

Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)

Summary: This notice clarifies how benefit claims under 35 U.S.C. §§ 119(e), 120, 121 and 365(c) must be presented in applications in order to be in compliance with the relevant statute and patent regulations, and accepted by the United States Patent and Trademark Office (Office).

35 U.S.C. § 120 Benefit Claims

Benefit claims under 35 U.S.C. § 120 must include a specific reference to the earlier filed (nonprovisional) application for which a benefit is sought. A “specific reference” requires: (1) the identification of the prior (nonprovisional) application by **application number**; and (2) an indication of the **relationship** between the nonprovisional applications, except for the benefit claim to the prior application in a continued prosecution application (CPA). The relationship between any two nonprovisional applications will be an indication that the later-filed nonprovisional application is either a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application. When there are benefit claims to multiple prior nonprovisional applications (*e.g.*, a string of prior nonprovisional applications), the relationship must include an identification of **each** nonprovisional application as either a continuation, divisional, or continuation-in-part application of a specific prior nonprovisional application for which a benefit is claimed. The identification is needed in order to be able to verify if copendency exists throughout the entire chain of prior nonprovisional applications.

35 U.S.C. § 119(e) Benefit Claims

Benefit claims under 35 U.S.C. § 119(e) must include a specific reference to the earlier filed provisional application for which a benefit is sought. A specific reference in this situation, however, only requires identification of the prior provisional application by the application number. No relationship between the subject nonprovisional application and the prior provisional application should be specified. If the subject nonprovisional application was not filed within twelve months of the filing date of the provisional application, the subject application must also include a benefit claim under 35 U.S.C. § 120 to an intermediate prior nonprovisional application that was filed within twelve months of the filing date of the provisional application. Therefore, in addition to the identification of the provisional application, the proper benefit claim for this situation must also identify the intermediate prior nonprovisional application that is directly claiming the benefit of the provisional application, and indicate the relationship between the nonprovisional applications (*e.g.*, an indication that the subject application is a continuation of the intermediate prior nonprovisional application).

Statement of the Problem

Background: Some applicants have been submitting patent applications which include, or are amended to include, at the beginning of the specification, a statement that benefits

are claimed under 35 U.S.C. §§ 119(e) and/or 120 to prior applications, followed by a listing of many prior nonprovisional and provisional applications. The listings do not indicate: (1) the specific relationship (i.e., continuation, divisional, or continuation-in-part) between the nonprovisional applications, as required by 37 CFR 1.78(a)(2)(i); and/or (2) each nonprovisional application which is directly claiming priority to a provisional application. Without such information, the Office does not have sufficient information to enter the benefit claims into the Office's computer database.

When entering benefit claims for an application into the Office's database, the relationship (i.e., continuation, divisional or continuation-in-part) between the nonprovisional applications is required. Further, the system will not accept any benefit claim to a provisional application if the provisional application was filed more than twelve months prior to the filing date of the subject application, unless the applicant clearly identifies, and claims the benefit of, a prior nonprovisional application that was filed within twelve months of the filing date of the provisional application. Accordingly, if benefit claims are presented without all the required information, the Office will not be able to enter such benefit claims into the Office's database, the filing receipt will not reflect the prior application(s), and the projected publication date will not be calculated as a function of an earlier application's filing date.

The specific relationships between (each of) the nonprovisional applications in a chain of nonprovisional applications are also important because such information will be printed in the application publication, and/or patent. Furthermore, the designation of an application as a continuation (rather than as a continuation-in-part) is an indication that the entire invention claimed in an application has support in the prior application, whereas the designation of an application as a continuation-in-part is an indication that the claimed invention is not entirely supported by the prior application. Thus, the specific relationship between nonprovisional applications in a chain of benefit claims, and the indication of the specific nonprovisional application(s) that is directly claiming the benefit of a provisional application, will provide the information that is needed by examiners and the public in order to determine the effective prior art date of the application publication, or patent, under 35 U.S.C. § 102(e).

