CFR 1.53(d) as a CPA if the prior application is a design application) purporting to add an inventor, the inventorship of the prior application will be retained in the continuing application as addition of an inventor is not permitted in these instances. The absence of a request to correct the inventorship submitted with the continuing application will not affect the filing date of the continuing application. However, the retained inventorship must

then be corrected by the filing of a request under 37 CFR 1.48(a) in the *>continuation or divisional< application stating that the error in failing to name the additional inventor in the prior application was without deceptive intention. Where an inventor is to be added, it is recommended that a *>continuation or divisional< application be filed under 37 CFR 1.53(b) with a newly executed oath or declaration and not be filed with a copy of the oath or declaration from the prior application. This procedure eliminates the need for a request under 37 CFR 1.48.

An inventorship error discovered while prosecuting a continuing application that occurred in both an abandoned parent application and the continuing application can be corrected in both applications by filing a single request in the continuing application (e.g., A + B named in parent, B + C named in continuing application, actual inventorship is C + D thereby eliminating inventorship overlap and resulting loss of benefit claim under 35 U.S.C. 120 if the error is not corrected in abandoned parent application as well as in continuation application). Absent such loss of inventorship overlap, correction need not be made in the abandoned application.

When entering the national stage under 35 U.S.C. 371, correction of inventorship is via the provisions of 37 CFR 1.497(d). See MPEP § 1893.01(e).

¶ *2.13 Correction of Inventorship Under 37 CFR 1.48(a), Insufficient*

The request to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

Examiner Note:

1. This form paragraph should only be used in response to requests to correct an error in the naming of the prior inventors in nonprovisional applications. If the request is merely to delete an inventor because claims were canceled or amended such that the deleted inventor is no longer an actual inventor of any claim in the application, use form paragraph 2.13.01 instead of this form paragraph.

Potential rejections

A rejection under 35 U.S.C. 102(f) or (g) must be considered if the request is denied.

The grant or denial of the request may result in the loss of inventorship overlap between a parent application and a continuing application and an inability to claim benefit in the continuing application of the parent application's filing date under 35 U.S.C. 120. Intervening references must then be considered.

2. A primary examiner may not decide the request if the request is also accompanied by a petition under 37 CFR 1.183 requesting waiver of one of the requirements explicitly set forth in 37 CFR 1.48(a) (typically a refusal of one of the inventors to be added or deleted to execute the required statement of facts) – the request for correction of inventorship and request for waiver of the rules should be forwarded to the Office of Petitions.

3. One or more of form paragraphs 2.13a - 2.13e should follow this form paragraph, as applicable.

4. Where it appears that: 1) the inventor(s) to be added or deleted may be hostile and will not execute a required statement of facts; and 2) the actual inventorship would overlap the original inventorship (37 CFR 1.78), follow this form paragraph with form paragraph 2.13f.

5. Requests under 37 CFR 1.41 to change inventorship where an executed oath or declaration has not been filed are to be acted upon by OIPE.

6. Where there is a correction in a person's name, e.g., due to misspelling, or marriage, a request under 37 CFR 1.48 is inappropriate. See MPEP § 605.04(b) and (c) for name changes.

7. An initial executed oath or declaration under 37 CFR 1.63 may change the inventorship as originally set forth when the application is filed without an executed oath or declaration without request for correction of inventorship (37 CFR 1.48(f)).

¶ *2.13a Statement of Facts Problem (for Use Following FP 2.13, If Applicable)*

The statement of facts by an inventor or inventors to be added or deleted does not explicitly state that the inventorship error occurred without deceptive intent on his or her part or cannot be construed to so state.

¶ *2.13b No New Oath or Declaration (for Use Following FP 2.13 or 2.13.02, If Applicable)*

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

¶ *2.13c Required Fee Not Submitted (for Use Following FP 2.13, 2.13.01 or 2.13.02, If Applicable)*

It lacks the required fee under 37 CFR 1.17(i).

¶ *2.13d Written Consent Missing (for Use Following FP 2.13 or 2.13.02, If Applicable)*

It lacks the written consent of any assignee of one of the originally named inventors.

¶ *2.13e 37 CFR 3.73(b) Submission (for Use Following FP 2.13 or 2.13.02, If Applicable)*

A 37 CFR 3.73(b) submission has not been received to support action by the assignee.

¶ *2.13f Hostile Inventor(s)/Inventorship Overlap (for Use Following FP 2.13, If Applicable)*

As it appears that a party required by 37 CFR 1.48(a)(2) to submit a statement of facts may not be willing to submit such statement, applicant should consider either: a) submission of a petition under 37 CFR 1.183 to waive that requirement if the original named inventor(s) has assigned the entire right and interest to an

assignee who has given its consent to the requested inventorship correction, MPEP § 201.03, Statement of Lack of Deceptive Intention, or b) refiling the application (where addition is needed under 37 CFR 1.53(b) with a new oath or declaration and any necessary petition under 37 CFR 1.47, or where only deletion is needed, either under 37 CFR 1.53(b) utilizing a copy of a prior oath or declaration under 37 CFR 1.63(d)(1)(iv), or under 37 CFR 1.53(d)) (design applications only), thereby eliminating the need for a 37 CFR 1.48 request.

¶ *2.13.01 Correction of Inventorship Under 37 CFR 1.48(b), Insufficient*

The request for the deletion of an inventor in this nonprovisional application under 37 CFR 1.48(b) is deficient because:

Examiner Note:

1. This form paragraph should only be used when the inventorship was previously correct when originally executed but an inventor is being deleted because claims have been amended or canceled such that he or she is no longer an inventor of any remaining claim in the non-provisional application. If the inventorship is being corrected because of an error in naming the correct inventors, use form paragraph 2.13 instead of this form paragraph.
2. Follow this form paragraph with one or both of form paragraphs 2.13c and 2.13g.
3. See note 1 of form paragraph 2.13, Potential rejections.

¶ *2.13g Statement Under 37 CFR 1.48(b)(2) Problem (for Use Following FP 2.13.01, If Applicable)*

The request was not accompanied by the statement required under 37 CFR 1.48 (b)(2).

¶ *2.13.02 Correction of Inventorship Under 37 CFR 1.48(c), Insufficient*

The request to correct the inventorship in this nonprovisional application under 37 CFR 1.48(c) requesting addition of an inventor(s) is deficient because:

Examiner Note:

1. This form paragraph should only be used when the inventorship was previously correct when the application was originally executed, but the inventorship now needs to be changed due to subsequent addition of subject matter from the specification to the claims, which subject matter was contributed by a party not originally named as an inventor.
2. See note 2 of form paragraph 2.13.
3. Follow this form paragraph with any of form paragraphs 2.13b-2.13e or 2.13h.
4. See note 1 of form paragraph 2.13, Potential rejections.
5. See notes 4-7 of form paragraph 2.13.

¶ *2.13h Statement of Facts, Added Inventor (for Use Following FP 2.13.02, If Applicable)*

The statement of facts by the inventor(s) to be added does not explicitly state that the amendment of the inventorship is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intent on the part of the inventor(s) to be added, or cannot be construed to so state.

¶ *2.14 Correction of Inventorship Under 37 CFR 1.48(a) or (c), Sufficient*

In view of the papers filed **[1]**, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48 (**[2]**). The inventorship of this application has been changed by **[3]**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Examiner Note:

1. In bracket 2, insert --a-- or --c--, as appropriate.
2. In bracket 3, insert explanation of correction made, including addition or deletion of appropriate names.

¶ *2.14.01 Correction of Inventorship Under 37 CFR 1.48(b), Sufficient*

In view of the papers filed **[1]**, the inventorship of this nonprovisional application has been changed by the deletion of **[2]**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

Examiner Note:

1. This form paragraph is to be used only for 37 CFR 1.48(b) corrections.
2. In bracket 2, insert the names of the deleted inventor(s).

III. 37 CFR 1.48(b)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

*****

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims*. If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in § 1.17(i).

*****

37 CFR 1.48(b) provides for deleting the names of persons originally properly included as inventors, but whose invention is no longer being claimed in a nonprovisional application. Such a situation would arise where claims have been amended or deleted during prosecution because they are unpatentable or as a result of a requirement for restriction of the application to one invention, or for other reasons. A request under 37 CFR 1.48(b) to delete an inventor would be appropriate prior to an action by the TC where it is decided not to pursue particular aspects of an invention attributable to some of the original named inventors.

37 CFR 1.48(b) requires that the amendment be accompanied by: (1) a request including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (2) a fee under 37 CFR 1.17(i). The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application. Written consent of any assignee is not required for requests filed under 37 CFR 1.48(b).

IV. 37 CFR 1.48(c)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

*****

(c) *Nonprovisional application—inventors added for claims to previously unclaimed subject matter*. If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

*****

37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application when an executed declaration under 37 CFR 1.63 was first filed. In such a situation, the nonprovisional application may be amended pursuant to 37 CFR 1.48(c) to add claims directed to the originally unclaimed but disclosed subject matter and also to name the correct inventors for the application based on the newly added claims. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.

37 CFR 1.48(c) requires that the amendment must be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor that the amendment is necessitated by an amendment to the claims and that the inventorship error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor; (4) the fee under 37 CFR 1.17(i); and (5) the written consent of any assignee of the original named inventors.

V. 37 CFR 1.48(d)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

*****

(d) *Provisional application—adding omitted inventors*. If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended to add the name or names of the omitted inventor or inventors. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and

(2) The processing fee set forth in § 1.17(q).

*****

37 CFR 1.48(d) provides a procedure for adding the name of an inventor in a provisional application,

where the name was originally omitted without deceptive intent.

37 CFR 1.48(d) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement that the inventorship error occurred without deceptive intention on the part of the omitted inventor or inventors; and (3) the fee set forth in 37 CFR 1.17(q). The statement of lack of deceptive intent may be included in the request and may be signed by a registered attorney or agent. A statement of lack of deceptive intent is not required from any of the original or to be added inventors.

See also discussion below regarding requests filed under 37 CFR 1.48(e).

VI. 37 CFR 1.48(e)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

*****

(e) *Provisional application—deleting the name or names of the inventor or inventors.* If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:

(1) A request to correct the inventorship that sets forth the desired inventorship change;

(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;

(3) The processing fee set forth in § 1.17(q); and

(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

*****

37 CFR 1.48(e) provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application.

37 CFR 1.48(e) requires that the amendment be accompanied by: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement of lack of deceptive intent by the person whose name is being deleted establishing that the error occurred without deceptive intention on his or her part; (3) the fee set forth in 37 CFR 1.17(q); and (4) the written consent of any assignee.

Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed nonprovisional application under 35 U.S.C. 111(a) that is filed within twelve months of an earlier provisional application may claim benefits based on the earlier filed provisional application so long as both applications have at least one inventor in common. An error in not naming or in naming a person as an inventor in a provisional application would not require correction under either 37 CFR 1.48(d) (to add an inventor) or 37 CFR 1.48(e) (to delete an inventor) in the provisional application so long as the nonprovisional application naming the correct inventorship would contain an overlap of at least one inventor with the provisional application. The existence of inventorship overlap would prevent the original inventorship error from having any effect upon the ability of the provisional application to serve as a basis for a benefit claim under 35 U.S.C. 119(e) with the U.S. Patent and Trademark Office.

If, however, applicant chooses to correct the inventive entity of a provisional application, for example, to permit the provisional application to serve as the basis of a priority claim in a foreign country, 37 CFR 1.48(d) and (e) set forth the procedures for adding one or more actual inventors and for deleting one or more erroneously named inventors respectively.

In the situation where an inventor was not named in a provisional application and an inventor was also erroneously named in the same provisional application and correction is desired, a request under 37 CFR 1.48(d) and a request under 37 CFR 1.48(e) would be required.

Where an inventorship error in a provisional application is desired to be corrected after expiration of twelve months from the filing date of the provisional application, a request under 37 CFR 1.48(d) and/or 37 CFR 1.48(e) may still be filed with OIPE, which handles requests under 37 CFR 1.48(d) and (e), to correct the inventorship in provisional applications.

VII. 37 CFR 1.48(f)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

*****

(f)(1) *Nonprovisional application—filing executed oath/declaration corrects inventorship.* If the correct inventor or inventors are not named on filing a nonprovisional application under

§ 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.

(2) *Provisional application filing cover sheet corrects inventorship.* If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under § 1.51(c)(1), the later submission of a cover sheet under § 1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship.

*****

37 CFR 1.48(f)(1) and (f)(2) will act to automatically correct an earlier identification of inventorship in a nonprovisional application by the filing of an initial executed oath or declaration and in a provisional application by the filing of an initial cover sheet. A request and fee is not required for the inventorship correction to occur.

The provision in 37 CFR 1.48(f)(1) for changing the inventorship only applies if an executed oath or declaration under 37 CFR 1.63 has not been submitted by any of the inventors. In this situation, the submission of an executed oath or declaration under 37 CFR 1.63 by any of the inventors is sufficient to correct an earlier identification of inventorship. A first-filed oath or declaration under 37 CFR 1.63 executed by less than all of the inventors initially identified will, under 37 CFR 1.48(f)(1), determine the inventorship in the application. Any subsequent oath or declaration filed by a different inventive entity will not be effective under 37 CFR 1.48(f)(1) to correct the inventorship that was specified in the first-filed oath or declaration.

37 CFR 1.48(f)(1) is not applicable for national stage applications filed under 35 U.S.C. 371 where the inventorship has been erroneously named in the international application. Accordingly, if the inventorship set forth in the oath or declaration filed in the national stage application differs from the inventorship specified in the international application, the requirements of 37 CFR 1.497(d) must be satisfied. See MPEP § 1893.01(e).

VIII. 37 CFR 1.48(g)

37 CFR 1.48. Correction of inventorship in a patent application, other than a reissue application, pursuant to 35. U.S.C. 116.

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(g) *Additional information may be required.* The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the correction of inventorship.

201.04 Parent Application

The term "parent" is applied to an earlier application of an inventor disclosing a given invention. Such invention may or may not be claimed in the first application. Benefit of the filing date of copending parent application may be claimed under 35 U.S.C. 120. The term parent will not be used to describe a provisional application.

201.04(a) Original Application

"Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a first filing or a continuing application.

201.04(b) Provisional Application [R-5]

35 U.S.C. 111. Application.

*****

(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 1.9. Definitions.

(a)(1)A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

*****

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

*****

(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.

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One of the provisions of the Uruguay Round Agreements Act (effective as of June 8, 1995), is the establishment of a domestic priority system. The Act provides a mechanism to enable domestic applicants to quickly and inexpensively file provisional applications. Under the provisions of 35 U.S.C. 119(e), applicants are entitled to claim the benefit of priority in a given application in the United States. The domestic priority period will not count in the measurement of the 20-year patent term. See 35 U.S.C. 154(a)(3). Thus, domestic applicants are placed on equal footing with foreign applicants with respect to the patent term.

>A provisional application is a regular national filing that starts the Paris Convention priority year. Foreign filings must be made within 12 months of the filing date of the provisional application if applicant wishes to rely on the filing date of the provisional application in the foreign filed application.<

The parts of a provisional application that are required are set forth in 37 CFR 1.51(c) and MPEP § 601.01(b). The filing date of a provisional application is the date on which (1) a specification which complies with 35 U.S.C. 112, first paragraph, and (2) any drawing required by 37 CFR 1.81(a) are filed. A provisional application must also include a cover sheet or cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under 37 CFR 1.53(b). The filing fee is set forth in 37 CFR 1.16(d).

NOTE:

(A) No claim is required in a provisional application.

(B) No oath or declaration is required in a provisional application.

(C) Provisional applications will not be examined for patentability, placed in an interference, or made the subject of a statutory invention registration.

A provisional application will automatically be abandoned 12 months after its filing date and will not be subject to revival to restore it to pending status thereafter. See 35 U.S.C. 111(b)(5). Public Law 106-113 amended 35 U.S.C. 119(e)(3) to extend the period of pendency of a provisional application to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. See also 37 CFR 1.7(b). 35 U.S.C. 119(e)(3) as amended by Public Law 106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

For example, if a provisional application was filed on January 15, 1999, the last day of pendency of the provisional application under 35 U.S.C. 111(b)(5) and 35 U.S.C. 119(e)(3) is extended to January 18, 2000 (January 15, 2000 is a Saturday and Monday, January 17, 2000 is a Federal holiday and therefore, the next succeeding business day is Tuesday, January 18, 2000). A nonprovisional application claiming the benefit of the provisional application must be filed no later than January 18, 2000.

A provisional application is not entitled to claim priority benefits based on any other application under 35 U.S.C. 119, 120, 121, or 365. If applicant attempts to claim the benefit of an earlier U.S. or foreign application in a provisional application, the filing receipt will not reflect the improper benefit or priority claim. Moreover, if a nonprovisional application claims the benefit of the filing date of a provisional application, and states that the provisional application relies upon the filing date of an earlier application, the claim for benefit or priority earlier than the filing date of the provisional application will be disregarded.

An application filed under 37 CFR 1.53(b) may be converted to a provisional application provided a request for conversion is submitted along with the fee as set forth in 37 CFR 1.17(q). The request and fee must be submitted prior to the earlier of the abandonment of the nonprovisional application, the payment of the issue fee, the expiration of 12 months after the

filing date of the nonprovisional application, or the filing of a request for statutory invention registration. The grant of any such request will not entitle applicant to a refund of the fees which were properly paid in the application filed under 37 CFR 1.53(b). See MPEP § 601.01(c)

Public Law 106-113 amended 35 U.S.C. 111(b)(5) to permit a provisional application filed under 37 CFR 1.53(c) be converted to a nonprovisional application filed under 37 CFR 1.53(b). 35 U.S.C. 111(b)(5) as amended by Public Law 106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995. A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in 37 CFR 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112, unless the provisional application otherwise contains at least one such claim. The request must be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. The filing fee for a nonprovisional application, an executed oath or declaration under 37 CFR 1.63, and the surcharge under 37 CFR 1.16(f), if appropriate, are also required. The grant of any such request will not entitle applicant to a refund of the fees which were properly paid in the application filed under 37 CFR 1.53(c). Conversion of a provisional application to a nonprovisional application will result in the term of any patent issuing from the application being measured from at least the filing date of the provisional application. This adverse patent term impact can be avoided by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e), rather than requesting conversion of the provisional application to a nonprovisional application. See 37 CFR 1.53(c)(3).

Design applications may not make a claim for priority of a provisional application under 35 U.S.C. 119(e). See 35 U.S.C. 172 and 37 CFR 1.78(a)(4).

**>

PTO/SB/16 (07-06)
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PROVISIONAL APPLICATION FOR PATENT COVER SHEET – Page 1 of 2

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(c).

Express Mail Label No. _____

INVENTOR(S)		
Given Name (first and middle [if any])	Family Name or Surname	Residence (City and either State or Foreign Country)

Additional inventors are being named on the _____ *separately numbered sheets attached hereto*

TITLE OF THE INVENTION (500 characters max):

Direct all correspondence to: **CORRESPONDENCE ADDRESS**

☐ The address corresponding to Customer Number:

OR

☐ Firm or Individual Name

Address

City	State	Zip
Country	Telephone	Email

ENCLOSED APPLICATION PARTS *(check all that apply)*

☐ Application Data Sheet. See 37 CFR 1.76

☐ CD(s), Number of CDs _____

☐ Drawing(s) *Number of Sheets* _____

☐ Other (specify) _____

☐ Specification (e.g. description of the invention) *Number of Pages* _____

Fees Due: Filing Fee of $200 ($100 for small entity). If the specification and drawings exceed 100 sheets of paper, an application size fee is also due, which is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

METHOD OF PAYMENT OF THE FILING FEE AND APPLICATION SIZE FEE FOR THIS PROVISIONAL APPLICATION FOR PATENT

☐ Applicant claims small entity status. See 37 CFR 1.27.

☐ A check or money order is enclosed to cover the filing fee and application size fee (if applicable).

☐ Payment by credit card. Form PTO-2038 is attached

TOTAL FEE AMOUNT ($)

☐ The Director is hereby authorized to charge the filing fee and application size fee (if applicable) or credit any overpayment to Deposit Account Number: _____. A duplicative copy of this form is enclosed for fee processing.

USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT

This collection of information is required by 37 CFR 1.51. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PROVISIONAL APPLICATION COVER SHEET
Page 2 of 2

PTO/SB/16 (07-06)
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

☐ No.
☐ Yes, the name of the U.S. Government agency and the Government contract number are: _____
_____

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

SIGNATURE _____ Date_____

TYPED or PRINTED NAME _____ REGISTRATION NO. _____
(if appropriate)

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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201.05 Reissue Application [R-3]

A reissue application is an application for a patent to take the place of an unexpired patent that is defective **>as a result of an error in the patent which was made without deceptive intention.< A detailed treatment of **>reissue applications can< be found in Chapter 1400.

201.06 Divisional Application [R-2]

A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division." >A divisional application is often filed as a result of a restriction requirement made by the examiner.< The divisional application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 121 or 365(c). *>See MPEP § 201.11 for the conditions for receiving the benefit of the filing date of the prior application. The divisional application should set forth at least the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

Divisional applications of utility or plant applications must be filed under 37 CFR 1.53(b). Divisional applications of design applications< may be filed pursuant to 37 CFR 1.53(b) or 1.53(d). 37 CFR 1.60 and 1.62 have been deleted as of December 1, 1997.

**>Effective July 14, 2003, continued prosecution application (CPA) practice set forth in 37 CFR 1.53(d) has been eliminated as to utility and plant applications.< An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "division" of the provisional application since the application will have its patent term calculated from its filing date, whereas an application filed under 35 U.S.C. 120, 121, or 365(c) will have its patent term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s). 35 U.S.C. 154(a)(2) and (a)(3).

In the interest of expediting the processing of newly filed divisional applications filed as a result of a restriction requirement, applicants are requested to include the appropriate U.S. Patent and Trademark Office classification of the divisional application and the status and *>assigned art unit< of the parent application on the papers submitted. The appropriate classification for the divisional application may be found in the Office communication of the parent application wherein the >restriction< requirement was made. It is suggested that this classification designation be placed in the upper right hand corner of the letter of transmittal accompanying these divisional applications or in an application data sheet as set forth in 37 CFR 1.76(b)(3).

Use form paragraph 2.01 to remind applicant of possible divisional status.

**>

¶ *2.01 Definition of Division*

This application appears to be a division of Application No. **[1],** filed **[2]**. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division." The divisional application should set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application.

Examiner Note:

1. In bracket 1, insert the Application No.(series code and serial no.) of the parent application.
2. In bracket 2, insert the filing date of the parent application.
3. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "division" of the provisional application since the application will have its patent term calculated from its filing date, whereas an application filed under 35 U.S.C. 120, 121, or 365(c) will have its term calculated from the date on which the earliest application was filed, provided a specific reference is made to the earlier filed application(s), 35 U.S.C. 154(a)(2) and (a)(3).

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A design application may be considered to be a division of a utility application (but not of a provisional application), and is entitled to the filing date thereof if the drawings of the earlier filed utility application show the same article as that in the design application sufficiently to comply with 35 U.S.C. 112, first paragraph. However, such a divisional design application may only be filed under the procedure set forth in 37 CFR 1.53(b) not under 37 CFR 1.53(d). ** See MPEP § 1504.20.

While a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to "new matter" if introduced by amendment into the parent application. Compare MPEP § 201.08 and § 201.11.

For notation to be put *>in< the file *>history< by the examiner in the case of a divisional application, see MPEP § 202.02.

201.06(a) Former 37 CFR 1.60 Divisional-Continuation Procedure [R-2]

*** 37 CFR 1.60 was deleted effective December 1, 1997. See 1203 O.G. 63, October 21, 1997. A continuation or divisional application filed under 37 CFR 1.60 on or after December 1, 1997, will automatically be treated as an application filed under 37 CFR 1.53(b). All continuation and divisional applications filed under 37 CFR 1.60 prior to December 1, 1997 will continue to be processed and examined under the procedures set forth in former 37 CFR 1.60. **>For more information pertaining to practice and procedure under former 37 CFR 1.60, see MPEP § 201.06(a) in the MPEP 8th Edition, Rev. 1 (February 2003)(available on the USPTO web site at www.uspto.gov/web/offices/pac/mpep/mpep.htm).<**

201.06(b) Former 37 CFR 1.62 File Wrapper Continuing Procedure [R-2]

***37 CFR 1.62 was deleted effective December 1, 1997. See 1203 O.G. 63, October 21, 1997. A >request for a< continuation or divisional application filed under former 37 CFR 1.62 on or after December 1, 1997, >, in an application that was filed on or after June 8, 1995,< will be treated as ** a request for continued examination (RCE) under 37 CFR *>1.114<, see MPEP 706.07(h), paragraph IV. **>A request< filed on or after December 1, 1997, under former 37 CFR 1.62 *>for< a continuation-in-part (CIP) application, **>, or for a continuation or divisional of an application having a filing date before June 8, 1995,< will be treated as an improper application.**

**

All continuation, divisional and CIP applications filed under former 37 CFR 1.62 prior to December 1, 1997, will continue to be processed and examined under the procedures set forth in former 37 CFR 1.62. **>For more information pertaining to practice and procedure under former 37 CFR 1.62, see MPEP § 201.06(b) in the MPEP 8th Edition, Rev. 1 (February 2003)(available on the USPTO web site at www.uspto.gov/web/offices/pac/mpep/mpep.htm).<

201.06(c) 37 CFR 1.53(b) and 37 CFR 1.63(d) Divisional-Continuation Procedure [R-5]

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

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(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.

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37 CFR 1.63. Oath or Declaration.

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(d)(1)A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:

(i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;

(ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;

(iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and

(iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon

that it was signed, is submitted for the continuation or divisional application.

(2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.

(3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and

(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

(4) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.

*****

I. IN GENERAL

37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (A) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.495; (B) a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c); or (C) a continued prosecution application (CPA) of a design application under 37 CFR 1.53(d). Applications submitted under 37 CFR 1.53(b), as well as CPAs submitted under 37 CFR 1.53(d), are applications filed under 35 U.S.C. 111(a). An application filed under 37 CFR 1.53(b) may be an original, a continuation, a divisional, a continuation-in-part, or a substitute. (See MPEP § 201.09 for substitute application.) The application may be for a "utility" patent under 35 U.S.C. 101, a design patent under 35 U.S.C. 171, a plant patent under 35 U.S.C. 161, or a reissue under 35 U.S.C. 251.

