



Benefit Claims to Prior Applications

under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)

Prepared by:

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Benefit Claims

under 35 USC §§ 120, 121, and 365(c)

- ◆ Must include a **specific reference** to the prior-filed nonprovisional application in
 - the first sentence of the specification; or
 - the application data sheet (ADS).

Benefit Claims

under 35 USC §§ 120, 121, and 365(c)

- ◆ **Specific reference** to a nonprovisional application requires the following:
 1. Identification of the prior-filed application by **application number; and**
 2. Indication of the **specific relationship** (*i.e.*, continuation, divisional, or continuation-in-part) of the applications;
Exception: If application is a CPA, the request for CPA is the required specific reference, rule 1.53(d)(7)
- ◆ Example 1: “This application is a **continuation of Application No. 10/---**, filed---.”

Benefit Claims to **Multiple Applications**

under 35 USC §§ 120, 121, and 365(c)

- ◆ If the benefit claims involve a chain of nonprovisional applications,
 - the relationship **must** be stated for each application (in the chain) relative to an immediate prior application, as a **continuation, divisional, or continuation-in-part**, to establish copendency throughout the entire chain.

Benefit Claims to **Multiple Applications** *under 35 USC §§ 120, 121, and 365(c)*

- ◆ Example 2: “This application is a continuation of Application No. C, filed ---, which is a divisional of Application No. B, filed ---, which is a continuation-in-part of Application No. A, filed ---.”
- ◆ Example 3: “This application is a continuation-in-part of Application No. C, filed ---, and also a continuation-in-part of Application No. D, filed -- -.”

Benefit Claims to **International (PCT) Applications** *under 35 USC §§ 120, 121, and 365(c)*

- ◆ **Specific reference** to an international application (IA) requires:
 1. Identification of the prior-filed IA by
 - **International application number** and **International filing date**
(not the § 371(c) compliance date); and
 2. Specific **relationship** of the applications.
 - Example 4: “This application is a continuation of International Application No. PCT/US--/---, filed ---.”
 - This example is for a benefit claim to an IA in a “bypass” application.
 - A “bypass” application is a § 111(a) application claiming under § 365(c) the benefit of an IA that did not enter the national stage under § 371.

Benefit Claims to **International (PCT) Applications** *under 35 USC §§ 120, 121, and 365(c)*

- ◆ Example 5: Specific reference to a National Stage (§ 371) Application
 - “This application is a continuation of Application No. 10/--, which is the National Stage of International Application No. PCT/US--/---, filed ---.”

Note: **§371(c) compliance date should NOT be given.**

- ◆ Example 6: Specific reference to an IA which claims the benefit of a prior U.S. Nonprovisional Application:
 - “This application is a continuation of International Application No. PCT/US--/---, filed ---, which is a continuation of U.S. Application No. 10/---, filed ---.”

Benefit Claims to **Provisional Applications**

under 35 USC § 119(e)

- ◆ Must include a **specific reference** to the prior-filed provisional application in the first sentence of the specification or an ADS.
- ◆ **Specific reference** requires:
 - **Only the identification of the prior provisional application by the application number.**
 - **No relationship** between the subject nonprovisional application and the provisional application should be specified.
 - Example 7: “This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---.”

Benefit Claims to **Provisional via Intermediate Nonprovisional Application**

under 35 USC §§ 120, 365(c) & 119(e)

- ◆ If the subject application is not filed within 12 months from the filing date of the provisional application, the **specific reference** must identify:
 - An **intermediate nonprovisional** application that is directly claiming the benefit of the provisional application; and
 - The **relationship** between the nonprovisional applications.
 - Example 8: “This application is a **continuation of Application** No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---.”

Benefit Claims to **Provisional via Intermediate IA** *under 35 USC §§ 120, 365(c) & 119(e)*

- ◆ Example 9: Specific reference to claim the benefit of a provisional application via an IA.
 - “This application is a continuation of International Application No. PCT/US--/---, filed ---, which claims the benefit of Provisional Application No. 60/---, filed ---.”

- ◆ Example 10: Specific reference to claim the benefit of a provisional application via a National Stage (§ 371) Application
 - “This application is a continuation of Application No. 10/--, which is the National Stage of International Application No. PCT/US--/---, filed ---, which claims the benefit of Provisional Application No. 60/---, filed ---.”