When benefit claims are required to, but do not, include: (1) an identification of (all) intermediate benefit claims, and/or (2) the relationship between nonprovisional applications, 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 under title 35, United States Code (eighteen-month publication), nor have the accuracy desired of such benefit claims in application publications. Further, the objection (by the Office), correction (by applicant), and review/entry of changes (by the Office) cycle for non-compliant benefit claims is a burdensome effort on both applicants and the Office that can be totally avoided if such benefit claims are properly submitted the first time. Accordingly, it is hoped that applicants will submit benefit claims with all the required information as set forth in this notice and, correspondingly, avoid submitting non-compliant benefit claims that leads to extra work for both the Office and applicants.

Procedures for Making Proper Benefit Claims

Part I: Reference to Prior Nonprovisional Application(s) Per 37 CFR 1.78(a)(2)(i) Must Include Identification of, and Relationship Between, Applications

35 U.S.C. § 120 provides that no application shall be entitled to the benefit of an earlier filed application unless it contains, or is amended to contain, a specific reference to the earlier filed application. The specific reference required by 35 U.S.C. § 120 is the reference required by 37 CFR 1.78(a)(2). **37 CFR 1.78(a)(2)(i) requires** that any nonprovisional application that claims the benefit of one or more prior-filed copending nonprovisional applications, or international applications designating the United States, 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**. 37 CFR 1.78(a)(2)(iv) also provides that a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) is the specific reference required under 35 U.S.C. § 120 to the prior-filed application. **Therefore**, except for the benefit claim to the prior-filed application in a CPA, **benefit claims** under 35 U.S.C. § 120, including claims under 35 U.S.C. §§ 121 and 365(c), **must not only identify the earlier application by application number**, or by international application number and international filing date, **but they must also indicate the relationship between the applications**.

Examples

The **relationship** between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: “This application is a continuation of Application No. 10/---, filed ---.” A benefit claim that merely states: “This application claims the benefit of Application No. 10/---, filed ---.” does not comply with 37 CFR 1.78(a)(2)(i), since the **relationship** between the applications is not stated. In addition, a benefit claim that merely states: “This application is a continuing application of Application No. 10/---, filed ---.” does not comply with 37 CFR 1.78(a)(2)(i) since the proper **relationship**, which **includes the type of continuing application**, is not stated. It is also noted that the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. An example of a proper benefit claim of a prior national stage of an international application is “This application is a continuation of U.S. Application No. X, which is the National Stage of International Application No. PCT/US--/---, filed ---.” For additional examples of proper benefit claims, see Manual of Patent Examining Procedure (8th ed., August 2001)(MPEP), Section 201.11, Reference to First Application. Section 201.11 of the MPEP will be revised in the upcoming revision to reflect the clarification made in this notice about the required manner of making proper claims for the benefit of prior nonprovisional and provisional applications.

As stated previously, to specify the relationship between the nonprovisional applications, applicant must specify whether the subject application is a continuation, divisional, or continuation-in-part of the prior nonprovisional 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 parent application. Moreover, if the benefit of more than one nonprovisional parent application is claimed, the relationship must include an identification of each nonprovisional application as a continuation, divisional, or continuation-in-part application of the immediate prior nonprovisional application for which a benefit is claimed in order to establish co-dependency throughout the entire chain of prior-filed parent nonprovisional applications. For example, the following two statements are improper: “This application claims the benefit of Application Nos. C, B, and A.” and “This application is a continuing application of Application Nos. C, B, and A.” On the other hand, the following statement is proper and acceptable: “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 ---.”

Sanctions for Making Improper Benefit Claims to Nonprovisional Applications

Any benefit claim under 35 U.S.C. § 120, 121 or 365(c) that does not identify a prior application **and also specify a relationship between each of the applications** will not be in compliance with 37 CFR 1.78(a)(2)(i), and will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. § 120. Such a benefit claim will not be recognized by the Office and will not be included on the filing receipt for the application, even if the claim appears in the first sentence of the specification or an application data sheet (37 CFR 1.76), because the Office does not have sufficient information to enter the benefit claim into the Office’s database. As a result, publication of the application will not be scheduled as a function of the prior application’s filing date. 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 reference. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided to the applicant shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a)(2)(ii) and thus avoid the need to submit a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t). Failure to timely submit the reference required by 37 CFR 1.78(a)(2)(i) is considered a waiver of any benefit claim under 35 U.S.C. § 120, 121 or 365(c) unless a petition to accept an unintentionally delayed claim under 37 CFR 1.78(a)(3), the surcharge set forth in 37 CFR 1.17(t), and the required reference, **including the relationship of the applications** (unless previously submitted) are filed. For example, if a benefit claim is submitted without the specific relationship between the nonprovisional applications before the expiration of the period, and the specific relationship between the nonprovisional applications is subsequently submitted after the expiration of the period, a petition and the surcharge would be required.