37 CFR 1.53(b) is the "default" application. An application that is not (A) the result of the entry of an international application into the national stage after compliance with 35 U.S.C. 371 and 37 CFR 1.495, (B) a provisional application under 37 CFR 1.53(c), or (C) a CPA of a design application filed under 37 CFR 1.53(d), is an application filed under 37 CFR 1.53(b). An application will be treated as one filed under 37 CFR 1.53(b) unless otherwise designated.

In order to be complete for filing date purposes, all applications filed under 37 CFR 1.53(b) must include a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing required by 37 CFR 1.81(a). The statutory filing fee and an oath or declaration in compliance with 37 CFR 1.63 (and 37 CFR 1.175 (if a reissue) or 37 CFR 1.162 (if for a plant patent)) are also required by 37 CFR 1.51(b) for a complete application, but the filing fee and oath or declaration may be filed after the application filing date upon payment of the surcharge set forth in 37 CFR 1.16(f). See 37 CFR 1.53(f) and MPEP § 607.

Any application filed on or after December 1, 1997, which is identified by the applicant as an application filed under 37 CFR 1.60 will be processed as an application under 37 CFR 1.53(b) (using the copy of the specification, drawings and signed oath/declaration filed in the prior application supplied by the applicant). Any submission of an application including or relying on a copy of an oath or declaration that would have been proper under 37 CFR 1.60 will be a proper filing under 37 CFR 1.53(b).

A new application containing a copy of an oath or declaration under 37 CFR 1.63 referring to an attached specification is indistinguishable from a continuation or divisional application containing a copy of an oath or declaration from a prior application submitted pursuant to 37 CFR 1.63(d). Unless an application is submitted with a statement that the application is a continuation or divisional application, see 37 CFR 1.78(a)(2), the Office will process the application as a new non-continuing application. Applicants are advised to clearly designate any continuation, divi-

sional, or continuation-in-part application as such by submitting a reference to the prior-filed application with the appropriate relationship (i.e., continuation, divisional, or continuation-in-part) in compliance with 37 CFR 1.78(a) in the first sentence(s) of the specification or in an application data sheet to avoid the need for a petition to accept an unintentionally delayed claim under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t), and the issuance of a filing receipt that does not indicate that the application is a continuation, divisional, or continuation-in-part. See MPEP § 201.11.

II. OATH/DECLARATION

37 CFR 1.63(d) provides that a newly executed oath or declaration is not required in a continuation or divisional application filed by all or by fewer than all of the inventors named in a prior nonprovisional application containing a signed oath or declaration as required by 37 CFR 1.63, provided that a copy of the signed oath or declaration filed in the prior application is submitted for the continuation or divisional application and the specification and drawings filed in the continuation or divisional application do not contain any subject matter that would have been new matter in the prior application. The copy of the oath or declaration must show the signature of the inventor(s) or contain an indication thereon that the oath or declaration was signed (e.g., the notation "/s/" on the line provided for the signature). >If the copy of the signed oath or declaration from the prior application included a power of attorney, the power of attorney in the copy of the signed oath or declaration from the prior application would carry over to the continuation or divisional application. If the power of attorney was changed during the prosecution of the prior application, see subsection VII below.<

It is not necessary to have the inventor sign a new oath or declaration merely to include a reference to the duty of disclosure if the parent application was filed prior to January 1, 1978, to indicate that the inventor has reviewed and understands the contents of the application if the parent application was filed prior to October 1, 1983, or to indicate the inventor's post office address if the parent application was filed prior to December 1, 1997, and the inventor's mailing or post office address is identified elsewhere in the application.

When a copy of an oath or declaration from a prior application is filed in a continuation or divisional application under 37 CFR 1.53(b), special care should be taken by the applicant to ensure that the copy is matched with the correct application file. Applicant should file the copy of the oath or declaration with a cover letter explaining that the copy of the oath or declaration is for the attached application or for a previously-filed 37 CFR 1.53(b) application (identified by application number which consists of a two-digit series code, e.g., 08/, and a six-digit serial number, e.g., 123,456). An adhesive label may be attached to the front of the copy of the oath or declaration. The label should clearly state that the copy of the oath or declaration is intended for the attached application submitted therewith or for Application No. XX/YYY,YYY. During initial processing, attachments (e.g., a cover letter) to application papers may be separated. Therefore, applicant should not rely solely upon a cover letter. Note: 37 CFR 1.5(a) states that no correspondence relating to an application should be filed prior to receipt of the application number information from the Patent and Trademark Office.

37 CFR 1.63(d) requires a copy of the signed oath or declaration from the prior application. In instances in which the oath or declaration filed in the prior application is itself a copy of an oath or declaration from a prior application, either a copy of the copy of the oath or declaration in the prior application or a direct copy of the original oath or declaration is acceptable, as both are a copy of the oath or declaration in the prior application, see 37 CFR 1.4(d)(1)(ii).

The patent statute and rules of practice do not require that an oath or declaration include a date of execution, and no objection should be made to an oath or declaration because it lacks either a recent date of execution or any date of execution. The applicant's duty of candor and good faith including compliance with the duty of disclosure requirements of 37 CFR 1.56 is continuous and applies to the continuing application.

A newly executed oath or declaration is required in a continuation or divisional application filed under 37 CFR 1.53(b) naming an inventor not named in the prior application, and in a continuation-in-part application.

III. SPECIFICATION AND DRAWINGS

A continuation or divisional application may be filed under 35 U.S.C. 111(a) using the procedures set forth in 37 CFR 1.53(b), by providing: (A) a new specification and drawings and a copy of the signed oath or declaration as filed in the prior application provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application; or (B) a new specification and drawings and a newly executed oath or declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. To claim the benefit of a prior application under 35 U.S.C. 120, 121, or 365(c), applicant must include a reference to the prior application in compliance with 37 CFR 1.78(a) in the first sentence(s) of the specification or in an application data sheet. See MPEP § 201.11. The new specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) may include changes to the specification and drawings originally filed in the prior application in the manner that an applicant may file a substitute specification, see 37 CFR 1.125, or amend the drawings of an application so long as it does not result in the introduction of new matter. Applicant should file a new set of claims as the original claims of the continuing application instead of filing a copy of the claims from the prior application and a preliminary amendment to those claims. It is the applicant's responsibility to review any new specification or drawings submitted for a continuation or divisional application under 37 CFR 1.53(b) and 37 CFR 1.63(d) to determine that it contains no new matter. An applicant is advised to simply file a continuing application with a newly executed oath or declaration when it is questionable as to whether the continuing application adds material that would have been new matter if presented in the prior application. If one or more claims are allowed in the continuation or divisional application which are directed to matter shown and described in the prior nonprovisional application but not claimed in the prior application, the applicant should be required to file a supplemental oath or declaration under 37 CFR 1.67(b).

If a continuation or divisional application filed with a newly executed oath or declaration contains subject matter that would have been new matter in the prior application, the application will have to be amended to indicate that it is a continuation-in-part application rather than a continuation or a divisional application. Form paragraph 2.10.01 may be used to require the applicant to correct the relationship of the applications. See MPEP § 201.11.

Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(f); and (B) that the application be redesignated as a continuation-in-part.

Any utility or plant patent application, including any continuing application, that will be published pursuant to 35 U.S.C. 122(b) should be filed under 37 CFR 1.53(b) with a specification (including the claims), and drawings, that the applicant would like to have published. This is important because the Office will generally publish the specification (including the claims) and drawings as filed and, under 35 U.S.C. 154(d), a patentee may obtain provisional rights if the invention claimed in a patent is substantially identical to the invention claimed in the application publication. Filing a continuing application under 37 CFR 1.53(b) with a preliminary amendment (which makes all the desired changes to the specification, including adding, deleting or amending claims) is NOT recommended because the changes made by the preliminary amendment will generally not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration. As noted above, a continuation or divisional application filed under 37 CFR 1.53(b) may be filed with a new specification and corrected drawings, along with a copy of an oath or declaration from a prior (parent) application, provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. Thus, the new specification and corrected drawings may include some or all of the amendments entered during the prosecution of the prior application(s), as well as additional amendments submitted for clarity or contextual purposes, and a new set of claims. In order to have a patent application publication of a continuation

or divisional application contain only a desired set of claims, rather than the set of claims in the prior application, it is strongly recommended that the continuation or divisional application be filed under 37 CFR 1.53(b) with a new specification containing only the desired set of claims. If the continuation or divisional application is filed with a copy of the specification from the prior application along with a preliminary amendment which cancels, amends and/or adds new claims, publication of the application may exclude the preliminary amendment unless a copy of the specification (with the amended set of claims) was also submitted through the Office's Electronic Filing System (EFS).

IV. INCORPORATION BY REFERENCE

An applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, an explicit statement that such specifically enumerated prior application or applications are "hereby incorporated by reference." The statement must appear in the specification. See 37 CFR 1.57(b) and MPEP § 608.01(p). The inclusion of this incorporation by reference statement will permit an applicant to amend the continuation or divisional application to include subject matter from the prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. For applications filed prior to September 21, 2004, the incorporation by reference statement may appear in the transmittal letter or in the specification. Note that for applications filed prior to September 21, 2004, if applicants used a former version of the transmittal letter form provided by the USPTO, the incorporation by reference statement could only be relied upon to add inadvertently omitted material to the continuation or divisional application.

For applications filed on or after September 21, 2004, a claim under 35 U.S.C. 120 and 37 CFR 1.78 for benefit of a prior-filed nonprovisional application or international application designating the U.S. that was present on the filing date of the continuation or divisional application is considered an incorporation by reference of the prior-filed application as to inadvertently omitted material, subject to the conditions and requirements of 37 CFR 1.57(a). The purpose of 37 CFR 1.57(a) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are) inadvertently omitted from an application. For applications filed on or after September 21, 2004, applicants are encouraged to provide an explicit incorporation by reference statement to the prior-filed application(s) for which benefit is claimed under 35 U.S.C. 120 if applicants do not wish the incorporation by reference to be limited to inadvertently omitted material pursuant to 37 CFR 1.57(a). See 37 CFR 1.57(b) and MPEP § 608.01(p) for discussion regarding explicit incorporation by reference.

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). As noted above, however, for applications filed on or after September 21, 2004, 37 CFR 1.57(a) provides that a claim for the benefit of a prior-filed application under 37 CFR 1.78 is considered an incorporation by reference as to inadvertently omitted material. See MPEP § 201.17.

A. Application NOT Entitled to a Filing Date

Material needed to accord an application a filing date may not be incorporated by reference unless an appropriate petition under 37 CFR 1.57(a)(3) or under 37 CFR 1.182 is granted. Until such a petition has been granted, the application will **not** be entitled to a filing date.

For an application filed on or after September 21, 2004, if the material needed for a filing date is completely contained within a prior-filed application to

which benefit is claimed, applicant may file a petition under 37 CFR 1.57(a)(3) along with the fee set forth in 37 CFR 1.17(f) and an amendment with the inadvertently omitted material requesting that the amendment be entered and the application be accorded a filing date as of the original date of deposit of the application papers. See 37 CFR 1.57(a)(3) and MPEP § 201.17.

In an application containing an explicit incorporation by reference statement in the specification or in a transmittal letter (if the transmittal letter was filed prior to September 21, 2004), a petition for the granting of a filing date may be made under 37 CFR 1.182. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

B. Application Entitled to a Filing Date

If a continuation or divisional application as originally filed on or after September 21, 2004 does not include an explicit incorporation by reference statement and is entitled to a filing date despite the inadvertent omission of a portion of the prior application(s), applicant may be permitted to add the omitted material by way of an amendment under 37 CFR 1.57(a). Such an amendment must be made within any time period set by the Office. See 37 CFR 1.57(a)(1).

If an application as originally filed included a proper explicit incorporation by reference statement (or an explicit incorporation by reference statement that has been made effective under 37 CFR 1.57(g)), the omitted specification page(s) and/or drawing figure(s) may be added by amendment provided the omitted item(s) contains only subject matter in common with a document that has been properly incorporated by reference. If the Office identified the omitted item(s) in a "Notice of Omitted Item(s)," applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should, however, submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.01(d) and § 601.01(g).

V. INVENTORSHIP

The filing of a continuation or divisional application by all or by fewer than all of the inventors named in a prior application without a newly executed oath or declaration is permitted. Applicant has the option of filing: (A) a newly executed oath or declaration signed by the inventors for the continuation or divisional application; or (B) a copy of the oath or declaration filed in the prior application accompanied by a statement from applicant, applicant's representative or other authorized party requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application. See 37 CFR 1.63(d). Where the continuation or divisional application and a copy of the oath or declaration from the prior application are filed without a statement from an authorized party requesting deletion of the names of any person or persons named in the prior application, the continuation or divisional application will be treated as naming as inventors the person or persons named in the copy of the executed oath or declaration from the prior application. Accordingly, if a petition or request under 37 CFR 1.48(a) or (c) was granted in the prior application, the oath or declaration filed in a continuation or divisional application pursuant to 37 CFR 1.53(b) and 37 CFR 1.63(d) should be a copy of the oath or declaration executed by the added inventor(s) filed in the prior application. The statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to 37 CFR 1.33(b) to sign an amendment in the continuation or divisional application.

A newly signed oath or declaration in compliance with 37 CFR 1.63 is required where an inventor who was not named as an inventor in the signed oath or declaration filed in the prior application is to be named in a continuation or divisional application filed

under 37 CFR 1.53(b). The newly signed oath or declaration must be signed by all the inventors.

VI. RULE 47 ISSUES

37 CFR 1.63(d)(3) provides for the situation in which the executed oath or declaration, of which a copy is submitted for a continuation or divisional application, was originally filed in a prior application accorded status under 37 CFR 1.47. 37 CFR 1.63(d)(3)(i) requires a copy of any decision granting a petition to accord 37 CFR 1.47 status to such application, unless all nonsigning inventor(s) or legal representative (pursuant to 37 CFR 1.42 or 1.43) have filed an oath or declaration to join in an application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c). Where one or more, but not all, nonsigning inventor(s) or legal representative (pursuant to 37 CFR 1.42 or 1.43) subsequently joins in any application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c), 37 CFR 1.63(d)(3)(ii) also requires a copy of any oath or declaration filed by the inventor or legal representative who subsequently joined in such application.

New continuation or divisional applications filed under 37 CFR 1.53(b) which contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 CFR 1.47 status in the prior application, should be forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions before being forwarded to the Technology Center (TC). The Office of Petitions will mail applicant a letter stating that "Rule 47" status has been accorded to the continuation or divisional application, but will not repeat the notice to the nonsigning inventor nor the announcement in the *Official Gazette*. See 37 CFR 1.47(c).

VII. CHANGE OF ATTORNEY/CORRESPONDENCE ADDRESS

37 CFR 1.63(d)(4) provides that where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address which occurred during the prosecution of the prior application.

VIII. SMALL ENTITY STATUS

If small entity status has been established in a parent application and is still proper and desired in a continuation or divisional application filed under 37 CFR 1.53(b), a new assertion as to the continued entitlement to small entity status under 37 CFR 1.27 is required. See MPEP § 509.03.

IX. COPIES OF AFFIDAVITS

Affidavits or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the prior nonprovisional application do not automatically become a part of a continuation or divisional application filed under 37 CFR 1.53(b). Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make such remarks of record in the 37 CFR 1.53(b) application and include a copy of the original affidavit or declaration filed in the prior nonprovisional application.

Use form paragraph 2.03 for instructions to applicant concerning affidavits or declarations filed in the prior application.

¶ *2.03 Affidavits or Declarations in Prior Application*

Applicant refers to an affidavit or declaration filed in the prior application. Affidavits or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132, filed during the prosecution of the prior application do not automatically become a part of this application. Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make the remarks of record in this application and include a copy of the original affidavit or declaration filed in the prior application.

Examiner Note:

This form paragraph is to be used in applications filed under 37 CFR 1.53(b). Do not use this form paragraph in applications filed under 37 CFR 1.53(d) since affidavits and/or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application automatically become a part of the 37 CFR 1.53(d) application.

X. EXTENSIONS OF TIME

If an extension of time is necessary to establish continuity between the prior application and the continuing application filed under 37 CFR 1.53(b), the petition for an extension of time must be filed as a

separate paper directed to the prior nonprovisional application. Under 37 CFR 1.136(a)(3), an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time for its timely submission. A continuing application filed under 37 CFR 1.53(b) is a new application which is assigned a new application number and filing date and is maintained separately from the file of the prior application. The filing of a continuing application is not a paper directed or placed in the file of the prior application and is not a "reply" to the last Office action in the prior application. Thus, a petition for an extension of time and the fee set forth in 37 CFR 1.17 are required to be filed as a separate paper in the prior application. Any petition for an extension of time directed to the prior application must be accompanied by its own certificate of mailing under 37 CFR 1.8 (if mailed by first class mail) or under 37 CFR 1.10 (if mailed by Express Mail), if the benefits of those rules are desired.

XI. ABANDONMENT OF THE PRIOR NONPROVISIONAL APPLICATION

Under 37 CFR 1.53(b) and 37 CFR 1.63(d) practice, the prior nonprovisional application is not automatically abandoned upon filing of the continuing application. If the prior nonprovisional application is to be expressly abandoned, such a paper must be signed in accordance with 37 CFR 1.138. A registered **>patent practitioner< not of record acting in a representative capacity under 37 CFR 1.34 may also expressly abandon a prior nonprovisional application as of the filing date granted to a continuing application when filing such a continuing application.

If the prior nonprovisional application which is to be expressly abandoned has a notice of allowance issued therein, the prior nonprovisional application can become abandoned by the nonpayment of the issue fee. However, once an issue fee has been paid in the prior application, even if the payment occurs following the filing of a continuing application under 37 CFR 1.53(b), a petition to withdraw the prior nonprovisional application from issue must be filed before the prior nonprovisional application can be abandoned (37 CFR 1.313). See MPEP § 711.01.

If the prior nonprovisional application which is to be expressly abandoned is before the Board of Patent Appeals and Interferences >(Board)<, a separate notice should be forwarded by the appellant to the Board, giving them notice thereof.

After a decision by the Court of Appeals for the Federal Circuit (CAFC) in which the rejection of all claims is affirmed, the proceeding is terminated when the mandate is issued by the Court.

XII. EXAMINATION

The practice relating to making first action rejections final also applies to continuation and divisional applications filed under 37 CFR 1.53(b). See MPEP § 706.07(b).

Any preliminary amendment that is present on the filing date of an application filed under 37 CFR 1.53(b) is part of the original disclosure. Amendments must be filed in compliance with the requirements of 37 CFR 1.121 (e.g., the amendment must include a complete claim listing whenever a claim is added, canceled, or amended). See MPEP § 714. Applications should be classified and assigned to the proper Technology Center (TC) by taking into consideration the claims that will be before the examiner upon entry of such a preliminary amendment.

Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(f); and (B) that the application be redesignated as a continuation-in-part. See MPEP § 608.04(b) when new matter is contained in a preliminary amendment.

If the examiner finds that pages of the specification or drawings figures described in the specification are missing and the application is a continuation or divisional application filed prior to September 21, 2004 under 37 CFR 1.53(b) using a copy of the oath or declaration filed in the prior application under 37 CFR 1.63(d), the examiner must check to determine whether the continuation or divisional application, as originally filed, includes a statement incorporating by reference the prior application(s). For applications filed prior to September 21, 2004, the statement could

appear in the application transmittal letter (or the specification, rather than only in the specification). The inclusion of this incorporation by reference of the prior application(s) was necessary in these applications to permit applicant to amend the continuation or divisional application to include subject matter in the prior application(s) without the need for a petition. See also the subsection above regarding "Incorporation by Reference." If the continuation or divisional application filed prior to September 21, 2004 under 37 CFR 1.53(b) does not include the incorporation by reference statement in the application papers (in the specification or in the transmittal letter) as originally filed and applicant has not been informed of the omitted items, the application should be returned to OIPE for mailing of a "Notice of Omitted Item(s)." For applications filed on or after September 21, 2004, see 37 CFR 1.57(a) and MPEP § 201.17.

201.06(d) 37 CFR 1.53(d) Continued Prosecution Application (CPA) Practice [R-5]

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

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(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

(ii) 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.

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I. CPA PRACTICE HAS BEEN ELIMINATED AS TO UTILITY AND PLANT APPLICATIONS

Effective July 14, 2003, continued prosecution application (CPA) practice has been eliminated as to utility and plant applications. Applicants who wish to continue examination of the same claimed invention after the prosecution of a utility or plant application is closed should consider filing a request for continued examination (RCE) under 37 CFR 1.114. For more information on RCE practice, see MPEP § 706.07(h). Applicants who wish to file a continuation, divisional, or continuation-in-part application should file an application under 37 CFR 1.53(b). See MPEP § 201.06(c). CPAs filed prior to July 14, 2003 will continue to be processed and examined under the procedures set forth in prior 37 CFR 1.53(d). Any request for a CPA filed on or after July 14, 2003 in a utility or plant application is improper, regardless of the filing date of the utility or plant application in which the CPA is filed.

The Office will not convert an improper CPA into an application under 37 CFR 1.53(b) unless the applicant shows that there are extenuating circumstances that warrant the burdensome process of such conversion.

If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the Technology Center (TC) who will reprocess the CPA and correct the application records as appropriate.

A. Applications Filed on or After June 8, 1995

If a utility or plant application has a filing date on or after June 8, 1995, an improper CPA filed on or after July 14, 2003 will be treated as a request for continued examination (RCE) under 37 CFR 1.114. See MPEP § 706.07(h) and form paragraph 7.42.15. If the improper CPA does not satisfy the requirements of 37 CFR 1.114 (e.g., the request lacks a submission or the fee under 37 CFR 1.17(e), or the prosecution of the application is not closed), the Office will treat the improper CPA as an improper RCE, and the time period set in the last Office action (or notice) will continue to run. The Office will send the applicant a Notice of Improper Request for Continued Examination (RCE), PTO-2051. If the time period for reply to the last Office action (or notice) has expired, the application is abandoned and the applicant must file a petition under 37 CFR 1.137 and the required petition fee to revive the abandoned application. Unless prosecution in the application was not closed, the petition must be accompanied by a submission as defined by 37 CFR 1.114(c) and the fee set forth in 37 CFR 1.17(e), unless previously filed. If the last Office action is a notice of allowance, the issue fee must also be paid at the time of filing the petition to revive. If prosecution in the application was not closed, the petition must be accompanied by a reply to the non-final Office action.

Applicants cannot, as a matter of right, obtain continued examination on claims that are independent and distinct from the invention previously claimed (i.e., applicants cannot switch inventions when filing an RCE). See 37 CFR 1.145. Therefore, if applicants file a request for a divisional CPA on or after July 14, 2003 and the request satisfies all the requirements in 37 CFR 1.114 (e.g., the request is accompanied by the fee as set forth in 37 CFR 1.17(e) and a submission), the Office will treat the improper divisional CPA as a proper RCE. However, any amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention will be treated as nonresponsive. See MPEP § 821.03. Any newly submitted claims that are directed to an invention distinct from and independent of the invention previously claimed will be withdrawn from consideration. Applicants should be notified by using form paragraph 8.26 or 8.27.

B. Applications Filed Before June 8, 1995

If a utility or plant application has a filing date before June 8, 1995, the Office cannot treat an improper CPA filed on or after July 14, 2003 as an RCE because RCE practice does not apply to applications filed before June 8, 1995. The Office will notify the applicant of the improper CPA by mailing a

Notice of Improper CPA (or FWC) Filing For Utility or Plant Applications Filed Before June 8, 1995, PTO-2011 (Rev. 7/03 or later). The time period for reply set in the last Office action (or notice) will continue to run. Applicant may file a continuing application under 37 CFR 1.53(b). If the time period for reply has expired, the application is abandoned. If the application in which the improper CPA is filed is abandoned when a continuing application is filed, applicant would need to file a petition under 37 CFR 37 CFR 1.137 to revive the prior application to establish copendency with the continuing application under 37 CFR 1.53(b).

II. FILING AND INITIAL PROCESSING OF CPAs FOR DESIGN APPLICATIONS

A. In General

In addition to the provisions of 37 CFR 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 CFR 1.53(d) if the prior application is a design application that is complete as defined by 37 CFR 1.51(b). A continuation or divisional application filed under 37 CFR 1.53(d) is called a "Continued Prosecution Application" or "CPA." A CPA has a number of advantages compared to a continuation or divisional application filed under 37 CFR 1.53(b). For example, the papers required to be filed in the U.S. Patent and Trademark Office in order to secure a filing date under 37 CFR 1.53(d) are minimal compared to 37 CFR 1.53(b). In addition, the Office will not normally issue a new filing receipt for a CPA. See 37 CFR 1.54(b). The time delay between the filing date and the first Office action should be less for a CPA than for an application filed under 37 CFR 1.53(b). For examination priority purposes only, the USPTO will treat continuation CPAs as if they were "amended" applications (as of the CPA filing date) and not as "new" applications. This treatment is limited to CPAs in which the prior application has an Office action issued by the examiner. If no Office action has been issued in the prior application, the CPA will be treated, for examination purposes, like a "new" application unless a petition to make special under 37 CFR 1.102 or a request for expedited examination under 37 CFR 1.155 is filed in the CPA. As "amended" applications generally have a shorter time frame for being acted on by examiners than "new" applications, the treatment of a CPA as an "amended" application will result in a first Office action being mailed in the CPA much sooner than if it had been filed as a continuation application under 37 CFR 1.53(b) (or under former 37 CFR 1.60 or 1.62). Therefore, applicants are strongly encouraged to file any preliminary amendment in a CPA at the time the CPA is filed. See 37 CFR 1.115 and MPEP § 714.03(a).

A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 CFR 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 CFR 1.53(b). If applicant wants the USPTO to disregard a previously filed request for a CPA filed in a design application (and not recognize its inherent request to expressly abandon the prior application) and to treat the paper as the filing of an application under 37 CFR 1.53(b), the applicant must file a petition under 37 CFR 1.182. A request to expressly abandon an application is not effective until the abandonment is acknowledged, including the express abandonment of the prior application of a CPA that occurs by operation of 37 CFR 1.53(d)(2)(v). The express abandonment of the prior application is acknowledged and becomes effective upon processing and entry of the CPA into the file of the prior application. Thus, such a petition under 37 CFR 1.182 should be filed expeditiously since the petition will not be granted once the request for a CPA has been entered into the prior application (and the inherent request to expressly abandon the prior application has been acknowledged). If the request for a CPA has been entered into the prior application by the time the petition under 37 CFR 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied. It is noted, however, that if the applicant intended to file a second application (either a continuation or a divisional) without abandoning the prior application, applicant can still achieve that result without loss of the benefit of the original filing date by: (A) continuing the prosecution of the original application via the CPA; and (B) filing a new continuation/divisional under 37 CFR 1.53(b) claiming benefit of the CPA and its parent applications under 35 U.S.C. 120 during the pendency of the CPA.