Impact of Failure to Make Proper Benefit Claims

- ◆ Failure to **timely** submit the **specific reference** is considered a waiver of any benefit claim unless a petition under 37 CFR 1.78(a) and surcharge are filed.
- ◆ The Office may not be able to publish applications promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought.
- ◆ The publication may not include accurate benefit claims to determine the prior art date under 35 USC § 102(e).

Notification of the Failure to Make Proper Benefit Claims

- ◆ The Office plans to notify applicants on, or with, the **filing receipt** that a benefit claim may not have been recognized because it did **not** include the proper **specific reference**.
- ◆ The **filing receipt** is usually provided shortly after the filing of the application so applicants should have sufficient opportunity to submit the proper benefit claim within the time period set in rule 1.78(a).
- ◆ Applicants should **carefully and promptly review filing receipts** in order to avoid the need to submit a petition under rule 1.78(a) and surcharge under rule 1.17(t).

Timely Correction of Benefit Claims

- ◆ Within the time period of 37 CFR 1.78(a)*, applicant may correct benefit claims by filing:
 - A request for corrected filing receipt, and
 - The Required **specific reference**
 - Via an amendment to the specification, or an application data sheet (ADS) (see slide 2); or
 - If previously submitted, a copy of the amendment or ADS.

*The later of four months from the actual filing date or the date on which the national stage commenced, or sixteen months from the filing date of the prior-filed application.

Untimely Correction of Benefit Claims

- ◆ After the time period of rule 1.78(a) has expired, applicant may petition to correct benefit claims by filing:
 - A **petition** to accept an **unintentionally** delayed claim under rule 1.78(a) and the **surcharge** under rule 1.17(t), and
 - The required **specific reference** (including the relationship of the nonprovisional applications and identification of any intermediate application which directly claims the benefit of the provisional application).
 - Note: any benefit claim under 35 USC § 119(e) must be submitted during the pendency of the instant nonprovisional application.

Prior Applications Also Must Include Specific Reference

◆ **Each intermediate** prior application must have **specific reference** to other prior applications.

- For example, this 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 ---.”

will only be effective if:

- Application No. C actually includes a proper benefit claim to Application No. B and Provisional Application No. A; and
- Application No. B actually includes a proper benefit claim to Provisional Application No. A.

Adding an Incorporation-By-Reference

- ◆ After the filing of an application, adding an incorporation-by-reference statement in a benefit claim is not permitted.
 - No new matter can be added to an application after its filing date.
 - See 35 USC § 132(a) and *Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ (CADDC 1980).
 - The Office will not accept a specific reference that includes an incorporation-by-reference statement of a prior application, unless such statement was submitted on filing of the application.

Appendix: Examples of Benefit Claims under 35 USC §§ 120, 121, and 365(c)

- ◆ Ex. 1: Specific reference to a nonprovisional application.
 - “This application is a continuation of Application No. 10/---, filed---.”
- ◆ Ex. 2: Specific reference to multiple nonprovisional applications.
 - “This application is a continuation of Application No. C, filed ---, which is a divisional of Application No. B, filed ---, which is a continuation-in-part of Application No. A, filed ---.”
- ◆ Ex. 3: Specific reference to multiple nonprovisional applications.
 - “This application is a continuation-in-part of Application No. C, filed ---, and also a continuation-in-part of Application No. D, filed ---.”

Appendix: Examples of Benefit Claims under 35 USC §§ 120, 121, and 365(c)

- ◆ Ex. 4: Specific reference to an IA.
 - “This application is a continuation of International Application No. PCT/US--/---, filed ---.”
- ◆ Ex. 5: Specific reference to a NS (§ 371) application
 - “This application is a continuation of Application No. 10/-- -, which is the National Stage of International Application No. PCT/US--/---, filed ---.”

Note: **§371(c) compliance date should NOT be given.**
- ◆ Ex. 6: Specific reference to an IA which claims the benefit of a prior U.S. Nonprovisional Application:
 - “This application is a continuation of International Application No. PCT/US--/---, filed ---, which is a continuation of U.S. Application No. 10/---, filed ---.”

