

**Comparison of CPA practice, URAA transitional practice under 37 CFR 1.129(a),
and new request for continued examination (RCE) practice**

	Continued prosecution application (CPA) under 37 CFR 1.53(d)	URAA transitional practice under 37 CFR 1.129(a)	Request for continued examination (RCE) under 37 CFR 1.114
1	CPA practice is not applicable to provisional applications or during reexamination Note: CPA practice has been made inapplicable to any utility or original plant applications filed on or after May 29, 2000 (including reissue)	37 CFR 1.129(a) practice is applicable only to original utility or original plant applications filed before or on June 8, 1995, and which have been pending for at least two years as of June 8, 1995 (date-wise virtual mutual exclusivity with RCE practice)	RCE practice is not applicable to provisional applications, design applications, applications filed before June 8, 1995, or during reexamination
2	A CPA may be filed before the prosecution in an application is closed	A submission under 37 CFR 1.129(a) must be filed after final rejection and before an appeal brief is filed	After August 16, 2000, a RCE must be filed after the prosecution in an application is closed
3	Statutory authority: 35 U.S.C. §§ 111(a), 120, and 121	Statutory authority: Section 532(a)(2)(A) of Pub. L. 103-465 (uncodified)	Statutory authority: 35 U.S.C. § 132(b)
4	The Office treats a CPA as continued examination of the same application, but it is technically/legally a new application	Further examination under 37 CFR 1.129(a) is in fact continued examination of the same application	A RCE is in fact continued examination of the same application
5	The applicant may defer paying the filing fee for a CPA under 37 CFR 1.53(g)	The applicant may not defer paying the fee for a submission under 37 CFR 1.129(a)	The applicant may not defer paying the fee for a RCE
6	The fee for a CPA must be the statutory filing fee: basic filing fee plus any applicable excess claims fees (even if previously paid in the prior application)	The Office sets the fee (fee need not include excess claims fee for claims previously paid for): the fee is set at an amount equal to the basic filing fee of a utility application (small entity reduction is available)	The Office sets the fee for a RCE (RCE fee need not include excess claims fee for claims previously paid for): the RCE fee is set at an amount equal to the basic filing fee of a utility application (small entity reduction is available)
	Continued prosecution application (CPA) under 37 CFR 1.53(d)	URAA transitional practice under 37 CFR 1.129(a)	Request for continued examination (RCE) under 37 CFR 1.114
7	A patent issuing on a CPA filed on or after May 29, 2000,	An application that is eligible for the transitional practice of 37 CFR	Filing a RCE on or after May 29, 2000, will not cause an application

	<p>is entitled to the patent term adjustment provisions of the AIPA, regardless of the filing date of any prior application of the CPA</p> <p>A patent issuing on a CPA is not entitled to any patent term adjustment accumulated during prosecution of any prior application of the CPA</p>	<p>1.129(a) is not entitled to the patent term adjustment provisions of the AIPA</p>	<p>to be entitled to the patent term adjustment provisions of the AIPA</p> <p>If an application is entitled to the patent term adjustment provisions of the AIPA (<i>i.e.</i>, was itself filed on or after May 29, 2000), filing a RCE cuts-off the applicant's ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment</p>
8	No limit on the number of times an applicant may file a CPA to obtain continued examination	An applicant may have only two (2) submissions entered as a matter of right under 37 CFR 1.129(a)	No limit on the number of times an applicant may file a RCE to obtain continued examination
9	A CPA is not entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8	A submission under 37 CFR 1.129(a) is entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8	A RCE is entitled to the benefit of a Certificate of Mailing under 37 CFR 1.8
10	Applicants may file a continuation or divisional CPA, but not a CIP CPA	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)	Applicants may not switch inventions (divisional equivalent) as a matter of right or add new matter (CIP equivalent)
11	A CPA abandons the (previously) pending application: appeals to the BPAI or courts in the prior application become moot automatically	A submission under 37 CFR 1.129(a) does not abandon the (previously and currently) pending application: no appeal issues because Office requires such submission to be filed before an appeal (to BPAI) brief is filed	A RCE does not abandon the (previously and currently) pending application: appeals to the BPAI are dismissed by operation of 37 CFR 1.114 but any pending court action must be dismissed to restore jurisdiction over the application to the Office
	Continued prosecution application (CPA) under 37 CFR 1.53(d)	URAA transitional practice under 37 CFR 1.129(a)	Request for continued examination (RCE) under 37 CFR 1.114
12	Inventorship carries over unless the applicant provides a statement deleting inventors	Inventorship carries/continues: any change must be via 37 CFR 1.48	Inventorship carries/continues: any change must be via 37 CFR 1.48
13	Small entity status does not carry (but can be claimed by reference to status in prior application or payment of small entity filing fee)	Small entity status carries/continues	Small entity status carries/continues

14	A CPA accompanied by an amendment (preliminary) cancelling all claims makes the CPA improper (not entitled to a filing date)	Submission under 37 CFR 1.129(a) accompanied by an amendment cancelling all claims is simply a non-responsive amendment	RCE accompanied by an amendment cancelling all claims is simply a non-responsive amendment
15	Submission need not include a reply that is a <i>bona fide</i> attempt to advance the application	Submission must include a reply that is a <i>bona fide</i> attempt to advance the application (37 CFR 1.111)	Submission must include a reply that is a <i>bona fide</i> attempt to advance the application (37 CFR 1.111) if a reply to an Office action is outstanding
16	A CPA filed on or after November 29, 2000, will be subject to the eighteen-month publication provisions of the AIPA, and the changes to 35 U.S.C. § 102(e)	Submission on or after November 29, 2000, does not subject application to the eighteen-month publication provisions of the AIPA or the changes to 35 U.S.C. § 102(e); voluntary publication may be requested	Submission on or after November 29, 2000, does not subject application to the eighteen-month publication provisions of the AIPA or the changes to 35 U.S.C. § 102(e); voluntary publication may be requested
17	A CPA based on the national stage of an international application is an application filed under 35 U.S.C. § 111(a) and thus it is subject to restriction practice in accordance with 37 CFR 1.141-1.146	If a submission is filed in a national stage application under 35 U.S.C. § 371, the application is still subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499	If a submission is filed in a national stage application under 35 U.S.C. § 371, the application is still subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499