Since no new matter may be introduced in a CPA, the procedure set forth in 37 CFR 1.53(d) is not available for filing a continuation-in-part application. All continuation-in-part applications must be filed under 37 CFR 1.53(b) and a newly executed oath or declaration is required.

Under the CPA procedure, the continuation or divisional application will utilize the file wrapper and contents of the prior nonprovisional application, including the specification, drawings and oath or declaration from the prior nonprovisional application, and will be assigned the same application number as the prior nonprovisional application. Any changes to the continuation or divisional application desired when filing the CPA must be made in the form of an amendment to the prior application as it existed prior to filing the CPA, see 37 CFR 1.53(d)(5). Any new specification filed with the CPA request will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with 37 CFR 1.125. However, the applicant must comply with the requirements of 37 CFR 1.125(b) before the substitute specification will be entered into the CPA. Since 37 CFR 1.125(b) requires that a substitute specification be accompanied by, *inter alia*, a statement that the substitute specification includes no new matter, any substitute specification containing new matter will be denied entry by the examiner. Any preliminary amendment to the written description and claims, other than a substitute specification, filed with a CPA request will ordinarily be entered. Any new matter which is entered, however, will be required to be canceled pursuant to 35 U.S.C. 132 from the descriptive portion of the specification. Further, any claim(s) which relies upon such new matter for support will be rejected under 35 U.S.C. 112, first paragraph. See MPEP § 2163.06. In the event that a substitute specification or preliminary amendment containing new matter was filed with a request for a CPA, applicant may file a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the request for a CPA and substitute specification/preliminary amendment were filed. Of course, a request for a CPA is not improper simply because the request is accompanied by a substitute specification or preliminary amendment containing new matter. Thus, an applicant will not be entitled to a refund of the filing fee paid in a proper CPA as a result of the granting of a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file.

A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 CFR 1.51(b) and is a design application. There is no other limit to the number of CPAs that may be filed in a chain of continuing applications. However, only one CPA may be pending at one time based on the same prior nonprovisional application.

Under 37 CFR 1.53(d), the specification, claims, and drawings, and any amendments entered in the prior nonprovisional application are used in the CPA. A new basic filing fee, search fee, and examination fee are required in accordance with 35 U.S.C. 41 and 37 CFR 1.16. No search and examination fees are required for a CPA filed before December 8, 2004. The only other statutory requirement under 35 U.S.C. 111(a) is a signed oath or declaration. Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under the statute and rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration will be considered to be the oath or declaration of the CPA.

The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter.

If application papers for a design application are in any way designated as a CPA filing under 37 CFR 1.53(d) (e.g., contain a reference to 37 CFR 1.53(d), CPA, or continued prosecution application), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even if the application papers also contain other inconsistent designations (e.g., if the papers are also designated as an applica-

tion filed under 37 CFR 1.53(b) or include a reference to a "continuation-in-part CPA"). If application papers for a utility or plant application are in any way designated as a CPA filing under 37 CFR 1.53(d), the application papers will be treated as a request for continued examination (RCE) under 37 CFR 1.114. See I. CPA PRACTICE HAS BEEN ELIMINATED AS TO UTILITY AND PLANT APPLICATIONS, above.

B. Conditions for Filing a CPA

A continuation or divisional application may be filed under 37 CFR 1.53(d), if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b). The term "prior nonprovisional application" in 37 CFR 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 CFR 1.51(b) must contain, *inter alia*, the appropriate filing fee (including the basic filing fee, search fee, and examination fee) and a signed oath or declaration under 37 CFR 1.63.

In addition, a continuation or divisional 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.

Note that request for continued examination (RCE) practice under 37 CFR 1.114 is not available in design applications. Any improper RCE filed in a design application will not be treated as a CPA. An improper RCE filed in a design application will not toll the running of any time period for reply.

C. Initial Processing

A CPA request will be initially processed by the TC assigned the prior application. The TC will verify that (A) the prior application is a design application, (B) the correct application number of the prior nonprovisional application is identified in the request, (C) the request is properly signed, (D) the prior nonprovisional application was pending on, and that the issue fee has not been paid in the prior nonprovisional application on or prior to, the filing date of the CPA request, (E) the prior nonprovisional application was complete under 37 CFR 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under 37 CFR 1.63 has been filed in the prior application), and (F) the proper filing fee has been paid in the CPA. If one or more other conditions for filing a CPA have not been satisfied or the proper basic filing fee, search fee, and examination fee have not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper fees have been submitted. See 37 CFR 1.53(h). If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the TC who will reprocess the CPA and correct the application records.

D. Incorrect Patent Application Number Identified

A request for a CPA must identify the prior nonprovisional application (37 CFR 1.53(d)(2)(i)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the TC should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the TC is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. For Image File Wrapper (IFW) processing, see IFW Manual. If the TC is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the TC to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the U.S. Patent and Trademark Office with the correct application number within two weeks of the mail date on the cover letter, the original date of receipt of the CPA request will be

considered by the U.S. Patent and Trademark Office as the date of receipt of the CPA request. See 37 CFR 1.5(a). A copy of the returned CPA request and a copy of the date-stamped cover letter should be retained by the TC. Applicants may use either the Certificate of Mailing or Transmission procedure under 37 CFR 1.8 or the "Express Mail" procedure under 37 CFR 1.10 for resubmissions of returned CPA requests if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned CPA request is not resubmitted within the two-week period with the correct application number, the TC should cancel the original "Office Date" stamp on the CPA request and re-stamp the returned CPA request with the date of receipt of the resubmission or with the date of deposit as "Express Mail" with the United States Postal Service, if the CPA request is resubmitted under 37 CFR 1.10. Where the CPA request is resubmitted later than two weeks after the return mailing by the U.S. Patent and Trademark Office, the later date of receipt or date of deposit as "Express Mail" of the resubmission will be considered to be the filing date of the CPA request. The two-week period to resubmit the returned CPA request is not extendible. See 37 CFR 1.5(a).

In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for a CPA the following information relating to the prior application to the best of his or her ability: (A) title of invention; (B) name of applicant(s); and (C) correspondence address. See 37 CFR 1.53(d)(8).

E. Signature Requirement

A CPA is a request to expressly abandon the prior application (37 CFR 1.53(d)(2)(v)) and, therefore, must be properly signed. For a listing of the individuals who may properly sign a CPA request, see 37 CFR 1.33(b). In a joint application with no attorney or agent, all applicants must sign the CPA request in order for the CPA request to be considered properly signed. An unsigned or improperly signed CPA request will be placed in the file of the prior application, and is entitled to an application filing date, but is ineffective to abandon the prior application. A CPA will NOT be examined until the CPA request is properly signed.

A request for a CPA may be signed by a registered practitioner acting in a representative capacity under 37 CFR 1.34. However, correspondence concerning the CPA will be sent by the Office to the correspondence address as it appears in the prior nonprovisional application until a new power of attorney, or change of correspondence address signed by an attorney or agent of record in the prior application, is filed in the CPA.

A request for a CPA may also be signed by the assignee or assignees of the entire interest. However, the request must be accompanied by papers establishing the assignee's ownership under 37 CFR 3.73(b), unless such papers were filed in the prior application and ownership has not changed.

F. Filing Date

The filing date of a CPA is the date on which a request on a separate paper for a CPA is filed. A request for a CPA cannot be submitted as a part of papers filed for another purpose, see 37 CFR 1.53(d)(2), (e.g., the filing of a request for a CPA within an amendment after final for the prior application is an improper request for a CPA).

A paper requesting a CPA may be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), by facsimile transmission (see MPEP § 502.01) or it may be filed directly at the Customer Service Window located in the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

The date of receipt accorded to a CPA request sent by facsimile transmission is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or Federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or Federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

Applicants filing a CPA by facsimile transmission may include a "Receipt for Facsimile Transmitted CPA" (PTO/SB/29A) containing a mailing address and identifying information (e.g., the prior application number, filing date, title, first named inventor) with the request for a CPA. The USPTO will: (A) separate the "Receipt for Facsimile Transmitted CPA" from the

CPA request papers; (B) date-stamp the "Receipt for Facsimile Transmitted CPA"; (C) verify that the identifying information provided by the applicant on the "Receipt for Facsimile Transmitted CPA" is the same information provided on the accompanying request for a CPA; and (D) mail the "Receipt for Facsimile Transmitted CPA" to the mailing address provided on the "Receipt for Facsimile Transmitted CPA." The "Receipt for Facsimile Transmitted CPA" cannot be used to acknowledge receipt of any paper(s) other than the request for a CPA. A returned "Receipt for Facsimile Transmitted CPA" may be used as *prima facie* evidence that a request for a CPA containing the identifying information provided on the "Receipt for Facsimile Transmitted CPA" was filed by facsimile transmission on the date stamped thereon by the USPTO. As the USPTO will verify only the identifying information contained on the request for a CPA, and will not verify whether the CPA was accompanied by other papers (e.g., a preliminary amendment), the "Receipt for Facsimile Transmitted CPA" cannot be used as evidence that papers other than a CPA were filed by facsimile transmission in the USPTO. Likewise, applicant-created "receipts" for acknowledgment of facsimile transmitted papers (whether created for the acknowledgment of a CPA or other papers) cannot be used as evidence that papers were filed by facsimile in the USPTO. Applicants are cautioned not to include information on a "Receipt for Facsimile Transmitted CPA" that is intended for retention in the application file, as the USPTO does not plan on retaining a copy of such receipts in the file of the application.

If an applicant filing a CPA by facsimile does not include an authorization to charge the basic filing fee, search fee, and examination fee to a deposit account or to a credit card using PTO-2038 (See MPEP § 509), the application will be treated under 37 CFR 1.53(f) as having been filed without the appropriate fees (as fees cannot otherwise be transmitted by facsimile).

37 CFR 1.6(f) provides for the situation in which the Office has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. 37 CFR 1.6(f) requires that a showing thereunder include, *inter alia*, a copy of the sending unit's report confirming transmission of the application or evidence that came into being after the complete transmission of the application and within one business day of the complete transmission of the application.

The Certificate of Mailing Procedure under 37 CFR 1.8 does not apply to filing a request for a CPA, since the filing of such a request is considered to be a filing of national application papers for the purpose of obtaining an application filing date (37 CFR 1.8(a)(2)(i)(A)). Thus, if (A) the Patent and Trademark Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to reply and (B) a petition for a three-month extension of time (and the fee) and a CPA are received in the U.S. Patent and Trademark Office on January 5, 1998 (Monday), accompanied by a certificate of mailing under 37 CFR 1.8 dated January 2, 1998 (Friday), then the prior application was abandoned on January 3, 1998, and the CPA is improper because the CPA was not filed before the abandonment of the prior application. As a further example, if (A) the U.S. Patent and Trademark Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to reply and (B) applicant submits a petition for a three-month extension of time (and the fee) and a CPA request via facsimile transmission accompanied by a certificate of transmission under 37 CFR 1.8 at 9:00 PM (PST) on January 2, 1998 (Friday), but the U.S. Patent and Trademark Office does not receive the complete transmission until 12:01 AM (EST) on January 3, 1998 (Saturday), then the CPA is improper because the CPA request was not filed until January 5, 1998, see 37 CFR 1.6(a)(3), which is after the abandonment (midnight on Friday, January 2, 1998) of the prior application.

G. Filing Fee

The filing fees for a CPA are the basic filing fee as set forth in 37 CFR 1.16(b)(1), the search fee as set forth in 37 CFR 1.16(l), and the examination fee as set forth in 37 CFR 1.16(p). See 37 CFR 1.53(d)(3).

A general authorization to charge fees to a deposit account which was filed in the prior application carries over from the prior nonprovisional application to a CPA. Thus, where a general authorization to charge fees to a deposit account was filed in the prior application the TC should charge the necessary filing fee of the CPA to the deposit account.

Where a general authorization to charge fees to a deposit account was filed in the prior application and applicant desires to file a CPA without paying the filing fee on the filing date of the application, applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application.

Where a filing date has been assigned to a CPA, but the basic filing fee, search fee, and examination fee are insufficient or have been omitted, applicant will be so notified by the TC and given a period of time in which to file the missing fee(s) and to pay the surcharge set forth in 37 CFR 1.16(f) in order to prevent abandonment of the application. For CPAs 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(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 CPAs filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(d), if any of the basic filing fee, search fee, or examination fee are paid on a date later than the filing date of the CPA, the surcharge under 37 CFR 1.16(f) is required. The time period usually set is 2 months from the date of notification. This time period is subject to the provisions of 37 CFR 1.136(a). A CPA will not be placed upon the files for examination until all of its required parts, including the basic filing fee, search fee, examination fee, and any necessary surcharge, are received. See 37 CFR 1.53(h). Thus, it would be inappropriate to conduct an interview or to issue an action on the merits in the CPA until the basic filing fee, search fee, examination fee, and any necessary surcharge, are received.

Small Entity Status

Small entity status established in the parent application does not automatically carry over to a CPA. Status as a small entity must be specifically established in every application in which the status is available and desired. 37 CFR 1.27(c)(4) provides that the refiling of an application as a continued prosecution application under 37 CFR 1.53(d) requires a new assertion of continued entitlement to small entity status.

Because small entity status does not automatically carry over from the prior application to the CPA, unless the request for a CPA specifically indicates that the filing fee is to be charged in the small entity amount or otherwise includes an assertion of entitlement to small entity status, the large entity filing fee should be charged.

H. Extensions of Time

If an extension of time is necessary to establish continuity between the prior application and the CPA, the petition for extension of time should be filed as a separate paper directed to the prior nonprovisional application. However, a CPA is not improper simply because the request for a CPA is combined in a single paper with a petition for extension of time. The "separate paper" requirement of 37 CFR 1.53(d)(2) is intended to preclude an applicant from burying a request for a CPA in a paper submitted primarily for another purpose, e.g., within an amendment after final for the prior application.

While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application, a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (i.e., expressly abandon) the prior application. Thus, it will be considered a "reply" for purposes of 37 CFR 1.136(a)(3). As a result, an authorization in the prior application to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees to a deposit account or to a credit card (See MPEP § 509) will be treated as a constructive petition for an extension of time in the prior application for the purpose of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

If an extension of time directed to the prior application is filed as a separate paper, it must be accompanied by its own certificate of mailing under 37 CFR 1.8 (if mailed by first class mail) or under 37 CFR 1.10 (if mailed by Express Mail), if the benefits of those rules are desired.

I. Notice of CPA Filing

Since a "Notice of Abandonment" is not mailed in the prior application as a result of the filing of a CPA

nor is a filing receipt normally mailed for a CPA, the examiner should advise the applicant that a request for a CPA has been granted by including form paragraph 2.30 in the first Office action of the CPA.

¶ *2.30 CPA Status Acceptable (for Design Applications)*

The request filed on **[1]** for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. **[2]** is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this form paragraph in the first Office action of a CPA to advise the applicant that a request for a CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § 706.07(h).
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number of the parent application.

A "conditional" request for a CPA will not be permitted. Any "conditional" request for a CPA submitted as a separate paper with an amendment after final in an application will be treated as an unconditional request for a CPA of the application. This will result (by operation of 37 CFR 1.53(d)(2)(v)) in the abandonment of the prior application, and (if so instructed in the request for a CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. The examiner should advise the applicant that a "conditional" request for a CPA has been treated as an unconditional request for a CPA and has been accepted by including form paragraph 2.35 in the first Office action of the CPA.

¶ *2.35 CPA Status Acceptable - Conditional Request (for Design Applications)*

Receipt is acknowledged of the "conditional" request for a Continued Prosecution Application (CPA) filed on **[1]** under 37 CFR 1.53(d) based on prior Application No. **[2]**. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this form paragraph in the first Office action of a CPA to advise the applicant that a "conditional" request for a CPA is treated as an unconditional request and the CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § 706.07(h).
2. In bracket 1 insert the filing date of the request for a CPA.
3. In bracket 2 insert the Application Number identified in the CPA request.

Where the examiner recognizes that a paper filed in the prior application contains a request for a CPA, but the request is not in a separate paper, the examiner should, if possible, contact applicant by telephone to notify applicant that the request for a CPA is ineffective or notify the applicant in the next Office action that the CPA request is ineffective by using form paragraph 2.31.

¶ *2.31 CPA Status Not Acceptable - Request Not on Separate Paper*

Receipt is acknowledged of the request for a Continued Prosecution Application (CPA) filed on **[1]** under 37 CFR 1.53(d) based on Application No. **[2]**. However, because the request was not submitted on a separate paper as required by 37 CFR 1.53(d)(2), the request is not acceptable and no CPA has been established.

Examiner Note:

1. Use this form paragraph to inform applicant that a request for a CPA in a design application is not in compliance with 37 CFR 1.53(d)(2) and, therefore, no CPA has been established.
2. In bracket 1 insert the filing date of the paper containing the request for a CPA.
3. In bracket 2 insert the Application Number identified in the CPA request.

J. Inventorship

The inventive entity set forth in the prior nonprovisional application automatically carries over into the CPA UNLESS the request for a CPA is accompanied by or includes on filing a statement requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the CPA. 37 CFR 1.53(d)(4). The statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to 37 CFR 1.33(b) to sign an amendment in the continuation or divisional application. The examiner should acknowledge receipt of a statement filed with a CPA requesting the deletion of the name or names of the person or persons who are not inventors of the invention being

claimed in the CPA in the first Office action in the CPA by using form paragraph 2.32.

¶ *2.32 Request To Delete a Named Inventor*

Receipt is acknowledged of the statement requesting that **[1]** be deleted as a named inventor which was filed with the Continued Prosecution Application (CPA) on **[2]**. The inventorship has been corrected as requested.

Examiner Note:

1. Use this form paragraph where a Continued Prosecution Application (CPA) is filed 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. Any request to delete a named inventor in a CPA filed after the CPA is filed must be accompanied by a request under 37 CFR 1.48.
2. In bracket 1 insert the name or names of the inventor(s) requested to be deleted.
3. In bracket 2 insert the filing date of the CPA.

After the first Office action is mailed, the application file should be sent to OIPE for revision of its records to reflect the change of inventorship. For paper application files, the examiner should note the change of inventorship on the original oath or declaration by writing in red ink in the left column "See Paper No. __ for inventorship changes." See MPEP § 201.03 and § 605.04(g). For Image File Wrapper (IFW) processing, see the IFW Manual. Any request by applicant for a corrected filing receipt to show the change in inventorship should not be submitted until after the examiner has acknowledged the change in inventorship in an Office action. Otherwise, the "corrected" filing receipt may not show the change in inventorship.

The inventive entity of the CPA will be the same as the inventive entity of the prior application even if the CPA papers include a transmittal letter or a new oath or declaration naming an inventor not named in the prior application. However, the new oath or declaration will be placed in the application file. Upon review of the application, the examiner will notify the applicant in the first Office action using form paragraph 2.33 that the inventive entity of the prior application has been carried over into the CPA. If the inventive entity set forth in the transmittal letter of the new oath or declaration is desired, then a request under 37 CFR 1.48 along with the required fee set forth in 37 CFR 1.17(i) must be filed. No new oath or declaration need be filed with the later-filed request under 37 CFR 1.48 if such was submitted on filing of the CPA. If a request under 37 CFR 1.48 is not filed, it should be noted that the filing in a CPA of a transmittal letter or a new oath or declaration containing an inventor not named in the prior nonprovisional application may result in the claims in the CPA being rejected under 35 U.S.C. 102(f).

¶ *2.33 New Inventor Identified*

It is noted that **[1]** identified as a named inventor in the Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) on **[2]**, but no request under 37 CFR 1.48, as is required, was filed to correct the inventorship. Any request to add an inventor must be in the form of a request under 37 CFR 1.48. Otherwise, the inventorship in the CPA shall be the same as in the prior application.

Examiner Note:

1. Use this form paragraph where a request for a Continued Prosecution Application (CPA) identifies one or more inventors who were not named as inventors in the prior application on the filing date of the CPA.
2. In bracket 1 insert the name or names of the inventor(s) requested to be added followed by either --was-- or --were--, as appropriate.
3. In bracket 2 insert the filing date of the CPA.

III. EXAMINATION OF CPAs

A. Benefit of Earlier Filing Date

A request for a CPA is a specific reference under 35 U.S.C. 120 to every application assigned the application number identified in the request, and 37 CFR 1.78(a)(2) provides that a request for a CPA is the specific reference under 35 U.S.C. 120 to the prior application. That is, the CPA includes the request for an application under 37 CFR 1.53(d) and the recitation of the application number of the prior application in such request is the "specific reference to the earlier filed application" required by 35 U.S.C. 120. No further amendment to the specification of the CPA nor a reference in the CPA's application data sheet is required by 35 U.S.C. 120 or 37 CFR 1.78(a) to identify or reference the prior application, as well as any other application assigned the application number of the prior application (e.g., in instances in which a CPA is the last in a chain of CPAs).

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See *Sampson v. Ampex Corp.*, 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus.*

Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari*, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application.

In the situation in which there is a chain of CPAs, each CPA in the chain will, by operation of 37 CFR 1.53(d)(7), contain the required specific reference to its immediate prior application, as well as every other application assigned the application number identified in such request. Put simply, a specific reference to a CPA by application number and filing date will constitute a specific reference to: (A) the non-continued prosecution application originally assigned such application number (the prior application as to the first CPA in the chain); and (B) every CPA assigned the application number of such non-continued prosecution application.

Where the non-continued prosecution application originally assigned such application number itself claims the benefit of a prior application or applications under 35 U.S.C. 119(e), 120, 121, or 365(c), 37 CFR 1.78(a)(2) and (a)(5) continue to require that such application contain a reference to any such prior application(s). The reference(s) can be in an application data sheet (37 CFR 1.76) or in the first sentence(s) of the specification. See 37 CFR 1.78(a)(2) and (a)(5). As a CPA uses the application file of the prior application, a specific reference in the prior application (as to the CPA) will constitute a specific reference in the CPA, as well as every CPA in the event that there is a chain of CPAs.

Where an applicant in an application filed under 37 CFR 1.53(b) seeks to claim the benefit of a CPA under 35 U.S.C. 120 or 121 (as a continuation, divisional, or continuation-in-part), 37 CFR 1.78(a)(2) requires a reference to the CPA by application number in the first sentence(s) of such application unless such reference is made in an application data sheet. 37 CFR 1.78(a)(2) provides that "[t]he identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number." Thus, where a referenced CPA is in a chain of CPAs, this reference will constitute a reference under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every CPA in the chain as well as the non-continued prosecution application originally assigned such application number.

Therefore, regardless of whether an application is filed under 37 CFR 1.53(b) or (d), a claim under 35 U.S.C. 120 to the benefit of a CPA is, by operation of 37 CFR 1.53(d)(7) and 37 CFR 1.78(a)(2), a claim to every application assigned the application number of such CPA. In addition, applicants will not be permitted to choose to delete such a claim as to certain applications assigned that application number (e.g., for patent term purposes). See 37 CFR 1.53(d)(7).

Further, an applicant in a CPA is not permitted to amend the first sentence(s) of the specification to provide the specific reference to the prior application, or to provide such a reference in an application data sheet. Any such amendment will not be entered. The applicant should be advised in the next Office action that any such amendment to the specification or reference in the application data sheet has not been entered by using form paragraph 2.34. See 37 CFR 1.78(a)(2).

¶ *2.34 Reference in CPA to Prior Application (by Amendment to the Specification)*

The amendment filed **[1]** requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a **[2]** application of Application No. **[3]** has not been entered. As set forth in 37 CFR 1.53(d)(7), a request for a CPA is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. Thus, there is no need to amend the first sentence(s) of the specification to refer back to the prior application and any such amendment shall be denied entry.

Examiner Note:

1. Use this form paragraph to inform the applicant that an amendment to the first sentence(s) of the specification referring to the CPA as a continuing application of the prior application has not been entered and will not be entered if submitted again.
2. In bracket 1, insert the filing date of the amendment.
3. In bracket 2, insert either --continuation-- or --divisional--.
4. In bracket 3, insert the Application Number of the prior non-provisional application.

Claims under 35 U.S.C. 119(a)-(d) and (e) for the benefit of the filing dates of earlier applications in a parent application will automatically carry over to a CPA.

B. Terminal Disclaimer

A terminal disclaimer filed in the parent application carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the same application number as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA. See MPEP § 1490, "Withdrawing a Terminal Disclaimer," subheading entitled "A. Before Issuance of Patent."

C. Prior Election

An election made in the prior application carries over to the CPA only if all of the following conditions are met: (A) the CPA is designated as a continuation or is not designated at all (i.e., the CPA is **NOT** designated as a divisional); (B) there was an express election by the applicant in reply to a restriction requirement in the prior application; (C) the CPA presents claim(s) drawn only to invention(s) claimed in the prior application; and (D) the CPA does not contain an indication that a shift in election is desired.

Where all of the conditions are met, the examiner's first action should repeat the restriction requirement made in the prior application to the extent it is still applicable in the CPA and include a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application.

D. Information Disclosure Statements and Preliminary Amendments

All information disclosure statements filed in the prior application that comply with the content requirements of 37 CFR 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.

In addition, all information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed before the mailing of a first Office action on the merits will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution. Therefore, applicants are encouraged to file any information disclosure statement in a CPA as early as possible, preferably at the time of filing the CPA. For further discussion of information disclosure statements, see MPEP § 609.

Applicants are also encouraged to file all preliminary amendments at the time of filing a CPA because the entry of any preliminary amendment filed after the filing date of the CPA could be denied under 37 CFR 1.115 if the preliminary amendment unduly interferes with the preparation of a first Office action. See MPEP § 714.03(a). In a situation where the applicant needs more time to prepare a preliminary amendment or to file an information disclosure statement, applicant can request a three-month suspension of action under 37 CFR 1.103(b). The three-month suspension of action under 37 CFR 1.103(b) must be filed at the time of filing a CPA. See MPEP § 709.

E. Copies of Affidavits

Affidavits and declarations, such as those under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application, automatically become a part of the CPA. Therefore, no copy of the original affidavit or declaration filed in the parent nonprovisional application need be filed in the CPA.