Appendix: Examples of Benefit Claims under 35 USC §§ 120, 121, and 365(c)

- ◆ Ex. 7: Specific reference to claim the benefit of a provisional application when the subject application is filed within 12 months from the filing date of the provisional application.
 - “This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---.”
- ◆ Ex. 8: Specific reference to claim the benefit of a provisional application via a nonprovisional application.
 - “This application is a **continuation of Application** No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---.”

Appendix: Examples of Benefit Claims under 35 USC §§ 120, 121, and 365(c)

- ◆ Ex. 9: Specific reference to claim the benefit of a provisional application via an IA.
 - “This application is a continuation of International Application No. PCT/US--/---, filed ---, which claims the benefit of Provisional Application No. 60/---, filed ---.”

- ◆ Ex. 10: Specific reference to claim the benefit of a provisional application via a National Stage (§ 371) Application
 - “This application is a continuation of Application No. 10/-- -, which is the National Stage of International Application No. PCT/US--/---, filed ---, which claims the benefit of Provisional Application No. 60/---, filed ---.”

For Further Information...

Office of Patent Legal Administration – (703) 308-6906 or e-mail to Patent_Practice@USPTO.gov

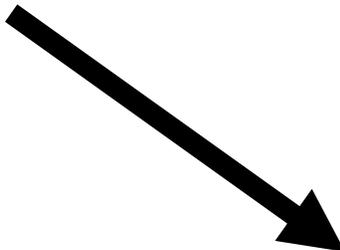
- ◆ **Amendment Practice** – Elizabeth Dougherty 306-3156 or Joe Narcavage 305-1795
- ◆ **Patent Term Adjustment (PTA)**- Kery Fries 308-0687
- ◆ **Eighteen-Month Publication** – Mark Polutta 308-8122
- ◆ **Provisional Applications**- Fred Silverberg 305-8986
- ◆ **Reexamination**- Jerry Dost 305-8610 or Ken Schor 308-6710
- ◆ **Reissue**- Joe Narcavage 305-1795
- ◆ **RCEs & CPAs**- Gena Jones 306-5586 or Joni Chang 308-3858
- ◆ **Sections 102(e), 102(g) and/or 103(c)** - Robert Clarke 305-9177, Mark Polutta 308-8122 or Jeanne Clark 306-5603
- ◆ **Electronic Filing, CDs** – Michael Lewis 305-5585 or Jay Lucas 308-6868

For Further Information...

- ◆ **The American Inventors Protection Act of 1999 in general-**
<http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>
- ◆ **The Patent Business Goals rule change in general-**
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The screenshot shows the USPTO website's 'News & Notices' page. At the top, there is a navigation bar with links for Home, Index, Search, System Alerts, eBusiness Center, News & Notices, and Contact Us. Below this is the USPTO logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. The main heading is 'News & Notices' with the phone number 'Office of Public Affairs: 703.305.8341'. A secondary navigation bar includes 'Event Calendar', 'Activities & Education', 'Job Opportunities', 'Vendor Opportunities', and 'Press Release Archives'. The main content area is divided into 'Public Notices' and 'Announcements & Press Releases'. Under 'Public Notices', there are links for 'Official Gazette (OG)' and 'Federal Register' (with a note that all FR files are PDF). Under 'Announcements & Press Releases', there are four columns: 'General', 'Patents', and 'Trademarks'. The 'General' column has a highlighted box around the link 'Notices Related to Security Issues and/or Emergencies'. Below this link are two bullet points: 'Under Secretary James Rogan Discusses Intellectual Property Issues With American Industry Leaders During Visit to Mexico (27Feb2003)' and 'USPTO Releases List of Top 10 Universities'. The 'Patents' column has two bullet points: 'Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121, and 365(c) (26Feb2003) [PDF]' and 'Amendments in a Revised Format Now Permitted (signed 1/31/03) [more information] (31Jan2003)'. The 'Trademarks' column has three bullet points: 'Increase in Trademark Filing Fee (12Dec2002)', 'Documents in Trademark Disputes Can Be Filed Online (06Dec2002)', and 'Trademark Public Advisory Annual Report (FY2002) (05Dec2002)'. A fourth bullet point, 'Transcript of the August 14, 2002 public meeting of', is partially visible at the bottom.

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