Part II: Reference to Prior Provisional Application(s) Per 37 CFR 1.78(a)(5)(i) Should Only Include Identification of Prior Provisional Application(s)

When the domestic benefit of a prior provisional application is being claimed under 35 U.S.C. § 119(e), however, the relationship between the two applications should **not** be specified. 35 U.S.C. § 119(e) provides that a nonprovisional application claiming the benefit of a provisional application must be filed within twelve months of the provisional application and must contain, or be amended to contain, a specific reference to the provisional application. The specific reference required by 35 U.S.C. § 119(e) is the reference required by 37 CFR 1.78(a)(5). 37 CFR 1.78(a)(5)(i) requires that any nonprovisional application, or international application designating the United States, 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 provisional application number. **No relationship should be specified whenever a claim for the benefit of a provisional application under 35 U.S.C. § 119(e) is made.**

If a relationship between a nonprovisional application and a prior provisional application is submitted, however, it may be unclear whether applicant wishes to claim the domestic benefit of the provisional application under 35 U.S.C. § 119(e), or the benefit of an earlier application's filing date under 35 U.S.C. § 120. Thus, applicants seeking to claim the domestic benefit of a provisional application under 35 U.S.C. § 119(e) should not state that the application is a "continuation" of a provisional application, nor should it be stated that the application claims benefit under 35 U.S.C. § 120 of a provisional application. If such a claim is submitted in an application transmitted to the Office other than through the Electronic Filing System, it will be entered into the Office computer system as a claim to the "benefit" of the provisional application. Although 35 U.S.C. § 120 does not preclude a benefit claim to a provisional application (that is, one could obtain the benefit under 35 U.S.C. § 120 of a prior filed provisional application), such a benefit claim under 35 U.S.C. § 120 is **not** recommended as such a claim may 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). Instead, applicants should state "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---", or "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application 60/---, filed ---." See MPEP § 201.11, Reference to First Application (8th ed., August 2001).

Part III: If Benefit is Claimed of a Prior Provisional Application Which was Filed More Than One Year Before the Subject Application, Then Each Prior Nonprovisional Application(s) Claiming Benefit of the Provisional Must be Specified

Any nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. § 119(e) must be filed within twelve months from the filing date of the provisional application. As noted above, an application that itself directly claims the benefit of a provisional application should identify, but not specify the relationship to, the provisional application. If the subject nonprovisional application is not filed within the twelve month period, however, it still may claim the benefit of the provisional application via an intermediate nonprovisional application under 35 U.S.C. § 120. The intermediate nonprovisional application must have been filed within twelve months from the filing date of the provisional application and the intermediate

nonprovisional application must have claimed the benefit of the provisional application. Further, it must be clearly indicated that the intermediate nonprovisional application is claiming the benefit under 35 U.S.C. § 119(e) of the provisional application. This identification of the intermediate nonprovisional application is necessary so that the Office can determine whether the intermediate nonprovisional application was filed within twelve months of the filing date of the provisional application, and thus, whether the benefit claim is proper.

Examples

Applicant should state such a benefit claim as follows: “This application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of U.S. Provisional Application No. A, filed ---.” A benefit claim that merely states “This application claims the benefit of nonprovisional Application No. C, filed ---, nonprovisional Application No. B, filed ---, and provisional application No. A, filed ---” would be improper where the subject application was not filed within twelve months of the provisional application.

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 clearly indicated. Applicant should 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 U.S. Provisional Application No. B, filed ---, and Application No. C claims the benefit of U.S. Provisional Application No. A, filed ---.” An example of a proper benefit claim of a prior national stage of an international application, which claims the priority to a provisional application, is “This application is a continuation of U.S. Application No. Y, which is the National Stage of International Application No. PCT/US--/--, filed ---, which claims the benefit under 35 U.S.C. § 119(e) of U.S. Provisional Application X, filed ---.”