IV. PUBLIC ACCESS TO CPAs

A. Waiver of Confidentiality

A CPA is 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 37 CFR 1.14 to obtain access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of 37 CFR 1.53(d) may be given similar access to, copies of, or similar information concerning, the other application(s) in the application file. 37 CFR 1.53(d)(6). However, all applications in the file jacket of a pending CPA are treated as pending, rather than abandoned, in determining whether copies of, and access to, such applications will be granted. For Image File Wrapper (IFW) processing,

see IFW Manual. See MPEP § 103 for further discussion of access to an abandoned application contained in the file of a pending CPA.

B. Certified Copy

A certified copy of a CPA will be prepared by the Certification Branch upon request. The certified copy will consist of a copy of the most recent non-continued prosecution application in the chain of CPAs. The filing date of the CPA will be shown in the certified copy as the filing date of the most recent non-continued prosecution application in the chain of CPAs.

V. FORMS

Form PTO/SB/29, "For Design Applications Only: Continued Prosecution Application (CPA) Request Transmittal" and Form PTO/SB/29A, "For Design Applications Only: Receipt For Facsimile Transmitted CPA" may be used by applicant for filing a CPA under 37 CFR 1.53(d). The forms used by the TCs to notify applicants of defects regarding applications filed under 37 CFR 1.53(d) are shown below. "Notice of Improper CPA (or FWC) Filing For Utility or Plant Applications Filed Before June 8, 1995" Form PTO-2011; "Notice of Improper CPA For Design Applications" Form PTO-2012; "Notice To File Missing Parts Of Application (CPA), For Design Applications" Form PTO-2021; "Notice Of Incomplete Reply (CPA) For Design Applications" Form PTO-2018; and "Notice Of Abandonment Under 37 CFR 1.53(f) (CPA) For Design Applications" Form PTO-2019.

**>

PTO/SB/16 (07-06)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PROVISIONAL APPLICATION FOR PATENT COVER SHEET – Page 1 of 2

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53(c).

Express Mail Label No. _____

INVENTOR(S)		
Given Name (first and middle [if any])	Family Name or Surname	Residence (City and either State or Foreign Country)

Additional inventors are being named on the _____ *separately numbered sheets attached hereto*

TITLE OF THE INVENTION (500 characters max):

Direct all correspondence to: **CORRESPONDENCE ADDRESS**

☐ The address corresponding to Customer Number:

OR

☐ Firm or Individual Name

Address

City	State	Zip
Country	Telephone	Email

ENCLOSED APPLICATION PARTS *(check all that apply)*

☐ Application Data Sheet. See 37 CFR 1.76

☐ CD(s), Number of CDs _____

☐ Drawing(s) *Number of Sheets* _____

☐ Other (specify) _____

☐ Specification (e.g. description of the invention) *Number of Pages* _____

Fees Due: Filing Fee of $200 ($100 for small entity). If the specification and drawings exceed 100 sheets of paper, an application size fee is also due, which is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

METHOD OF PAYMENT OF THE FILING FEE AND APPLICATION SIZE FEE FOR THIS PROVISIONAL APPLICATION FOR PATENT

☐ Applicant claims small entity status. See 37 CFR 1.27.

☐ A check or money order is enclosed to cover the filing fee and application size fee (if applicable).

☐ Payment by credit card. Form PTO-2038 is attached

☐ The Director is hereby authorized to charge the filing fee and application size fee (if applicable) or credit any overpayment to Deposit Account Number: _____. A duplicative copy of this form is enclosed for fee processing.

TOTAL FEE AMOUNT ($)

USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT

This collection of information is required by 37 CFR 1.51. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/29 (07-06)
Approved for use through 01/31/2007. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

6. Small entity status: Applicant claims small entity status. See 37 CFR 1.27.

7. The Director is hereby authorized to credit overpayments or change the following fees to Deposit Account No._____: (A duplicative copy of this form is enclosed)

   a. ☐ Fees required under 37 CFR 1.16.

   b. ☐ Fees required under 37 CFR 1.17.

   c. ☐ Fees required under 37 CFR 1.18.

8. ☐ A check in the amount of $ _____is enclosed.

9. ☐ Payment by credit card. Form PTO-2038 is attached.

10. ☐ Applicant requests suspension of action under 37 CFR 1.103(b) for a period of _____months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.

11. ☐ New Attorney Docket Number, if desired _____
[Prior application Attorney Docket Number will carry over to this CPA unless a new Attorney Docket Number has been provided herein.]

12. a. ☐ Receipt For Facsimile Transmitted CPA (PTO/SB/29A)

    b. ☐ Return Receipt Postcard (Should be specifically itemized. See MPEP 503)

13. ☐ Other:

NOTE: ***The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.***

14. NEW CORRESPONDENCE ADDRESS

☐ The address associated with Customer Number: ☐ ***OR*** ☐ New correspondence address below

Name			
Address			
City		State	
Zip Code		Country	Email

15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	
Name (Print/Type)	
Registration No. (Attorney/Agent)	
Date	
Telephone Number	

Page 2 of 2

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/29A (07-06)
Approved for use through 01/31/2007. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

If this RECEIPT is included with a request for a CPA filed by facsimile transmission, it will be date stamped and mailed to the ADDRESS in item 1.

1. ADDRESS *Applicant's Mailing Address for this receipt must be CLEARLY PRINTED or TYPED in the box below.*

FOR DESIGN APPLICATIONS ONLY

RECEIPT

FOR

FACSIMILE TRANSMITTED

CPA

(To accompany a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) filed by facsimile transmission)

***NOTE:* By this receipt, the USPTO (a) acknowledges that a request for a CPA in a design application was filed by facsimile the date stamped below by the USPTO and (b) verifies only that the application number provided by the applicant on this receipt is the same as the application number provided on the accompanying request for a CPA. This receipt CANNOT be used to acknowledge receipt of any paper(s) other than the request for a CPA.**

2. APPLICATION IDENTIFICATION:
(Provide at least enough information to identify the application)

a. For prior application

Application No: ……..……..……..

Filing Date: ……..……..……..

Title: ……..……..……..

Attorney Docket No: ……..……..……..

First Named Inventor: ……..……..……..

b. For instant CPA application

New Attorney Docket No: ……..……..……..
(if applicable)

The USPTO date stamp, which appears in the box to the right, is an acknowledgement by the USPTO of receipt of a request for a CPA filed by facsimile transmission on the date indicated below.

(THIS AREA FOR PTO DATE STAMP USE)

USPTO HANDLING INSTRUCTIONS:
Please stamp area to the right with the date the complete transmission of the request for a CPA was received in the USPTO and also include the USPTO organization name that provided the date stamp (stamp may include both items). Verify that the application number provided by applicant on this receipt is the same as the application number provided by applicant on the request for a CPA accompanying this receipt. If there is an inconsistency between the application number provided on this receipt and the request for a CPA, strike through the inconsistent application number provided on this receipt and insert the correct application number, if possible. Then place in a window envelope and mail.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 24 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

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The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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DATE MAILED:

Notice of Improper CPA (or FWC) Filing
For Utility or Plant Applications Filed Before June 8, 1995
No Filing Date Granted

Applicant filed a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) (or a file wrapper continuing (FWC) application under 37 CFR 1.62) on _____in the above-identified application which is a utility or plant application filed before June 8, 1995. Effective July 14, 2003, CPA Practice under 37 CFR 1.53(d) is no longer available for utility and plant applications. *See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications*, Final Rule, 68 *Feg. Reg.* 32376 (May 30, 2003). FWC practice also has been eliminated as of December 1, 1997. *See* 1203 *O.G.* 63 (October 21, 1997).

The time period for reply set in the last Office action (or notice) of the application in which the improper CPA (or FWC) is filed (hereafter "prior application") continues to run from the mailing date of the Office action or notice. Applicant may wish to file a continuing application under 37 CFR 1.53(b). If, however, the prior application is abandoned (*e.g.*, the time period for reply has expired), applicant would need to file a petition to revive the prior application to establish copendency with the continuing application under 37 CFR 1.53(b).

Any petition to revive under 37 CFR 1.137 should be directed to the attention of the Office of Petitions and may be addressed to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Alternatively, if no application is desired, applicant may file a request for refund of any CPA (or FWC) filing fee paid (less the handling fee set forth in 37 CFR 1.21(n)).

A copy of this notice MUST be returned with the reply.

Direct the reply and any questions concerning this notice to

_____, Technology Center _____

(703)_____

Form **PTO-2011** (Rev. 7/03)

**>

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DATE MAILED:

NOTICE OF IMPROPER CPA
FOR DESIGN APPLICATIONS
No Filing Date Granted

The Continued Prosecution Application (CPA) request deposited on _____ is improper under 37 CFR 1.53(d) and has **not** been granted a filing date for reason(s) indicated below.

☐ 1. The prior application is not a complete (37 CFR 1.51(b)) application.

☐ 2. The request for a CPA was not filed before the payment of issue fee on the prior application. The issue fee was paid on _____.

☐ 3. The request for a CPA was not filed before the abandonment of, or termination of proceedings on, the prior application. The prior application was abandoned, or proceedings terminated, on _____.

☐ 4. A petition under 37 CFR 1.136(a) and appropriate fee are necessary to establish copendency between this CPA and the prior application.

☐ 5. Other: _____.

Any assertions that the above-identified CPA request is proper under 37 CFR 1.53(d) must be by way of petition directed to the attention of the Office of Petitions, and may be addressed to:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any such petition must be accompanied by the $400.00 petition fee (37 CFR 1.17(f)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

Any petition **must be** submitted within **TWO MONTHS** of the mailing date of this notice (37 CFR 1.181(f)) or the application may be returned or otherwise disposed of and the filing fee, if submitted, will be refunded less the $130.00 handling fee (37 CFR 1.21(n)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.

A copy of this Notice MUST be returned with the reply.

Direct any questions concerning this notice to

_____, Technology Center 2900

(571)_____

Form **PTO-2012** (Rev. 4/05)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DATE MAILED:

NOTICE TO FILE MISSING PARTS OF APPLICATION (CPA) FOR DESIGN APPLICATIONS
Filing Date Granted

The Continued Prosecution Application (CPA) request filed on _____ is entitled to a filing date under 37 CFR 1.53(d)(1). The CPA request, however, lacks the filing fee(s) and/or items indicated below.

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the fee(s), and any surcharge required below to avoid abandonment of this CPA. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

The total amount owed by applicant is the sum of items 1(a) or 1(b), and 2 (if checked) below.

☐ 1. The basic filing fee (37 CFR 1.16(b)(1)), search fee (37 CFR 1.16(l)), and/or examination fee (37 CFR 1.16(p)) is missing or insufficient.

Applicant must submit:

a. **Non-small entity**: $ _____ to complete the basic filing fee, search fee, examination fee, and the $130.00 surcharge set forth in 37 CFR 1.16(f); **or**

b. **Small entity**: $ _____ to complete the basic filing fee, search fee, and examination fee and the $65.00 surcharge set forth in 37 CFR 1.16(f) if the applicant is entitled to the small entity status and a written assertion of small entity status under 37 CFR 1.27 is filed in the CPA.

☐ 2. A $50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).

☐ 3. The CPA request is unsigned. Applicant must file a signed duplicate or ratification of the CPA request.

☐ 4. Other: _____.

A copy of this notice MUST be returned with the reply.

Any reply may be addressed to: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Direct any questions concerning this notice to

_____, Technology Center 2900

(571)_____

Form **PTO-2021** (Rev. 4/05)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DATE MAILED:

NOTICE OF INCOMPLETE REPLY (CPA)
FOR DESIGN APPLICATIONS
Filing Date Granted

The reply filed on _____ to the Notice to File Missing Parts of Application (CPA) (Notice) mailed on _____ has been entered into the application. The reply, however, is incomplete for the following reason(s):

☐ 1. The basic filing fee (37 CFR 1.16(b)(1)), search fee (37 CFR 1.16(l)), and/or examination fee (37 CFR 1.16(p)) required by the Notice has not been received. The amount of $_____ is due.

☐ 2. The surcharge set forth in 37 CFR 1.16(f) of $_____ has not been received.

☐ 3. The reply does not include _____ as required by the Notice.

A complete reply must be timely filed to prevent **ABANDONMENT** of the above-identified application and may be addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The period for reply set forth in the Notice continues to run from the mailing date of the Notice. Applicant may obtain an EXTENSION OF TIME under the provisions of 37 CFR 1.136(a) by filing a petition accompanied by the appropriate fee (37 CFR 1.17(a)).

A copy of this notice MUST be returned with the reply.

Direct any questions concerning this notice to

_____, Technology Center 2900

(571)_____

Form **PTO-2018** (Rev. 4/05)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DATE MAILED:

NOTICE OF ABANDONMENT UNDER 37 CFR 1.53(f) (CPA)
For Design Applications

The above-identified Continued Prosecution Application (CPA) is abandoned for failure to timely or completely reply to the Notice to File Missing Parts of Application (CPA) (Notice) mailed on _____.

☐ No reply was received.

☐ The reply received on _____ was untimely.

☐ The reply received on _____ was incomplete. The reply did not include:

☐ 1. The surcharge required for filing the basic filing fee on a date later than the filing date of a nonprovisional application (37 CFR 1.16(f)).

☐ 2. The basic filing fee (37 CFR 1.16(b)(1)), search fee (37 CFR 1.16(l)), and/or examination fee (37 CFR 1.16(p)) required by the Notice.
(Note: A nonprovisional application may not be relied on for benefits under 35 U.S.C. 120 and 37 CFR 1.78 unless the processing and retention fee set forth in 37 CFR 1.21(l) is paid within the period set forth in 37 CFR 1.53(f)).

☐ The letter of Express Abandonment filed on _____ is acknowledged; however, the application is abandoned for failure to timely or completely reply to the Notice as indicated above.

A petition to the Director under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l), and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Any questions concerning petitions to revive should be directed to Office of Petitions at (571) 272-3282.
Any petitions to revive may be addressed to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Direct any questions concerning this notice to

_____, Technology Center 2900

(571)_____

Form **PTO-2019** (Rev. 4/05)

201.07 Continuation Application [R-3]

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) (or 1.53(d) if the application is a design application). The applicant in the continuation application must include at least one inventor named in the prior nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application. The continuation application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c). >For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 201.11.<

An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the primary examiner. *>A continued prosecution< application >(CPA)< under 37 CFR 1.53(d) >(available only for design applications)<, however, must be filed prior to payment of the issue fee unless a petition under 37 CFR 1.313(c) is granted in the prior application. In addition, a continuation or divisional application may only be filed under 37 CFR 1.53(d) if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b).

For notation to be put in the file history by the examiner in the case of a continuation application, see MPEP § 202.02.

Use form paragraph 2.05 to remind applicant of possible continuation status.

¶ *2.05 Possible Status as Continuation*

This application discloses and claims only subject matter disclosed in prior application no **[1]**, filed **[2]**, and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Examiner Note:

1. This form paragraph should only be used if it appears that the application may be a continuation, but priority has not been properly established.

2. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

201.08 Continuation-in-Part Application [R-3]

A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application. (*In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930)). The continuation-in-part application may only be filed under 37 CFR 1.53(b). The continuation-in-part application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c). >For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 201.11.<

A continuation-in-part application CANNOT be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

The mere filing of a continuation-in-part does not itself create a presumption that the applicant acquiesces in any rejections which may be outstanding in the copending national nonprovisional application or

applications upon which the continuation-in-part application relies for benefit.

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions set forth in 35 U.S.C. 120 and 37 CFR 1.78. Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

Unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the **>other< requirements of 35 U.S.C. 120 >and 37 CFR 1.78, such as<:

(A) The first application and the alleged continuation-in-part application were filed with at least one common inventor;

(B) The alleged continuation-in-part application was "filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application"; and

(C) The alleged continuation-in-part application "contains or is amended to contain a specific reference to the earlier filed application." (The specific reference **>must be submitted either in the first sentence(s) of the specification or in an application data sheet (see 37 CFR 1.76(b)(5)).)

See MPEP § 201.11 for more information on claiming the benefit of a prior nonprovisional application.<

For notation to be put in the file history by the examiner in the case of a continuation-in-part application see MPEP § 202.02. See MPEP § 708 for order of examination.

Use form paragraph 2.06 to remind applicant of possible continuation-in-part status.

¶ *2.06 Possible Status as Continuation-in-Part*

This application repeats a substantial portion of prior Application No. **[1]**, filed **[2]**, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Examiner Note:

1. This form paragraph should only be used when it appears that the application may qualify as a continuation-in-part, but no priority claim has been perfected.
2. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

201.09 Substitute Application [R-5]

The use of the term "Substitute" to designate any application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later application, finds official recognition in the decision *Ex parte Komenak*, 45 USPQ 186, 1940 C.D. 1, 512 O.G. 739 (Comm'r Pat. 1940). Current practice does not require applicant to insert in the specification reference to the earlier application; however, attention should be called to the earlier application. The notation in the file history (see MPEP § 202.02) that one application is a "Substitute" for another is printed in the heading of the patent copies. See MPEP § 202.02.

As is explained in MPEP § 201.11, a "Substitute" does not obtain the benefit of the filing date of the prior application.

Use form paragraph 2.07 to remind applicant of possible substitute status.
**>

¶ *2.07 Definition of a Substitute*

Applicant refers to this application as a "substitute" of Application No. **[1]**, filed **[2]**. The use of the term "substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case finds official recognition in the decision, *Ex parte Komenak*, 45 USPQ 186, 1940 C.D. 1, 512 O.G. 739 (Comm'r Pat. 1940). The notation on the file wrapper (See MPEP § 202.02) that one case is a "substitute" for another is printed in the

heading of the patent copies. A "substitute" does not obtain the benefit of the filing date of the prior application.

<

201.10 Refile [R-2]

No official definition has been given the term "Refile," though it is sometimes used as an alternative for the term "Substitute."

If the applicant designates his or her application as "Refile" and the examiner finds that the application is in fact a duplicate of a former application by the same party which was abandoned prior to the filing of the second application, the examiner should require the substitution of the word "substitute" for "refile", since the former term has official recognition.

Use form paragraph 2.08 to remind applicant of possible refile status.

**>

¶ *2.08 Definition of a Refile*

It is noted that applicant refers to this application as a "refile." No official definition has been given the term "refile," though it is sometimes used as an alternative for the term "substitute." Since this application appears to be in fact a duplicate of a former application which was abandoned prior to the filing of the second case, the substitution of the word "substitute" for "refile" is required since the term "substitute" has official recognition. Applicant is required to make appropriate corrections.

<

201.11 Claiming the Benefit of an Earlier Filing Date Under 35 U.S.C. 120 and 119(e) [R-5]

Under certain circumstances a later-filed application for patent is entitled to the benefit of the filing date of a prior-filed nonprovisional application or provisional application which has at least one common inventor. The conditions are specified in 35 U.S.C. 120 and 37 CFR 1.78(a)(1) – (a)(3) for the benefit claim of a prior nonprovisional application and 35 U.S.C. 119(e) and 37 CFR 1.78(a)(4) – (a)(6) for the benefit claim of a prior provisional application.

35 U.S.C. 120. Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. 119. Benefit of earlier filing date; right of priority.

*****

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

37 CFR 1.78. Claiming benefit of earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonpro-

visional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or

(ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or

(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must be paid within the time period set forth in § 1.53(g).

(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance

with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

**>

(iv) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an amendment or Supplemental Application Data Sheet withdrawing the benefit claim, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.<

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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There are several conditions for a later-filed application to receive the benefit of the filing date of a prior-filed application under 35 U.S.C. 120, 121, or 365(c), or, provided the later-filed application is not a design application (see 35 U.S.C. 172), under 35 U.S.C. 119(e). The conditions are briefly summarized as follows:

(A) The prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112 for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(B) The later-filed application must be copending with the prior-filed nonprovisional application for a benefit claim under 35 U.S.C. 120, 121, or 365(c). For a benefit claim under 35 U.S.C. 119(e), the later-filed application must be filed not later than 12 months after the filing date of the prior provisional application.

(C) The later-filed application must contain a reference to the prior-filed application in the first sentence(s) of the specification or in an application data sheet, for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(D) The later-filed application must be filed by an inventor or inventors named in the prior-filed application for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(E) If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e).

(F) If the prior-filed application is a provisional application filed in a language other than English, a benefit claim under 35 U.S.C. 119(e) *>requires the following to be filed in the provisional application<: (1) an English language translation of the provisional

application; and (2) a statement that the translation is accurate. See 37 CFR 1.78(a)(5)(iv).

(G) If the prior-filed application was an international application designating the United States of America, it must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(a)(1)(i).

(H) If the prior-filed application was filed under 35 U.S.C. 111, the prior-filed application must be entitled to a filing date and the basic filing fee of the prior-filed application must have been paid. See 37 CFR 1.78(a)(1)(ii) regarding a benefit claim under 35 U.S.C. 120, 121, or 365(c), and see 37 CFR 1.78(a)(4) regarding a benefit claim under 35 U.S.C. 119(e).

More information for each condition is provided in the subsections below.

If the claims in the later-filed application are not entitled to the benefit of an earlier filing date, the examiner should:

(A) Notify applicant that the claims in the later-filed application are not entitled to the benefit of an earlier filing date because one or more conditions for receiving the benefit of an earlier filing date have not been satisfied (the examiner may use form paragraph 2.09 and other appropriate form paragraphs provided in the following subsections); and

(B) Conduct a prior art search based on the actual filing date of the application instead of the earlier filing date. The examiner may use an intervening reference in a rejection until applicant corrects the benefit claim or shows that the conditions for claiming the benefit of the prior application have been met. The effective filing date of the later-filed application is the actual filing date of the later-filed application, not the filing date of the prior-filed application. See MPEP § 706.02.

I. DISCLOSURE REQUIREMENT

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The prior-filed application must disclose the common named inventor's invention claimed in the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. See 37 CFR 1.78(a)(1). Accordingly, the disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112, first paragraph.

A. Claiming the Benefit of Provisional Applications

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisonal application to be afforded the priority date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

In *New Railhead*, the patented drill bit was the subject of a commercial offer for sale. A provisional application was filed after the sale offer, but well within the one year grace period of 35 U.S.C. 102(b). A nonprovisional application, which issued as Patent No. 5,899,283, was filed within one year of the filing of the provisional application but more than one year after the sale offer. If the '283 patent was not afforded the priority date of the provisional application, the patent would be invalid under 35 U.S.C. 102(b) since it was filed more than one year after the commercial offer for sale. The court looked at claim 1 of the '283 patent which recites a bit body being angled with respect to the sonde housing. The court then reviewed the provisional application and concluded that nowhere in the provisional application is the bit body expressly described as "being angled with respect to the sonde housing" as recited in claim 1 of the '283 patent. The court held that the disclosure of the provisional application does not adequately support the

invention claimed in the '283 patent as to the angle limitation and therefore, the '283 patent is not entitled to the filing date of the provisional application under 35 U.S.C. 119(e)(1) and the '283 patent is invalid under 35 U.S.C. 102(b).

A claim is not required in a provisional application. However, for a claim in a later filed nonprovisional application to be entitled to the benefit of the filing date of the provisional application, the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter of the claim in the later filed nonprovisional application. If a claim in the nonprovisional application is not adequately supported by the written description and drawing(s) (if any) of the provisional application (as in *New Railhead*), that claim in the nonprovisional application is not entitled to the benefit of the filing date of the provisional application. If the filing date of the earlier provisional application is necessary, for example, in the case of an interference or to overcome a reference, care must be taken to ensure that the disclosure filed as the provisional application adequately provides (1) a written description of the subject matter of the claim(s) at issue in the later filed nonprovisional application, and (2) an enabling disclosure to permit one of ordinary skill in the art to make and use the claimed invention in the later filed nonprovisional application without undue experimentation.

B. Claiming the Benefit of Nonprovisional Applications

The disclosure of a continuation application must be the same as the disclosure of the prior-filed application. See MPEP § 201.07. The disclosure of a divisional application must be the same as the disclosure of the prior-filed application, or include at least that portion of the disclosure of the prior-filed application that is germane to the invention claimed in the divisional application. See MPEP § 201.06. The disclosure of a continuation or divisional application cannot include anything which would constitute new matter if inserted in the prior-filed application. A continuation-in-part application may include matter not disclosed in the prior-filed application. See MPEP § 201.08. Only the claims of the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date.

Under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997).

A claim in the later-filed application is not entitled to the benefit of the filing date of the prior-filed application if the disclosure of the prior-filed application does not enable one skilled in the art to "use" the claimed invention. See *In re Hafner*, 410 F.2d 1403, 1406, 161 USPQ 783, 786 (CCPA 1969) ("[T]o be entitled to the benefits provided by [35 U.S.C. 120], the invention disclosed in the "previously filed" application must be described therein in such a manner as to satisfy *all* the requirements of the first paragraph of [35 U.S.C.] 112, including that which requires the description to be sufficient to enable one skilled in the art to *use* the [invention].").

Where the prior application (a nonprovisional application) is found to be fatally defective because of insufficient disclosure to support allowable claims, a later-filed application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. *Hunt Co. v. Mallinckrodt Chemical Works*, 177 F.2d 583, 587, 83 USPQ 277, 281 (2d Cir. 1949) and cases cited therein.

Any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application; *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Van Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972).

By way of further illustration, if the claims of a continuation-in-part application which are only entitled to the continuation-in-part filing date "read on" published, publicly used or sold, or patented subject matter (e.g., as in a genus-species relationship) a rejection under 35 U.S.C. 102 would be proper. Cases of interest in this regard are as follows: *Mendenhall v. Cedarapids Inc.*, 5 F.3d 1557, 28 USPQ2d 1081 (Fed. Cir. 1993); *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971); *In re Hafner*, 410 F.2d 1403, 161 USPQ 783 (CCPA 1969); *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958); *In re Steenbock*, 83 F.2d 912, 30 USPQ 45 (CCPA 1936); and *Ex parte Hageman*, 179 USPQ 747 (Bd. App. 1971).

C. Form Paragraphs

Form paragraphs 2.09 and 2.10 should be used where the claims of the later-filed application are not adequately disclosed or enabled by the disclosure of the prior application.

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¶ *2.09 Heading for Conditions for Benefit Claims Under 35 U.S.C. 119(e), 120, 121, or 365(c)*

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. **[1]** as follows:

Examiner Note:

1. In bracket 1, insert either or both --119(e)-- or --120--.
2. One or more of form paragraphs 2.10 to 2.11.01 or 2.38 to 2.40 must follow depending upon the circumstances.

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¶ *2.10 Disclosure of Prior-Filed Application Does Not Provide Support for Claimed Subject Matter*

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. **[1]**, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. **[2]**

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. This form paragraph may be used when there is lack of support or enablement in the prior-filed application for the claims in the application that is claiming the benefit of the prior-filed application under 35 U.S.C. 120, 121, or 365(c) or under 35 U.S.C. 119(e). The prior-filed application can be a provisional application or a nonprovisional application.
3. In bracket 1, insert the application number of the prior-filed application.
4. In bracket 2, provide an explanation of lack of support or enablement. If only some of the claims are not entitled to the benefit of the filing date of the prior application, the examiner should include a list those claims after the explanation (e.g., "Accordingly, claims 1-10 are not entitled to the benefit of the prior application.").

Form paragraph 2.10.01 should be used where applicant is claiming the benefit of a prior nonprovisional application under 35 U.S.C. 120, 121, or 365(c) and the relationship (continuation or divisional) of the applications should be changed to continuation-in-part because the disclosure of the later-filed application contains matter not disclosed in the prior-filed nonprovisional application.

¶ *2.10.01 Continuation or Divisional Application Contains New Matter Relative to the Prior-Filed Application*

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to change the relationship (continuation or divisional

application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: **[1]**.

Examiner Note:

1. This form paragraph should be used when an application claims the benefit of a prior-filed application under 35 U.S.C. 120, 121, or 365(c), contains new matter, and purports to be a "continuation," "division," or "divisional application" of the prior-filed application. Do not use this form paragraph if the applicant is claiming the benefit of a provisional application under 35 U.S.C. 119(e).
2. In bracket 1, provide an example of the matter not disclosed in the prior-filed application.

II. TIME FOR FILING LATER-FILED APPLICATIONS

A. Claiming the Benefit of Provisional Applications

When a later-filed application is claiming the benefit of a prior-filed provisional application under 35 U.S.C. 119(e), the nonprovisional application must be filed not later than 12 months after the date on which the provisional application was filed. If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application may be filed on the next succeeding business day. See 35 U.S.C. 21(b), 37 CFR 1.7(b), and MPEP § 201.04(b) and § 505.

Public Law 106-113 amended 35 U.S.C. 119(e)(2) to eliminate the copendency requirement for a nonprovisional application claiming benefit of a provisional application. 35 U.S.C. 119(e)(2) as amended by Public Law 106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999. Although a nonprovisional application claiming the benefit of a provisional application is not required to be copending with the provisional application, abandonment of a provisional application for failure to pay the basic filing fee would indicate that the nonprovisional application could not claim the benefit of the provisional application because the basic filing fee was not paid within the time period set forth in 37 CFR 1.53(g) as required by 37 CFR 1.78(a)(4).

Applicant may claim the benefit of a provisional application by claiming the benefit of an intermediate copending nonprovisional application. The later-filed application must claim the benefit of the intermediate nonprovisional application under 35 U.S.C. 120, 121, or 365(c); the intermediate application must be filed not later than 12 months after the filing date of the provisional application; and both the later-filed application and the intermediate application must claim the benefit of the provisional application under 35 U.S.C. 119(e).

B. Claiming the Benefit of Nonprovisional Applications — Copendency

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c), the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application. Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. Thus, the later-filed application may be filed under 37 CFR 1.53(b) while the prior application is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. Patents usually will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed.

If the prior application is abandoned, the later-filed application must be filed before the abandonment in order for it to be copending with the prior application. The term "abandoned," refers to abandonment for failure to prosecute (MPEP § 711.02), express abandonment (MPEP § 711.01), abandonment for failure to pay the issue fee (37 CFR 1.316), and abandonment for failure to notify the Office of a foreign filing after filing a nonpublication request under 35 U.S.C. 122(b)(2)(B)(iii) (MPEP § 1124).

The expression "termination of proceedings" includes the situations when an application is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

After a decision by the Court of Appeals for the Federal Circuit in which the rejection of all claims is affirmed, the proceeding is terminated when the mandate is issued by the Court. There are several other situations in which proceedings are terminated as is explained in MPEP § 711.02(c).

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor. The later-filed application may be referred to as a continuing application when the prior application is not a provisional application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

A later-filed application which is <u>not</u> copending with the prior application (which includes those called "substitute" applications as set forth in MPEP § 201.09) is not entitled to the benefit of the filing date of the prior application. Therefore, prior art against the claims of the later-filed application is determined based on the filing date of the later-filed application. An applicant is not required to refer to such prior application(s) in an application data sheet or in the specification of the later-filed application, but is required to otherwise call the examiner's attention to the prior application if it or its contents or prosecution is material to patentability of the later-filed application as defined in 37 CFR 1.56(b).

C. Form Paragraphs

Use form paragraphs 2.09 and 2.11 to indicate the benefit claim under 35 U.S.C. 120, 121, or 365(c) is improper because there is no copendency between the applications.

¶ *2.11 Application Must Be Copending With Parent*

This application is claiming the benefit of prior-filed nonprovisional application No. **[1]** under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. Do not use this form paragraph for benefit claims under 35 U.S.C. 119(e) to provisional applications.
3. In bracket 1, insert the application number of the prior-filed nonprovisional application.

Use form paragraphs 2.09 and 2.11.01 and to indicate that the later-filed application must be filed not later than 12 months after the filing date of the provisional application for which a benefit is sought.

¶ *2.11.01 Application Must Be Filed Within 12 Months From the Provisional Application*

This application is claiming the benefit of provisional application No. **[1]** under 35 U.S.C. 119(e). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application.

Note: If the day that is 12 months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application claiming the benefit of the provisional application may be filed on the next succeeding business day.

Applicant is required to delete the reference to the prior-filed provisional application from the first sentence(s) of the specification or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish that this application, or an intermediate nonprovisional application, was filed within 12 months of the filing date of the provisional application.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.

2. In bracket 1, insert the application number of the prior-filed provisional application.

III. REFERENCE TO PRIOR APPLICATION(S)

The third requirement of the statute is that the later-filed application must contain a specific reference to the prior application. This should appear as the first sentence(s) of the specification following the title preferably as a separate paragraph (37 CFR 1.78(a)) and/or in an application data sheet (37 CFR 1.76). If the specific reference is only contained in the application data sheet, then the benefit claim information will be included on the front page of any patent or patent application publication, but will not be included in the first sentence(s) of the specification. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application, unless an incorporation by reference statement of the prior application was presented upon filing of the application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

A. Reference to Prior Nonprovisional Applications

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated. In addition, a benefit claim that merely states that "this application is a continuing application of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing (i.e., continuation, divisional, or continuation-in-part) application, is not stated.

A request for a CPA filed under 37 CFR 1.53(d) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. (Note: The CPA is assigned the same application number as the prior application.) In a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and may not be made. Any such reference should be deleted. No amendment in a CPA may delete the specific reference to the prior application assigned the same application number. A specific reference to an application not assigned the same application number, but relied on for benefit under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is required. Cross references to other related applications not assigned the same application as the CPA may be made when appropriate.

When a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as "This is a divisional (or continuation, or continuation-in-part, as appropriate) application of Application No. ---, filed ---" should appear as the first sentence(s) of the specification or in an application data sheet, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. In the case of an application filed under 37 CFR 1.53(b) as a divisional, continuation or continuation-in-part of a CPA, there should be only one reference to the series of applications assigned the same application number, with the filing date cited being that of the original noncontinued application. Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application under 35 U.S.C. 371, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, which was the National Stage of International Application No. PCT/DE95/---, filed ---."

Any benefit claim that does not <u>both</u> identify a prior application by its application number <u>and</u> specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit

claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in the first sentence(s) of the specification or an application data sheet. As a result, publication of the application may not be scheduled as a function of the prior application's filing date. If the Office does not recognize a benefit claim under 35 U.S.C. 120 because it does not contain the required reference and the time period set forth in 37 CFR 1.78(a)(2)(ii) for submitting the required reference has expired, applicant must submit a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t) in order for the Office to accept the unintentionally delayed claim under 35 U.S.C. 120 since the application will not have been scheduled for publication on the basis of the prior application's filing date.

To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application. Note that the terms are exclusive. An application cannot be, for example, both a continuation and a divisional or a continuation and a continuation-in-part of the same application. Moreover, if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications. For example, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---.

B. Reference to Prior Provisional Applications

When the nonprovisional application is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/ ---, filed ---." should appear as the first sentence(s) of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---.". In the case of design applications, it should appear as set forth in MPEP § 1504.20.

The relationship (i.e., continuation, divisional, or continuation-in-part) is not required and should not be specified when a prior provisional application is being claimed under 35 U.S.C. 119(e). No relationship should be specified because whenever a priority claim to a provisional application under 35 U.S.C. 119(e) is made, it is implicit that the relationship is "nonprovisional application of a provisional application." If a relationship between a prior provisional application and the nonprovisional application is submitted, it may be unclear whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. Thus, applicants seeking to claim the priority to a provisional application under 35 U.S.C. 119(e) should <u>not</u> state that the application is a "continuation" of a provisional application or that the application claims 35 U.S.C. 120 benefit to a provisional application. Although 35 U.S.C. 120 does not preclude a benefit claim to a provisional application, it is not recommended that applicants claim the benefit to a provisional application under 35 U.S.C. 120 since such a claim could have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. 154(a)(2).

C. Benefit Claims to Multiple Prior Applications

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. See *Sticker Indus. Supply Corp. v. Blaw-*

Knox Co., 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) and *Hovlid v. Asari*, 305 F. 2d 747, 134 USPQ 162 (9th Cir. 1962). The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See *In re Henriksen*, 399 F2.d 253, 158 USPQ 224 (CCPA 1968).

A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application. Although an application that itself directly claims the benefit of a provisional application is not required to specify the relationship to the provisional application, if the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application so that the Office can determine whether the intermediate nonprovisional application was filed within 12 months of the provisional application and thus, whether the claim is proper. Applicant must state, for example, "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---." A benefit claim that merely states "this application claims the benefit of nonprovisional Application Nos. C and B, and provisional Application No. A" would be improper. Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be indicated. Applicant must state, for example, "this application is continuation of Application No. D, filed ---, which is a continuation-in-part of Application No. C, filed ---, Application No. D claims the benefit of provisional Application No. B, filed ---, and Application No. C claims the benefit of provisional Application No. A, filed ---." If a benefit claim to a provisional application is submitted without an indication that an intermediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim and will not include the benefit claim on the filing receipt. Therefore, a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t) will be required if the intermediate application and the relationship of each nonprovisional application are not indicated within the period set forth in 37 CFR 1.78(a).

D. Reference Must Be Included in the Specification or an Application Data Sheet (ADS)

The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an ADS or the specification must contain or be amended to contain such reference in the first sentence(s) following the title. If applicant is claiming the benefit of multiple prior applications, the reference to the prior applications may be in a continuous string of multiple sentences at the beginning of the specification. The multiple sentences must begin as the first sentence after the title, and any additional sentence(s) including a benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim. If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to

correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt. If, however, a claim is not included in the first sentence(s) of the specification or in an ADS and is not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition under 37 CFR 1.78(a) and the surcharge to correct the claim. The Office may not recognize any benefit claim where there is no indication of the relationship between the nonprovisional applications or no indication of the intermediate nonprovisional application that is directly claiming the benefit of the provisional application. Even if the Office has recognized a benefit claim by entering it into the Office's database and including it on applicant's filing receipt, the benefit claim is not a proper benefit claim under 35 U.S.C. 119(e) or 35 U.S.C. 120 and 37 CFR 1.78 unless the reference is included in an ADS or in the first sentence>(s)< of the specification and all other requirements are met.

E. Examiners Should Require the Reference if Missing

In view of this requirement, the right to rely on a prior application may be waived by an applicant if a reference to the prior application is not included in the later-filed application. If the examiner is aware of the fact that an application is a continuing application of a prior application or the applicant fails to submit the reference to the prior application in compliance with 37 CFR 1.78(a) (e.g., the reference was submitted in the transmittal letter but not in the first sentence(s) of the specification or in an application data sheet), he or she should merely call attention to this in an Office action by using the wording of form paragraphs 2.15 or 2.16.

¶ *2.15 Reference to Prior Application, 35 U.S.C. 119(e) or 120 Benefit*

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. **[1]**, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filling an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Examiner Note:

1. In bracket 1, insert --119(e)-- or --120--.
2. In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is <u>not</u> required and may <u>not</u> be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA. 37 CFR 1.53(d)(2)(iv) and (d)(7).

¶ *2.16 Reference to a Prior Application*

It is noted that this application appears to claim subject matter disclosed in prior Application No. **[1]**, filed **[2]**. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or

365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmitted letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11

Examiner Note:

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is <u>not</u> required and may <u>not</u> be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA. 37 CFR 1.53(d)(2)(iv) and (d)(7).

If the examiner is aware of a prior application he or she should note it in an Office action, as indicated above, but should not require the applicant to call attention to the prior application.

For notations to be placed in the file history in the case of continuing applications, see MPEP § 202.02 and § 1302.09.

F. Correcting or Adding a Benefit Claim After Filing

The Office will not grant a request for a corrected filing receipt to include a benefit claim unless the proper reference to the prior application is included in the first sentence(s) of the specification or an ADS within the time period required by 37 CFR 1.78(a) with a few exceptions. See subsection V., "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)". If the proper reference was previously submitted, a copy of the amendment, the first page of the specification, or the ADS containing the benefit claim should be included with the request for a corrected filing receipt. The Office plans to notify applicants on or with the filing receipt that a benefit claim may not have been recognized because the benefit claim was improper but applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition (37 CFR 1.78(a)(3) or (a)((6)) and the surcharge.

If a benefit claim is added after the time period required by 37 CFR 1.78(a), a petition and the surcharge are required. See subsection V. "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT 37 CFR 1.78(a)(2) AND (a)(5)." Any petition under 37 CFR 1.78(a)(3) or (a)(6) must be accompanied by an amendment to the specification or an ADS unless the proper reference was previously submitted. In addition to the petition under 37 CFR 1.78 and the amendment or ADS, to add a benefit claim it may be necessary for applicant to file one of the following, depending on the status of the application:

(A) a request for continued examination (RCE) under 37 CFR 1.114, if the application is under a final rejection or has been allowed (see MPEP §706.07(h)). An amendment or ADS filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively; or

(B) a reissue application or a request for a certificate of correction under 37 CFR 1.323, if appropriate (see MPEP §§ 1402 and 1481), if the application has issued as a patent.

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim after the filing date of the application, the amendment would not be proper. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application unless an incorporation by reference statement of the prior application was presented upon filing of the application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

G. Deleting Benefit Claims

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications.

The examiner should consider whether any new prior art may now be available if a benefit claim is deleted. If an applicant is submitting an amendment to the specification or an ADS to delete a benefit claim after final rejection or action, the amendment or ADS will be treated under 37 CFR 1.116 (see MPEP § 714.12 and § 714.13). If the amendment or ADS to delete a benefit claim is submitted after the application has been allowed, the amendment or ADS will be treated under 37 CFR 1.312 (see MPEP § 714.16). A deletion of a benefit claim will not delay the publication of the application unless the amendment or ADS is recognized by the Office within nine weeks prior to the projected publication date that was originally calculated based on the benefit claim.

A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), no amendment may delete the specific reference to a prior application assigned the same application number. (Note: In the CPA, the request is the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. Further, in a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and should not be made.) The correction or entry of the data in the PALM data base can be made by technical support staff of the TC. Upon entry of the data, a new PALM bib-data sheet should be printed and placed in the file. See also MPEP § 707.05 and § 1302.09.

IV. SAME INVENTOR OR INVENTORS

The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. 119(e) or 120 be filed by an inventor or inventors named in the previously filed application or provisional application. 37 CFR 1.78(a)(1) and (a)(4) require that each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

V. TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)

The time period requirement under 37 CFR 1.78(a)(2) and (a)(5) is only applicable to utility or plant applications filed on or after November 29, 2000.

The American Inventors Protection Act of 1999 (AIPA), Public Law 106-113, amended 35 U.S.C. 119 and 120 to provide that the Office may set a time period for the filing of benefit claims and establish procedures to accept an unintentionally delayed benefit claim. The Office has implemented these statutory changes, in part, by amending 37 CFR 1.78 to include: (A) a time period within which a benefit claim to a prior nonprovisional or provisional application must be stated or it is considered waived; and (B) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional or provisional application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the benefit claim of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the benefit claim must be made within the later of: (1) four months from the date on which the national stage commenced under 37 U.S.C. 371(b) or (f); or (2) sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c).

If the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to the prior application (unless previously submitted); (B) a surcharge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(3).

Likewise, if the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition for an unintentionally delayed benefit claim must be submitted during the pendency of the nonprovisional application. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) to the prior provisional application (unless previously submitted); (B) a surcharge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(6).

Petitions for an unintentionally delayed benefit claim should be forwarded to the Office of Petitions. See MPEP § 1002.02(b).

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of such information concerning the benefit claim. Applicant must still submit the benefit claim in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (i.e., by an amendment in the first sentence(s) of the specification or in an ADS) to have a proper claim under 35 U.S.C. 120 or 119(e) and 37 CFR 1.78 to the benefit of a prior application. If, however, an applicant

includes a benefit claim elsewhere in the application and not in the manner specified in 37 CFR 1.78(a), and the claim is not recognized by the Office as shown by its absence on a filing receipt (e.g., if the benefit claim is in a part of the application where benefit claims are not conventionally located, such as the body of the specification), the Office will require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the benefit claim contained elsewhere in the application.

A petition under 37 CFR 1.78(a)(3) and the surcharge would not be required for correcting a timely submitted benefit claim for the following situations:

(A) Changing the relationship of the applications (e.g., changing from "continuation" or "divisional" to "continuation-in-part" or from "continuation-in-part" to "continuation" or "divisional");

(B) Changing the filing date of a prior-filed nonprovisional or provisional application; and

(C) Changing a benefit claim of a prior-filed provisional application under 35 U.S.C. 120 (e.g., "This application is a continuation of prior-filed provisional application No. ---") to a benefit claim of the same provisional application under 35 U.S.C. 119(e) (e.g., "This application claims the benefit of prior-filed provisional application No. ---") during the pendency of the later-filed application. Note, however: If the later-filed application has issued as a patent, the correction cannot be made by a certificate of correction and would not be effective in a reissue application because the term of a patent is measured from the prior application's filing date and removing the benefit claim under 35 U.S.C. 120, 121, or 365(c) would have the effect of lengthening the term of the patent.

If a benefit claim is filed after the required time period and without a petition as required by 37 CFR 1.78(a)(3) or (a)(6), the applicant should be informed that the benefit claim was not entered and that a petition needs to be filed using form paragraph 2.39.

¶ *2.39 35 U.S.C. 119(e), 120, 121 or 365(c) Benefit Claim is Untimely*

The benefit claim filed on **[1]** was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. **[2]** based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for utility or plant applications filed on or after November 29, 2000.
2. In bracket 1, insert the filing date of the amendment or paper containing the benefit claim.
3. In bracket 2, insert --119(e)--, --120--, --121--, or --365(c)--.
4. Do not use this form paragraph if the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or in an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt. In this situation, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filling an amendment to the first sentence(s) of the specification or an ADS, if the reference has not been previously submitted. See MPEP § 201.11.

VI. ENGLISH TRANSLATION

If benefit is being claimed to a provisional application which was filed in a language other than English, (A) an English language translation of the provisional application, and (B) a statement that the translation is accurate, are required to be filed * in the provisional application **. >If a nonprovisional application claims the benefit of the filing date of a non-English language provisional application, a translation of the

provisional application and a statement that the translation was accurate required by 37 CFR 1.78(a)(5)(iv) will not be required to be filed in the provisional application, if the translation and statement were filed in the nonprovisional application before November 25, 2005.< If the translation and statement were not * filed in the provisional application or >in< the nonprovisional application >before November 25, 2005,< the applicant will be notified in the nonprovisional application and given a period of time within which to file the translation and statement >in the provisional application, and a reply in the nonprovisional application confirming that the translation and statement were filed in the provisional application. In the alternative, applicant may reply to the notice by filing an amendment or a supplemental application data sheet (37 CFR 1.76(c)) withdrawing the benefit claim<. In a pending nonprovisional application, failure to timely reply to such notice will result in the abandonment of the nonprovisional application.

Form paragraph 2.38 may be used to notify applicant that an English translation of the non-English language provisional application is required.

**>

¶ *2.38 Claiming Benefit to a Non-English Language Provisional Application*

This application claims benefit to provisional application No. **[1]**, filed on **[2]**, in a language other than English. An English translation of the non-English language provisional application and a statement that the translation is accurate must be filed in provisional application No. **[3]**. See 37 CFR 1.78(a)(5). The **[4]** required by 37 CFR 1.78(a)(5) is missing. Accordingly, applicant must supply 1) the missing **[5]** in provisional application No. **[6]** and 2) in the present application, a confirmation that the translation and statement were filed in the provisional application. If 1) and 2) are not filed (or the benefit claim withdrawn by the filing of an amendment or Supplemental Application Data Sheet) prior to the expiration of the time period set in this Office action, the present application will be abandoned. See 37 CFR 1.78(a)(5)(iv).

Examiner Note:

1. Use this form paragraph to notify applicant that an English translation of the non-English language provisional application and/or a statement that the translation is accurate is required. Do not use this form paragraph if a translation of the provisional application and a statement that the translation was accurate were filed in the nonprovisional application (the present application) before November 25, 2005.

2. In brackets 1 and 3, insert the application number of the non-English language provisional application.

3. In bracket 2, insert the filing date of the prior provisional application.

4. In brackets 4 and 5, insert --English translation and a statement that the translation is accurate-- or --statement that the translation is accurate--, where appropriate.

<

VII. THE PRIOR-FILED APPLICATION MUST BE ENTITLED TO A FILING DATE

If the prior-filed application is a nonprovisional application filed under 35 U.S.C. 111(a), the application must be entitled to a filing date as set forth in 35 CFR 1.53(b) or (d), and the basic filing fee as set forth in 37 CFR 1.16 must have been paid within the pendency of the application. See 37 CFR 1.78(a)(1). If the prior-filed application is an international application designating the United States of America, the prior-filed application must be entitled to a filing date in accordance with PCT Article 11. If the prior-filed application is a provisional application, the provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee of the provisional application must have been paid within the time period set in 37 CFR 1.53(g) (the filing fee is paid within the time period set in 37 CFR 1.53(g) if an extension of time was filed to make a response to a notice to file missing parts requiring the filing fee timely).

Form paragraph 2.40 may be used to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.

¶ *2.40 Prior-Filed Application Not Entitled to a Filing Date or Basic Filing Fee Was Not Paid*

This application claims the benefit of prior-filed application No. **[1]** under 35 U.S.C. 120, 121, or 365(c) or under 35 U.S.C. 119(e). If the prior-filed application is an international application designating the United States of America, it must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(a)(1)(i). If the prior-filed application is a nonprovisional application, the prior-filed application must been entitled to a filing date as set forth in 37 CFR 1.53(b) or 1.53(d) and include the basic filing fee set forth in 37 CFR 1.16. See 37 CFR 1.78(a)(1)(ii). If the prior-filed application is a provisional application, the prior-filed application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee must be paid within the time period set forth in 37 CFR 1.53(g). See 37 CFR 1.78(a)(4).

This application is not entitled to the benefit of the prior-filed application because the prior-filed application **[2]**. Applicant is required to delete the reference to the prior-filed application.

Examiner Note:

1. Use this form paragraph to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.

2. In bracket 1, insert the application number of the prior-filed application.

3. In bracket 2, insert "was not entitled to a filing date"; "did not include the basic filing fee"; or "was not entitled to a filing date and did not include the basic filing fee".

201.11(a) Filing of Continuation or Continuation-in-Part Application During Pendency of International Application Designating the United States [R-3]

It is possible to file a U.S. national application under 35 U.S.C. 111(a) and 37 CFR 1.53(b) during the pendency (prior to the abandonment) of an international application which designates the United States without completing the requirements for entering the national stage under 35 U.S.C. 371(c). See MPEP §1895. The ability to take such action is based on provisions of the United States patent law. 35 U.S.C. 363 provides that "An international application designating the United States shall have the effect from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office...". 35 U.S.C. 371(d) indicates that failure to timely comply with the requirements of 35 U.S.C. 371(c) "shall be regarded as abandonment by the parties thereof...". It is therefore clear that an international application which designates the United States has the effect of a pending U.S. application from the international application filing date until its abandonment as to the United States. The first sentence of 35 U.S.C. 365(c) specifically provides that "In accordance with the conditions and requirements of section 120 of this title,... a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States." The condition of 35 U.S.C. 120 relating to the time of filing requires the later application to be "filed before the patenting or abandonment of or termination of proceedings on the first application...".

DELAYED SUBMISSION OF BENEFIT CLAIM IN INTERNATIONAL APPLICATION

A petition under 37 CFR 1.78(a)(3) for accepting an unintentionally delayed benefit claim and the surcharge under 37 CFR 1.17(t) are required to add a benefit claim under 35 U.S.C. 120 >and 365(c)< in an abandoned international application >designating the United States< filed on or after November 29, 2000, even when the international application did not enter the national stage under 35 U.S.C. 371. For example, when filing a "bypass" continuation application under 35 U.S.C. 111(a) that claims the benefit of an international application >designating the United States< with a filing date on or after November 29, 2000 that could have but did not claim the benefit of an earlier U.S. application, and the benefit claim is to be added to the international application, a petition under 37 CFR 1.78(a)(3) must be filed in the international application.

201.12 **Title >to an Application Claiming Benefit of an Earlier Application< [R-3]

**>The assignment records of the USPTO will only reflect an assignment of a divisional application or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed.< See MPEP § 306. When the assignment is in a provisional application, see MPEP § 306.01.

201.13 Right of Priority of Foreign Application [R-3]

Under certain conditions and on fulfilling certain requirements, an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country, to overcome an intervening reference or for similar purposes. The conditions are specified in 35 U.S.C. 119(a)-(d) and (f)>, and 37 CFR 1.55<.

35 U.S.C. 119. Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or

assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

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(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

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37 CFR 1.55. Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

(A) A design application; or

(B) An application filed before November 29, 2000.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323

**>

(3) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section:

(i) When the application becomes involved in an interference (see § 41.202 of this title),

(ii) When necessary to overcome the date of a reference relied upon by the examiner, or

(iii) When deemed necessary by the examiner.

(4)(i)An English language translation of a non-English language foreign application is not required except:

(A) When the application is involved in an interference (see § 41.202 of this title),

(B) When necessary to overcome the date of a reference relied upon by the examiner, or

(C) When specifically required by the examiner.

(ii) If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.<

*****

The period of 12 months specified in this section is 6 months in the case of designs, 35 U.S.C. 172. See MPEP § 1504.10.