Sanctions for Making Improper Benefit Claims to Provisional Applications

If a benefit claim to a provisional application is submitted without an indication that an intermediate nonprovisional application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the twelve month period, or the relationship between nonprovisional applications is not indicated, the Office will not have sufficient information to enter the benefit claim into the computer database. Therefore, the Office will **not** recognize such a benefit claim, and will not include the benefit claim on the filing receipt. The Office plans to notify applicants on, or with, the filing receipt that a benefit claim may not have been recognized because information regarding the intermediate nonprovisional application(s) and/or the relationship between each nonprovisional application have not been provided. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided to the applicant shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a) and thus avoid the need to submit a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t). Failure to timely submit the

reference required by 37 CFR 1.78(a) is considered a waiver of any benefit claim under 35 U.S.C. § 119(e), 120, 121 or 365(c) unless a petition under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), identification of the intermediate nonprovisional application which claims the benefit to the provisional application, and the relationship between each nonprovisional application are filed.

Part IV: Office Practice to Not Require Petition and Surcharge if Benefit Claim is Not Present in the Proper Place But is Recognized By Office Continues But Applicants Are Advised That Proper Reference Must be Presented

The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title. Previously, the Office indicated that 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 included elsewhere in the application and not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition and the surcharge to correct the claim. See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication Provisions, 66 Fed. Reg. 67087, 67089-90 (Dec. 28, 2001). The Office will continue to follow this practice.

Sanctions for Making Improper Benefit Claims

Applicants are simply being advised by this notice that the Office will 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 a provisional application. Applicants are also reminded that, even if the Office has recognized a benefit claim that includes the proper reference 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) and/or 35 U.S.C. § 120, and 37 CFR 1.78, unless the reference is included in an application data sheet, or the first sentence of the specification, and all other requirements are met.

Part V: 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 a proper reference to the prior application(s) is included in the first sentence of the specification, or an application data sheet, within the time period required by 37 CFR 1.78(a). Any request for corrected filing receipt to include a corrected or added benefit claim must be submitted within the time period required by 37 CFR 1.78(a) and be accompanied by an amendment to the specification, or an application data sheet. If the proper reference was previously submitted, a copy of the amendment, the first page

of the specification, or the application data sheet, containing the claim should be included with the request for 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 it did not include the proper reference. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a) and thus avoid the need to submit a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t). **Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition and the surcharge.**

When an unintentionally delayed benefit claim is submitted with a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t), the benefit claim must include a proper reference to the prior application(s) in order for the petition to be granted. The reference to the prior application(s) must include: (1) the relationship between nonprovisional applications (*i.e.*, continuation, divisional, or continuation-in-part), and (2) the indication of any intermediate application that is directly claiming the benefit of a provisional application, in order to establish copendency throughout the entire chain of prior applications.

Applicants are also reminded that, if an amendment to the specification, or an application data sheet (ADS), is submitted in an application under final rejection, the amendment or ADS must be in compliance with 37 CFR 1.116. The amendment or ADS filed in an application under final rejection will not be entered as a matter of right. See MPEP §§ 714.12 and 714.13. Therefore, applicants should consider filing a request for continued examination (RCE) (including fee and submission) under 37 CFR 1.114 with the petition to accept an unintentionally delayed benefit claim, the surcharge, and an amendment that adds the proper reference to the first sentence of the specification or an ADS.

Part VI: Each Intermediate Prior Application Must Have Proper Reference

If the benefit of more than one prior application is claimed, applicant should also make sure that the proper references are made in each intermediate nonprovisional 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 U.S. Provisional Application No. A, filed ---,” then Application No. C must include a benefit claim containing a reference to Application No. B and provisional Application No. A, and Application No. B must include a benefit claim containing a reference to provisional Application No. A.

Part VII: Adding an Incorporation-By-Reference Statement in a Benefit Claim is Not Permitted After Filing

An incorporation-by-reference statement added after the filing date of an application is not permitted 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. See *Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Therefore, the Office will not grant a petition to accept a benefit claim that includes an incorporation-by-reference statement of a prior application, unless the incorporation-by-reference statement was submitted on filing of the application.

Inquiries regarding this notice should be directed to Eugenia A. Jones or Joni Y. Chang, Legal Advisors, Office of Patent Legal Administration, by telephone at (703) 305-1622.

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