The conditions, for benefit of the filing date of a prior application filed in a foreign country, may be listed as follows:

(A) The foreign application must be one filed in "a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States or in a WTO member country."

(B) The foreign application must have been filed by the same applicant (inventor) as the applicant in the United States, or by his or her legal representatives or assigns.

(C) The application, or its earliest parent United States application under 35 U.S.C. 120, must have been filed within 12 months from the date of the earliest foreign filing in a "recognized" country as explained below.

(D) The foreign application must be for the same invention as the application in the United States.

(E) For an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable.

(F) For applications that entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT Article and Regulations.

(G) In the case where the basis of the claim is an application for an inventor's certificate, the requirements of 37 CFR 1.55(b) must also be met.

Applicant may be informed of possible priority rights under 35 U.S.C. 119(a)-(d) >and (f)< by using the wording of form paragraph 2.18.

¶ *2.18 Right of Priority Under 35 U.S.C. 119(a)-(d) and (f)*

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d) and (f), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

I. RECOGNIZED COUNTRIES OF FOREIGN FILING

The right to rely on a foreign application is known as the right of priority in international patent law and this phrase has been adopted in the U.S. statute. The right of priority originated in a multilateral treaty of 1883, to which the United States adhered in 1887, known as the Paris Convention for the Protection of Industrial Property (Paris Convention). The treaty is administered by the World Intellectual Property Organization (WIPO) at Geneva, Switzerland. This treaty has been revised several times, the latest revision in effect being written in Stockholm in July 1967 (copy at Appendix P of this Manual). Articles 13-30 of the Stockholm Revision became effective on September 5, 1970. Articles 1-12 of the Stockholm Revision became effective on August 25, 1973. One of the many provisions of the treaty requires each of the adhering countries to accord the right of priority to the nationals of the other countries and the first United States statute relating to this subject was enacted to carry out this obligation. There is another treaty between the United States and some Latin American countries which also provides for the right of priority. A foreign country may also provide for this right by reciprocal legislation.

The United States and Taiwan signed an agreement on priority for patent and trademark applications on April 10, 1996, and Taiwan is now a country for which the right of priority is recognized in the United States. Applicants seeking patent protection in the United States may avail themselves of the right of priority based on patent applications filed in Taiwan, on or after April 10, 1996.

An application for patent filed in the United States on or after January 1, 1996, by any person who has, or whose legal representatives or assigns have, previously filed an application for patent in Thailand shall have the benefit of the filing date in Thailand in accordance with 35 U.S.C. 119 and 172.

NOTE: Following is a list of countries with respect to which the right of priority referred to in 35 U.S.C. 119(a)-(d) has been recognized. The letter "I" follow-

ing the name of the country indicates that the basis for priority in the case of these countries is the Paris Convention for the Protection of Industrial Property (613 O.G. 23, 53 Stat. 1748). The letter "P" after the name of the country indicates the basis for priority of these countries is the Inter-American Convention relating to Inventions, Patents, Designs, and Industrial Models, signed at Buenos Aires, August 20, 1910 (207 O.G. 935, 38 Stat. 1811). The letter "L" following the name of the country indicates the basis for priority is reciprocal legislation in the particular country. The letter "W" following the name of the country indicates the basis for priority is membership in the World Trade Organization (WTO). See 35 U.S.C. 119(a). The letter "W°" indicates that the country became a WTO member after January 1, 1996. See http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm for a current list of WTO member countries along with their dates of membership. Applications for plant breeder's rights filed in WTO member countries and foreign UPOV contracting parties may be relied upon for priority pursuant to 35 U.S.C. 119(f) and MPEP Chapter 1600.

Albania (I, W°),

Algeria (I),

Angola (W°),

>Andorra (I),<

Antigua and Barbuda (I, W),

Argentina (I, W),

Armenia (I>, W°<),

Australia (I, W),

Austria (I, W),

Azerbaijan (I),

Bahamas (I),

Bahrain (I, W),

Bangladesh (I, W),

Barbados (I, W),

Belarus (I),

Belgium (I, W),

Belize (I, W),

Benin (I, W°),

Bhutan (I),

Bolivia (I, P, W),

Bosnia and Herzegovina (I),

Botswana (I, W),

Brazil (I, P, W),

Brunei Darussalam (W),

Bulgaria (I, W°),

Burkina Faso (I, W),

Burundi (I, W),

Cambodia (I>, W°<),

Cameroon (I, W),

Canada (I, W),

Central African Republic (I, W),

Chad (I, W°),

Chile (I, W),

China (I, W°),

Colombia (I, W),

>Comoros (I),<

Congo (I, W°),

Costa Rica (I, P, W),

Cote d'Ivoire (I, W),

Croatia (I, W°),

Cuba (I, P, W),

Cyprus (I, W),

Czech Republic (I, W),

Democratic People's Republic of Korea (I),

Democratic Republic of the Congo (I, W°),

Denmark (I, W),

Djibouti (I, W),

Dominica (I, W),

Dominican Republic (I, P, W),

Ecuador (I, P, W°),

Egypt (I, W),

El Salvador (I, W),

Equatorial Guinea (I),

Estonia (I, W°),

European Community (W),

Fiji (W°),

Finland (I, W),

France (I, W),

Gabon (I, W),

Gambia (I, W°),

Georgia (I, W°),

Germany (I, W),

Ghana (I, W),

Greece (I, W),

Grenada (I, W°),

Guatemala (I, P, W),

Guinea (I, W),

Guinea-Bissau (I , W),

Guyana (I, W),

Haiti (I, P, W°),

Holy See (I),

Honduras (I, P, W),

Hong Kong Special Administrative Region of China (I, W),

Hungary (I, W),

Iceland (I, W),

India (I, W),

Indonesia (I, W),

Iran (Islamic Republic of) (I),

Iraq (I),

Ireland (I, W),

Israel (I, W),

Italy (I, W),

Jamaica (I, W),

Japan (I, W),

Jordan (I, W°),

Kazakstan (I),

Kenya (I, W),

Kuwait (W),

Kyrgyzstan (I, W°),

Lao People's Democratic Republic (I),

Latvia (I, W°),

Lebanon (I),

Lesotho (I, W),

Liberia (I),

Libya (I),

Libyan Arab Jamahiriya (I),

Liechtenstein (I, W),

Lithuania (I, W°),

Luxembourg (I, W),

Macau Special Administrative Region of China (I, W),

Madagascar (I, W),

Malawi (I, W),

Malaysia (I, W),

Maldives (W),

Mali (I, W),

Malta (I, W),

Mauritania (I, W),

Mauritius (I, W),

Mexico (I, W),

Monaco (I),

Mongolia (I, W°),

Morocco (I, W),

Mozambique (I, W),

Myanmar (W),

Namibia (I, W),

Nepal (I>, W°<),

Netherlands (I, W,),

New Zealand (I, W),

Nicaragua (I, P, W),

Niger (I, W°),

Nigeria (I, W),

Norway (I, W),

Oman (I, PW°),

Pakistan (>I,< W),

Panama (I, W°),

Papua New Guinea (I, W°),

Paraguay (I, P, W),

Peru (I, W),

Philippines (I, W),

Poland (I, W),

Portugal (I, W),

Qatar (I, W°),

Republic of Korea (I, W),

Republic of Moldova (I, W°),

Romania (I, W),

Russian Federation (I),

Rwanda (I, W°),

Saint Kitts and Nevis (I, W°),

Saint Lucia (I, W),

Saint Vincent and the Grenadines (I, W),

San Marino (I),

Sao Tome and Principe (I),

Saudi Arabia (I)

Senegal (I, W),

Serbia and Montenegro (I)

Seychelles (I)

Sierra Leone (I, W),

Singapore (I, W),

Slovakia (I, W),

Slovenia (I, W),

Solomon Islands (W°),

South Africa (I, W),

Spain (I, W),

Sri Lanka (I, W),

Sudan (I),

Suriname (I, W),

Swaziland (I, W),

Sweden (I, W),

Switzerland (I, W),

Syrian Arab Republic (I),

Taiwan>, Province of China (Chinese Taipei)< (L, W°),

Tajikistan (I),

Tanzania, United Republic of (I, W),

Thailand (L, W),

The former Yugoslav Republic of Macedonia (I, W°),

Togo (I, W),

Tonga (I),

Trinidad and Tobago (I, W),

Tunisia (I, W),

Turkey (I, W),

Turkmenistan (I),

Uganda (I, W),

Ukraine (I),

United Arab Emirates (I, W°),

United Kingdom (I, W),

Uruguay (I, P, W),

Uzbekistan (I),

Venezuela (I, W),

Viet Nam (I),

Zambia (I, W),

Zimbabwe (I, W).

Sixteen African Countries have joined together to create a common patent office and to promulgate a common law for the protection of inventions, trademarks, and designs. The common patent office is called “Organisation Africain de la Propriete Intellectuelle” (OAPI) and is located in Yaounde, Cameroon. The English title is “African Intellectual Property Organization.” The member countries using the OAPI Patent Office are Benin, Cameroon, Central African Republic, Chad, Congo, Gabon, Cote d’Ivoire, Mauritania, Niger, Senegal, Republic of Togo, Burkina Faso>,< Guinea, Guinea-Bissau, Mali and Equatorial

Guinea. Since all these countries adhere to the Paris Convention for the Protection of Industrial Property, priority under 35 U.S.C. 119(a)-(d) may be claimed of an application filed in the OAPI Patent Office.

If any applicant asserts the benefit of the filing date of an application filed in a country not on this list, the examiner should contact the Office of International Relations to determine if there has been any change in the status of that country. It should be noted that the right is based on the *country* of the foreign filing and not upon the citizenship of the applicant.

II. RIGHT OF PRIORITY (35 U.S.C. 119(a)-(d) AND 365) BASED ON A FOREIGN APPLICATION FILED UNDER A BILATERAL OR MULTILATERAL TREATY

Under Article 4A of the Paris Convention for the Protection of Industrial Property a right of priority may be based either on an application filed under the national law of a foreign country adhering to the Convention or on a foreign application filed under a bilateral or multilateral treaty concluded between two or more such countries. Examples of such treaties are The Hague Agreement Concerning the International Deposit of Industrial Designs, the Benelux Designs Convention, and the Libreville Agreement of September 13, 1962, relating to the creation of an African Intellectual Property Office. The Convention on the Grant of European Patents, the Patent Cooperation Treaty (MPEP § 201.13(b)), the Office for Harmonization in the Internal Market (OHIM), and the Community Plant Variety Office (CPVO) are further examples of such treaties.

A. The Priority Claim

A priority claim need not be in any special form and may be a statement signed by a registered attorney or agent. A priority claim can be made on filing: (A) by including a copy of an unexecuted or executed oath or declaration specifying a foreign priority claim (see 37 CFR 1.63(c)(2)); or (B) by submitting an application data sheet specifying a foreign priority claim (see 37 CFR 1.76).

In claiming priority of a foreign application previously filed under such a treaty, certain information must be supplied to the U.S. Patent and Trademark Office. In addition to the application number and the date of the filing of the application, the following information is required: (A) the name of the treaty under which the application was filed; and (B) the name and location of the national or intergovernmental authority which received such application.

B. Certification of the Priority Papers

35 U.S.C. 119(b)(3) authorizes the Office to require the applicant to furnish a certified copy of priority papers. Applicants are required to submit the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323. See 37 CFR 1.55(a)(2). Certification by the authority empowered under a bilateral or multilateral treaty to receive applications which give rise to a right of priority under Article 4A(2) of the Paris Convention will be deemed to satisfy the certification requirement.

C. Identity of Inventors

The inventors of the U.S. nonprovisional application and of the foreign application must be the same, for a right of priority does not exist in the case of an application of inventor A in the foreign country and inventor B in the United States, even though the two applications may be owned by the same party. However, the application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor which is permitted in some foreign countries, rather than by the inventor himself, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. An indication of the identity of inventors made in the oath or declaration accompanying the U.S. nonprovisional application by identifying the foreign application and stating that the foreign application had been filed by the assignee, or the legal representative, or agent, of the inventor, or on behalf of the inventor, as the case may be, is acceptable. Joint inventors A and B in a nonprovisional application filed in the United States Patent and Trademark Office may properly claim the benefit of an application filed in a foreign country by A and another application filed in a foreign country by B, i.e., A and B may each

claim the benefit of their foreign filed applications. See MPEP § 605.07.

D. Time for Filing U.S. Nonprovisional Application

The United States nonprovisional application, or its earliest parent nonprovisional application under 35 U.S.C. 120, must have been filed within 12 months of the earliest foreign filing. In computing this 12 months, the first day is not counted; thus, if an application was filed in Canada on January 3, 1983, the U.S. nonprovisional application may be filed on January 3, 1984. The Convention specifies in Article 4C(2) that "the day of filing is not counted in this period." (This is the usual method of computing periods, for example a 6-month period for reply to an Office action dated January 2 does not expire on July 1, but the reply may be made on July 2.) If the last day of the 12 months is a Saturday, Sunday, or Federal holiday within the District of Columbia, the U.S. nonprovisional application is in time if filed on the next succeeding business day; thus, if the foreign application was filed on September 4, 1981, the U.S. nonprovisional application is in time if filed on September 7, 1982, since September 4, 1982, was a Saturday and September 5, 1982 was a Sunday and September 6, 1982 was a Federal holiday. Since January 1, 1953, the Office has not received applications on Saturdays and, in view of 35 U.S.C. 21, and the Convention which provides "if the last day of the period is an official holiday, or a day on which the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day" (Article 4C(3)), if the 12 months expires on Saturday, the U.S. application may be filed on the following Monday. Note *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). See, e.g., *Dubost v. U.S. Patent and Trademark Office*, 777 F.2d 1561, 1562, 227 USPQ 977, 977 (Fed. Cir. 1985).

E. Filing of Papers During Unscheduled Closings of the U.S. Patent and Trademark Office

37 CFR 1.9(h) provides that the definition of "Federal holiday within the District of Columbia" includes an official closing of the Office. When the entire U.S. Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides "[t]he U.S. Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia" to clarify that any day that is a Saturday, Sunday or Federal holiday within the District of Columbia is a day that the U.S. Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4C(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia, correspondence deposited as Express Mail with the USPS in accordance with 37 CFR 1.10 will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or Federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).

When the U.S. Patent and Trademark Office is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications.

Information regarding whether or not the Office is officially closed on any particular day may be obtained by calling **>1-800-PTO-9199 or (571) 272-1000<.

F. First Foreign Application

The 12 months is from earliest foreign filing except as provided in 35 U.S.C 119(c). If an inventor has filed an application in France on January 4, 1982, and an identical application in the United Kingdom on March 3, 1982, and then files in the United States on February 2, 1983, the inventor is not entitled to the right of priority at all; the inventor would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and the inventor would not be entitled to the benefit of the date of the

United Kingdom application since this application is not the first one filed. *Ahrens v. Gray*, 1931 C.D. 9, 402 O.G. 261 (Bd. App. 1929). If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose.

Public Law 87-333 modified 35 U.S.C. 119(c) to extend the right of priority to "subsequent" foreign applications if one earlier filed had been withdrawn, abandoned, or otherwise disposed of, under certain conditions.

The United Kingdom and a few other countries have a system of "post-dating" whereby the filing date of an application is changed to a later date. This "post-dating" of the filing date of the application does not affect the status of the application with respect to the right of priority; if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application. See *In re Clamp*, 151 USPQ 423 (Comm'r Pat. 1966).

If an applicant has filed two foreign applications in recognized countries, one outside the year and one within the year, and the later application discloses additional subject matter, a claim in the U.S. application specifically limited to the additional disclosure would be entitled to the date of the second foreign application since this would be the first foreign application for that subject matter.

G. Incorporation by Reference

**>An applicant may incorporate by reference the foreign priority application by including, in the U.S. application-as-filed, an explicit statement that such specifically enumerated foreign priority application or applications are "hereby incorporated by reference." The statement must appear in the specification. See 37 CFR 1.57(b) and MPEP § 608.01(p). For U.S. applications filed prior to September 21, 2004, the incorporation by reference statement may appear in the transmittal letter or in the specification. The inclusion of this statement of incorporation by reference of the foreign priority application will permit an applicant to amend the U.S. application to include subject matter from the foreign priority application(s), without raising the issue of new matter. Thus, the incorporation by reference statement can be relied upon to permit the entering of a portion of the foreign priority application into the U.S. application when a portion of the foreign priority application has been inadvertently omitted from the U.S. application, or to permit the correction of translation error in the U.S. application where the foreign priority application is in a non-English language.

For U.S. applications filed on or after September 21, 2004, a claim under 37 CFR 1.55 for priority of a prior-filed foreign application that was present on the filing date of the U.S. application is considered an incorporation by reference of the prior-filed foreign priority application as to inadvertently omitted material, subject to the conditions and requirements of 37 CFR 1.57(a). The purpose of 37 CFR 1.57(a) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are) inadvertently omitted from an application. For U.S. applications filed on or after September 21, 2004, applicants are encouraged to provide an explicit incorporation by reference statement to the prior-filed foreign priority application(s) for which priority is claimed under 37 CFR 1.55 if applicants do not wish the incorporation by reference to be limited to inadvertently omitted material pursuant to 37 CFR 1.57(a). See 37 CFR 1.57(b) and MPEP § 608.01(p) for discussion regarding explicit incorporation by reference.<

III. EFFECT OF RIGHT OF PRIORITY

The right to rely on the foreign filing extends to overcoming the effects of intervening references or uses, but there are certain restrictions. For example, the 1 year bar of 35 U.S.C. 102(b) dates from the U.S. filing date and not from the foreign filing date; thus if an invention was described in a printed publication, or was in public use in this country, in November 1981, a foreign application filed in January 1982, and a U.S. application filed in December 1982, granting a patent on the U.S. application is barred by the printed publication or public use occurring more than one year prior to its actual filing in the United States.

The right of priority can be based upon an application in a foreign country for a so-called "utility model," called Gebrauchsmuster in Germany.

201.13(a) Right of Priority Based Upon an Application for an Inventor's Certificate

37 CFR 1.55. Claim for foreign priority.

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(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

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An inventor's certificate may form the basis for rights of priority under 35 U.S.C. 119(d) only when the country in which they are filed gives to applicants, at their discretion, the right to apply, on the same invention, either for a patent or for an inventor's certificate. The affidavit or declaration specified under 37 CFR 1.55(b) is only required for the purpose of ascertaining whether, in the country where the application for an inventor's certificate originated, this option generally existed for applicants with respect to the particular subject matter of the invention involved. The requirements of 35 U.S.C. 119(d) and 37 CFR 1.55(b) are not intended, however, to probe into the eligibility of the particular applicant to exercise the option in the particular priority application involved.

It is recognized that certain countries that grant inventors' certificates also provide by law that their own nationals who are employed in state enterprises may only receive inventors' certificates and not patents on inventions made in connection with their employment. This will not impair their right to be granted priority in the United States based on the filing of the inventor's certificate.

Accordingly, affidavits or declarations filed pursuant to 37 CFR 1.55(b) need only show that in the country in which the original inventor's certificate was filed, applicants generally have the right to apply at their own option either for a patent or an inventor's certificate as to the particular subject matter of the invention.

Priority rights on the basis of an inventor's certificate application will be honored only if the applicant had the option or discretion to file for either an inventor's certificate or a patent on his or her invention in his or her home country. Certain countries which grant both patents and inventor's certificates issue only inventor's certificates on certain subject matter, generally pharmaceuticals, foodstuffs, and cosmetics.

To ensure compliance with the treaty and statute, 37 CFR 1.55(b) provides that at the time of claiming the benefit of priority for an inventor's certificate, the applicant or his or her attorney must submit an affidavit or declaration stating that the applicant when filing his or her application for the inventor's certificate had the option either to file for a patent or an inventor's certificate as to the subject matter forming the basis for the claim of priority.

Effective Date

37 CFR 1.55(b) originally went into effect on August 25, 1973, which is the date on which the international treaty entered into force with respect to the United States. The rights of priority based on an earlier filed inventor's certificate shall be granted only with respect to U.S. patent applications where *both* the earlier application and the U.S. patent application were filed in their respective countries following this effective date.

201.13(b) Right of Priority Based Upon an International Application Filed Under the Patent Cooperation Treaty [R-2]

35 U.S.C. 365. Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119 of this title, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120 of this title, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

35 U.S.C. 365(a) provides that a national application shall be entitled to the right of priority based on a prior international application of whatever origin, which designated any country other than, or in addition to, the United States. Of course, the conditions prescribed by section 119(a)-(d) of title 35 U.S.C., which deals with the right of priority based on earlier filed foreign applications, must be complied with.

35 U.S.C. 365(b) provides that an international application designating the United States shall be entitled to the right of priority of a prior foreign application which may either be another international application or a regularly filed foreign application. The international application upon which the claim of priority is based can either have been filed in the United States or a foreign country; however, it must contain the designation of at least one country other than, or in addition to, the United States.

As far as the actual place of filing is concerned, for the purpose of 35 U.S.C. 365(a) and (b) and 35 U.S.C. 119(a)-(d) and (f), an international application designating a country is considered to be a national application regularly filed in that country on the international filing date irrespective of whether it was physically filed in that country, in another country, or in an intergovernmental organization acting as Receiving Office for a country.

An international application which seeks to establish the right of priority will have to comply with the conditions and requirements as prescribed by the Treaty and the PCT Regulations, in order to avoid rejection of the claim to the right of priority. Reference is especially made to the requirement of making a declaration of the claim of priority at the time of filing of the international application (Article 8(1) of the Treaty and Rule 4.10 of the PCT Regulations) and the requirement of either filing a certified copy of the priority document with the international application, or submitting a certified copy of the priority document to the International Bureau at a certain time (Rule 17 of the PCT Regulations). The submission of the priority document to the International Bureau is only required in those instances where priority is based on an earlier filed foreign *national* application.

Thus, if the priority document is an earlier national application and did not accompany the international application when filed with the Receiving Office, an applicant must submit such document to the International Bureau not later than 16 months after the priority date. However, should an applicant request early processing of his or her international application in accordance with Article 23(2) of the Treaty, the priority document would have to be submitted to the International Bureau at that time (Rule 17.1(a) of the PCT Regulations). If priority is based on an earlier international application, a copy does not have to be filed, either with the Receiving Office or the International Bureau, since the latter is already in possession of such international application.

The formal requirements for obtaining the right of priority under 35 U.S.C. 365 differ somewhat from those imposed by 35 U.S.C. 119(a)-(d) and (f), although the 1-year bar of 35 U.S.C. 102(b), as required by the last clause of section 119(a) is the same. However, the substantive right of priority is the same, in that it is derived from Article 4 of the Paris Convention for the Protection of Industrial Property (Article 8(2) of the Treaty).

35 U.S.C. 365(c) recognizes the benefit of the filing date of an earlier application under 35 U.S.C. 120. Any international application designating the United States, whether filed with a Receiving Office in this country or abroad, and even though other countries may have also been designated, has the effect of a regular national application in the United States, as of the international filing date. As such, any later filed national application, or international application designating the United States, may claim the benefit of the filing date of an earlier international application designating the United States, if the requirements and conditions of section 120 of title 35 U.S.C. are fulfilled. Under the same circumstances, the benefit of the earlier filing date of a national application may be obtained in a later filed international application designating the United States. In those instances, where

the applicant relies on an international application designating, but not originating in, the United States the *>Director< may require submission of a copy of such application together with an English translation, since in some instances, and for various reasons, a copy of that international application or its translation may not otherwise be filed in the U.S. Patent and Trademark Office.

PCT Rule 17.
The Priority Document

17.1. Obligation to Submit Copy of Earlier National or International Application

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(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed ("the priority document"), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b^{bis}), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(b^{bis})Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

(i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or

(ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.<

17.2. Availability of Copies

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(a) Where the applicant has complied with Rule 17.1(a), (b) or (b^{bis}), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.<

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) the international application was withdrawn,

(ii) the relevant priority claim was withdrawn or considered, under Rule 26bis.2(b), not to have been made.

(iii) *[Deleted]*

(d) *[Deleted]*

37 CFR 1.451. The priority claim and priority document in an international application.

(a) The claim for priority must, subject to paragraph (d) of this section, be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application or international application filed with the United States Receiving Office is claimed in an international application, the applicant may request in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office or in a separate letter filed in the United States Receiving Office not later than 16 months after the priority date, that the United States Patent and Trademark Office prepare a certified copy of the prior application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is set forth in § 1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the

International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

(d) The applicant may correct or add a priority claim in accordance with PCT Rule 26bis.1.

201.14 Right of Priority, Formal Requirements [R-5]

Under the statute (35 U.S.C. 119(b)), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specified. If these requirements are not complied with the right of priority is lost and cannot thereafter be asserted.

For nonprovisional applications filed prior to November 29, 2000, the requirements of the statute are (a) that the applicant must file a claim for the right and (b) he or she must also file a certified copy of the original foreign application; these papers must be filed within a certain time limit. The maximum time limit specified in the statute is that the claim for priority and the priority papers must be filed before the patent is granted, but the statute gives the Director authority to set this time limit at an earlier time during the pendency of the application.

Where a claim for priority under 35 U.S.C. 119(b) has not been made in the parent application, the claim for priority may be made in a **>continuing application< provided the parent application has been filed within 12 months from the date of the earliest foreign filing. **>See *In re Tangsrud*, 184 USPQ 746 (Comm'r Pat. 1973). If the claim for priority and the certified copy of the priority document are not filed in the continuing application within the time period set in 37 CFR 1.55,< the right of priority is lost. A reissue was granted in *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted.

It should be particularly noted that these papers must be filed in all cases even though they may not be necessary during the pendency of the application to overcome the date of any reference. The statute also gives the Director authority to require a translation of the foreign documents if not in the English language and such other information as the Director may deem necessary.

For original applications filed under 35 U.S.C.111(a) (other than a design application) on or after November 29, 2000, the requirements of the statute are that the applicant must (a) file a claim for the right of priority and (b) identify the original foreign application by specifying the application number of the foreign application, the intellectual property authority or country in which the application was filed and the date of filing of the application. These papers must be filed within a certain time limit. The time limit specified in 35 U.S.C.119(b)(1) is that the claim for priority and the required identification information must be filed at such time during the pendency of the application as set by the Director. The Director has by rule set this time limit as the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). This time period is not extendable. In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). Claims for foreign priority not presented within the time period specified in 37 CFR 1.55(a)(1)(i) are considered to have been waived. If a claim for priority under 35 U.S.C.119(a) - (d) or (f), or 365(a) is presented after the time period set in 37 CFR 1.55(a)(1)(i), the claim may be accepted if it includes the required identification information and is accompanied by a grantable petition to accept the unintentionally delayed claim for priority. See 37 CFR 1.55(c). In addition, 35 U.S.C. 119(b)(3) gives the Director authority to require a certified copy of the foreign application and an English translation if the foreign application is not in the English language and such other information as the Director may deem necessary. The Director has by rule, 37 CFR 1.55(a)(2), required a certified copy of the foreign application to be submitted before the patent is granted. If the certified copy of the foreign application is submitted after the payment of the issue fee, it must be accompanied by the processing fee set forth in 37 CFR 1.17(i). See MPEP § 201.14(a).

Unless provided in an application data sheet, 37 CFR 1.63 requires that the oath or declaration must identify the foreign application for patent or inven-

tor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

201.14(a) Right of Priority, Time for Filing Papers [R-3]

The time for filing the priority papers required by the statute is specified in 37 CFR 1.55(a).

37 CFR 1.55. Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

(A)A design application; or

(B)An application filed before November 29, 2000.

(ii) In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT.

(2) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323

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(3) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than provided in paragraphs (a)(1) or (a)(2) of this section:

(i) When the application becomes involved in an interference (see § 41.202 of this title),

(ii) When necessary to overcome the date of a reference relied upon by the examiner, or

(iii) When deemed necessary by the examiner.

(4)(i)An English language translation of a non-English language foreign application is not required except:

(A)When the application is involved in an interference (see § 41.202 of this title),

(B)When necessary to overcome the date of a reference relied upon by the examiner, or

(C)When specifically required by the examiner.

(ii) If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate.<

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(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) must be accompanied by:

(1) The claim under 35 U.S.C. 119(a)-(d) or 365(a) and this section to the prior foreign application, unless previously submitted;

(2) The surcharge set forth in § 1.17(t); and

(3) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

It should first be noted that the Director has by rule specified an earlier ultimate date than the date the patent is granted for filing a claim and a certified copy. For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, a claim for foreign priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). This time period is not extendable. For applications that entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. Any foreign priority claim not presented within the time period set in 37 CFR 1.55(a)(1)(i) is considered to have been waived. If a claim for foreign priority is presented after the time period set in 37 CFR 1.55(a)(1)(i), the claim may be accepted if the claim

properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. A grantable petition to accept an unintentionally delayed claim for priority must include: (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) the surcharge set forth in 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR1.55(c).

For nonprovisional applications filed prior to November 29, 2000 and for design applications, a claim for foreign priority may be made up until the time when the patent is granted. Priority claims and certified copies of foreign applications filed after payment of the issue fee will be placed in the application file but will not be reviewed, as explained in further detail below.

For all applications, assuming the claim for foreign priority has been made, the latest time at which the papers may be filed without a processing fee (37 CFR 1.17(i)) is the date of the payment of the issue fee, except that, under certain circumstances, they are required at an earlier date. These circumstances are specified in the rule as:

(A) in the case of interferences in which event the papers must be filed within the time specified in the interference rules;

(B) when necessary to overcome the date of a reference relied on by the examiner; and

(C) when specifically required by the examiner.

The claim for foreign priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for foreign priority or the certified copy of the foreign application is filed after the date of payment of the issue fee but prior to the date of grant of the patent, the priority claim or certified copy must be accompanied by a processing fee set forth in 37 CFR 1.17(i). The priority claim or certified copy will be placed in the file record but there will be no review of the papers and the patent when published will not include the priority claim. A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the priority claim or certified copy considered after publication of the patent. In addition, for original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, a grantable petition to accept an unintentionally delayed claim for priority under 37 CFR 1.55(c) must also be filed with the certificate of correction.

In view of the shortened periods for prosecution leading to allowances, it is recommended that priority papers be filed as early as possible. Although 37 CFR 1.55(a)(2) permits the filing of priority papers up to and including the date for payment of the issue fee, it is advisable that such papers be filed promptly after filing the application. Frequently, priority papers are found to be deficient in material respects, such as for example, the failure to include the correct certified copy, and there is not sufficient time to remedy the defect. Occasionally, a new oath or declaration may be necessary where the original oath or declaration omits the reference to the foreign filing date for which the benefit is claimed. The early filing of priority papers would thus be advantageous to applicants in that it would afford time to explain any inconsistencies that exist or to supply any additional documents that may be necessary.

It is also suggested that a pencil notation of the application number of the corresponding U.S. application be placed on the priority papers. Such notation should be placed directly on the priority papers themselves even where a cover letter is attached bearing the U.S. application data. Experience indicates that cover letters and priority papers occasionally become separated, and without the suggested pencil notations on the priority papers, correlating them with the corresponding U.S. application becomes exceedingly difficult, frequently resulting in severe problems for both the Office and applicant. Adherence to the foregoing suggestion for making a pencil notation on the priority document of the U.S. application data will result in a substantial lessening of the problem.

If the priority claim in an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000 is submitted after the time period set forth in 37 CFR 1.55(a)(1) and without the required petition (37 CFR 1.55(c)), the examiner may use the following form paragraph to

inform applicant that the foreign priority claim will not be entered.

¶ *2.21.01 35 U.S.C. 119(a)-(d) or (f) or 365(a) Foreign Priority Claim is Untimely*

The foreign priority claim filed on **[1]** was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55(a)(1). For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for original applications filed under 35 U.S.C. 111(a) on or after November 29, 2000. DO NOT use for design applications.
2. In bracket 1, insert the date the amendment or paper containing the foreign priority claim was filed.

201.14(b) Right of Priority, Papers Required [R-2]

The filing of the priority papers under 35 U.S.C. 119(a)-(d) makes the record of the file of the United States patent complete. The U.S. Patent and Trademark Office does not normally examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority, except as described in MPEP § 201.15 and in cases of interferences.

The papers required are the claim for priority and the certified copy of the foreign application. For original applications filed under 35 U.S.C. 111(a) (other than design applications) on or after November 29, 2000, the claim for foreign priority must identify the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In addition, the claim for priority must also identify any foreign application for the same subject matter having a filing date before that of the foreign application for which priority is claimed.

For all applications, the claim to priority need be in no special form, and may be made by a person authorized to sign correspondence under 37 CFR1.33(b). No special language is required in making the claim for priority, and any expression which can be reasonably interpreted as claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration, an application data sheet (37 CFR1.76), or the application transmittal letter with the recitation of the foreign application. See MPEP § 201.13, paragraph A.

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the applications as filed with a certificate of the foreign patent office giving certain information. “Application” in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed. A French patent stamped “Service De La Propriete Industrielle - Conforme Aux Pieces Deposees A L’ Appui de La Demande” and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application.

When the claim to priority and the certified copy of the foreign application are received while the application is pending before the examiner, the examiner should make no examination of the papers except to see that they correspond in number, date and country to the application identified in the oath or declaration and contain no obvious formal defects. The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit

of the foreign filing date on the basis of the disclosure thereof. In addition, for original applications filed under 35 U.S.C. 111(a) (other than design applications) on or after November 29, 2000, the examiner should make sure that the claim for foreign priority is timely. Examiners may use form paragraph 2.21.01 to notify applicant that the foreign priority claim is untimely.

>

I. < DURING INTERFERENCE

If priority papers are filed in an interference, it is not necessary to file an additional certified copy in the application file. The administrative patent judge will *>associate< them *>with< the application *.

>

II. < LATER FILED APPLICATIONS, REISSUES

Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application and a certified copy of the foreign application as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. A reminder of this provision is found in form paragraph 2.20. The applicant when making such claim for priority may simply identify the application containing the certified copy. In such cases, the examiner should acknowledge the claim on form PTOL-326. Note copy in MPEP § 707.

If the applicant fails to call attention to the fact that the certified copy is in the parent or related application and the examiner is aware of the fact that a claim for priority under 35 U.S.C. 119(a)-(d) or (f) was made in the parent application, the examiner should call applicant's attention to these facts in an Office action, so that if a patent issues on the later or reissue application, the priority data will appear in the patent. In such cases, the language of form paragraph 2.20 should be used.

**>

¶ *2.20 Priority Papers in Parent or Related (Reissue Situation) - Application*

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent or related Application No. **[1]** under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

<

Where the benefit of a foreign filing date, based on a foreign application, is claimed in a later filed application or in a reissue application and a certified copy of the foreign application, as filed, has not been filed in a parent or related application, a claim for priority may be made in the later application. *In re Tangsrud*, 184 USPQ 746 (Comm'r Pat. 1973). When such a claim is made in the later application and a certified copy of the foreign application is placed therein, the examiner should acknowledge the claim on form PTOL-326. Note copy in MPEP § 707.

>

III. < WHERE AN ACTUAL MODEL WAS ORIGINALLY FILED IN GERMANY

The German design statute does not permit an applicant having an establishment or domicile in the Federal Republic of Germany to file design patent applications with the German Patent Office. These German applicants can only obtain design protection by filing papers or an actual deposit of a model with the judicial authority ("Amtsgericht") of their principal establishment or domicile. Filing with the German Patent Office is exclusively reserved for applicants who have neither an establishment or domicile in the Federal Republic of Germany. The deposit in an "Amtsgericht" has the same effect as if deposited at the German Patent Office and results in a "Geschmacksmuster" which is effective throughout Germany.

In implementing the Paris Convention, 35 U.S.C. 119(a)-(d) and (f) requires that a copy of the original foreign application, specification, and drawings certified by the patent office of the foreign country in which filed, shall be submitted to the U.S. Patent and Trademark Office, in order for an applicant to be entitled to the right of priority in the United States.

Article 4, section A(2) of the Paris Convention however states that "(a)ny filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union . . . shall be recognized as giving rise to the right of priority." Article 4D(3) of

the Convention further provides that countries of the Union may require any person making a declaration of priority to produce a copy of the previously filed application (description, drawings, etc.) certified as correct by the authority which received this application.

As far as the physical production of a copy of the earlier filed paper application is concerned, an applicant should have no difficulty in providing a copy, certified by the authority which received it, if the earlier filed application contained drawings illustrating the design. A problem, however, arises when the only prior "regular national filing" consisted of the deposit of an actual model of the design. 35 U.S.C. 119 is silent on this subject.

Therefore, the U.S. Patent and Trademark Office will receive as evidence of an earlier filed German design application under 35 U.S.C. 119(a)-(d), drawings or acceptable clear photographs of the deposited model faithfully reproducing the design embodied therein together with other required information, certified as being a true copy by an official of the court with which the model was originally deposited.

35 U.S.C. 119(a)-(d), prior to amendment by the American Inventors Protection Act of 1999 (AIPA), Public Law 106-113, provides for the certification of the earlier filed application by the patent office of the foreign country in which it was filed. Because Article 4D(3) of the Paris Convention which 35 U.S.C. 119(a)-(d) implements refers to certification ". . . by the authority which received such application . . .", the reference to "patent office" in the statute is construed to extend also to the authority which is in charge of the design register, i.e., the applicable German court. As a consequence, an additional certification by the German Patent Office will not be necessary especially since Article 4D(3) of the Paris Convention provides that authentication shall not be required. Effective November 29, 2000, the AIPA amended 35 U.S.C. 119(b)(3) to state that certification "…shall be made by the foreign intellectual property authority in which the foreign application was filed." 35 U.S.C. 119(b)(3) as amended by the AIPA applies to applications filed under 35 U.S.C 111(a) and international applications complying with 35 U.S.C. 371, with filing dates on or after November 29, 2000.

Although, as stated above, a "regular national filing" gives rise to the right of priority, the mere submission of a certified copy of the earlier filed foreign application, however, may not be sufficient to perfect that right in this country. For example, among other things, an application filed in a foreign country must contain a disclosure of the invention adequate to satisfy the requirements of 35 U.S.C. 112, in order to form the basis for the right of priority in a later filed United States application.

201.14(c) Right of Priority, Practice [R-3]

Before going into the practice with respect to those instances in which the priority papers are used to overcome a reference, there will first be described the practice when there is no occasion to use the papers, which will be in the majority of cases. In what follows in this section it is assumed that no reference has been cited which requires the priority date to be overcome.

I. UNTIMELY CLAIM FOR PRIORITY

If the foreign priority claim in an original application filed under 35 U.S.C.111(a) (other than a design application) on or after November 29, 2000 is submitted after the time period set in 37 CFR 1.55(a)(1)(i) and without a petition under 37 CFR 1.55(c), the examiner may use form paragraph 2.21.01 to notify applicant that the foreign priority claim will not be entered.

II. NO IRREGULARITIES AND PRIORITY CLAIM TIMELY

When the papers under 35 U.S.C. 119(a)-(d) are received within the time period set forth in 37 CFR 1.55(a)(1), if applicable, they are **>entered into the application file history.< Assuming that the papers are timely and regular in form and that there are no irregularities in dates, the examiner in the next Office action will advise the applicant that the papers have been received on form PTOL-326 or by use of form paragraph 2.26. For Image File Wrapper (IFW) processing, see the IFW Manual.

¶ *2.26 Claimed Foreign Priority - Papers Filed*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Where the priority papers have been filed in another application, use form paragraph 2.27.

¶ *2.27 Acknowledge Foreign Priority Paper in Parent*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. **[1]**, filed on **[2]**.

Examiner Note:

1. For problems with foreign priority, see form paragraphs 2.18 to 2.24.
2. In bracket 1, insert series code and serial no. of parent.

The examiner will enter the information specified in MPEP § 202.03 on the face of the file wrapper or on the PALM bib-data sheet*>,< as appropriate.

III. PAPERS INCONSISTENT WITH A TIMELY PRIORITY CLAIM

If the certified copy filed does not correspond to the foreign application identified in the application oath or declaration or an application data sheet, or if the application oath or declaration or an application data sheet does not refer to the particular foreign application, the applicant has not complied with the requirements of the rule relating to the oath or declaration. In such instances, the Office action, after acknowledging receipt of the papers, should require the applicant to explain the inconsistency and to file a new oath or declaration or an application data sheet stating correctly the facts concerning foreign applications required by 37 CFR 1.63 by using form paragraph 2.21.

¶ *2.21 Oath, Declaration, or Application Data Sheet Does Not Contain Reference to Foreign Filing*

Receipt is acknowledged of papers filed under 35 U.S.C. 119(a)-(d) based on an application filed in **[1]** on **[2]**. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration, or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration, or application data sheet is required in the body of which the present application should be identified by application number and filing date.

Other situations requiring some action by the examiner are exemplified by other form paragraphs.

IV. NO CLAIM FOR PRIORITY

Where applicant has filed a certified copy but has not made a claim for priority, use form paragraph 2.22.

¶ *2.22 Certified Copy Filed, But No Claim Made*

Receipt is acknowledged of a certified copy of the **[1]** application referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

Examiner Note:

In bracket 1, insert the application number of the foreign application.

NOTE: Where the applicant's accompanying letter states that the certified copy is filed for priority purposes or for the convention date, it is accepted as a claim for priority.

V. FOREIGN APPLICATIONS ALL FILED MORE THAN A YEAR BEFORE EARLIEST EFFECTIVE U.S. FILING

Where the earlier foreign application was filed more than 12 months prior to the U.S. application, use form paragraph 2.23.

¶ *2.23 Foreign Filing More Than 12 Months Earlier*

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in **[1]** on **[2]**. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Examiner Note:

1. In bracket 1, insert the country name.
2. In bracket 2, insert the filing date of the foreign application.

VI. SOME FOREIGN APPLICATIONS FILED MORE THAN A YEAR BEFORE U.S. FILING

For example, where a British provisional specification was filed more than a year before a U.S. application, but the British complete application was filed within the year, and certified copies of both were submitted, language similar to the following should be used: "Receipt is acknowledged of papers filed on September 18, 1979, purporting to comply with the requirements of 35 U.S.C. 119(a)-(d). It is not seen how the claim for priority can be based on the British specification filed January 23, 1978, because the instant application was filed more than one year thereafter. However, the printed heading of the patent will note the claimed priority date based on the complete specification; i.e., November 1, 1978, for such subject matter as was not disclosed in the provisional specification."

VII. CERTIFIED COPY NOT THE FIRST FOREIGN APPLICATION

Form paragraph 2.24 may be used to notify applicant that the date for which foreign priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration.

¶ *2.24 Claimed Foreign Priority Date Not the Earliest Date*

Receipt is acknowledged of papers filed on **[1]** purporting to comply with the requirements of 35 U.S.C. 119(a)-(d) and they have been placed of record in the file. Attention is directed to the fact that the date for which foreign priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration.

VIII. NO CERTIFIED COPY

Where priority is claimed but no certified copy of the foreign application has been filed, use form paragraph 2.25.

¶ *2.25 Claimed Foreign Priority, No Papers Filed*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in **[1]** on **[2]**. It is noted, however, that applicant has not filed a certified copy of the **[3]** application as required by 35 U.S.C. 119(b).

Examiner Note:

1. In bracket 1, insert the country name.
2. In bracket 2, insert the filing date of the foreign application.
3. In bracket 3, insert the application number of the foreign application.

Any unusual situation may be referred to the Technology Center (TC) Director.

IX. APPLICATION IN ISSUE

When priority papers for applications which have been sent to the Publishing Division are received, the priority papers should be sent to the Publishing Division. For Image File Wrapper (IFW) processing, see the IFW Manual.

When the claim for foreign priority or the certified copy of the foreign application is filed after the date of payment of the issue fee but prior to the date of grant of the patent, the priority claim or certified copy must be accompanied by a processing fee set forth in 37 CFR 1.17(i). The priority claim or certified copy will be placed in the file record but there will be no review of the papers and the patent when published will not include the priority claim. A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the priority claim or certified copy considered after publication of the patent. In addition, for original applications filed under 35 U.S.C.111(a) (other than design applications) on or after November 29, 2000, a grantable petition to accept an unintentionally delayed claim for priority under 37 CFR 1.55(c) must be filed with the certificate of correction.

X. RETURN OF PAPERS

For Image File Wrapper (IFW) processing, see the IFW Manual. It is sometimes necessary for the examiner to return papers filed under 35 U.S.C. 119(a)-(d) either upon request of the applicant, for example, to obtain a translation of the certified copy of the foreign application, or because they fail to meet a basic requirement of the statute, such as where all foreign applications were filed more than a year prior to the U.S. filing date.

When the papers have not been **>entered into the application file history<, it is not necessary to secure approval of the Director of the United States Patent and Trademark Office for their return but they should be sent to the TC Director for cancellation of the Office stamps. Where the papers have been **>entered into the application file history,< a request for permission to return the papers should be addressed to the Director of the United States Patent

and Trademark Office and forwarded to the TC Director for approval. Where the return is approved, the written approval should be **>entered into the application file history.< Any questions relating to the return of papers filed under 35 U.S.C. 119(a)-(d) should be directed to the Office of the Commissioner for Patents.

XI. **>NOTATION IN FILE HISTORY REGARDING FOREIGN PRIORITY APPLICATION<

For Image File Wrapper (IFW) processing, see the IFW Manual. Where foreign applications are listed on the 37 CFR 1.63 oath or declaration or application data sheet, the examiner should check that such foreign applications are properly listed on the **>PALM bib-data sheet<, correcting errors of typography or format as necessary, and initialing the "verified" line when the information on the **>PALM bib-data sheet< matches the oath or declaration or application data sheet. See MPEP § 202.03. Should there be an error on the oath or declaration, or application data sheet itself, the examiner should require a new oath or declaration, or application data sheet, where appropriate. If a foreign application listed on the oath or declaration, or application data sheet is not listed on the **>PALM bib-data sheet, the examiner should provide the information regarding the foreign application number, the country, and the filing date on the PALM bib-data sheet and forward the marked-up PALM bib-data sheet to the Legal Instrument Examiner for correction in the Office computer systems.< Applications listed on the **>PALM bib-data sheet< but filed in countries not qualifying for benefits under 35 U.S.C. 119(a)-(d) should be lined through in * ink. A listing of countries qualifying for benefits under 35 U.S.C. 119(a)-(d) appears at MPEP § 201.13.

**

201.14(d) Proper Identification of Priority Application

In order to help overcome problems in determining the proper identification of priority applications for patent documentation and printing purposes, the following tables have been prepared which set out for various countries the forms of acceptable presentation of application numbers.

The tables should enable applicants, examiners and others to extract from the various formats the minimum required data which comprises a proper citation.

Proper identification of priority applications is essential to establishing accurate and complete relationships among various patent documents which reflect the same invention. Knowledge of these relationships is essential to search file management, technology documentation and various other purposes.

The tables show the forms of presentation of application numbers as used in the records of the source or originating patent office. They also show, under the heading "Minimum Significant Part of the Number," the simplified form of presentation which should be used in United States Patent and Trademark Office records.

Note particularly that in the simplified format that:

(A) Alpha symbols preceding numerals are eliminated in all cases except Hungary.

(B) A decimal character and numerical subset as part of a number is eliminated in all cases except France.

(C) Use of the dash (—) is reduced, but is still an essential element of application numbers, in the case of Czechoslovakia and Japan.

MINIMUM SIGNIFICANT PART OF AN APPLICATION NUMBER PROVIDING UNIQUE IDENTIFICATION OF AN APPLICATION

Table I—Countries Using Annual Application Number Series

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Austria [AT]	A 12116/69	12116/69	The letter A is common to all patent applications.
Czechoslovakia [CS]	PV3628-72	3628-72	PV is an abbreviation meaning "application of invention."
Denmark [DK]	68/2986	68/2986	
Egypt [EG]	487-1968	487-1968	
Country #	Example of application number at source	Minimum - significant part of the number	Remarks
Finland [FI]	3032/69 (old numbering system) 752032 (new numbering system)	3032/69 752032	New numbering system introduced on January 1, 1975. First two digits indicate year of application.
France [FR]	69.38066 7319346	68.38066 7319346	Deletion of the intermediary full stop from this number onwards.
Note: All French applications are numbered in a single annual series, e.g., demande de brevet, demande de certificate d'addition (first addition, second addition, etc.)			Annual series of numbers is used for all applications of patent documents. The number allotted to an application at its filing (national registration number) is also the number of the granted patent.

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Germany, Fed. Rep. of [DE]	P 1940738// 6-24 G6947580.5	1940738 D6947580	P=Patent. The first two digits of the number represent the last two digits of the year of application less 50 (e.g., 1969 less 50=19; 1973 less 50=23). The first digit after the slash is an error control digit. The two digits following the dash indicate the examining division. G= Gebrauschsmuster. The first two digits of the number represent the last two digits of the year of application. The difference in numbering scheme of the first two digits affords unique identification of this type of application. However, see note below (D). The digit after the period is for error control.
Ireland	1152/69	1152/69	
Italy [IT]	28039-A/70	28039/70	Application numbers are not presented on published patent documents or given in an official gazette. An exclusive block of application numbers is given annually to each of 93 provincial bureaus where patent applications may be filed. In 1973, 90,000 numbers were allotted, wherein an estimated total of 30,000 applications were expected to be filed. While, as a consequence, gaps will exist in the ultimately used numbers, each application has a unique number. For this purpose, neither the dash nor the letter identifying the receiving bureau, which follows the application number, is needed.
Japan [JP]	46-69807 46-81861	46-69807 D46-81861	The two digits before the dash indicate the year (1925 or 1988) of the Emperor's reign in which the application was filed (46=1971). Patent and utility model applications are numbered in separate series.
Netherlands [NL]	7015038	7015038	First two digits indicate year of application.
Norway [NO]	1748/70 (old numbering system) 74001 (new numbering system)	1748/70 74001	New numbering system introduced on January 1, 1974. First two digits indicate year of application.
South Africa [ZA]	70/4865	70/4865	

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Sweden [SE]	16414/70 7300001-0 (new system)	16414/70 7300001	The new numbering system was introduced January 1, 1973. First two digits indicate year of application. The digit after the dash is used for computer control.
Switzerland [CH]	15978/70	15978/70	
United Kingdom [GB]	41352/70	41352/70	
Yugoslavia [YU]	P1135/66	1135/66	
Zambia [ZM]	142/70	142/70	
Argentina [AR]	231790	231790	
Australia [AU]	59195/69	59195/69	Long series spread over several years. New series started in 1970.
Belgium [BE]	96469	96469	Application numbers are not presented on published patent documents or given in an official gazette. A series of parallel numbers is provided to each of 10 offices which, respectively, may receive applications (control office + 9 provincial bureaus) and assign application numbers. Series was started in 1958. Since an application number does not uniquely identify a BE document, the patent number is often cited as the “priority application number.”
Brazil [BR]	222986	222986	
Bulgaria [BG]	11572	11572	
Canada [CA]	103828	103828	
Colombia [CO]	126050	126050	

Table II—Countries Using Other Than Application Number Series

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Brazil [BR]	222986	222986	
Bulgaria [BG]	11572	11572	
Canada [CA]	103828	103828	
Colombia [CO]	126050	126050	
Cuba [CU]	33384	33384	
German (Dem. Rep.) [DD]	AP84c/ 137355 WP135b/ 147203	137355 147203	AP=Ausschliessungspatent; WP=Wirtschaftspatent. The other symbols before the slash are classification symbols. A single numbering series covers both AP and WP applications.
Greece [GR]	44114	44114	
Hungary [HU]	OE 107	OE 107	The letters preceding the number are essential for identifying the application. They are the first letter and the first following vowel of the applicant's name. There is a separate numbering sequence for each pair of letters.
Israel [IL]	35691	35691	
Luxembourg [LU]	60093	60093	
Mexico [MX]	123723	123723	
Monaco [MC]	908	908	
New Zealand [NZ]	161732	161732	
OAPI [OA]	52118	52118	
Philippines [PH]	11929	11929	
Poland [PO]	P144826 44987	144826 D44987	

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Portugal [PT]	P52-555-5607	52555 D5607	
Romania [RO]	65211	65211	
Soviet Union	1397205-15	1397205	The numbers following the slash denote the examination division and a processing division.
United States [US]	889877	889877	The highest number assigned in the series of numbers started in January 1960. New series started in January 1970, January 1979, D January 1987, January 1993, and January 1998.

ICIREPAT Country Code is indicated in brackets, e.g., [AR].

D In order to distinguish utility model applications from patent applications, it is necessary to identify them as to type of application in citations or references. This may be done by using the name of the application type in conjunction with the number or by using the symbol “U” in brackets or other enclosure following the number.

201.15 Right of Priority, Overcoming a Reference

The only times during *ex parte* prosecution that the examiner considers the merits of an applicant's claim of priority is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States and when an interference situation is under consideration. If at the time of making an action the examiner has found such an intervening reference, he or she simply rejects whatever claims may be considered unpatentable thereover, without paying any attention to the priority date (assuming the papers have not yet been filed). The applicant in his or her reply may argue the rejection if it is of such a nature that it can be argued, or present the foreign papers for the purpose of overcoming the date of the reference. If the applicant argues the reference, the examiner, in the next action in the application, may specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or he or she may merely continue the rejection.

Form paragraph 2.19 may be used in this instance.

¶ *2.19 Overcome Rejection by Translation*

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Examiner Note:

This paragraph should follow a rejection based on an intervening reference.

In those cases where the applicant files the foreign papers for the purpose of overcoming the effective date of a reference, a translation is required if the foreign papers are not in the English language. When the examiner requires the filing of the papers, the translation should also be required at the same time. This translation must be filed together with a statement that the translation of the certified copy is accurate. When the necessary papers are filed to overcome the date of the reference, the examiner's action, if he or she determines that the applicant is not entitled to the priority date, is to repeat the rejection on the reference, stating the reasons why the applicant is not considered entitled to the date. If it is determined that the applicant is entitled to the date, the rejection is withdrawn in view of the priority date.

If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. If the applicant is found to be entitled to the date, the reference is simply not used but may be cited to applicant on form PTO-892. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date.

The foreign application may have been filed by and in the name of the assignee or legal representative or agent of the inventor, as applicant. In such cases, if the certified copy of the foreign application corresponds with the one identified in the oath or declaration as required by 37 CFR 1.63 and no discrepancies appear, it may be assumed that the inventors are entitled to the claim for priority. If there is disagreement as to inventors on the certified copy, the priority date should be refused until the inconsistency or disagreement is resolved.

The most important aspect of the examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications. The foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that he or she would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought.

In applications filed from the United Kingdom there may be submitted a certified copy of the "provisional specification," which may also in some cases be accompanied by a copy of the "complete specification." The nature and function of the United Kingdom provisional specification is described in an article in the Journal of the Patent Office Society of November 1936, pages 770-774. According to United Kingdom law the provisional specification need not contain a

complete disclosure of the invention in the sense of 35 U.S.C. 112, but need only describe the general nature of the invention, and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important. If it is found that the United Kingdom provisional specification is insufficient for lack of disclosure, reliance may then be had on the complete specification and its date, if one has been presented, the complete specification then being treated as a different application and disregarded as to the requirement to file within 1 year.

In some instances, the specification and drawing of the foreign application may have been filed at a date subsequent to the filing of the petition in the foreign country. Even though the petition is called the application and the filing date of this petition is the filing date of the application in a particular country, the date accorded here is the date on which the specification and drawing were filed.

It may occasionally happen that the U.S. application will be found entitled to the filing date of the foreign application with respect to some claims and not with respect to others. Occasionally a sole or joint applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

201.16 Using Certificate of Correction to Perfect Claim for Priority Under 35 U.S.C. 119(a)-(d) or (f) [R-1]

35 U.S.C. 119. Benefit of Earlier Filing Date; Right of Priority.

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(b)(1)No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

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The failure to perfect a claim to foreign priority benefit prior to issuance of the patent may be cured by filing a reissue application. *Brenner v. State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968).

However, under certain conditions, this failure may also be cured by filing a certificate of correction request under 35 U.S.C. 255 and 37 CFR 1.323. For example, in the case of *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975), the Commissioner granted a request to issue a certificate of correction in order to perfect a claim to foreign priority benefits. In that case, a claim to foreign priority benefits had not been filed in the application prior to issuance of the patent. However, the application was a continuation of an earlier application in which the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied. Accordingly, the Commissioner held that the "applicants' perfection of a priority claim under 35 U.S.C. 119 in the parent application will satisfy the statute with respect to their continuation application."

Although *In re Van Esdonk* involved the patent of a continuation application filed under former 37 CFR 1.60, it is proper to apply the holding of that case in similar factual circumstances to any patented application having benefits under 35 U.S.C. 120. This is primarily because a claim to foreign priority benefits in a continuing application, where the claim has been perfected in the parent application, constitutes in essence a mere affirmation of the applicant's previously expressed desire to receive benefits under 35 U.S.C. 119(a)-(d) or (f) for subject matter common to the foreign, parent, and continuing applications.

In summary, a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patented continuing application if the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the parent application prior to issuance of the patent and the requirements of 37 CFR

1.55(a) are met. Furthermore, if the continuing application (other than a design application), which issued as a patent, was filed on or after November 29, 2000 **, in addition to the filing of a certificate of correction request, patentee must also file a petition for an unintentionally delayed foreign priority claim under 37 CFR 1.55(c).

However, a claim to foreign priority benefits cannot be perfected via a certificate of correction if the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance and the requirements of 37 CFR 1.55(a) are not met. In this latter circumstance, the claim to foreign priority benefits can be perfected only by way of a reissue application in accordance with the rationale set forth in *Brenner v. State of Israel*, 158 USPQ 584.

*>If the original application, which issued as the patent, was filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, a< claim for priority under 35 U.S.C. 119(a)-(d) or (f) for the benefit of a prior foreign application may be added (or corrected) in *>the< issued patent by reissue or certificate of correction (assuming the conditions for reissue or certificate of correction are otherwise met)**. In addition to the filing of a reissue application or a request for a certificate of correction, a petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or (f) along with the surcharge as set forth in 37 CFR 1.17(t) and a statement that the entire delay between the date the claim was due under 37 CFR1.55(a)(1) and the date the claim was filed was unintentional must be submitted. See 37 CFR1.55(c).

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201.17 Incorporation by Reference Under 37 CFR 1.57(a) [R-3]

37 CFR 1.57. Incorporation by reference.

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 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 portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111 (a) which claims benefit of the international application.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

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I. IN GENERAL

37 CFR 1.57(a) provides that, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but 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 portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim for priority or benefit shall be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawings.

The purpose of 37 CFR 1.57(a) is to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawing(s), or a portion thereof, is (are) inadvertently omitted from an application, such as through a clerical error. It allows inadvertently omitted material to be

added to the application by way of a later-filed amendment if the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application even though there is no explicit incorporation by reference of the prior-filed application.

For a discussion of explicit incorporation by reference statements, see MPEP § 608.01(p).

II. CONDITIONS AND REQUIREMENTS OF 37 CFR 1.57(a)

The following conditions and requirements need to be met for an applicant to add omitted material to an application pursuant to 37 CFR 1.57(a):

(A) the application must have been filed on or after September 21, 2004;

(B) all or a portion of the specification or drawing(s) must have been inadvertently omitted from the application;

(C) 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, must have been present on the filing date of the application;

(D) the inadvertently omitted portion of the specification or drawing(s) must be completely contained in the prior-filed application;

(E) applicant must file an amendment to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier;

(F) if the application is not otherwise entitled to a filing date, applicant must also file a petition under 37 CFR 1.57(a) accompanied by the petition fee set forth in 37 CFR 1.17(f);

(G) applicant must supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(H) applicant must supply an English language translation of any prior-filed application that is in a language other than English; and

(I) applicant must identify where the inadvertently omitted portion of the specification or drawing(s) can be found in the prior-filed application.

A. Application Filed On or After September 21, 2004

37 CFR 1.57(a) became effective on September 21, 2004 and applies to applications filed on or after that date. Thus, an application that inadvertently omits material must have been filed on or after September 21, 2004 in order for 37 CFR 1.57(a) to apply. Applicants may, however, rely on prior-filed applications filed before September 21, 2004 to supply inadvertently omitted material to applications filed on or after September 21, 2004.

B. Material Must Be Inadvertently Omitted

There is no requirement for applicant to submit a declaration stating that the omission was inadvertent or to submit proof that a particular omission was inadvertent at the time of filing of the application. If applicant submits an amendment to add the omitted material pursuant to 37 CFR 1.57(a), it would constitute a certification under 37 CFR 10.18(b) that the omission was inadvertent. The Office, however, may inquire as to inadvertence where the record raises such issue.

C. Claim Under 37 CFR 1.55 or 1.78 Present on Filing Date

The priority claim under 37 CFR 1.55 or the benefit claim under 37 CFR 1.78 of the prior-filed application must be present on the filing date of the later-filed application in order for it to be considered an incorporation by reference of the prior-filed application under 37 CFR 1.57(a). The later-filed application claiming benefit of the prior-filed application can be a continuation, divisional, or continuation-in-part application of the prior-filed application.

D. Omitted Material Completely Contained in Prior-filed Application

The phrase “completely contained” in 37 CFR 1.57(a) requires that the material to be added to the later-filed application under 37 CFR 1.57(a) must be expressly, as opposed to implicitly, disclosed in the prior-filed application. Furthermore, the material to be added must be completely contained in the prior-filed application **as filed** since it is the prior application as filed which is being incorporated under 37 CFR 1.57(a).

E. Amendment to Add Inadvertently Omitted Material

The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined in 37 CFR 1.114(b), or the abandonment of the application, whichever occurs earlier. If the Office of Initial Patent Examination (OIPE) mails a "Notice of Omitted Item(s)" indicating that a portion of the specification or drawings have been omitted, any amendment pursuant to 37 CFR 1.57(a) should be submitted within the two month time period set in the notice and should be identified as an amendment under 37 CFR 1.57(a). The amendment must be in compliance with 37 CFR 1.57(a) and 1.121. See MPEP § 601.01(d) and § 601.01(g). While an amendment to include inadvertently omitted material may be submitted in reply to a final Office action which first raises the issue of the omitted material, such an amendment does not have a right of entry as it would be considered as an amendment under 37 CFR 1.116. If the application is abandoned or the prosecution is closed, applicant may file a petition to revive an application under 37 CFR 1.137 and/or a request for continued examination under 37 CFR 1.114, as appropriate, in order to restore the application to pending status and/or reopen prosecution in the application. If, however, an application has been patented, a certificate of correction or a reissue application could not be used to add inadvertently omitted material to that patent via 37 CFR 1.57(a).

In order for the omitted material to be included in the application, and hence considered to be part of the disclosure, the application must be amended to include the omitted portion. Therefore, applicants can still intentionally omit material contained in the prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference of 37 CFR 1.57(a). Applicants can maintain their intent by simply not amending the application to include the intentionally omitted material.

In addition to filing the amendment to add the inadvertently omitted material, applicant is also required to: (A) supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111; (B) supply an English-language translation of any prior-filed application that is in a language other than English; and (C) identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

F. Petition Requirement

If an application is not otherwise entitled to a filing date under 37 CFR 1.53(b), the amendment must be by way of petition under 37 CFR 1.57(a)(3) accompanied by the fee set forth in 37 CFR 1.17(f). If OIPE mails a "Notice of Incomplete Application" indicating that the application lacks a specification or drawings, applicant should file a petition under 37 CFR 1.57(a) in response to the notice if applicant wants to rely on 37 CFR 1.57(a). See MPEP § 601.01(d) and § 601.01(f).

G. International Applications

Any amendment to an international application pursuant to 37 CFR 1.57(a) will be effective only as to the United States and shall have no effect on the international filing date of the application. The incorporation by reference relief provided in 37 CFR 1.57(a) cannot be relied upon to accord an international filing date to an international application that is not otherwise entitled to a filing date under PCT Article 11, and it cannot be relied upon to alter the international filing date accorded under PCT Article 11. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (37 CFR 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application.

III. EXAMPLES

Example 1:

The Office of Initial Patent Examination (OIPE) noticed that Figure 3 was omitted from the application during the initial review of the application although the specification included a description of Figure 3. The application as originally filed contained a claim under 37 CFR 1.78 for the benefit of a prior-filed application that included the appropriate Figure 3. OIPE mailed a Notice of Omitted Item(s) notifying the applicant of the

omission of Figure 3 and providing a two-month period for reply.

Applicant may rely on the incorporation by reference provided by 37 CFR 1.57(a) to amend the application to add Figure 3. Applicant, however, must file the amendment to add the inadvertently omitted drawing figure in compliance with 37 CFR 1.57(a) within the time period set forth in the Notice of Omitted Item(s).

Example 2:

Applicant discovered that the last page of the specification is inadvertently omitted after the prosecution of the application has been closed (e.g., a final Office action, an *Ex Parte* Quayle action, or a notice of allowance has been mailed to the applicant). The application, as originally filed, contained a claim under 37 CFR 1.78 for the benefit of a prior-filed application that included the last page of the specification.

If applicant wishes to amend the specification to include the inadvertently omitted material, applicant must reopen the prosecution by filing a Request for Continued Examination (RCE) under 37 CFR 1.114 accompanied by the appropriate fee and an amendment in compliance with 37 CFR 1.57(a) within the time period for reply set forth in the last Office action (e.g., prior to payment of the issue fee, unless applicant also files a petition to withdraw the application from issue).

Example 3:

Applicant filed a (third) application that includes a claim under 37 CFR 1.78 for the benefit of a (second) prior-filed application and a (first) prior-filed application. The second application was a continuation application of the first application and the second application was abandoned after the filing of the third application. Subsequently, the applicant discovered the last page of the specification was inadvertently omitted from the third application and the second application.

If the benefit of the filing date of first application for the omitted subject matter is required (for example, the omitted material is required to provide support for the claimed subject matter of the third application and there is an intervening reference that has a prior art date prior to the filing date of the third application, but after the filing date of the first application), applicant must amend the specification of the second application and the specification of the third application to include the inadvertently omitted material in compliance with 37 CFR 1.57(a) (note: the second and third applications must be filed on or after the effective date of 37 CFR 1.57(a)). Since the second application is abandoned, applicant must file a petition to revive under 37 CFR 1.137 in the second application only for the purpose of correcting the specification under 37 CFR 1.57(a) along with the amendment in compliance with 37 CFR 1.57(a).

IV. FORM PARAGRAPHS

Examiners may use form paragraph 6.19.02 set forth below to notify applicant that an amendment to add inadvertently omitted material pursuant to 37 CFR 1.57(a) is not in compliance with 37 CFR 1.57(a). If the amendment is made to the specification and/or drawings and introduces new matter into the disclosure, form paragraph 7.28 must also be used to object to the new matter added to the disclosure, and if the amendment adds new matter to the claims or affects the claims, form paragraph 7.31.01 must also be used to reject the claims under 35 U.S.C. 112, first paragraph.

¶ *6.19.02 Amendment Not in Compliance with 37 CFR 1.57(a)*

The amendment to add inadvertently omitted material pursuant to 37 CFR 1.57(a) filed **[1]** is not in compliance with 37 CFR 1.57(a) because **[2]**.

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.

2. In bracket 2, insert the reason why the amendment has not been entered. For example: (1) the present application was filed before September 21, 2004, the effective date of 37 CFR 1.57(a); (2) the claim for priority/benefit of the prior-filed application was not present on the filing date of the present application; (3) the inadvertently omitted portion is not completely contained in the prior-filed application; (4) a copy of the prior-filed application (except where the prior-filed application is an application filed under 35 U.S.C. 111) was not submitted; (5) an English language translation of the prior-filed non-English language application was not submitted; or (6) applicant did not identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

3. This form paragraph must be followed by form paragraph 7.28, where the amendment is made to the specification and/or drawings and introduces new matter into the disclosure, and/or form paragraph 7.31.01, where the amendment adds new matter to the claims or affects the claims.

4. If the amendment is an after-final amendment, an advisory action should be issued indicating that the amendment raises new issues because it is not in compliance with 37 CFR 1.57(a).

5. This form paragraph should not be used if there is an express incorporation by reference since applicant would not need to comply with the requirements of 37 CFR 1.57(a).

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202 Cross-Noting

**

202.02 Notation in File History Regarding Prior U.S. Applications, Including Provisional Applications [R-3]

For Image File Wrapper (IFW) processing, see the IFW Manual.**>The front page of a printed patent identifies all prior applications for which benefits are claimed under 35 U.S.C. 119(e), 120, 121, or 365(c) in continuation-in-part, continuation, divisional, substitute, and reissue applications. Therefore, the identifying data of all prior applications for which benefits are claimed should be reviewed by the examiner to ensure that the data is accurate and provided in either the first sentence(s) of the specification or in an application data sheet. See 37 CFR 1.78(a) and MPEP § 201.11. For example, the reference to a prior nonprovisional application must include the appropriate relationship (e.g., continuation, divisional, or continuation-in-part) between the nonprovisional applications.<

The *>front page< of a printed patent issuing on a continued prosecution application (CPA) filed under 37 CFR 1.53(d) will identify the application number and filing date of the most recent noncontinued prosecution application (but not the filing date of the CPA) as well as all **>prior applications< from which *>benefit< was claimed in the most recent noncontinued prosecution application.

Where ** prior application data, including provisional application data, is preprinted ** on the PALM bib-data sheet **, the examiner should check that data for accuracy, including whether the application is, in fact, copending with the *>prior< nonprovisional application or applications *>for< which *>benefit< is claimed. >Similarly, the application number of any provisional application for which benefit is claimed should be printed on the PALM bib-data sheet.< If applicant claims benefit under 35 U.S.C. 119(e) to a prior provisional application, and states that the provisional application claims priority to earlier domestic or foreign application(s), the earlier application(s) should not be reflected on the ** PALM bib-data sheet because a provisional application is not entitled to the right of priority of any other application. See 35 U.S.C. 111(b)(7).

Where the data is correct, the examiner should initial ** the PALM bib-data sheet ** in the provided space. Should there be error in the preprinted *>prior< application data, the ** correction or entry of the data in the PALM data base can be made by technical support staff of the Technology Center. Upon entry of the data, a new PALM bib-data sheet should be printed and **>scanned into< the file.

**

The inclusion of ** prior application information in the *>patent< does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

See MPEP § 306 for work done by the Assignment Division pertaining to these particular types of applications.

In the situation in which there has been no reference to a *>prior< application because the benefit of its filing date is not desired, no notation as to the *>prior< application is made on the ** PALM bib-data sheet **.

202.03 Notation on File Wrapper When Priority Is Claimed for Foreign Application [R-3]

For Image File Wrapper (IFW) processing, see the IFW Manual. A ** PALM bib-data sheet should include the application number, country (or intellectual property authority), day, month, and year of each foreign application that the U.S. application is claiming the *>priority< of. The examiner should check this information for accuracy. Should there be error, the examiner should make the appropriate corrections directly ** on the PALM bib-data sheet, and have the information corrected in the Office computer systems by forwarding the information ** to the examiner's

Legal Instrument Examiner, with an explanation of the correction to be made. The examiner should initial ** the PALM bib-data sheet in the "VERIFIED" space provided when the information is correct or has been amended to be correct. However, the examiner must still indicate on the Office action and ** on the PALM bib-data sheet whether the conditions of 35 U.S.C. 119(a)-(d) or (f) have been met.

If the filing dates of several foreign applications are claimed (see MPEP § 201.15, last paragraph) and **>the certified copy of each foreign application has< been received **, information respecting each of the foreign applications is to be entered ** on the PALM bib-data sheet.

The front page of the patent when it is issued, and the listing in the *Official Gazette*, will refer to the claim of priority, giving the country, the filing date, and the number of the foreign application in those applications in which ** the PALM bib-data sheet has been endorsed.

202.04 In Oath or Declaration [R-2]

As will be noted by reference to MPEP § 201.14, 37 CFR 1.63 requires that the oath or declaration **>must identify any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing, unless such information is supplied on an application data sheet in accordance with 37 CFR 1.76.<
**

203 Status of Applications

203.01 New [R-2]

A "new" application is a nonprovisional *>application< that has not yet received an action by the examiner. An amendment filed prior to the first Office Action does not alter the status of a "new" application.

203.02 Rejected

A nonprovisional application which, during its prosecution in the examining group and before allowance, contains an unanswered examiner's action is designated as a "rejected" application. Its status as a "rejected" application continues as such until acted upon by the applicant in reply to the examiner's action (within the allotted reply period), or until it becomes abandoned.

203.03 Amended [R-2]

An "amended" ** nonprovisional application is one that having been acted on by the examiner, has in turn been acted on by the applicant in reply to the examiner's action. The applicant's reply may be confined to an election, a traverse of the action taken by the examiner or may include an amendment of the application.

203.04 Allowed or in Issue [R-2]

An "allowed" nonprovisional application or an application "in issue" is one which, having been examined, is passed to issue as a patent, subject to payment of the issue fee. Its status as an "allowed" application continues from the date of the notice of allowance until it is withdrawn from issue or until it issues as a patent or becomes abandoned, as provided in 37 CFR 1.316.

The files of allowed applications are kept in the **>Office of Patent Publication. For Image File Wrapper (IFW) processing, see the IFW Manual<.

203.05 Abandoned [R-3]

An abandoned application is, *inter alia*, one which is removed from the Office docket of pending applications:

(A) through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or by the attorney or agent of record;

(B) through failure of applicant to take appropriate action at some stage in the prosecution of a nonprovisional application;

(C) for failure to pay the issue fee (MPEP * § 711 to § 711.05); or

(D) in the case of a provisional application, no later than 12 months after the filing date of the provisional application (see MPEP § 711.03(c) and 35 U.S.C. 111 (b) (5)).

203.06 Incomplete [R-3]

An application **>that is not entitled to a filing date (e.g., for lacking some of the essential parts)< is termed an incomplete application. (MPEP § 506 * and § 601.01(d)-(g)).

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203.08 Status Inquiries [R-2]

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I. < NEW APPLICATION

Current examining procedures now provide for the routine mailing from the Technology Centers (TCs) of Form PTOL-37 in *every* case of allowance of an application. Thus, the mailing of a form PTOL-37 in addition to a formal Notice of Allowance (PTOL-85) in all allowed applications would seem to obviate the need for status inquiries even as a precautionary measure where the applicant may believe his or her new application may have been passed to issue on the first examination. However, as an exception, a status inquiry would be appropriate where a Notice of Allowance is not received within three months from receipt of form PTOL-37.

Current examining procedures also aim to minimize the spread in dates among the various examiner dockets of each art unit and TC with respect to actions on new applications. Accordingly, the dates of the "oldest new applications" appearing in the *Official Gazette* are fairly reliable guides as to the expected time frames of when the examiners reach the applications or action.

Therefore, it should be rarely necessary to query the status of a new application.

>

II. < AMENDED APPLICATIONS

Amended applications are expected to be taken up by the examiner and an action completed within two months of the date the examiner receives the application. Accordingly, a status inquiry is not in order after reply by the attorney until 5 or 6 months have elapsed with no response from the Office.> However, in the event that a six month period has elapsed, and no response from the Office is received, applicant <u>should</u> inquire as to the status of the application to avoid potential abandonment. Applicants are encouraged to use PAIR to make status inquiries. See subsection III below.< A >stamped< postcard receipt for replies to Office actions, adequately and specifically identifying the papers filed, will be considered *prima facie* proof of receipt of such papers. >See MPEP § 503.< Where such proof indicates the timely filing of a reply, the submission of a copy of the postcard with a copy of the reply will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely reply to a final action will obviate the need for a petition to revive only if the reply was in compliance with 37 CFR 1.113.

>

III. < IN GENERAL

>Applicants are encouraged, where appropriate, to check Patent Application Information Retrieval (PAIR) (http://pair.uspto.gov) which provides applicants direct secure access to their own patent application status information, as well as to general patent information publicly available. See MPEP § 1730.< Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Office of Initial Patent Examination* to the TCs for direct action. Such letters will be stamped "Status Letters."

If the correspondent is not entitled to the information, in view of 37 CFR 1.14, he or she should be so informed. For Congressional and other official inquiries, see MPEP § 203.08(a).

Telephone inquiries regarding the status of applications, by persons entitled to the information, should be directed to the TC technical support personnel and not to the examiners **>, since< the technical support personnel can readily provide status information without contacting the examiners.

See also MPEP § 102 regarding status information.

Processing Status Letters by the TCs

(A) All status letters sent to a TC will be delivered to a designated location (e.g., Customer Service Office) within the TC for action. Status requests with respect to PCT applications are to be processed by the PCT Legal Division and should be forwarded to that office for reply. Status information regarding an application identified in a published patent document

should be forwarded to the File Information Unit for reply. See MPEP § 102.

(B) A designated representative of the TC will review the status letter to determine the nature of the request and whether the requester is entitled to receive the requested information. PALM Intranet should be used to determine whether the requester is entitled to the information. If after reviewing the information in PALM it is not clear whether the requester is entitled to receive the information requested, the TC representative should review the application file to resolve the issue.

(C) The TC representative will determine the appropriate reply to the status letter by

(1) using PALM Intranet to determine the status of the application,

(2) reviewing the new application dates within the TC,

(3) reviewing any tracking system for the particular item or action at issue,

(4) discussing the matter with the supervisory patent examiner or the examiner in charge of the application, or

(5) when necessary, reviewing the application file.

The TC representative should discuss the matter with an appropriate resource person in the TC if it is not clear what the reply should be.

(D) The TC representative may reply to a status letter, other than an inquiry directed to an abandoned application, by placing a telephone call to the attorney or agent of record. If the status letter requests a date of expected action, the reply should make clear that the date provided is only an "expected" date of when the examiner will take action on the application. If the requester requests that the Office provide a written reply to the status letter, the reply may be faxed (preferable) or mailed (only if requested) to the correspondence address.

(E) The TC representative will note the reply to the status inquiry on the status letter with the initials of the TC representative and the date that the reply was completed.

(F) All TCs will employ the Status Letter Database to track the progress of the status letters. The TC will retain a record of the reply to the status letter. The record includes the entry of the information concerning the status letter and the reply into the Status Letter Database.

(G) After the information has been entered into the Status Letter Database, the status letter along with the reply must be *>associated< with the application file (including abandoned applications)**.

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

Correspondence and inquiries from the White House, Members of Congress, embassies, and heads of Executive departments and agencies normally are cleared through the Office of International Relations and/or the Office of Congressional Relations.

When persons from the designated official sources request services from the Office, or information regarding the business of the Office, they should, under long-standing instructions, be referred, at least initially, to a staff member in the appropriate office.

This procedure is used so that there will be uniformity in the handling of contacts from the indicated sources, and also so that compliance with directives of the Department of Commerce is attained.

Inquiries referred to in this section such as correspondence from embassies, the Office of the U.S. Trade Representative, and the Department of State should immediately be transmitted to the Director of the Office of International Relations by messenger, and a staff member of that office should be notified by phone that such correspondence has been received. Inquiries referred to in this section, such as correspondence from Congress or the White House, should immediately be transmitted to the Director of the Office of Congressional Relations by messenger, and * a staff member of that office should be notified by phone that such correspondence has been received.

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